

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

**From:** Clarke, Robert

**Sent:** Thursday, May 04, 2006 12:56 PM

**To:** AB93Comments

**Subject:** FW: Comments on Continuing Application Practice

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

**From:** Pruden, Mike [mailto:mpruden@MacLean-Fogg.com]

**Sent:** Thursday, May 04, 2006 12:51 PM

**To:** Clarke, Robert

**Subject:** Comments on Continuing Application Practice

Dear Mr. Clarke,

Attached herewith are my comments on the proposed rule changes for continuing applications, rce practice, and applications containing patentably indistinct claims.

Thank you for providing an opportunity to present comments on the proposed rule changes.

Very truly yours,

Michael Pruden  
Reg. No. 52,135

# MacLean-Fogg Company

May 3, 2006

VIA ELECTRONIC MAIL ([robert.clarke@uspto.gov](mailto:robert.clarke@uspto.gov))

Mr. Robert A. Clarke  
Mail Stop Comment – Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Re: Comments on Continuing Application Process**

Dear Mr. Clarke:

I am the Intellectual Property Counsel for the MacLean-Fogg Company, a manufacturer of approximately 700 million dollars in annual sales with approximately 2000 employees. Because the proposed rule changes will erode our ability to protect our innovation and substantial investment in research and development, I simply cannot support the PTO's proposed rule changes. Accordingly, I strongly urge the PTO to reconsider their position on this matter.

The MacLean-Fogg Company is a manufacturer of components and assemblies for use in the automotive and electric utility industries. We face considerable pricing pressure from competing manufacturers located in low cost labor countries, such as China. Our products are manufactured through the use of parts forming machines, lathes, grinding machines, and other equipment used to finish metallic products. We also use mold and mandrels for fiber reinforced plastic goods and polymer based products. This equipment is ubiquitous in China and India. Since manufacturers operating in China and India enjoy considerably lower cost labor force, they possess a distinct advantage over U.S. manufacturers.

Ingenuity, innovation, and invention remain one of the primary advantages that we hold over our foreign competitors. Eroding away our ability to protect our invention is tantamount to eroding away the advantage we hold over our foreign rivals. The considerable investment we make in research and development will essentially be given away because our ability to fully protect what we have developed will be compromised by the proposed rules.

These competitors show a remarkable disregard for the intellectual property of others. Indeed, the relatively poor intellectual property enforcement that we and other U.S. companies have encountered in China prompted President Bush to make improved enforcement of intellectual property rights an issue with President Hu Jintao during his recent U. S. visit on April 20, 2006. See [www.whitehouse.gov/news/releases/2006/04/20060420.html](http://www.whitehouse.gov/news/releases/2006/04/20060420.html). The proposed rules will prevent us from doing so. The inevitable result will be further out-sourcing of American manufacturing and American jobs. The purported benefits of reducing backlog and avoidance of Lemelson's bar code patents will

Robert A. Clarke  
May 3, 2006  
Page 2

benefit only a few, if any, while exacting a devastating toll on the rest of the users of the U.S. patent system who need multiple patents in order to protect the U.S. market.

A robust, flexible, and vigorous patent system in the United States enables us to protect our core market. Without patent protection, pricing on our products that sustains domestic manufacturing would be lost along with the jobs of many employees.

We fund research and development in order to develop multiple ways of practicing a particular invention in order to meet the differing preferences of our customers. We must file multiple patent applications, continuations, continuation-in-part, and divisional applications in order to protect fully our research and development against foreign competitors.

According to the PTO, the rules changes are necessary because “the current volume of continued examination filings ... are having a crippling effect on the Office’s ability to examine ”new” (i.e., non-continuing applications.)” However, in almost all situations where I have prosecuted a continued application, the case was assigned to the same examiner that examined the preceding application. Such Examiner was already familiar with the application and the cited references at issue. In terms of efficiency, it should be much easier and expeditious for such an Examiner to examine the continuing applications. Indeed, I have found that the turn around time for receipt of Office communications and allowances in such continued applications is generally substantially shorter than for non-continued applications.

While I appreciate the difficult situation that the PTO is currently in, I urge the PTO to consider measures that are less drastic than those currently proposed. For example, I believe the PTO could reduce or eliminate the scope of its problems by simply increasing fees in order to have the necessary funds for acquiring, training, and retaining qualified patent examiners. Additionally, the PTO could make it a requirement that continuing applications be examined by the same examiner that examined the parent or preceding application.

Very truly yours,

Michael Pruden  
Reg. No. 52,135

MBP:pjb