

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

**From:** Brian Washburn [mailto:brian.washburn@gmail.com]

**Sent:** Sunday, February 12, 2006 7:05 AM

**To:** AB93Comments

**Subject:** Comment on proposed rules changes

Dear Sir,

The following comment is in response to the proposed rule changes governing the continuation practice under 35 U.S.C. 120, as was recently announced in the Federal Register on January 3, 2006 (71 Fed. Reg. 48).

The primary objective reason why applicants file continuation applications is in order to keep prosecution of the applications "alive". "Alive" prosecution permits applicants to submit broader claims to encompass unpredictable future changes to the technological environment to which the invention applies. In many industries, especially in the computing technology and business methods arts, the ever-changing standards and environments, make it almost impossible for an applicant to draft original claims in such precise manner as to encompass varying embodiments of the invention when applied to a constantly changing overall environment.

Patents are granted for a period of 20 years of filing date. Twenty years is a long time, and there's a strong likelihood that the environment to which the invention applies would be constantly changing.

Consider the following example. An applicant in 1980 files a claim covering an invention, which includes a keyboard and LCD screen as two separate prior art elements of the claim. A third element, i.e. a joystick, is also included, which forms the basis of the novelty aspect of the claim. But, in 1985 the concept of a keyboard connected to an LCD becomes available. By 2000, such devices (i.e. laptops) are ubiquitous. The claim filed in 1980 does not cover the addition of a joystick to this "connected keyboard/LCD screen" environment of 2000.

By skimming through various District Court opinions involving patent claims, as well as those of the Federal Circuit, it is readily observable that the vast majority of cases are dismissed for non-infringement of the asserted claims. In most cases the infringing products or service *do in fact* incorporate the "invention" per se of the asserted patents. But because the claims were drafted and prosecuted before the forming and maturing of the industry, the patentee at that time failed to envision the scope of the invention as is applicable to the future industrial environment.

By curbing continuation practice, the Patent Office would be effectively curbing innovation. Without the benefit of a live continuation the value of an "inventing" would be greatly diminished.

Respectfully submitted,

Brian Washburn