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FACSIMILE TRANSMISSION SHEET

TO: Ms. Eugenia A. Jones

FAX PHONE: 1-703-872-9411

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DATE SENT: September 10, 2001

PAGES SENT: 3

FROM: Terry S. Callaghan

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Via Facsimile

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

Attention: Ms. Eugenia A. Jones

Re PROPOSED USPTO RULES REGARDING ELIMINATION OF CPAS

Dear Ms. Jones

We are writing in response to the Notice of Proposed Rulemaking by the United States Patent and Trademark Office (PTO) by which continued prosecution applications (CPAs) will be eliminated. We ask that the comments below kindly be considered despite the lateness of its submittal. For the reasons stated below, we are opposed to the proposed rule changes.

Although CPAs will eventually phase out since they cannot be filed for applications filed on or after May 29, 2000, the PTO intends to eliminate CPAs entirely in view of the newer request for continued examination (RCE) practice. The PTO believes that the CPA practice is redundant in view of the RCE practice. We believe that eliminating the CPA practice at this time is premature due to the benefits provided by the CPA practice over the RCE practice or filing a conventional continuation application. The PTO's statement that the CPA practice is redundant to the RCE practice is inconsistent with the PTO's own prior position that it is favorable to file a CPA rather than an RCE. Specifically, on the PTO's own form PTO/SB/30 (8-00), the PTO states, "[I]f the above-identified application was filed prior to May 29, 2000, applicant may wish to consider filing a continued prosecution application (CPA) under 37 C.F.R. § 1.53(d) (PTO/SB/29) instead of a RCE to be eligible for the patent term adjustment provisions of the AIPA."

As the PTO is aware, filing an RCE does not constitute the filing of a new application and thus does not trigger: (1) the potential AIPA term extension benefits that arise from filing after May 29, 2000; (2) the §102(e) exception under 35 U.S.C. §103 for filing an application after November 29, 2000; or (3) publication of the application by filing after November 29, 2000. Unlike filing an RCE, the filing of a CPA does provide these benefits. While many of these benefits could be attained by filing a conventional continuation application under 37 C.F.R. §1.53(b), there are several disadvantages of filing a conventional continuation application over a CPA. Specifically, an examiner is more likely to respond within a matter of months to the filing of a CPA whereas examiners often do not respond to conventional continuation

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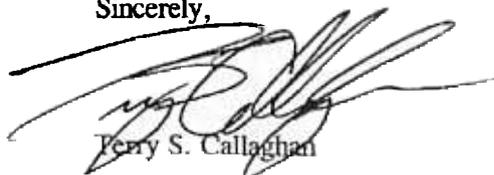
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applications for several months or even years. Additionally, much more paperwork is typically filed with a conventional continuation application, including extra sheets of drawings, the application text, amendments that were previously made, and often copies of all the references that were submitted in the parent application. Although resubmitting references is not required for the references to be considered, it has been our experience that examiners often appreciate receiving copies of references in continuing applications so that they do not need to retrieve copies for themselves.

Nearly half of this firm's pending utility patent applications were filed before May 29, 2000, and would potentially benefit from CPA practice. We suspect that roughly one-half of the PTO's pending applications likewise would potentially benefit from CPA practice. If applicants are required to file conventional continuation applications to obtain the above benefits not provided by an RCE in those applications that are already pending for over fifteen months (those filed before May 29, 2000), then those applicants will be forced to experience further PTO delay while waiting for a first office action in the continuation application. Thus, elimination of CPAs will likely cause even more delay for the applications that have been pending the longest. As an example, this firm has an application that was filed over three and one-half years ago and has not yet received an office action due to no delay on the part of the applicant. If we subsequently file a conventional continuation application from this particular application, then the applicant may experience yet another three-year delay waiting for a first office action. Clearly, such a situation is unfair to the applicants.

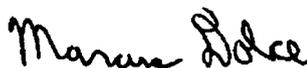
For the above reasons, the undersigned do not support the proposed rule by which CPAs are eliminated. The opinions expressed in this letter do not represent the opinions of the entire firm or its clients.

Sincerely,



Terry S. Callaghan

Sincerely,



Marcus P. Dolce

TSC/rsw