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From: Dan Dettlaff [mailto:dettlaff@frontiernet.net]

Sent: Sunday, April 30, 2006 11:41 PM

To: AB93Comments

Subject: Changes to Practice of Continuing Applications, RCEs & Applications Containing Patentably Indistinct Claims

Please consider the following comments concerning the notice of proposed rule making regarding continuations:

1. The Office's claim that "current practice allows an applicant to generate an unlimited string of continued examination filings from an initial application" is inaccurate. In light of the changes to patent term (20 years from filing), there is a practical limit to the length of a string of continuing applications. The value of each subsequent continuing application decreases since the remaining life, as measured from the initial patent application, is also decreasing.
2. Consider the scenario where a patent application stems from a joint research project having multiple inventors is initially filed. Imagine that the joint inventors are otherwise not related, and indeed may have interests adverse to each other. EACH inventor desires to file a continuation to further claim their respective contributions to the joint patent; however, under the proposed rules only one inventor (the first to subsequently file) would be allowed to file a continuation application from the initial (joint) application. The first-to-subsequently-file-inventor will deprive the other joint inventors of subsequent patent rights. This is an unfair consequence, and such a law may violate due process rights of the other joint inventors since they will be treated differently than the first joint inventor to subsequently file a continuation.
3. Often the features of an invention that are important in distinguishing it from the prior art are not confirmed, or may not even be fully appreciated, until after the prior art is identified and evaluated. Continuing applications are a necessary tool in refining patent quality.
4. Continuing applications are a strategic tool also i.e., to allow some patent claims to issue in light of infringement activity. An inventor should not have to choose between filing a continuation to combat an infringer and a continuation for other purposes.
5. From the fees charged standpoint and examiner evaluation standpoint, the Office (and an Examiner) should be indifferent whether a new or continuing application is being examined. In each case, the inventor considers the claims presented worth the filing fees charged to have them examined. In fact, examining a continuation application should be less burden than examining a new application. If the Office and the Examiner are both getting credit, either financially or meritoriously, for the work than both should be indifferent. If either the Office or the Examiner is not indifferent, than the "fix" is to make examining a new application and a continuing application equivalent, not to cut-off the filing of continuing applications.

The problem of the patent application backlog is that the inflow of patent applications exceeds the outflow of patent applications examined (or otherwise dispositioned) by the Office. The proposed changes to continuation practice are aimed at choking-off incoming patent work. I disagree with this approach to fixing the backlog. This approach negatively impact innovation and leave U.S. inventions unprotected, which is bad for U.S. interests. The better approach is a supply-side improvement – truly improve the efficiency of the Office – rather than making changes aimed at curbing patent services demand.

Sincerely,

Dan Dettlaff