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Sent: Tuesday, May 02, 2006 9:45 PM

To: AB93Comments

Subject: Comments on Changes to Practice for Continuing Applications

The undersigned hereby comments on the notice of proposed rulemaking entitled Changes to Practice for Continuing Applications, etc., 71 Fed.Reg. 48 et seq. The undersigned is a partner in the Fish & Neave IP Group of the law firm of Ropes & Gray LLP. However, these comments are those of the undersigned alone and do not necessarily reflect the views of Ropes & Gray LLP.

The proposed rules limit the number of continuation or requests for continued examination that are available as a matter of right to one in any one application, and also requires that all patentably indistinct claims be presented in a single application. In public statements subsequent to publication of the notice of proposed rulemaking, the opposition of the patent bar and the applicant community in general to being forced to take positions on claims prior to examination have been clear. Accordingly, the undersigned will not repeat in these comments the many well-publicized reasons that the applicant community is opposed to the proposed rules. However, the undersigned agrees with those reasons.

The undersigned does not believe that the Office has the statutory authority to make the proposed rule changes, at least as to continuation applications. 35 USC 120 clearly states that an application that meets certain requirements "shall have the effect" of an earlier-filed application. The only limitation that Section 120 allows the Director to impose relates to when during pendency of the later application the benefit claim may be made. The power to impose that limitation was added by the American Inventors Protection Act in 1999 to enable the Director to prevent an applicant from delaying publication of an application by delaying the benefit claim. It would be a big stretch for the Office to rely on that power to limit the timing of the benefit claim to "never," and for a reason having nothing to do with the reason that the power was granted in the first place.

As for requests for continued examination, the statute (35 USC 132(b)) apparently gives the Office complete discretion, specifying only that the Director shall prescribe regulations for continued examination. Although the intent of that statutory provision was to make things easier on applicants by eliminating the need for the artifice that was the continued prosecution application, the provision admittedly appears to give the Office a free hand. Nevertheless, a request for continued examination, as the Office is fond of telling applicants, is not a new application, and the filing of an RCE does not increase the number of pending applications. While some believe that many continuation applications are abusive attempts by applicants to claim more than they are entitled to, the undersigned is not aware of any criticisms of that nature directed to RCEs. It is rare that an RCE is used for anything other than a good faith attempt to advance prosecution in a situation where it has been difficult to come to a meeting of the minds with the Examiner.

Office officials have been speaking in defense of the proposed rulemaking, noting that no other "tribunal" allows unlimited "bites at the apple." That is not true. While it may be true of "tribunals" such as courts, there are many agencies where one can keep on returning with an amended application. For example, land use agencies, such as local zoning and planning boards allow a landowner to come back with a revised plan - the landowner's real property does not become unbuildable simply because the initial proposal is rejected. So too with intellectual property - an applicant who has truly made an invention does not cease to have an invention simply because an Examiner manages to find, seriatim, four reasons to reject the application.

The undersigned refers to four reasons because Office officials, in justifying the proposed rulemaking, have stated that an applicant will still have four "bites at the apple" - one reply to each of two actions in an application and its continuation. However, it has been rare since the

creation of the RCE for any Examiner to accept any amendment after final rejection (other than one adopting an Examiner suggestion) even if it clearly complies with 37 CFR 116(b); it is too easy for the Examiner to simply tell the applicant to file an RCE. If that practice continues, that will unfairly take away one of an applicant's "bites" in each application. If the proposed rules are enacted, training to "reacquaint" Examiners with 37 CFR 116(b) is required.

The proposed rulemaking would allow further continuations if the applicant could show that the amendments being offered in a further continuation "could not have been made earlier." That standard requires clarification. Although it has always been the standard under 37 CFR 116(b), it has never been well-established what qualifies as something that could not have been done earlier, because whenever it became an issue, a continuation was always available.

Thus, if an applicant thought in good faith that he had a good position on a certain claim, amended or otherwise, that should be a sufficient reason. Similarly, whenever the Examiner finds new prior art, that should be a sufficient reason. The Office could take a hard line, requiring an applicant to fall back after the first rejection to safe, extremely narrow claims, but that would be unfair. Applicants are entitled to claim as broadly as their inventions allow. And the companion rulemaking limiting the number of claims that can be presented for examination would make it difficult to present a range of claims, which otherwise would be a way, in one reply, to present extremely narrow claims that have a good chance of allowance but offer weak protection, as well as successively broader claims that test the limits of allowability, and which the applicant honestly believes he is entitled to.

On a similar note, the proposed rulemaking would essentially eliminate a well-established and, by all accounts, benign practice according to which an applicant, faced with some allowed claims and some rejected claims, accepts the allowed claims and pursues the rejected claims in a continuation. Unless the Office were to state unequivocally as a matter of policy that in such cases a second continuation, if necessary to continue prosecution of claims rejected in the first continuation, would be considered justified, applicants will instead fight for all claims in the first application, to maximize the number of "bites" available as to the initially rejected claims.

If the Office is serious about reducing the number of continuing applications, it might consider starting, before imposing Draconian measures on applicants, with putting its own house in order. The undersigned refers to out-of-control restriction practice that forces applicants to file large numbers of divisional applications, which increase the total number of applications filed just as surely as continuations. The undersigned recently received a restriction requirement in an application with seven independent claims. While not every independent claim should automatically be considered a different invention, this was a seven-way restriction requirement. In this particular case, the Examiner purported to justify the seven-way requirement based on classification, and yet several of the "different inventions" were classified in the same classes and subclasses. Under a unity of invention standard, there clearly was only one invention, and a reasonable restriction might have been a two- or three-way restriction. Indeed, during international examination of the counterpart international application, the same Examiner did not raise any unity objections. The undersigned's point is not to complain about the outcome in that particular case, but to point out that there are things that the Office can do to minimize the number of applications filed before penalizing inventors.

Respectfully submitted,

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Reg. No. 31,069