

August 31, 2001

Box Comments - Patents
Commissioner for Patents
Washington, D.C. 20231

Re.: AIPLA Response to the USPTO's Notice of Proposed Rulemaking Entitled
"Elimination of Continued Prosecution Application Practice as to Utility and Plant
Patent Applications"

Dear Sir:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to present its views on the Notice of Proposed Rulemaking entitled "Elimination of Continued Prosecution Application Practice as to Utility and Plant Patent Applications" published in the *Federal Register* on July 9, 2001.

The AIPLA is a national bar association of more than 13,000 members engaged in private and corporate practice, in government service, and in the academic community. The AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property.

The AIPLA agrees that the United States Patent and Trademark Office (USPTO) should from time to time review its rules of practice and eliminate those which are redundant, which involve unnecessary costs, or which cause inefficiency. However, the AIPLA does not agree that the present proposal achieves any of these objectives and accordingly, the AIPLA is unable to support the proposed rule change.

While continued prosecution application (CPA) practice and request for continued examination (RCE) practice are similar in that both provide a quick and easy way to obtain continued prosecution, the two are not redundant. Since a CPA, unlike an RCE, is a new application, it may be used to take advantage of some of the provisions of the American Inventors Protection Act of 1999 (AIPA), such as amended 35 U.S.C. § 103(c) to overcome a rejection under 35 U.S.C. § 102(e)/103, amended 35 U.S.C. § 154(b) which implements the patent term guarantees by providing for patent term adjustment, or 35 U.S.C. § 122(b) to obtain eighteen-month publication of the application. In addition, a CPA may be used to effect a change in inventorship without the paperwork associated with a petition under 37 C.F.R. § 1.48 or to present claims to a patentably distinct invention. An RCE cannot be used for either of these purposes.

While an applicant can utilize 37 C.F.R. §1.53(b) to achieve the above-noted objectives, refiling under 37 C.F.R. § 1.53(b) can be more costly because of the need to submit a complete copy of the original specification and drawings. In addition, the processing delays for a § 1.53(b) application are greater with the result that patent term will likely be reduced as compared with refiling by way of a CPA. Finally, since a complete new file must be prepared by the USPTO, the expense of storage and retention is certainly greater for a § 1.53(b) application than for a CPA and increases the risk that an important part of the prosecution history of the continuing application and copies of relevant prior art will be misplaced in the USPTO.

The Notice also suggests that CPA practice is more costly and inefficient because a CPA, unlike an RCE, must be published. This argument is unpersuasive. The applicant who chooses to file a CPA instead of an RCE is doing so either to take advantage of AIPA provisions, to correct inventorship, or to change the nature of the claims being prosecuted. The elimination of CPA practice will not result in greater use of RCE practice, but rather will result in more refilings under 37 C.F.R. § 1.53(b) with the result that the costs and inefficiency associated with publication will continue. Accordingly, the proposal does not correct the publication cost and perceived inefficiency associated with CPA practice.

Finally, since CPA practice will continue to exist for design applications, the elimination of CPA practice for utility and plant applications will not reduce the number of refiling options. Both the USPTO staff and the bar will be required to maintain familiarity with as many refiling options.

In summary, since CPA practice and RCE practice are not redundant, since CPA practice provides an easier and less costly way of taking advantage of various provisions of AIPA for correcting inventorship and for changing the focus of the claims being examined, and since it is believed that the number of continuation applications which will be subject to publication if CPA practice is eliminated will not be reduced, the AIPLA is unable to support the proposal to eliminate CPA practice for utility and plant applications.

Sincerely,

A handwritten signature in black ink that reads "Michael Kirk". The signature is written in a cursive style with a small flourish at the end.

Michael Kirk
Executive Director