

-----Original Message-----

From: Info [mailto:Info@mcpickering.com]

Sent: Thursday, April 27, 2006 2:53 PM

To: AB93Comments

Subject: Changes in Continuation Practice

Dear Sirs:

I am writing to request that the Commissioner modify and clarify the proposed changes to the continuation practice. The proposed rule changes do not prohibit continuations, but require a petition and fee should an applicant need to file more than one continuation. There are three common reasons to file more than one continuation: 1) submission of new art from a foreign search or a related case; 2) submission of an amendment in response to new arguments presented by the Examiner (based on existing or new art); and 3) submission of new or amended claims without new arguments from the Examiner.

Submission of New Art/Submission of an Amendment in Response to New Arguments Presented By the Examiner

It is assumed that the proposed standard for granting a petition would allow an applicant to file a continuation to submit new art from a foreign search or a related case, and to file an amendment in response to new arguments presented by the Examiner. However, it is unclear why the proposed changes require the applicant to pay a petition fee in these cases as the applicant does not appear to be at fault in either instance.

For example, if an applicant submits claims with a scope equal to or narrower than the broadest claim previously presented, distinguishes the claim from the arguments of record, and the Examiner finally rejects the claim based on new arguments (or provides new arguments in an Answer during appeal), it is unclear why the applicant should pay a petition fee to continue examination if the applicant finds the Examiner's new arguments persuasive, but also believes that the Examiner's new arguments can be overcome with an amendment.

In this example, the applicant does not appear to be at fault because the applicant has not previously had an opportunity to respond to the new arguments. As a result, I respectfully request that the Commissioner modify the proposed rules to not require a petition fee to submit new art from a foreign search or a related case, or to submit an amendment in response to new arguments presented by the Examiner.

Submission of New or Amended Claims without New Arguments from the Examiner

It is unclear whether the proposed standard for granting a petition would allow an applicant to file a continuation if the applicant wishes to submit new or amended claims without new arguments from the Examiner. There are many reasons why an applicant may wish to submit new or amended claims in a second or subsequent continuation without new arguments from the Examiner.

A practitioner may have just realized that they have not claimed all that the applicant is entitled to claim. A practitioner may have just concluded that a different word or phrase provides broader coverage, different coverage, or more accurately recites the invention. A practitioner may have just understood the arguments and distinctions made by the Examiner, and realized that a further amendment is necessary.

Although practitioners seek to present a comprehensive claim set with each paper, an appreciation of the full scope of an invention with respect to the art is not always readily achievable. Thus, the loss of the ability to file second and subsequent continuations to add or amend claims could lead an applicant to lose valuable patent rights.

As is often the case, the interests of the parties must be balanced to reach a fair decision. In the present situation, on the one hand, the Office seeks to improve the backlog by restricting continuation practice. On the other hand, an applicant may potentially lose valuable patent rights as a result of not being able to file new or amended claims in a second or subsequent continuation.

On balance, the competing equities would not seem to favor restricting a second or subsequent continuation that adds or amends the claims. The improved administrative efficiency that the Office may realize from denying a second or subsequent continuation to add or amend claims does not outweigh the irreparable harm that an applicant may experience due to the loss of patent rights. This is particularly the case when there are ways of addressing the backlog that do not risk any potential loss of rights. For example, the Office can reduce the backlog by hiring and retaining more Examiners to meet the growing case load.

Further, reissue practice is not a substitute for granting continued prosecution. Reissue practice is quite limited and does not allow a patent holder the same freedom to prosecute the application as can be obtained in a continuation. Since an applicant can not obtain the same range of claims in a reissue as can be obtained in a continuation, a reissue can not be considered to be a substitute for a continuation. As a result, an applicant forced into a reissue rather than a continuation may still experience irreparable harm due to the inability to obtain the same claims that could be obtained in a continuation.

Thus, since an appreciation of the full scope of an invention with respect to the art is not always readily achievable, even with diligent effort, the balance of equities do not favor restricting continuation practice when alternate approaches exist for addressing the backlog that do not involve the potential loss of valuable patent rights, and reissue is not a substitute for a continuation, I respectfully request that the Commissioner clarify the standard with respect to adding or amending claims in a second or subsequent continuation without new arguments from the Examiner, and urge the Commissioner to grant petitions in these instances.

Respectfully submitted,
Mark C. Pickering