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**From:** dan steinberg [mailto:vaporgenie@yahoo.com]

**Sent:** Wednesday, January 18, 2006 10:05 PM

**To:** AB93Comments

**Subject:** continuation practice

Actually, the proposal below of requiring a showing on a second filed CIP would not be so onerous. I think this proposal is reasonable. I was misinformed and thought that the USPTO was considering abolishing continuations altogether.

sincerely,

dan steinberg

<sup>1</sup> Any second or subsequent continuation, CIP or RCE must include "a showing to the satisfaction of the Director as to why the amendment, argument, or evidence could not have been submitted prior to the close of prosecution after a single continuation, CIP or RCE"; and

USPTO

I am a practicing patent agent (Reg no 45,129) and inventor. I have read the proposal to abolish continuation applications. I think this is a VERY bad proposal. Continuation applications are useful and necessary, especially in cases where significant improvements have been invented after a patent has been file. the abuses of continuation applications outlined by Lemley and Moore (in their paper) can be easily addressed with other policy options. Lemley and Moore also make some very specious and inconvincing arguments about continuation abuse.

Also, requiring inventors to file an entirely new application merely to cover incremental improvements will greatly add to the cost through increased issue fees, maintenance fees and attorneys fees.

Also, abolishing continuations will offer the inventor no possible mechanism for strengthening the patent disclosure without changing the claims.

Here I will respond to some of Lemley and Moores arguments:

1) "Examiners are compensated for an initial action and then case resolution. So continuations just wear down the examiner"

response: OK. Compensate examiners for each and every response or resolution. Abolishing continuations is overreacting to this issue. Abolishing continuations is not necessary.

2) "Changing claims allows a patentee to write claims directed to a competitors product"

Response: I don't understand why this is an issue. If the competitor marketed or invented the product before the filing date, then the patentee does not have priority. Seems like a simple priority issue. If a patent is examined properly, a patentee can never expand claim scope to include material that is already in the public domain. Again, abolishing continuation practice seems a blunt instrument to deal with this issue, which is only tangentially related to continuations. Abolishing continuations is not necessary.

3) Only patents filed abroad must be published, so inventors can keep their inventions secret and have a "submarine" patent.

response: require ALL patent applications to be published. Abolishing continuations is not necessary.

4) Publication rules are "limited in scope" because they don't require provisional applications to be published.

response: this is ridiculous. Provisionals are never examined, and many are never followed up with a real application and many don't even have claims. Further, provisional applications ARE available in the file wrapper.

5) there is no publishing of applications that are no longer pending.

Response: so provide an indication if an application is no longer pending. Provide more information about pending application. Immediately publish applications that are continuations of a published application. Abolishing continuations is not necessary.

6) Lemelson had a patent pending for 44 years.

response: this is the patent with the single longest pendency, and has been declared invalid.

7) 6 years should be the limit for triggering prosecution laches defense.

response: the data used by Lemley and Moore covers the time period from 1976 until 2000. Presently, the USPTO is much slower than it has been in the past in providing office actions. I have had cases take 2 YEARS to receive a FIRST office action. Patent pendency has increased, and so the 6 year limit-based on data from 1976-2000-is not reasonable.

In my practice and experience, continuation applications are consistently used by my clients to add later-discovered material, or provide more accurate technical descriptions of the invention. These uses of continuation applications serve to improve the quality and disclosure of patents. I have NEVER had a client that appears to be abusing continuation practice in the manner described by Lemley and Moore. In every single CIP application I have filed, the CIP application described new material that would not justify an entirely new application in terms of cost for the client. Filing separate patent applications for

small new improvements as proposed by Lemley and Moore would greatly increase the cost for inventors (i.e. by multiplying issue fees and maintenance fees).

Another remedy would be to limit the number of CIPs to one or two. I expect that in the vast majority of cases where continuations are filed, only one or two are needed.

While there may be ongoing abuse of continuation procedures, there are many remedies other than simply abolishing continuations. I would support, for example, enhanced patent publication, such as publishing all applications in a continuation chain, or requiring publication of ALL applications 18 months after filing. Perhaps the PTO should consider a rule allowing only one patent to issue (with exceptions for divisionals) from a continuation chain?

The big question that Lemley and Moore failed to answer is how would inventors add new material, corrections, or technical details to a patent application?

So, I dont like the proposal to abolish continuation applications. The problems are not as great as argued, and there are other remedies for the problems that do exist.

Sincerely,

dan steinberg

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