

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

From: Brown, Mike [mailto:brown@bpmlegal.com]

Sent: Thursday, March 09, 2006 3:40 PM

To: AB93Comments

Subject: Proposed Changes to Continuation Practice

Sirs:

I have reviewed the proposed changes to the rules, and I strongly urge the PTO to reconsider and not to enact them. I believe that the rules will do nothing to solve the perceived problems, and will work an unwarranted hardship on applicants, especially individual inventors and small businesses. In twenty-five years of practice as a patent prosecutor, I have filed a large number of continuing applications (including RCE's and their predecessors CPA and FWP), but have never filed such an application for purposes other than to get my client the patent protection to which he/she is entitled. I have never filed a continuing application for the purpose of delay, and I suggest that the 20-year-from-filing patent term introduced a decade ago contains its own solution to that problem.

The proposed changes assume that the cause for the prosecution backlog and delays are caused by applicants who choose to file long chains of continuing applications, where they could have filed a smaller number of independent applications originally. I think this belief is misguided, and the problem lies with excessively rigid and unfair rules in the USPTO, applied by examiners who are not given sufficient time to examine applications and are, all too often, inexperienced and/or unable to express their rejections in clear colloquial American English. Rather, I think that much of the problem of excess delay and filing of "too many" continuing applications should be dealt with by changes in PTO examining practices, coupled with allowing Examiners more time to prepare complete office actions in the first place.

Taking up the various kinds of continuing applications separately:

- Requests for Continued Examination (RCE's) (and its predecessors CPA and FWC)

The primary reason (indeed, nearly the only reason) that I ever file these is because the Examiner has issued a "final" rejection, in almost every case raising issues I had no opportunity to respond to before. Usually, these are second office actions. The first office action raised issues which I fully responded to by argument and/or amendment. The Examiner withdraws the first rejections, and introduces entirely new art - and then makes the new action "final" on the grounds that my amendment (in response to his requirement) necessitated the new grounds of rejection. In most cases the Examiner will not grant an interview at this point. Obviously, the "final" rejection raising new art is not really "final", it's just an invitation to pay an RCE fee. The only possible response is to file an RCE to address these new grounds of rejection. In more than one case, I've overcome the new rejections, only to have the Examiner raise yet more new rejections and make them "final", and around we go.

I believe this whole procedure is unfair and unjustifiable and a waste of the resources of both the Applicant and USPTO. Why should the Applicant be forced to file an appeal or RCE, just to respond to art he has never seen before? How does it serve either the Applicant or the USPTO to create unnecessary appeals and extra continuations (if continuations really are a problem), when the application could be better dealt with in a normal process of prosecution.

First, Examiners should be encouraged, and given sufficient time, to perform complete examinations prior to the first office action. Then, I propose that no office action should be considered "final" until the Examiner has settled on the art which he/she feels proves his/her point, and the Applicant has had an opportunity to respond to that art by argument and/or amendment. If the Examiner rejects the claims again *over the same art* after the Applicant has responded to that art, then, *and only then*, can the rejection truly be said to be "final". The case can proceed to appeal with both sides secure in their positions.

I have no problem with making this contingent on amendments being further narrowing of the original claim in response to the art cited - clearly, if the Applicant decides to replace the claims with different claims claiming a different aspect of the invention, than that should be filed as a "continuation". If, on the other hand, the Applicant merely narrows the claims by incorporating elements which were already there, and in so doing overcomes the cited prior art, then if the Examiner finds new art this should not justify a "final" rejection.

- Continuations

I do not file many continuations, and very seldom file second or higher serial continuations. Most continuations I have filed have been filed because the Examiner has indicated some claims are allowable, and my client wants to get a patent on those claims as soon as possible, but feels that the remaining rejected claims are also patentable and should be pursued. We cancel the rejected claims, allowing the parent case to issue, and file a continuation with the cancelled claims (usually with appropriate amendments). This serves the best interests of the Applicant, getting him/her an issued patent as soon as possible, and the USPTO, by narrowing the issues on the remaining claims so that they may eventually be issued or appealed. I do not see any benefit to anyone in limiting this sort of continuation.

I propose that there should not be a limit on continuations which are filed with claims which (a) were present in, but cancelled from, an immediate parent case; and (b) which are directly traceable back to the originally filed application (i.e. not brand-new claims introduced in the continuation).

I would not object to limiting the number of serial continuations which can be filed as a matter of right if those continuations (a) broaden the claims from the original filing or (b) claim aspects of the invention present in, but not claimed, in the original application. I would propose a limit of two serial continuations under these conditions - although, that

said, I think such things happen so seldom that the procedures necessary to implement such a limitation are hardly justified by the few cases they would eliminate.

I am reminded of Mark Twain's comments to Congress on the subject of copyright term limitation, which are equally applicable here -

"Why, if a man ... should come to me and try to get me to use my large political and ecclesiastical influence to get a bill passed by this Congress limiting families to twenty-two children by one mother, I should try to calm him down. I should reason with him. I should say to him, "Leave it alone. Leave it alone and it will take care of itself. Only one couple a year in the United States can reach that limit. If they have reached that limit let them go right on. Let them have all the liberty they want. In restricting that family to twenty-two children you are merely conferring discomfort and unhappiness on one family per year in a nation of 88,000,000, which is not worth while."

- Continuations-in-part (CIP)

I do not see any point in limiting the number of CIP applications which may be filed. CIP's, by definition, introduce new matter. I have filed CIPs for three reasons:

1. When an application was filed and rejected under section 112, first paragraph, as not providing sufficient support for the claims. This most often happens in applications based on foreign filings, where the requirements for support are different, although it does sometimes happen where the Applicant thought he had explained his invention sufficiently, but the Examiner did not agree. If the claims remain the same, or narrower, and all that is added is support for the claims, I do not see any reason to impose a limit on the number of continuations based on this kind of CIP. In effect, the CIP is the same application as the original filing (it claims the same invention), but has the detail which would have been included in the original case if the Applicant had known what the Examiner was going to require. I would not limit the number of this kind of CIP which could be serially filed, so long as they are filed in response to requirements set by an Examiner.

2. Where an application was filed which described a wide variety of embodiments, and during prosecution of the original application it has become clear that the invention is much narrower than the Applicant originally thought. Sometimes in these situations it has been useful to file a "CIP" which eliminates all of the embodiments but the one which is patentable, which allows the Examiner to concentrate and focus on that embodiment, without the extraneous prior art brought in by the described (but now unclaimed) material in the parent. Strictly speaking, these may not really be "CIPs", since the intention is not to add new matter, but it is often necessary to add new drawings and description to support the remaining (narrower) claims. As with continuations, above, if the claims in the new "CIP" are essentially the same as, or narrower than, the claims in the parent, I do not see any benefit in limiting the number of such cases.

3. To add new matter which was not previously described, but which is a further development of matter claimed in a pending parent application - the classic CIP situation. Since only the matter which was present in the original filing gets the benefit of the original filing date, and the twenty-year-from-filing term and application publication serves as a deterrent to long chains of CIPs which aren't really CIPs because they do not really claim anything from the parent, I do not see any reason to limit the number of such applications which can be serially filed. As a practical matter, limiting the number would have a very small impact, especially compared to the negative impact of introducing the limit and the procedures necessary to evaluate those who would exceed it.

Sincerely,

Michael F. Brown
Reg. Pat. Attorney No. 29,619
<http://www.bpmlegal.com/>