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Subject: Rule change regarding continuations (RIN 0651-AB93)

Dears Sirs:

Attached in PDF format is my comment regarding the proposed rule change regarding continuations (RIN 0651-AB93).

Sincerely,

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Often times a change is needed to effectuate a move in a positive direction. However, sometimes the real problem with making such a change is the uncertainty of the outcome as a result of such a change. The unpredictable result that may occur appears to be the real danger of the current USPTO rule change proposal regarding continuations. No one really knows what may be the effect of being allotted one continuation per application. Although the USPTO recognizes that the current staff is presently unable to provide quality examination as the rate of applications being filed continues to increase, simply limiting applicants to one continuation per application hardly seems like a cure to the problem. In fact, this change may well complicate matters instead of simply providing a solution. Serious consideration should be given to some of the possible negative results of this rule change.

One problem consists of placing a greater burden on the board of appeals as the rule change may well cause more applicants to appeal to the board of appeals. Applicants are more inclined to appeal to further adjust their claims since the proposed rule will prevent applicants from further working with examiners if they have already used their allotted one continuation. If a further continuation is available, applicants could make further adjustments to their claims to place them in better form for appeal or changes could be made to the claims that the examiner deems necessary. Furthermore, applicants are more prone to appeal to get broader claims allowed, which will further tax the board of appeals. The proposed rule change could even possibly lead to situations where there is an appeal on the original application and an appeal on the first and only continuation.

One of the biggest issues with the proposed rule change is that the change allows one continuation per application without taking away the practice of finally rejecting claims based on a new ground of rejection. The concept of compact prosecution allowed final rejections that are a first rejection, namely a new ground of rejection. This would bring about a truly inequitable result to applicants. Applicants are not presumed to know of every single piece of prior art when they come up with an invention. Before this proposed rule change, applicants were always given the equitable opportunity to change the claims to overcome the newly discovered prior art reference through a continuation or a request for continued examination. However, this rule change abolishes that equitable opportunity and instead creates a situation where the USPTO presumes that applicants should be aware of all possible prior art, which is a presumption that asks far too much of applicants. If the USPTO adopts such a rule change, at the very least the USPTO should change its guidelines so that no rejection may be made final based on a new ground of rejection.

While the USPTO recognizes that it has a serious problem keeping up with the demand of applications filed, this proposed rule change hardly seems the proper solution. Instead of coming up with a rule change that appears to produce no certain results, the USPTO should place its efforts, resources, and money into a more viable solution of expanding their number of examiners. The real strength of the USPTO is in its ability to examine and prosecute patents. Therefore, it seems logical that the best solution to solve the problems at the USPTO is to train and hire more examiners that are better equipped to handle the increasing demand of newly filed patent applications. However, the USPTO should not stop there. The USPTO should provide a better working environment for their examiners and reward them financially for the work that they produce so as to maintain their staff instead of constantly losing quality examiners.

While many can disagree about how to provide a viable solution to help the USPTO keep up with the demand of patent applications, all can agree that there is a definite problem. However, this proposed rule change hardly seems the right approach as the results of such a change are too unpredictable and uncertain. A solution with more concrete results and certainty would be to hire more examiners to handle the increase in demand of patent applications.

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