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Sent: Wednesday, May 03, 2006 11:05 PM
To: AB93Comments
Subject: AB93Comments

Please see attachment

Commissioner for Patents

Sir,

Comments on Proposed Rule Changes to 37 Cfr1.78 To Deny a Second Continuation or RCE Filed Without Justification that the Amendment Argument or Evidence Presented Could Not Have Been Submitted Previously

The proposed rule change is predicated on the position that the current volume of continued application filings and duplicative applications with “conflicting” or patentably indistinct claims are having a “crippling effect” on the Office’s ability to examine new applications.

In particular, the proponents pose that as, numerically 30% (115,000), of the applications received last year were either RCE or continuing applications, that also resulted in a numerically equivalent (30%) drain of examiner resources.

However, it is well recognized that examiner time required for reviewing a continuation/RCE is significantly less, perhaps one half of first examination time.

Thus, the drain in examining resources by elimination of all continuations/RCE would be approximately 15%, not the asserted 30% - a potential backlog reduction of about 17,000 cases, not the asserted 35,000

Furthermore, as only about 12,000 of the continuation/CIP application and 10,000 RCE’s were second or subsequent requests, requiring a third, even less time demanding review, perhaps only one quarter, the numerical reduction of approximately 22,000 (12,000 +10,000) translates into a substantive reduction in examiner time to approximately (5,000/115,000) or 4% or less, resulting in a back log reduction of 3000 or less cases.

The prospective reduction of 5000 (or less) cases should be compared with the expected increase in appeals, not only a proportion of the 22,000 to be denied second/subsequent Continuations/RCE but additional appeals which may be filed instead of a first continuation/RCE to avoid risk of denial on appeal without recourse at the PTO instead of the vastly greater expense of court proceedings,

Of course, the appeal process requires the time of at least three administrative judges usually drawn from the ranks of the most able and experienced examiners who must study all the case papers ab initio, not merely a single examiner's third sighting of the case papers. Thus, even if only 20% (4000) of the notionally denied second/subsequent Continuations/RCE were instead appealed, there would be a net drain of examiner resources equivalent perhaps to 7000 cases (4000 X 3 -5000).

Thus, unless human resources were added in the appeal, the PTO would simply be replacing one backlog with another.

The above analysis does not even factor in the prospective (unknown but likely) increase in the filing of appeals before the first continuation. (Note that the even if examiner time required for continuations/RCE were as great as new applications (which is most certainly not the case), a saving of PTO resources would still not result.

The prospective increase in the number of petitions would also drain additional PTO resources increasing, dramatically, current delays of 4 months before decision, limiting their usefulness still further.

Clearly, the asserted savings in junior examiner time are illusionary and most likely outweighed by the increased demand for resources in other, higher and more costly levels, resulting in a counterproductive net drain of PTO resources.

It has also to be said that the PTO has not proposed any forgiveness for an applicant's mistake made during a continuation or RCE. proceeding.

In their stated policy of unwillingness to hire a sufficient number of examiners to handle an increasing number of applications, the PTO has no intention of, meeting the increasing demands of an increasingly complex technological society in which the amount of technical information is estimated as doubling every 3-4 years.

The PTO has apparently "forgotten" about the expenses of applicant's, particularly individual inventor's and their attorney/agent costs in needing to ponder and adopt the recent proliferation of rule changes which have -contrary to PTO stated policy of back loading for successful applicants - actually increased, exemplified by the recent rule requiring costly 'formal drawings' even before indication of allowable subject matter.

Recent hirees by the PTO should also bear in mind that the traditional continuation procedure which has prevailed over the last 40+ years was intended to provide some compensation for the limitations imposed on applicants by the adoption of compact prosecution - further abridged by the PTO Regulations shortening the 6 month response times originally permitted by Statute. The current proposition would take one step further away from the goal of facilitating the protection of the useful arts for a limited period of time as required by the Constitution.

Respectfully submitted,

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Registered Patent Agent