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From: Kent B. Chambers [mailto:kchambers@hamiltonterrire.com]

Sent: Wednesday, May 03, 2006 12:28 PM

To: AB93Comments

Subject: Comments To Practice for Continuing Applications, RCE Practice, et al.

The following comments are in opposition to the USPTO's proposed rule making to change Continuing Application and RCE practice.

1. Restricting the right of an Applicant to one continuations or RCEs, by right, can unjustly impede an Applicant's ability to patent their invention. My experience is that continuations and RCEs are filed for reasons other than those cited by the PTO. Namely, continuations and RCEs are often filed as a result of new art cited in an application. For example, if claims are amended after a first Office Action and new art is cited in the Final Office Action that teaches or suggest the invention, the Applicant has no choice except to file an RCE with amended claims. Additionally, new art can be discovered, such as art cited in a corresponding foreign application, that requires amendment of the claims. This is in no way an abuse of the system or the result of prosecution mishandling. Accordingly, the Applicant should not have to justify to the PTO why filing a subsequent RCE should be permitted.
2. Regarding Prof. Lemley's article, I personally respect Prof. Lemley. However, Prof. Lemley is not an experienced patent prosecutor. I completely disagree with at least one of his theses that patent attorneys abuse continuation practice to enrich themselves. That is unethical. In my experience, continuations and RCEs are filed to overcome cited art or to better protect the invention.
3. Often RCEs are filed because it is cheaper and faster than appealing. Restricting RCEs will most likely significantly increase the number of Appeals, which further increases the burden on the PTO, the financial burden on the Applicant, and delays final disposition of an application.
4. The PTO has cited the percent of continuations and RCEs filed relative to all applications but has failed to cite the actual burden of time to the PTO. Before adopting the new rule, I believe the PTO should cite the actual burden in terms of time. Given that the Examiner is already familiar with the application, previous arguments, and art cited, the burden on the Examiner to examine an RCE or continuation application should be SUBSTANTIALLY less than the burden associated with a new application. Thus, the real burden of continuations and RCEs to PTO resources is still in question. Accordingly, the PTO should not use its cited burden as justification for potentially taking away rights of Applicants.
5. Inventors and attorneys may not initially see the full extent of their invention. This can particularly occur when a new attorney takes over prosecution of the case and identifies additional features that were not

originally claimed. I do not believe that the Applicant should have to justify to the PTO the filing of a continuation application in these circumstances.

Thanks, Kent

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