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From: Hersh, Joyce C. [mailto:jhersh@klng.com]

Sent: Wednesday, May 03, 2006 4:32 PM

To: AB93Comments

Cc: Grant Houston

Subject: BPLA Comments on Continuing Application Practice

Dear Sir:

Attached are the comments of the Committee on Patent Office Practice of the Boston Patent Law Association, concerning the rules proposed in "Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims," published in the Federal Register on January 3, 2006.

We appreciate the opportunity to offer our comments and would greatly appreciate confirmation that they have been received.

Kind regards,

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Attn: Robert W. Bahr, Senior Patent Attorney

FROM: Boston Patent Law Association,
Committee on Patent Office Practice

DATE: May 3, 2006

RE: Comments on Proposed Rules, "Changes To
Practice for Continuing Applications, Requests for
Continued Examination Practice, and Applications
Containing Patentably Indistinct Claims" 71
Federal Register 48 (Jan. 3, 2006)

Dear Under Secretary Dudas:

The Boston Patent Law Association (BPLA) appreciates the opportunity to offer comments regarding the "Changes To Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims" published in the *Federal Register* on January 3, 2006.

The BPLA is a regional (Federal First Judicial Circuit) association of intellectual property professionals which provides educational programs and a forum for the interchange of ideas and information concerning patent, trademark, and copyright laws. Its members include attorneys, agents, and students practicing in all areas of technology, at law firms, corporations and academic institutions.

The comments and suggestions which follow are from our members, and were compiled and are submitted below. In general, the proposals appear to be targeting "outlier" behavior of a few applicants. Our members believe that the proposals, if adopted, are likely to exacerbate the current pendency problems within the U.S. Patent and Trademark Office's ("USPTO"; "the Office"). Our members therefore recommend that the Office tailor the proposals more narrowly to directly address those situations which are the most problematic. Their suggestions on how to do so follow.

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Comments on the Proposal:

Limiting the Number of Continuing Applications in the Manner Described in the Proposed Rules May Exceed the Office's Rulemaking Authority

If adopted as proposed, the rules would be susceptible to a challenge as exceeding the Office's rulemaking authority by limiting an applicant's rights under 35 U.S.C. § 120. We also doubt that the possibility that a continuing application may be accepted by petition under certain circumstances will overcome this challenge, given the retroactive nature of the proposed rules, the extremely limited circumstances under which an applicant may file a continuing application, and the public statements by representatives of the Office in its recent town meetings that the success rate of such petitions would be low.

Although the proposal asserts that the Office has the authority to promulgate these rules, the Court of Appeals for the Federal Circuit and its predecessor court, the Court of Customs and Patent Appeals, have both consistently held that the Office cannot arbitrarily limit an applicant's right to file continuing applications under 35 U.S.C. § 120.

In re Henricksen (399 F.2d 253, 158 U.S.P.Q. 224 (C.C.P.A. 1968)) states that there is no statutory basis for fixing an arbitrary limit to the number of prior applications through which a chain of copendency may be traced to obtain the benefit of the earliest filing date in the chain, provided that the applicant has met the other requirements of the statute. That case involved a string of six successive continuation-in-part applications based on one utility application filing. The examiner had issued a double patenting rejection in the seventh application based on the subject matter of the first, on the grounds that an applicant could only claim priority to an application twice-removed in time from the current application.

The C.C.P.A. studied 35 U.S.C. § 120 and its legislative history, and noted that it contained no limit on the number of application involved in a chain of priority. It held that "[t]he action of the board is akin to a *retroactive* rule change which may have the effect of *divesting* applicants of valuable rights to which, but for the change in Patent Office position brought about by the board's decision, they were entitled." (at 231, *emphases original*). The Court also noted that "the cure for this deplorable state of affairs rests with Congress, not with us. If a restriction is to be imposed, it must be based upon law, legislatively or judicially expressed."

Ex parte Hull (191 U.S.P.Q. 157 (Bd. Pat. App. & Int. 1975)) involved a situation where the examiner rejected an applications on the grounds that the applicant intentionally and unduly delayed disclosure to the public of the subject matter of the claims by failing to timely permit a patent to issue. The applicant had filed five successive continuation-in-part applications from an allowed application, each filed after the mailing of a notice of allowance in the previous application. The claims of each application corresponded exactly or substantially to those of the previous application, and the applicant himself had stated that the purpose of the string of applications was to prevent the disclosure of the invention to the public.

The Board *reversed* the examiner's rejection, on the grounds that the applicant had believed he was acting in accordance with established law and rules of patent office practice. However, the Board also noted that the applicant was now on notice that a future rejection would be *sustained* as contrary to the purposes of the Constitution, given that there was no statute or case law preventing the Office from invoking equitable doctrine as the basis for such a future rejection.

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In re Bogese II (303 F.3d 1362, 64 U.S.P.Q. 2d 1448 (Fed. Cir. 2002)) involved a situation in which the applicant had created a string of twelve continuation applications claiming benefit of a single utility filing. Eleven of the applications were never amended. In the last application, the examiner issued a warning that the next continuation filing would be rejected under the equitable doctrine of laches, if no efforts were made to advance prosecution. The applicant submitted another file wrapper continuation, which was rejected as the examiner had warned. The Federal Circuit upheld the examiner's rejection on the grounds that the applicant had "received the specific warning that *Hull* found necessary."

Thus, the case law on this subject makes clear that where the applicant is not advancing prosecution, the Office possesses the authority to warn an applicant that future continuing applications will not be accepted. The courts also make clear, however, that the Office does not possess the authority to arbitrarily limit an applicant's right to claim priority under 35 U.S.C. § 120, absent a warning and facts indicating undue delay on the applicant's part.

Adoption of the rules as proposed is therefore likely to trigger a legal challenge, resulting in confusion and disruption to members of the patent bar, and increasing the possibility that applicants' rights will be lost as the rules of practice change repeatedly. We therefore recommend that the rules not be adopted as proposed, and that applicants who fail to advance prosecution instead be warned and dealt with as in *Bogese*.

Prohibiting or Discouraging Self-Restriction May Violate Statute

The proposed prohibition on self-restriction and the presumption by the USPTO that some applications will contain patentably indistinct subject matter may violate 35 U.S.C. 101. This statute states that a person can obtain a patent on an invention, and is the source of present-day divisional practice. Discouraging an applicant from self-restricting could be viewed by a court as discouraging an applicant from complying with 35 U.S.C. § 101. We therefore recommend that the Office not adopt this proposal.

The Proposals May Increase Work For the USPTO by Increasing the Number of Divisional Applications Filed

The proposals could cause an increase in the number of applications filed, because applicants will be forced to file all of their divisional applications during the pendency of an original application. Put simply, the Office may not receive many potential divisional applications which previously would never have been filed.

Under the current rules, when a restriction requirement is received in an original application, an applicant has the option of "parking" unelected groups of claims in a continuation application, and deciding at a later date whether or not to pursue them. For instance, for an original application having a six-way restriction requirement, a small entity applicant will choose the most commercially important group, and shortly before issuance, file a divisional on the second-most commercially important group of claims. The remaining groups of claims are either abandoned, or are "parked" in a continuation application, pending a determination of commercial worth.

While this strategy could be decried as circumventing the *intent* of the divisional filing procedure, it inherently possesses sufficient risks and costs to the applicant under *Geneva Pharms., Inc. v. Glaxosmithkline PLC* (349 F.3d 1373, 68 U.S.P.Q.2d 1865 (Fed. Cir. 2003)) in

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that the remaining claims (if ever pursued) will no longer be insulated from a double patenting rejection. Thus, this filing strategy is self-limiting.

However, under the proposed rules, an applicant will be forced to file all divisionals during the pendency of the original application. Well-heeled applicants will follow this strategy, while small entities will not be able to do so due to financial constraints. Thus, the USPTO is likely to see an *increase* in filings from large entity applicants, who can afford to file and prosecute many applications simultaneously. Small entities who under the current rules can spread out their patenting costs over several years may forego some filings because they cannot afford such front-loading of costs.

Thus, the USPTO is likely to be forced to examine divisional applications that previously were “abandoned” before they were ever filed. This may exacerbate the Office’s workload problem, rather than alleviating it. We also note that requiring applicants to file all divisional applications during the pendency of the original application is directly antagonistic to the idea of deferred examination, a proposal that the Office is currently working on.

Before implementing the proposed rules, we recommend that the USPTO assess the scope of this potential divisional filing problem by studying the divisional filing habits of large vs. small entity applicants, and how many followed through on most of the claim groups set forth in a restriction requirement.

The Proposed Rules Do Not Provide an Exemption For Continuing Applications Filed to Address Unusual Situations Created by the Intersection of U.S. and International Patent Laws

Under the proposed rules, an applicant may only file one of three types of continuing applications, unless he successfully shows why the “amendment, argument or evidence could not have been submitted” in the previous application.

However, not every application follows a predictable path through prosecution, and it is not uncommon for applicants to file continuing applications as the most expedient way to address situations that arise through the intersection of U.S. and foreign patent laws.

For instance, it is not uncommon for an applicant to simultaneously file both a U.S. utility application and also an international application under the PCT. It is also not uncommon for an applicant to receive an International Search Report after an Information Disclosure Statement has been filed in the U.S. application. If the U.S. application has been allowed at the time when the ISR is received, then the only way for the references in the ISR to be submitted (as required under 37 C.F.R. §§ 1.56 and 1.97) is to submit a supplementary IDS with an RCE. Under the rules as proposed, such an RCE would count as the applicant’s “by right” continuing application, possibly preventing the applicant from later filing a continuing application by their own choice.

If the rules are adopted as proposed, applicants are likely to address such situations by petition, so as not to “waste” their only by-right continuing application. The Petitions Office is therefore likely to see an increase in petition filings.

In addition, an applicant with a PCT application currently has the option of entering the National Phase in the U.S., or filing a continuation claiming priority to the PCT application. Our members note that limiting an applicant to a single continuing application “by right” effectively eliminates the ability of applicants to file via the continuation application route.

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The Proposed Rules Do Not Provide an Exemption For Continuing Applications Filed to Address Unusual Situations Created Within the U.S. Patent and Trademark Office

Applicants also use the filing of an RCE to address unusual situations that arise solely within the USPTO.

For instance, one of the authors of these comments has seen a situation where a Notice of Allowance was mailed from the Office while a Notice to File Missing Parts of the Application was still outstanding. Because an IDS had not yet been submitted, and examination had been (prematurely) closed, the only way to have had any references be considered was to file an RCE along with the missing parts and the IDS.

If the rules are adopted as proposed, applicants are likely to address such situations by petition, so as not to “waste” their only by-right continuing application. The Petitions Office is therefore likely to see an increase in petition filings.

The Rules May Discourage Seminal Disclosures, Reducing the Public Notice Function of Patents

Small entity applicants may be discouraged from filing seminal disclosures describing all aspects of an invention unless they have sufficient resources available for intensive, short-term development and protection of every disclosed aspect of the invention. If such resources are not available, an applicant may be tempted to keep secret some aspects of the invention, rather than disclosing fully and risk being denied the ability to pursue the matter in a continuing application.

Large, omnibus disclosures are beneficial to the public because they provide a more full disclosure of the invention, and can spur further research and “design around” business activity. Under the current rules, the potential for commercial gain provides an incentive to people to protect their ideas, and when they do, they fully describe the idea. The compression of time and costs under the proposed rules will cause inventors to describe and protect only those aspects of an idea that are believed to be of the most immediate commercial benefit. Thus, commercial gain may move from being an *incentive* to patent, to becoming the dictating factor in *what* to patent (and thus disclose to the public).

The proposed rules may discourage broad disclosure, and may instead encourage applicants to spread out a discovery over multiple narrow, incremental filings. This may also increase the USPTO’s workload, rather than decrease it.

The Proposed Rules Are Likely to Have a Disproportionately Harsh Impact on Small Entities

Contrary to the Office’s assertions, the proposed rules are likely to have a disproportionately harsh impact on small entities.

Sole inventors and small businesses often lack the funds required for intensive, short-term development and protection of every potential aspect of the invention, and often need to spread out patenting costs over time. Under the proposed rules, they may prefer to avoid disclosing embodiments where sufficient funds for full commercial development are lacking.

Academic institutions and other entities which tend to license their inventions would be in an even more difficult position. The applications filed by such entities are often large disclosures representing a major discovery. Because the institution is usually in no position to market the products of the discovery, it seeks to license the rights in the invention as soon as possible. This frequently takes time, during which the college must prosecute the application, respond to restriction requirements, and file divisional applications.

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In the medical and pharmaceutical fields, it may take years to determine which of several disclosed embodiments will be commercially valuable. Currently, an applicant has the option to file a large application disclosing all embodiments, and can “abandon” (more accurately, never claim) those which are later found to not be of interest. The proposed rules would effectively require one to know ahead of time which embodiments will be attractive to a licensee, something that usually can only be guessed at.

The proposed limits on continuing applications will effectively require an applicant to either use concurrent divisional applications to pursue protection on all embodiments for which there is a remote chance of commercial viability, or abandon potentially valuable subject matter.

The Proposed Rules May Reduce Investor Funding

Depending on how difficult filing a continuing application proves to be, the proposed rules, if adopted, may have an adverse impact on investor funding in new technologies.

The unfettered freedom to file a continuing application under the current rules allows an applicant to “reposition” an invention, and to pursue subject matter not previously claimed, thereby making the invention more attractive to investors. Indeed, it is not unusual for venture capitalists or licensees of an invention to demand that, as a condition for investment, a continuing application claiming particular subject matter be filed. It is also not uncommon for an investor to require that, for an application close to issue, a continuation application be filed as an “insurance policy” while due diligence is conducted, so that the continuation can be used to repair any defects found in the parent. In such cases, the continuation patent becomes the main focus of the licensed intellectual property, and the parent is disclaimed or abandoned. When no defects are found, it is the continuation application that is abandoned.

While we understand that the Office would probably prefer that an applicant with a potentially defective patent instead file a re-examination, the first step in such a proceeding is the surrender of the patent. Such an occurrence would eliminate any possibility of obtaining investor funding. Thus while the Office would likely prefer that such continuations were not filed at all, doing so provides enormous flexibility and benefit to applicants, with relatively minimal burden to the Office.

The Proposed Rules Limiting Continuing Applications Will Be Retroactive For Many Applicants

The proposal states that on or after the effective date of the rules, all filings must comply with the proposed rules, and that “an applicant may only file one continuation or continuation-in-part application (and not ‘one more’ continuation or continuation-in-part application) after the effective date of the final rule”. The same is true of RCEs (“an applicant may only file one request for continued examination (and not ‘one more’ request for continued examination) after the effective date of the final rule without a petition under proposed § 1.114(f)”).

Therefore, if an applicant filed an RCE on December 31, 2005, that RCE will now prevent the applicant from filing a continuation or a continuation-in-part without a petition. The proposal therefore is effectively a retroactive rule change, something the Court of Customs and Patent Appeals specifically proscribed in *In re Henriksen* (“The action of the board is akin to a *retroactive* rule change which may have the effect of divesting applicants of valuable rights to which, but for the change in Patent Office position brought about by the board’s decision, they were entitled.” *In re Henriksen*, 158 U.S.P.Q. 224, 231 (C.C.P.A. 1968)).

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Alternative Suggestions:

Raise Fees for the Filing of Continuation or Continuation-In-Part Applications

Because there exists an argument that placing limits on the filing of continuing applications exceeds the Office's authority, we recommend instead that the Office consider increasing the filing fees for such applications.

The Office already charges a upwardly-sliding extension fees for an applicant who files a reply to a paper increasingly close to the statutory six-month deadline. A similar scale could be used for filing fees for continuing applications.

For instance, the first continuing application could be "by right" as suggested in the proposal, but the second could have a filing fee that is 1.5 times the normal filing fee, etc.

Such a fee change would be insulated from legal attack, and would maintain the flexibility of the current filing system. The increasing fees would discourage the filing of excessive applications and encourage the more rapid resolution of examination. Yet those applicants who truly need to file a continuing application would still be able to take advantage of the full range of filing strategies that exist today.

Requests for Continued Examination Should Not Be Considered "Continuing Applications"

The RCE replaced the CPA (continuing prosecution application), which replaced the FWC (file wrapper continuation application). Although ostensibly a descendant of a type of continuing application, the RCE is no longer viewed or used as one by applicants. Rather, the RCE is used by applicants to extend the period of examination.

Previously, an applicant and an examiner discussed an application until issue was joined. There were no limitations on the time needed to do so. Today, an applicant is limited to two office actions, and generally only the first of those two is substantive. Most examiners will not consider or enter any amendments made in response to the second office action, so an applicant who genuinely wishes to address the rejections and move prosecution forward is required to file an RCE in order to enter the amendments and receive substantive feedback on them.

In presentations, "road shows" and town meetings, Office representatives have stated that an RCE provides the applicant with "four bites at the apple." Many applicants would disagree with this characterization of the examination process and would maintain that only two of the four "bites" represent substantive examination.

In practice, an applicant responding to a first office action with amendments and arguments will usually receive a final office action that enters the amendments with a statement that the action is final because the applicant's amendment necessitated new grounds of search and examination (this reason is sometimes given even where no claim amendments were made!). The previous grounds of rejection are usually reiterated, and are often largely identical to those of the first action. Such an action provides little or no useful information to the applicant as to why the amendments failed to overcome the rejections.

Should an applicant respond within two months of the mailing date of the final action, the Advisory Action that is issued usually states only a refusal to enter the amendments.

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At this point, the applicant has the choice of either filing an RCE or appealing the rejections. Because he has had little or no feedback on the amendments made in response to the first action, the applicant will usually file an RCE, if for no other reason than to obtain feedback on previous amendments made.

Thus, the filing of an RCE does not usually provide an applicant with “four bites at the apple.” Rather, the lack of meaningful consideration of amendments by the examiner effectively provides the applicant with little more than four guesses at what might produce allowance.

Because the filing of an RCE does not in practice provide an applicant with four opportunities for meaningful exchange with the examiner, we recommend that the RCE not be considered a “continuing application” should the office elect to adopt the proposed rules. Rather we suggest that the Office institute successively increasing fees for filing multiple Requests for Continued examination in an application.

Reject Poor-Quality Literal or Machine Translations As Indefinite

The proposed rules stated that some applicants file poor-quality literal or machine translations of foreign applications, and then delay prosecution by repeatedly re-filing the applications as continuations.

At least one of the drafters of these comments has had first-hand experience with such foreign-origin applications, and has actually received explicit instructions from foreign applicants to *not* revise the application in any way. We therefore *recommend and request* that in such cases where the translation of the claims and/or the specification is of such poor quality that the nature of the invention cannot be determined without difficulty, the entire specification be rejected as indefinite under 35 U.S.C. § 112.

Such a solution would address this problem directly, without punishing those applicants who do make efforts to comply with U.S. patent law. We recommend that some sort of procedure be put in place that would allow an examiner to reject a specification as indefinite, and providing the applicant with a specified time period in which to provide a better-quality translation.

In situations where the invention cannot be understood from an attentive reading of the specification and claims, the Office may wish to encourage examiners to use 37 C.F.R. §1.105 to require that the applicant provide a concise, plain-English explanation of the invention. Although the examples provided in that rule do not include a description of the invention, it can be fairly said that an understanding of the invention is “information . . . reasonably necessary to properly examine or treat the matter.”

Care should be taken by the Office, however, to ensure that such a procedure does not fall harshly upon applicants who are immigrant U.S. citizens or resident aliens possessing evolving language skills. The Office should also guard against the abuse of such a procedure by the occasional examiner who might seek to “remove” applications from their docket.

Encourage the Use of “Plain English” in Office Actions

We recommend that the Office encourage examiners to use “plain English” in the drafting of rejections. While the form paragraphs used by the Office are useful, it would be helpful to applicants if these were supplemented with clearer statements as to the precise ground and nature of the rejection.

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As an example, one of drafters of these comments took over prosecution of an application which had been pending for a number of years. In spite of numerous amendments and arguments, the claims remained rejected as anticipated by references in another field that had been cited repeatedly. A telephone call to the examiner revealed that the invention, an extremely tiny precision medical device of relatively simple structure, was believed by the examiner to be anticipated by other very large devices. The conversation revealed that the rejections could be overcome by an amendment that recited size limitations, which were fully supported in the specification.

Why was this not explicitly stated, or even hinted at, in any previous office action? The examiner was very experienced. Admittedly, so were the attorneys, but with no guidance as to the underlying reason for the rejection, it is easy for an applicant to be distracted by what might appear to be inapposite art, not realizing the real reason behind its citation.

We therefore recommend that the Office strive to improve the quality of Office Actions, so that the applicant has a better understanding of the precise nature of the rejection, and can better craft amendments that will advance prosecution.

Encourage Telephonic Interviews

In the past, many practitioners found interviews, either telephonic or in person, to be an extremely efficient method of advancing prosecution. Over the past several years, however, the opportunities for scheduling such interviews has decreased, and the interviews themselves have often been unproductive. The drafters of these comments have found that in recent years, examiners have repeatedly agreed to specific claim amendments and later reneged, refused interviews, or even insisted that interviews are not allowed!

We therefore recommend that the Office take steps to encourage interviews as a method of rapidly disposing of issues and advancing prosecution.

Deferred Examination

Several members of the BPLA are of the opinion that deferred examination would be especially helpful to a number of our clients, and may also help to alleviate the Office's workload. One of the drafters of these comments was therefore gratified to hear at Mr. Doll's and Toupin's presentation at BIO 2006 in Chicago that the Office is considering instituting a system of deferred examination.

It was noted that a type of deferred examination currently exists, but that it cuts into the applicant's patent term. The Office proposed that a formal deferred examination system be created in which the patent term is tolled, with which the BPLA agrees.

We also note that 37 C.F.R. § 1.103(d) currently only allows deferral of examination "for a period not extending beyond three years from the earliest filing date for which a benefit is claimed." For a utility application claiming benefit of a provisional application, the "true" period of deferral would be only about ten months (36 months under a deferral request vs. 26 months under normal examination (twelve months' of pendency of the provisional + fourteen months for the target date of the first substantive action = 26 months)). Most applicants do not find an additional ten months of deferral to be worth the fees and attorney time required to obtain it.

Instead, a true deferral system, such as that practiced in Japan, would be extremely useful to many applicants. Mssrs. Doll and Toupin noted that in Japan, requests for examination are never

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filed in *one-third* of applications. It would clearly be beneficial to the Office to have the applicants themselves cull those inventions which they deem not worthy of protection.

We also note that the proposed requirement that applicants file all divisional applications during the pendency of an original application, rather being allowed to file some groups of claims in continuing applications (see above), is directly antagonistic to the idea of deferred examination.

Many applicants find that it takes time to commercialize an invention. In the case of an academic institution, it is not uncommon for the institution to file a provisional application and immediately seek a licensee to take over responsibility for the examination of the application and commercialization of the invention. Such applicants will often file an international application based on the provisional simply to obtain more time to find a licensee before incurring the majority of costs of patent examination. These applicants are already seeking a form of deferral, and a formal system of deferred examination would be a boon for them.

As presented by Mssrs. Doll and Toupin, a filing fee would be required for an application in which deferred examination is requested, but no search or examination fee. Examination requests would be required by a particular date.

The Office also proposed that such a system should allow examination to be requested by third parties. We do not agree with this aspect. Such an opportunity would likely prove irresistible to third parties wishing to interfere with an applicant's ability to allocate its financial resources. However, the BPLA does recommend that applications in which examination is deferred be published, and that deferment would be an opportune period for third parties to submit art and arguments for later consideration by the examiner.

The Office expressed some reservations that such a system would produce a drop in revenue statistics, but the BPLA notes that the drop should be offset by reduced examination expenditures. This should be especially true if examination is never requested in one-third of applications filed, as is currently the case in Japan. The Office could also charge periodic maintenance fees, as are currently required by other patent offices. The Office could also institute a "processing and retention fee" to maintain the application, as was formerly done under 37 C.F.R. § 1.21(l).

The Office could also consider changing the maintenance fee structure so that the anniversary dates are measured from the filing date, rather than the issue date, although this is likely to require a change in the law.

In summary, BPLA members suggest that a legal study be done to determine if the Office can institute a deferred examination system without a requirement that Congress revise existing patent law. If such a system can be put in place with only a change of the patent rules, we recommend that the Office draft a proposal for public comment. If a change in the law is required, then the Office should take steps to introduce such legislation.

Increase Examiner Training

The BPLA also recommends that the Office increase the amount of training received by examiners. Many practitioners can attest to the regular receipt of office actions that evidence a misunderstanding of basic concepts such as anticipation, inherency, and written description vs. enablement. Training should be ongoing, with refresher seminars and spot-checking of work product, even for experienced examiners.

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The law governing patents changes over time, and just as many jurisdictions require Continuing Legal Education for lawyers, examiners should also undergo training, on an ongoing basis, even in basic concepts.

Utilize Existing Opportunities for Training

We also recommend that the Office mine existing opportunities for examiner (and practitioner) training. There are a number of situations within the Office that can be used as training tools for both examiners and practitioners.

For instance, the Pre-Appeal Brief Conferences currently do not memorialize their findings in any way. While this may have been done in order to increase the number of cases that can be reviewed by the panels, we feel that an important training opportunity is being lost. When an examiner's rejections are overturned by a panel, there is no indication that the examiner has learned why, and the practitioner certainly does not learn why they were right (if in fact they were right). Even worse, when a panel sustains a rejection, the practitioner never learns anything from the experience. Indeed, one of the drafters of these comments has heard other practitioners insist that the Conferences are a waste of time because they merely rubber-stamp the rejections. Such views are not surprising, given that the Panels' reasoning is unavailable.

Similar learning opportunities are being lost at the Board and Petitions level. Any time a finding is returned with no explanation, the entire transaction becomes mere "paper pushing," with no one learning from the experience.

We therefore recommend that the Office identify such transactions, and require that some minimum level of legal and factual reasoning be provided to both the examiner and the practitioner.

Require Continued Legal Education (CLE) for Practitioners

Many jurisdictions in the U.S. require attorneys to obtain CLE credit in order to maintain bar membership. The BPLA offers a wide variety of educational programs and informational seminars, and many of its members take advantage of these opportunities. Nevertheless, there is no requirement that patent practitioners do so.

We therefore recommend that the Office study the possibility of requiring a minimum level of CLE for practitioners, either through local bar associations, law schools, or online. The Office could tailor its requirements to suit its needs by requiring, for instance, education in drafting of claims, or filing procedures. Care should be taken, however, to not place at a disadvantage part-time practitioners or those living in geographic areas where local learning opportunities may be limited.

Form a Patent Practice Advisory Committee

Most good practitioners have excellent reasons for following particular filing and prosecution strategies, and would be happy to explain the reasons behind them. Most practitioners would also take a dim view of those applicants who do indeed absorb a disproportionate amount of patent resources or abuse the patent system.

We recommend that the Office solicit volunteers from the patent bar to form a rotating Committee for the purpose of studying problems experienced by the USPTO and proposing

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solutions tailored to address those problems. We believe that the Office would have no shortage of volunteers for such a committee.

We appreciate the opportunity to provide comments on the proposed rules, and we hope that our suggestions are helpful to the Office. Please feel free to contact us, if we can be of further assistance.

Sincerely,

Committee on Patent Office Practice,
Boston Patent Law Association

/Joyce C. Hersh/

Joyce Hersh

/Grant Houston/

Grant Houston