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**From:** Grant Green [mailto:[gdgreen@sbcglobal.net](mailto:gdgreen@sbcglobal.net)]  
**Sent:** Fri 4/28/2006 10:14 PM  
**To:** AB93Comments  
**Cc:**  
**Subject:** Comments regarding proposed changes to continuation practice

Dear Mr. Bahr,

I am writing as an individual practitioner (reg. no. 31,259), mainly for lack of time to have my comments considered by other members of my department. For that reason, my comments should not be construed as having been made on behalf of my employer.

I shall first address problems I perceive with the specific proposed rule changes, and then conclude with more general observations and comments.

§1.78(d)(i-iii): The first problem with the proposed change is that it appears contrary to 35 USC §120. §120 provides that an application claiming the same invention disclosed in an earlier application and filed during the pendency of the earlier application \*shall\* be entitled to the priority date of the earlier application. The proposed change in §1.78(d), to limit priority of continuations and CIPs to only a single prior application, and to exclude all other continuation or CIP applications, would substantially diminish an applicant's rights under §120. In the absence of any statutory provision, it would appear that the proposed change is outside the Commissioner's authority to adopt.

Additionally, such a limitation is contrary to public policy. The primary purpose of the patent provision in the Constitution is to promote the progress of sciences and the useful arts: in the case of patents, this is achieved by rewarding the full enabling disclosure of new inventions. The proposed rule change would penalize the practice of filing CIP applications as additional information regarding a new discovery or invention becomes available. An applicant faced with the proposed §1.78(d)(i) would be forced to either (a) delay filing until such time as all foreseeable information had been obtained, or (b) to forego filing CIP applications that disclose additional information to the public. Both choices are contrary to the public interest in having new discoveries and inventions disclosed as early and as fully as possible.

Further, the proposed rule overlooks the fact that examiners sometimes enter more than one restriction requirement in an application (or enter a further restriction requirement in a divisional), and

sometimes revoke a restriction requirement after it has been entered.

Finally, the limitation that one cannot have already filed an RCE in the parent application, coupled with the proposed change to §1.114, means that applicants will \*always\* file a continuation at the time they receive a final rejection, to preserve his or her ability to file an RCE in the parent application later.

§1.78(d)(iv): This proposed provision would permit one to claim priority to additional applications (otherwise excluded under parts (i) to (iii)) if filed "to obtain consideration of an amendment, argument, or evidence that could not have been submitted during the prosecution of the prior-filed application." Such application must also be justified by a petition that establishes "to the satisfaction of the Director that the amendment, argument, or evidence could not have been submitted during the prosecution of the prior-filed application." Again, since the Commissioner does not have statutory authority to deny a priority claim under §120, there seems little point in such a declaration.

Further, the phrase "to the satisfaction of the Director" is vague, as it fails to establish a standard under which the Director would be satisfied. The phrase "could not have been submitted during the prosecution of the prior-filed application" is similarly questionable. Must such evidence or argument have been physically impossible to have filed, or would the fact that it would impose financial hardship suffice?

More importantly, this provision does not permit one to file a second CIP that discloses additional information regarding a discovery or invention.

§1.114(f): The limitation of prosecution to a single RCE (particularly when one cannot file an RCE prior to filing a continuation or CIP) seems counterproductive. RCE practice, like the file wrapper continuation practice it replaced, has the salutary effect of improving and streamlining prosecution, preserving all arguments (both Office and applicant) in one file, under a single PALM entry. This makes prosecution much easier for members of the public to follow.

The imposition of an additional petition requirement in order to use the RCE procedure substantially diminishes its usefulness, both to the Office and to applicants. The present procedure, under which an examiner can simply repeat his or her previous

rejections and make them final in cases where the applicant has not amended their claims, substantially eliminates the burden on the Office due to any abuse of the RCE procedure.

General: I understand the Office's interest in reducing the pendency of patent applications, and its goal of limiting continuation practice in order to reduce the number of applications it must examine. I suggest, however, that (a) inserting an additional petition requirement will result in a net increase in workload on the Office, rather than a decrease, while at the same time increasing the burden on applicants, and (b) there are better ways to approach the problem.

First, the additional petition required to file a second continuation or CIP, or first RCE, will mainly place an additional burden on the Office. In every case in which an applicant wishes (or needs) to file a second continuation application, such a petition would be filed. The Office will then need to consider and rule upon the petition, prior to further examination of the continuation. Thus, the pendency of the application will be \*extended\* (except for those cases in which the petition is denied). Further, if the decision on the petition is delegated to the examiner, it merely adds to the examiner's burden, taking away time that the examiner could otherwise use to examine the application and the prior art. Thus, there will be a strong incentive for examiners (and/or the Office, depending where the decision is delegated) to deny such petitions, which will then be followed by appeals and/or mandamus actions under the Administrative Procedures Act, which will further increase the pendency of the application.

In contrast, under current practice an examiner need only deal with the merits of the application, with which he or she is already familiar. In those cases in which an applicant has filed multiple applications claiming the same (or overlapping) subject matter, the simple expedient of assigning all these cases to the same examiner relieves the burden on the Office. If the applicant has claimed the same invention in multiple applications, he or she must disclose this to the Office pursuant to Rule 56. The examiner will immediately recognize that any prior art and argument applicable against one application will be equally applicable against the other applications. There is thus a net benefit to the Office, as each additional application can be examined much more quickly than a new application, thus freeing resources for use in examining such other new applications. Alternatively, by pooling together all of the related applications, the examiner can spend the net amount of time allotted

for the total number of applications to see that they are more thoroughly examined.

Looking at the numbers of applications reported in the supplementary information, the Office cites 11,800 as second (or greater) continuation or CIP applications, and 10,000 second (or greater) RCEs. I have not seen figures for the total number of applications filed in 2005, but note that the Office reports 355,000 applications filed in 2004. Even assuming no growth, this means that the number of second continuations and CIPs is only 3.3% of the total, and second RCEs would constitute 2.8%. (In contrast, the number of divisional applications filed is 18,500, or 5.2%.) Thus, even if the proposed rules completely eliminated all second continuations, CIPs, and RCEs, the maximum benefit to the Office would be a reduction in number of applications of 6.1%. To the extent that more than 355,000 applications were filed in 2005 (which seems extremely likely), the percentage savings is reduced. To the extent that some of the petitions for priority will be granted (which one hopes is likely), the percentage savings will be lower still. Based on the Office's statement that only "a small minority of applicants have misused continued examination practice", it is possible that the percentage of applications reduced by the proposed rules would be as little as 1%. However, nothing in the supplementary information accompanying the proposed rules addresses the impact of reviewing additional petitions. One can predict that there will be a drastic increase in the number of petitions filed – approximately 11,800 petitions for second continuations and CIPs, and approximately 10,000 petitions for RCEs based on the current figures: these figures will no doubt increase with the total number of applications. Does the possibly slight reduction in number of pending applications justify inviting an additional 22,000 petitions? In addition to the sheer number of new petitions, I believe that the Office has failed to consider the additional time that will be required in each case to review the petition. In each case in which the petition is granted, consideration of the petition will necessarily have increased the pendency of the application. I suggest that this is counterproductive, and that the Office's time is best spent actually examining the applications, rather than deciding petitions.

A much more productive savings could be achieved by overhauling current restriction practice. The Office recently considered possible ways to improve restriction practice, all of which were ultimately rejected as too expensive and too time-consuming. However, the Office failed to consider the possibility

of abolishing or substantially limiting restriction practice. Restriction practice is not required by statute: §121 permits, but does not \*require\*, the Commissioner to divide an application containing more than one invention. Thus, restriction practice can be reformed within the Commissioner's authority.

Under current restriction practice, most new applications are subject to a restriction requirement that seeks to divide the claims into as many groups as possible. It is not unusual to encounter a restriction requirement with 30 groups or more, and I have seen restriction requirements with more than 100 groups. In such cases, an applicant must pursue a large number of applications in order to obtain effective coverage for the genus of compounds originally claimed. This is a burden not only on the applicant, but also on the Office, which must examine each of the applications individually. Due to the Office's policy of assigning divisional applications to art units based on the subject matter claimed, the divisional applications are often assigned to examiners who have not previously seen the specification, and must examine it from scratch. I suggest that it would be more efficient if the Office either abolished restriction practice, or limited restrictions to those cases in which two claimed inventions are literally unrelated (for example, an application claiming a digital camera, and an improved mouthwash). If restriction practice is retained, I suggest that all divisional applications should be examined by the same examiner. By reducing the number of divisional applications filed, the burden on the Office to examine additional applications is relieved. By having the same examiner examine all divisionals filed, the efficiency of examination (and thus the application pendency) is improved: because the examiner will already be familiar with the specification, the invention, the relevant art, and applicants' prior arguments, he or she can more quickly locate process the divisional applications. Additionally, by eliminating the need for restriction requirements in most applications, the Office could reduce examiner workload and application pendency immediately, by eliminating the need to consider and justify a restriction requirement, and the time necessary to issue and respond to same.

This may require some reorganization of the examining corps, as applications need not be assigned to different art units based on narrow divisions of subject matter. An examiner's training and competence in the chemical units, for example, is likely such that the same examiner can examine applications whether they cover e.g., only nitrogen-containing heterocycles, or nitrogen and sulfur-containing heterocycles. Similarly, an examiner in the

biotechnology units is probably equally competent to examine claims regarding the DNA sequence of a new gene \*and\* the amino acid sequence of the corresponding protein. Further, the search for the DNA sequence will likely turn up every reference relevant to the protein, and vice versa. Separating these claims into two (or more) applications, and requiring that essentially the same search be repeated for each application is a waste of USPTO resources.

Thank you for your consideration.

Respectfully submitted,

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