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**From:** John Kacvinsky [mailto:jfk@kacvinskylaw.com]

**Sent:** Thursday, March 02, 2006 12:44 PM

**To:** AB93Comments

**Cc:** 'John Kacvinsky'

**Subject:** Proposed Rule Changes

Dear Commissioner Doll,

Attached please find a letter with comments presented on behalf of Kacvinsky LLC in favor of the United States Patent & Trademark Office's Notice of Proposed Rule Making entitled "Changes to Practice for Continuing Applications . . ." published on January 3, 2006, at 71 Fed. Reg. 48. As detailed in our letter, our firm supports these rules.

We appreciate the advance notice and the opportunity to comment on the Office's proposed rule making. We think that there are good practical and policy reasons behind the proposed regulation of continuation applications. We urge the Office to enact the proposed rules without substantial revision.

Please let us know if we can provide any further information to assist in your decision.

Best Regards,

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March 2, 2006

**Via Electronic Mail**

Mail Stop Comments  
Patents, Commissioner for Patents,  
P.O. Box 1450, Alexandria, VA, 22313-1450

RE: Proposed Rule Making

Dear Commissioner Doll:

These comments are presented on behalf of Kacvinsky LLC in favor of the United States Patent & Trademark Office's Notice of proposed rule making entitled "Changes to Practice for Continuing Applications . . ." published on January 3, 2006, at 71 Fed. Reg. 48. As we will detail below, our firm supports these rules.

Kacvinsky LLC is a significant customer of the United States Patent & Trademark Office ("the Office"). We employ approximately 6 patent practitioners, and in 2005 we received about 15 issued patents. In addition, we are currently prosecuting hundreds of pending applications. Each year we pay, on behalf of our clients, substantial fees to the Office.

The Federal Circuit has recognized the Office's authority to regulate continuation practice. The proposed rules are an appropriate exercise of that authority, in that they do not institute a numerical limit on the number of continued examination filings or a time limit on the filing of continuations. Applicants are afforded an opportunity to justify the third and later applications in a chain.

The proposed rules will tend to reduce the pendency of patent applications. Increasingly long times before initial examination have concerned many practitioners. Five years to a first office action has gone from a rarity to a commonplace occurrence in certain classes. Reducing the time between filing and issuance of a patent will provide greater legal certainty to the public. We commend the Office on its choice to apply its finite examining resources toward faster examination of new applications rather than permitting the current emphasis on older applications.

The proposed rules would not affect the vast majority of our applications. We typically finish prosecuting the majority of applications without resorting to even two

continued examination filings. Moreover, in situations that do not warrant a second continued examination filing, applicants can still correct mistakes (and broaden claims where appropriate) through the reissue process.

The availability of one continued examination filing as a matter of right provides applicants ample opportunity (up to four office actions) to identify and claim what is regarded to be their invention. Experience has shown that few original applications merit more than two continuations. Yet that small group of original applications proliferates into a large number of applications that get priority and disproportionately contribute to the backlog.

The proposed rules will also reduce wasteful litigation, because the presence of continuations inhibits resolution through negotiations. Today, if the patentee has continuations still pending for a patent that it has asserted, the accused infringer cannot explain its non-infringement defense, because the patentee will merely re-write its claims of the continuation. At that point, the patentee's only solution is to sue when in fact the lawsuit may be misguided. By requiring that later continued examination filings be shown to be necessary, the proposed rules will eliminate continuations merely being filed to cover products unknown at the time of the prosecution of the original application or the subsequently filed continuation that exists as of right. Greater legal certainty to negotiations between patent holders and others will result from the elimination of the not uncommon practice of a perpetual, unnecessarily delayed stream of continued examination filings. We approve of the greater legal certainty in licensing negotiations that will result from the Office preventing unnecessary delay during prosecution.

Lastly, we also generally support the newly proposed rules to limit redundant patentably indistinct claims that waste examination resources. We think such restrictions are necessary to avoid abusive filing tactics by applicants seeking to circumvent the proposed regulation of continued examination filings.

A number of our clients think that the adoption of the proposed rules by the Office is vital to their interests. Unlike individuals expressing their personal views and bar associations stating a consensus position, we also represent our clients' interests who both own patents and have to deal with assertions. We add our voice to theirs in supporting the Office's proposed rule making to expend its resources on multiple continued examination filings only where necessary.

In conclusion, we appreciate the advance notice and the opportunity to comment on the Office's proposed rule making. We think that there are good practical and policy reasons behind the proposed regulation of continuation applications. We urge the Office to enact the proposed rules without substantial revision.

Very Truly Yours,

KACVINSKY LLC

John F. Kacvinsky

For the Firm