

From: Herbert Goodman [mailto:goodman@fhgc-law.com]
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To: AB93Comments
Subject: Proposed Rules Relating to Continued Examination Practice

To the Commissioner for Patents:

My comment provides reasons why a “bypass” continuation should not be included in the proposed § 1.78(a)(1) definition of a continuing application. The discussion in the Federal Register at page 56 states that “In addition, the changes to § 1.78 (if adopted) would render the option of filing a ‘bypass’ continuation application under 35 U.S.C. 111(a) less preferable to simply entering the national stage under 35 U.S.C. 371 in an international application.” With reference to “bypass” continuations, (i) if the proposed rule is adopted the PTO examination process would be hindered rather than facilitated; (ii) the proposed rule is not supported by the PTO published arguments to justify the proposed severe limitations on continuation practice; and (iii) the proposed rule is unjust to the applicants of pending bypass continuations.

1.A. The claims of an international application often do not meet the procedural and/or substantive requirements of United States law. There may be improper multiple dependent claims. A known (i.e., not novel) product may be claimed by reciting a name for the known product which designates a new use. In the pharmaceutical field, the substantive law of most foreign countries does not permit claiming a method of treatment or prevention. An applicant who has filed an international application in another Receiving Office has the choice of filing in the USPTO by entering the national stage under 35 U.S.C. 371 and filing a preliminary amendment of the claims (and sometimes of the specification which might be a literal translation) or by filing a continuation wherein changes, including a new set of claims, are incorporated into the specification.

1.B. The procedure of filing an amended specification including a new set of claims instead of filing a preliminary amendment has been encouraged by the PTO. The “Changes To Support Implementation of The United States Patent and Trademark Office 21st Century Strategic Plan,” Federal Register/Vol. 69 No. 182/Tuesday, September 21, 2004/Rules and Regulations, page 56518, states: “Furthermore, applicants are strongly encouraged to avoid submitting any preliminary amendments so as to minimize the burden on the Office in processing preliminary amendments and reduce delays in processing the application.” The M.P.E.P., § 714.01(e) states “Filing a preliminary amendment is not recommended because the changes made by the preliminary amendment may not be reflected in the patent application publication even if the preliminary amendment is referred to in an oath or declaration.” The present position of the PTO set forth in the SUPPLEMENTARY INFORMATION of the present proposed rule changes, page 49, right column, states: “The Office also notes that not every applicant comes to the Office prepared to particularly point out and distinctly claim what the applicant regards as his invention, for example, where

the applicant's attorney or agent has not adequately reviewed or revised the application documents (often a literal translation) received from the applicant."

1.C. If the proposed rules are adopted, the filing of a "bypass" continuation application would not be a viable option, because the applicant could not file one continuation or one RCE thereof as a matter of right. Instead, the applicant would enter the national phase under § 371, together with a preliminary amendment which is a result counter to the PTO's preference that applications should be reviewed or revised by an United States attorney or agent and the application should be filed without a preliminary amendment.

2. The PTO argument in justification for the proposed rule changes is that the filing of multiple continuation applications places an undue burden on the examination process and increases the backlog of unexamined applications and, therefore, an applicant should be limited to an examination of a first application and one continuation or RCE thereof as a matter of right. Any further continuation (or RCE) would be permitted only if a petition is filed which makes a showing to the satisfaction of the director that the amendment, argument or evidence submitted in the continuation (or RCE) could not have been submitted during the prosecution of the prior-filed application. The PTO position appears to be that two examinations as a matter of right are all that is justified under the present circumstances of PTO workload. However, in the "bypass" continuation procedure wherein the examination of the "bypass" continuation application by the United States examiner is the first examination in the USPTO, the arguments set forth in the preceding sentences do not apply. There are no PTO arguments to my knowledge which support limiting the applicant of a "bypass" continuation application to only one United States examination as a matter of right.

3. The proposed rule as it relates to "bypass" continuation applications which have already been filed is unjust to the applicants. By filing a "bypass" continuation application, instead of entering the national phase under § 371, applicants acted in accordance with PTO encouragement to utilize the procedure that did not require the filing of a preliminary amendment. It is unjust to such applicants to retroactively hold that they are not entitled as a matter of right to the filing of one continuation (or RCE) of an earlier filed "bypass" continuation.

4. The discussion hereinbefore in terms of the bypass continuation application also applies to a bypass divisional application and to a bypass CIP application.

The present comments represent my views and are not to be attributed to the firm of which I am a member or to any of its clients.

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