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From: Clarke, Robert

Sent: Wednesday, May 03, 2006 3:39 PM

To: AB94Comments

Subject: FW: Proposed Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims, Notice of proposed rulemaking

-----Original Message-----

From: Metzger, David R. [mailto:dmetzger@sonnenschein.com]

Sent: Wednesday, May 03, 2006 3:22 PM

To: Clarke, Robert

Subject: Proposed Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims, Notice of proposed rulemaking

Dear Mr. Clark:

Please find attached my comments regarding the proposed Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims.

Sincerely,

/S/

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May 3, 2006

The Honorable Jon Dudas
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark
Office
Mail Stop Comments
P.O. Box 1450 Alexandria, VA 22313-1450

Attn: Robert W. Bahr
Senior Patent Attorney
Office of the Deputy Commissioner
for Patent Examination Policy

Re: Comments on Proposed Changes to Practice for Continuing Applications,
Requests for Continued Examination Practice, and Applications Containing
Patentably Indistinct Claims, 71 *Fed. Reg.* 48 (03 January 2006)

Dear Under Secretary Dudas:

This is to express my full support and adoption of the testimony and comments submitted by the American Intellectual Property Law Association (AIPLA) and the Small Business Administration (SBA) in opposition to the above-identified proposed rulemaking. I incorporate herein by reference the AIPLA's and SBA's comments. I make below some more general comments.

I have been practicing in the patent prosecution area for 20 years. This is the first time that the USPTO has deliberately set itself up against the its clients, namely applicants and the patent practitioners. Despite all of the prior changes in the Patent Statute and USPTO regulations, the USPTO has always worked with the community to implement the changes in a way the works for everyone. I am quite taken aback by the "town hall meetings" that the

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USPTO embarked upon to explain, sometimes quite testily and dismissively, why these rules are going to be adopted.

Additionally, I note that the proposed rulemaking plays fire with a system that is generally running well from a societal and national economy viewpoint. The current practices and systems are well understood by applicants or all types, patent practitioners, the courts, and, of course, the USPTO. There may be a few abusers of the system, but such abuses have been ameliorated, if not eliminated, by the adoption of 20 years from initial filing patent life spans, and 18 month publication. Additionally, the Circuit Court of Appeals for the Federal Circuit has upheld the doctrine of prosecution laches. See, *Symbol Technologies/Cognex Corporation v. Lemelson Medical, Education & Research Foundation*, 277 F.3d 1361 (Fed. Cir. 2002). See also, M.P.E.P. Sec. 2190. To introduce such extensive radical and contentious changes will most likely wreck havoc upon the system, and will, not end up help the backlog issues facing the USPTO, as noted in the APLA report, and many other commentators.

Moreover, the USPTO is attempting to do this outside of the normal legislative process and without sufficient legal basis, as noted by the various commentators. This alone should give the USPTO pause in proceeding further.

The USPTO's concern about the notice function of claims is curious, since that notice function really is only viable in two instances: When a patent issues, and published claims that issue essentially unchanged. Upon no other claim can or should potential defendants rely. Indeed, it is a prudent endeavor (and not a difficult task) for one wishing to practice all or a portion of a novel disclosure in patent application, to evaluate for him or herself the extent of the disclosure and its permutations, much like a patent applicant does. This type of evaluation is undertaken often. However, the proposed rule making is made under the mistaken belief that applicants should be relegated to their initial evaluation of what they have invented. I fail to see how this would help innovation and innovators in this country.

The lumping together of requests for continued examination with continuations, continuations-in-part, and related applications, is particularly disturbing. RCE's were adopted for the specific reason that they provide a way to deal with and advance examination beyond what already amounts to an effective one chance for amendment. The proposed rulemaking limiting of the availability of only a single RCE amounts to effectively limiting amendments to only two. This hardly serves any useful purpose in the on-going dialog that is the patent examination process.

What is apparent is that the USPTO is seeking to treat the preparation and examination of patent applications much like the production of widgets. Yet, each patent application is a

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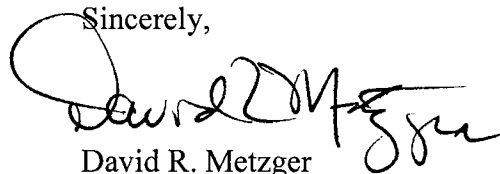
uniquely customized product that requires its own special considerations, even though standard techniques are applicable during the preparation and examination thereof. It is through the examination process that the patent product is finally produced. The proposed rulemaking seems based on the erroneous assumption that the initial application is the final product.

Additionally, it seems that the USPTO is seeking to become more like the European Patent Office and/or the Japanese Patent Office. Yet, I do not see either as a Holy Grail of patent offices or their laws and regulations as at all best for supporting innovation and innovators (small entity or large entity). Our systems have developed to well accommodate our customs and expectations.

Although the USPTO is seeking "quick fixes" to reduce its backlog of work, in the end, the fixes that will work best will be those that address long term concerns relating to funding and the USPTO workforce. It may be, as mentioned to me by another practitioner, that the USPTO would be better served by establishing regional offices to take advantage of a largely underutilized technical workforce that exists outside of the Washington, D.C. area. I can well imagine regional offices in Chicago and Northern California.

For the reasons expressed by all the commentators, and the AIPLA and SBA reasons in particular, I submit that the proposed rules not be adopted, but that the USPTO first deal with its internal workforce and funding issues. Patent applicants can ride out a few years of backlog in order to retain our very good system that is highly effective at protecting innovators and their innovations.

Sincerely,



David R. Metzger