

**From:** Henderson, Ron [mailto:Ron.Henderson@btlaw.com]  
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**To:** patent\_quality\_comments  
**Subject:** Comments Pertaining to Category 3-Pendency

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The comments offered represent the respondent's own personal views and not those of Barnes & Thornburg LLP.

I have 4 comments pertaining to Pendency as follows:

1. Establish a "Purgatory Continuation" that is only examined after the filing of a Request for Examination paper. Many of our large corporate clients wish to keep their subject matter pending for long periods of time while the products disclosed in their patent applications are being commercialized. This leads to long continuing application chains in which subsequent applications become allowed but yet the client still wishes to keep the subject matter pending. My proposal is to establish a Purgatory Continuation, which is a second or subsequent application that is filed, but that is never examined unless the applicant asks for it to be examined. Such an application could have a fairly hefty filing fee such as \$3,000 to \$4,000. Because the Fed. Cir. has stated that 14 years of pendency is too long and amounts to prosecution laches, then having the Purgatory Continuation go abandoned automatically at that point would be appropriate. Such a continuation would reduce the amount of applications that the USPTO would actually have to examine because they would just remain pending. The USPTO would receive a large amount of fees, but would not have to expend examination resources on these types of continuations.

2. If my proposal in item 1 above is not adopted, then I propose that continuations should get in line with other applications based on the continuing application filing date (not the earliest parent application filing date). This would reduce the number of repeated continuing application filings that would be necessary to keep the subject matter pending because it would slow down the continuation application prosecution process by a couple years. So, subject matter that is currently winding up in 5 or 6 issued patents before the prosecution laches period runs might only wind up in 3 or 4 issued patents, thereby reducing the number of applications that the USPTO needs to process.

3. Eliminate Draconian Reissue Declaration Scrutiny - It seems that it takes many, many attempts at submitting a reissue declaration in a broadening reissue application to get one accepted. Examiner's we've talked with are also frustrated by the ridiculous scrutiny Reissue Declarations receive. You can't even use the USPTO's own form Reissue Declaration and have it accepted. We oftentimes will get one broadening reissue case allowed, then use the Reissue Declaration from that case as a model or template in the next case, only to have it rejected the next time. We can't seem to get the same type or style of Reissue Declaration accepted twice. ENOUGH is ENOUGH already with the level of scrutiny of Reissue Declarations. Put together a USPTO form that has a few check box options that will be accepted. The patent prosecution bar, the clients, and the examiners are fed up with the current situation. Finally, on this point, the difficulty in obtaining a broadening reissue is one of the reasons why clients file long strings of continuations . . . so the draconian Reissue Declaration scrutiny is a contributing factor in the USPTO's application backlog.

4. Remove the requirement to submit U.S. Patents and Published U.S. Patent Applications in IDS's - As noted in the Federal Register Notice, the USPTO has excellent software tools to search databases, including the USPTO's own patent and published application databases. Accordingly, I would welcome a rule that absolves patent applicants and their attorneys from

having to submit U.S. Patents and Published Applications to the USPTO (this might need to happen at the Congressional/Statutory Level, though . . . but I wanted to provide this comment anyway). Many large corporate clients develop some fairly sophisticated and comprehensive patent libraries. When a new application is filed in area covered by one of the library categories, the prospect of potential inequitable conduct being found years later militates in favor of sending in the whole library category. When in doubt, attorneys and applicants will almost always choose to submit prior art. Examiner's sometime complain in Office Actions about large IDS's, but what choice do applicants and their attorneys have when faced with some of the inequitable conduct decisions that are out there.

Best regards,

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