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From: George Leavell [mailto:george@mpiplaw.com]

Sent: Wednesday, February 22, 2006 10:00 PM

To: AB93Comments

Subject: Comments to 37CFR proposed rules changes

Thank you for receiving and considering comments for those of us in the field. As a patent attorney with over 7 years experience writing and prosecuting patent applications, I have several comments to share.

The current rules and practice DO NOT allow an applicant to "generate an unlimited string of continued examination filings". An applicant can only file a continuation application during the pendency of the patent application and that is a sufficient limitation.

Regarding requests for continued (RCE) prosecution: the vast majority of RCEs are the result of a low quality initial search by the examiner and/or a poorly written, poorly thought out (e.g., superficial) first office action that only marginally touches on the subject matter of the claims.

By way of example, the initial search seems to be based on a very superficial review of the claims and specification and a quick "similar words and phrases" search of patent databases. The first office action then says something like Reference A teaches the "widget inserted in the thingamajig coupled to the substrate" of claim 1.

When in fact, all that reference A "teaches" is the terms "widget", "thingamajig" and "substrate" within 4-10 words of one another and the subject matter of the applicant's application and reference A are totally unrelated.

Applicant is unable to respond with an argument or an amendment on the merits of the claims as the cited reference is too far off point. Therefore the typical first office action response merely points out that the examiner did not understand (i.e. read) the application and/or the cited reference.

The result is the examiner performing a sometimes comprehensive search and other times a marginally better search, that identifies "reference B". The Examiner then issues a "final" rejection based on the "combination" of reference A and reference B.

Such a "final" rejection should not be final but the applicant is left with little recourse but to file an RCE or an appeal. The RCE is the less expensive alternative and therefore often the only economic choice for the

applicant, especially small entities and sole inventors.

A more effective change would mandate a better quality search and a better quality examination on the first office action.

Regarding continuation in part (CIP) applications:

CIP applications should be unlimited during the pendency of any application as during the 2-5 years of prosecution the invention is often refined and the Applicant should be able to secure coverage for those new innovations.

Divisional applications and CIP applications, both continuation applications, are caused in large part BY THE USPTO and NOT by the applicant. For example, many times the Applicant invents an apparatus and a method for using the novel apparatus. The PTO typically restricts the application to either the method or the apparatus but not both.

Under the proposed rules the applicant would not be able to apply for both the method and the apparatus inventions unless they filed two applications at the same time, thereby increasing the number of applications filed in the PTO and also increasing the cost to the applicant.

Further, if the applicant developed two novel uses of the novel apparatus, and disclosed and claimed both novel uses in the initial application, the current practice of the patent office would be yet another restriction requirement.

If the applicant subsequently developed a third novel use, the proposed rules would bar him from seeking patent protection for the third novel use.

Under the proposed new rules, the only viable option left to the applicant is to file multiple applications at the same time rather than somewhat in series as is often currently done.

This will result in even more applications filed with the PTO and not less and substantially increased costs on the applicants thereby stifling innovation and not fostering and promoting innovation as patent protection is supposed to provide.

In summary, multiple continuations are not the cause of the applicant but the cause of the PTO itself. The proposed rule changes would only increase the number of similar applications filed rather than reduce it. Such increased filings would increase costs to inventors and thereby stifle innovation and not foster or promote innovation as patent protection is supposed to provide.

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From: George Leavell [mailto:george@mpiplaw.com]  
Sent: Thursday, April 06, 2006 9:18 PM  
To: Clarke, Robert; AB93Comments; Lucas, Jay  
Subject: Comments to proposed 37CFR rule changes

I attended a meeting with the USPTO's Jay Lucas on March 31, 2005 to discuss the proposed rule changes.

Mr. Lucas stated the problem being addressed by the proposed rule changes is:

Too many continuations (RCEs, CIPs, other continuations) delay the prosecution of newly filed applications.

Mr. Lucas presented statistics that show that the number of CIPs and other continuations have not increased significantly. Therefore any proposed limitations on filing CIPs and other continuations would not significantly reduce the total number of continuations filed.

Further, limiting the number of CIPs cuts off an inventor's rights which should be protected if at all possible and not cut short or limited. This is especially true if the CIPs are not a problem for the PTO. This limitation of CIPs could also be attacked in Court and ultimately stricken.

As CIPs and other continuations do not appear to be part of the "problem" for the PTO, then the CIPs and other continuations should not be limited at all in the proposed rule changes.

Mr. Lucas' problem statement could be summarized as: "Too many RCEs are filed."

From Mr. Lucas' description of the proposed rule changes, the changes seem even less effective at reducing the number of RCEs because there are so many exceptions that allow additional continuations/RCEs/CIPs. Mr. Lucas also stated that an increase in appeals is also expected to occur.

Mr. Lucas stated additional RCEs can be filed if a good reason is given. Good reasons could be newly cited prior art - which is almost always the case.

Therefore the exception nearly consumes the rule.

I suggest an alternative approach that could actually reduce the number of RCEs by addressing the REAL ISSUE of poor quality searches and the resulting off-point office actions and multiple RCEs:

First and foremost, allow the Examiners more time to actually read the ENTIRE SPECIFICATION and not just read the abstract, claims and drawings. This effort should be REQUIRED BEFORE the first office action or search. The PTO should put some enforcement process in place to make sure the examiner has read the entire specification.

I cannot quantify the number of times the examiner has not read the specification and has therefore misunderstood the meaning of a term or phrase that is central to the patentability - remember the inventor is his own lexicographer and therefore often does actually create/redefine words. The inventor often does this even if patent counsel has advised him

otherwise.

Second, if a patent application is not issued or abandoned after the FIRST RCE, then at the first office action of the SECOND RCE the following must happen:

1) A new supervising patent examiner (SPE) that has not participated in examining the application must review the file history to that point.

If the new SPE does not agree with the prosecution to that point, then the RCE count should be rolled back to ZERO and the file annotated accordingly and therefore the first office action of the SECOND RCE would actually be treated as the first office action on that application and not the first office action of the SECOND RCE, or even the FIRST RCE.

If the new SPE agrees with the prosecution to that point, then the RCE count remains at TWO and:

2) The new SPE and the original examiner and the original examiner's SPE must then all agree on and sign the new search and the first office action of the SECOND RCE, before the office action is issued.

3) The first office action of the SECOND RCE will include a suggestion as what is allowable in the application (such allowable subject matter may or may not be in the claims). This will help focus the prosecution on what the examiners think is patentable and thereby illustrate that they understand the invention and have read the specification. This will also accelerate the completion of the prosecution of the application.

4) The first office action of the SECOND RCE will include an invitation to discuss the office action by telephone.

Finally, the PTO needs to start doing some feedback on their own internal processes. In this instance, statistics should be maintained for each art unit. If a particular examiner has notably more 2nd (and subsequent) RCEs than the rest of the art unit, then the examiner's work should be reviewed for opportunity for additional training. Maybe the examiner needs additional training to conduct more on point searches or maybe the examiner's language skills need help.

The above actions will place the burden on the patent office to carry out more effective examinations and will consume additional man-hours however, this will result in:

- 1) Reduced RCEs
- 2) Shorter prosecution times
- 3) Fewer appeals
- 4) Better trained patent examiners
- 5) Better examined patents
- 6) More enforceable patents

Mr. Lucas stated it well when he said there are problems that need to be addressed or the patent system will be irretrievably broken. That said, I do not believe the proposed rules will address or resolve the issues and will ultimately result in more RCEs, more appeals and more delays because the root cause has not been addressed.

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