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From: Van Mahamedi [mailto:VMahamedi@SMLAWIP.com]

Sent: Wednesday, May 03, 2006 4:44 PM

To: Clarke, Robert

Subject: Comments for proposed rules on continuation practice

Dear Mr. Clarke

Please consider the attached comments in response to the Proposed Changes to Practice for Continuing Applications, Request for Consintued Examination Practice, and Applications Containing Patentably Indistinct Claims, Notice of proposed rulemaking, first published in the Federal Register at 71 Fed. Reg. 48 <<http://www.uspto.gov/web/offices/com/sol/notices/71fr48.pdf>> (January 3, 2006) and then published in the Official Gazette at 1302 Off. Gaz. Pat. Office 1318 <<http://www.uspto.gov/web/offices/com/sol/og/2006/week04/patcntn.htm>> (January 24, 2006).

Thank you.

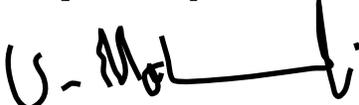
Van Mahamedi
Attorney

I believe the PTO should not adopt any of the proposed rules on continuation practice, as the proposed rules are counterproductive, and a disservice to the public. I am in complete agreement with the comments presented from AIPLA, and would request the PTO consider their sound opinion. I also encourage the PTO to consider these consequences which I believe would arise from the new rules:

1. The rules will increase all backlogs at the PTO. The number of new continuations will increase in the short term, as clients seek to preserve rights that may be lost. The number of divisionals will also increase. Most importantly, new applications filed will increase, as there will be incentive to over compensate at the time of initial filing. Meanwhile, Applicant's will be filing appeal briefs and much longer, more argumentative Office Action responses.
2. The relationship between practitioners and examiners will become more adversarial, and less cooperative. The current practice of allowing prosecution to be extended without loss of rights affords both Applicant and Examiner an opportunity to discuss merits of respective arguments and to negotiate. This is good for Applicant and the public. In contrast, with the new rules, Applicant's will focus on preparing for the possibility of appeal at every step. To analogize, the new rules would be like eliminating mediation in favor of strict litigation practice.
3. The new rules bring uncertainty to our system. There are far too many unresolved issues to tackle at one time. For example, what will be the standard to grant applicant's a petition for a second RCE? What if the Applicant has an unrealized embodiment? Would the new continuation rules preclude what the reissue rules permit (if so, why-since reissue is so much more inefficient)? These rules will not be well defined for a long time, and in the meantime, rights will be lost from confusion and uncertainty. I also echo AIPLA's concern that the proposed rules are an overly aggressive interpretation of the statutes (e.g. 35 USC 121).
4. By issuing these proposed rules, the PTO will in effect be attempting to reduce its burden by tilting the system to favor the incremental patent filer, at the expense of the filer who is presenting more innovative ideas. Those with more innovative ideas must now realize all embodiments to their inventions early on, and may have limited ability to procure patent protection on all aspects. The Office should appreciate these filers are often privately funded companies. In this respect, the rules favor large business, who in my opinion, is more likely have use for incremental improvement applications.
5. I believe the PTO has embarked on a high-risk approach without first considering more safe approaches to the problem of reducing backlog. Consider:

- enacting a requirement that would make Applicant's present precise 112 support in their amendments, and issue standards for accepting new claims and claim amendments that comply with the so-called "written description" requirement.
- expedite applicant's who provide prior art and an initial self-examination.
- outsource more, consider contacting with a US research company as well overseas patent offices like you have done with KIPO.
- impose tougher restrictions with regard to Section 112 requirements, prior art searching and other requirements, on continuation applications.
- publish all applications, implement features to allow the general public to see and review patents with images, and to understand them better, and make the protest rules easy for anyone to use. For example, let the public view patents by category, and submit references by email.
- lastly, work with the patent bar to come up with a solution. We all want faster examination, and you have our attention now.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'U-Mahamedi'.

Van Mahamedi