

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

From: Abraham, Sarah E. [mailto:SAbraham@fbtlaw.com] **On Behalf Of** Goldstein, Steven J.

Sent: Tuesday, March 21, 2006 9:17 AM

To: AB93Comments

Subject: Comments on USPTO Continuation Proposal

I have been practicing patent prosecution for 31 years. In the first 19 of those years I was a patent attorney at The Procter & Gamble Company, rising to the level of Associate General Counsel-Patents. Since 1994, I have been chairman of the Intellectual Property Department at Frost Brown Todd LLC in Cincinnati, Ohio. I am also an adjunct professor at the University of Cincinnati College of Law, teaching patent law and patent prosecution. I have a great deal of experience and insight into the patent prosecution process. My purpose in writing this letter is to urge you not to adopt the USPTO continuation proposal.

The underlying basis for the proposed rules is a belief that the current rules relating to continuations are somehow being abused by patent prosecutors. I do not believe that, in the vast majority of cases, this is true. The adoption of the GATT amendments in the 1990's eliminated almost all of the incentive to file continuations, since a string of continuations only acts to shorten the term of the patent which eventually issues. It has been alleged that patent attorneys keep filing continuations until the application gets to a different examiner who allows the application. I do not believe that in my 31 years of prosecution I have ever seen that happen. But even if that does happen, it seems that would be an internal USPTO problem to address, not a reason to cut down on the filing of continuations.

The fact is that there are many legitimate reasons to file continuations. For example, because examiners frequently do not have enough time to focus on an application, they frequently issue office actions based on a misunderstanding of the technology or the prior art involved. In these cases, we frequently get to a final rejection without a meeting of the minds on the real prosecution issues involved. We then have to file our single allowed continuation and we haven't really even begun serious prosecution.

Another issue can be seen by considering a simple obviousness rejection. In addressing such a rejection, the applicant frequently can respond in one of three ways: argument, amendment or Rule 132 Declaration (data). Because of the way the law has developed, it is preferable to try argument (and possibly amendment) before any data is submitted. If the applicant makes an argument and the examiner does not accept it, the application will receive a final rejection and the examiner most likely will not allow the filing of the data at that point. Once again, the one allowed continuation has to be filed. If it is decided to try to amend the claims in the continuation (and the examiner still does not allow the case), it is possible that the second continuation will be exhausted before any data is filed. What is the applicant supposed to do at that point if an additional continuation cannot be filed? This situation is exacerbated by the USPTO "disposal" system which encourages examiners to require the filing of continuations.

On final example. Frequently an examiner will allow some narrow claims (which have commercial value); the applicant will take allowance of those claims (perhaps to pursue an infringer), and will then file a continuation to try to get the broader claims. Once again, the one permitted continuation application has been filed but there is still significant prosecution yet to come.

All three of these cases embody legitimate prosecution---no games are being played and the patent system is not being abused (and there are many other similar examples I could give). In all three cases, the single allowed continuation has had to be used---and a petition to file further continuations likely would not succeed, since the attorney really could not argue that the arguments he wants to present in the continuation could not have been presented earlier (we could argue that the arguments should not have been presented, but not that they could not be presented). This is the problem presented by the proposal: based on incorrect assumptions, it

prevents legitimate prosecution techniques, which really are required by the current state of the patent law. This is a very unfortunate result. It does not permit the patent application to be properly prosecuted---and it appears to be based on a lack of understanding of the prosecution process.

The best way to deal with this situation is to eliminate the proposed continuation rule entirely. If that cannot be done, then the number of permitted continuations should be increased to at least three. In addition, the standard for granting a petition for an additional continuation should be relaxed---requiring that the argument or data could not have been presented does not take into account the realities of patent prosecution.

I hope this is helpful. If you have any questions, you are welcome to call me at (513) 651-6131. Thank you for your time and attention.

Sincerely yours,

Steven J. Goldstein
Chairman, Intellectual Property
Frost Brown Todd LLC
2200 PNC Center
201 East Fifth Street
Cincinnati, Ohio 45202
tel. (513) 651-6131
fax (513) 651-6981
sgoldstein@fbtlaw.com