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To: AB93Comments

Subject: Comments on Proposed Changes in Practice for Continuing Applications, RCEs, and Applications Containing Patentably Indistinct Claims

Comments on Proposed Changes in Practice for Continuing Applications, RCEs, and Applications Containing Patentably Indistinct Claims

May 2, 2006

AB93Comments@uspto.gov

U.S. Patent and Trademark Office
Alexandria, VA 22313-1450

Ladies and Gentlemen:

This e-mail is in response to the proposal published in the Federal Register, Vol. 71, No. 1, Tuesday, January 3, 2006, 71 F.R. 48, to amend the Rules of Practice in Patent Cases for continuing applications, RCEs, and applications containing patentably indistinct claims.

The comments below are my own, and do not necessarily reflect the views of my Law Firm, any client, or any organization of which I am a member. They are, however, based on my nearly 40 years of patent practice.

The proposal notes the increasing backlog of patent applications pending in the USPTO, and proposes what many if not most practitioners regard as drastic measures to deal with the backlog. Others will tell you why the proposed solutions are not statutory, contrary to established precedent, overkill, unfair, or just bad ideas. I offer instead a few simple measures that may help ease the backlog.

1) HIRE MORE EXAMINERS.

Oral presentations explaining the need for the new Rule changes state

that the size of the growing backlog is such that it cannot be cured simply by hiring more examiners. I fail to see why this is so.

Suggestion: If the current office space will not hold all the new examiners the USPTO needs, or if there are not enough applicants in the Washington, D.C. market, establish satellite Offices in large cities around the country (specifically contemplated by 35 USC 1(b)).

Some examiners leave the Office because they are married to a person who moves away (or they marry a person who lives away) from the Washington, D.C., area.

Suggestion: Let examiners who have shown that they are competent continue to be examiners with mini-satellite Offices in their homes, wherever they may live in the United States. Transfer of paper files should not be a problem, as more and more files are electronic. Examiners in satellite Offices could be limited to the examination of applications in electronic files.

2) ENCOURAGE UNLIMITED FREE SUSPENSIONS OF APPLICATIONS.

Currently, most suspensions under 37 CFR 1.103 require a petition with reasons justifying the suspension, and a fee for consideration of the petition; and are granted for only a period of six months. These provisions made sense when patent terms were 17 years from issuance, but are unnecessary for applications whose patents will expire 20 years from the effective filing date claimed. Some patent applications are filed because there is a deadline to do so (such as a public use or publication, or a Paris convention or provisional application deadline to claim the benefit of an earlier application), even though the product is nowhere near ready for market, and in fact may never be marketed by the patent applicant.

Suggestion: Allow the people who file such applications (or anyone who wants to delay the expense of the patenting process) to request an unlimited suspension of their application at any time, without fee or justification. Any time while under such a suspension would be counted as an applicant delay in failure to promptly prosecute, and would not result in a Patent Term Adjustment. Or perhaps such a suspension would be deemed a complete waiver of Patent Term Adjustment.

3) ENCOURAGE SUBMISSION OF PRIOR ART BY THIRD PARTIES.

37 CFR 1.291 allows for protests, but for the most part only if the protest is filed before publication of the application. 37 CFR 1.99 allows for third party submissions after publication, but only for 2 months after publication.

The PAIR system has recently been revised to provide an estimate of when a first Office Action might be expected in a pending, but as yet unexamined, application. Apparently, these estimates are available only to the Applicant's representative.

Many times, people who have prior art and / or a motive for submitting it do not learn of a published application until after it has been published for a while. Let these people help the Examiners find prior art that may be useful in examining the applications. To do so would be more efficient, and a better service to the public, than making people who have prior art and / or a motive for submitting it watch the applications get issued, and then get sued on an invalid patent (or less drastically, file requests for reexamination).

Suggestion: Publish estimates of when a first Office Action might be expected on Public PAIR, and allow a 37 CFR 1.99 third party submission if it is filed when the estimated first Office Action date is at least 3 months off (or some other time period that makes sense).

4) ALLOW CHANGES IN WHO EXAMINES THE APPLICATION.

Current policy is understood to be to assign continuing applications to the same examiner who examined the parent application, and part of the problem is understood to be that some examiners are tired of "re-work" applications they have seen before.

Suggestion: Allow anyone examining a third- (or more) generation application to request a transfer of the application to someone else. Conversely, allow an applicant filing a third- (or more) generation application to request (for a fee) a transfer to someone else.

5) SPEED UP THE PROCESS OF GETTING TO THE BOARD OF PATENT APPEALS.

Currently, the Board of Patent Appeals and Interferences boasts of a vastly reduced backlog. Some of the reduced backlog at the Board,

however, is because it can be difficult to get appeals to the Board. The new Rules for appeals (37 CFR 1.67(c)(1)(ix) and (x)) require an evidence appendix and a related proceedings appendix. If there is no evidence to put in the evidence appendix, or related proceedings to put in the related proceedings appendix, some attorneys have assumed that the appendices are not needed. The USPTO position, as published in the MPEP (8th ed. Rev. 3, August 2005), appears to be that if there is no evidence or related proceedings, there should be appendices anyway, with the word "none". (MPEP 1205.02, p. 1200-15, Rev. 3, August 2005). If a non-compliant brief is filed, the usual remedy is for the Examiner to give a month to file an amended Brief. However, the Examiner is not supposed to require an amended brief for a "minor non-compliance" such as a missing evidence appendix and/or a missing related proceedings appendix, if the record is clear that there was no evidence and/or related proceeding to include in the appendices. (MPEP 1205.03, pp. 1200-16 and 1200-17, Rev. 3, August 2005). Nevertheless, administrators at the Board are returning applications to the examiners, if the brief lacks "empty appendices", or if less than three conferees signed the examiner's answer, or if all the information disclosure statements are not properly initialed. The applications then take months to get returned to the Board.

Suggestion: Have the Board and the ex parte examiners follow the same rules with respect to the submission of "empty appendices". Have conferees (or another person in the examining group) review the files of appealed applications, for the same informalities for which the Board administrators now examiner the files; and get the problems fixed before the examiner's answer is mailed.

Other applications languish for months or years waiting for an examiner's answer.

Suggestion: Have someone in the Group Directors' offices watch the docket, and say "If you can't write a suitable examiner's answer in six months after a brief is filed, either re-examine and reopen prosecution with better references, or allow the application."

If the process of getting an appeal heard by the Board were speedier, more applicants would appeal what they consider to be bad rejections, rather than issuing the narrow claims the examiner is willing to allow, and filing a continuation to get proper consideration of the claims which the Applicant believes are justified.

6) TRY LESS DRASTIC MEASURES FIRST.

About 20 years ago, the Office eliminated most petitions for extensions of time by moving to the present system of "buying" extensions by paying a fee when the response is filed.

Suggestion: Allow applicants who feel the need to file more than two continuing applications or Requests for Continued Examination to do so for an appropriate fee - or alternatively, to file a petition explaining the need for the continuing application. (The fee could be progressive, i.e., more for each successive continuing application.)

If all of these procedures were adopted, I believe that there could be a substantial reduction in the number of applications awaiting first action - with less discomfort to inventors and the patent bar - and with less expensive and time-consuming litigation arguing whether the proposed Rule changes are not statutory, or contrary to established precedent.

submitted,

Respectfully

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