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To: AB93Comments

Subject: Comments

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May 3, 2006
By Email (AB93Comments@uspto.gov)

The Honorable Jon Dudas
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
Mail Stop Comments ? Patents
Attn: Robert W. Bahr
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Re: Comments on Proposed Rule Making – *Changes To Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims*, 71 Federal Register 48 (Jan. 3, 2006)

Dear Under Secretary Dudas:

These comments are submitted in response to the above-identified notice of proposed rule making published at 71 Fed. Reg. 48 (Jan. 3, 2006) (hereafter, “Notice”) with respect to the proposed changes to patent practice contained therein (“the proposed rules”).

The comments herein represent my personal views as a registered patent attorney and are not to be attributed to the firm at which I currently practice law, its other attorneys, or any of its clients.

While I can appreciate that the U.S. Patent and Trademark Office (“USPTO”) faces increased scrutiny from Congress and applicants concerning the quality and pace of patent examination, I strongly urge the USPTO not to adopt any of the proposed rules.

First, I will address various assertions in the Notice as alleged justifications for the proposed rules and then I will suggest alternatives that should be considered by the USPTO, applicants, and the bar.

The Patent Act does not permit the proposed rules. The Notice asserts that the proposed rules are supported by the “inherent authority” of the Director. However, in view of 35 U.S.C. §§ 120, 121, 132, and 365(c), the USPTO simply lacks the statutory authority to adopt the proposed rules and place severe restrictions on continued examination practice. Congress is tasked with proposing, debating, and enacting laws to govern patent practice in the United States. The USPTO cannot play an end game around the legislative process by promulgating rules that

are unsupportable under the Patent Act, as amended. If the proposed rules are adopted, tremendous uncertainty will cloud patent practice while the courts will be burdened with challenges to the basic framework of the proposed rules.

The proposed rules will not reduce the backlog. In the Notice, the USPTO asserts that “each continued examination filing . . . contributes to the backlog of unexamined applications before the Office” and that “the Office is proposing to revise the patent rules of practice to better focus the application process.” However, the reality is that the proposed rules will not only fail to reduce the backlog but actually will cause substantial growth in the backlog. If the rules are given force and effect, applicants likely will respond by increasing the number of new application filings but including fewer embodiments of an invention in each application. Applicants also likely will file new applications with claims tailored to draw restriction/election requirements from Examiners. Take for example an applicant’s interest in protecting an inventive valve for use in an engine. Under the proposed rules, the applicant likely will file numerous restrictable species of claims such as species directed to the valve itself, an engine with the valve incorporated therein, a vehicle having an engine with the valve incorporated therein, a method of operating the valve, a method of operating the engine, a method of manufacturing the valve, etc. Out of necessity, in order to continue prosecution and obtain desired variations in claim coverage, the applicant would prosecute divisional applications to each of these inventions. Furthermore, the proposed rules likely would result in a substantial increase in reissue application filings, both before and after the 2-year claim broadening period, as well as applications for reexamination. The proposed rules will fail to reduce the backlog.

Examination will become a slow exercise in hyper-technical application of the rules. The Notice states that the proposed rules will result in “faster and more effective examination for the vast majority of applicants.” The Notice continues that the proposed rules “will make the exchange between examiners and applicants more efficient and effective” and that “patents should issue sooner.” I do not believe that any such results will be realized. Instead, the proposed rules likely would cause a substantial increase in petitions as well as appeals to the Board of Patent Appeals and Interferences. The severe restrictions proposed for continued examination practice will force applicants to fight more aggressively for their claims as well as for the very right to continued examination, for example, under the proposed “could have been presented earlier” and “substantial overlapping disclosure” analyses. The net effect likely will be substantial slowing of the patent application process (and concomitantly slowing of patent issuance) without facilitating examination on the merits. As is well known to practitioners, neither the petition nor appeals process at the USPTO facilitates quick resolution of issues. Further, the proposed rules likely will result in a more adversarial and less collegial practice before the USPTO.

Uncertainty will severely blur the analysis of so-called “patentably indistinct claims.” According to the Notice, in order to ease the burden of examining multiple applications, all patentably indistinct claims should be submitted in a single application absent good and sufficient reason. There is no clear standard for assessing whether claims are “patentably indistinct.” The absence of any such standard will give rise to extensive litigation far into the future.

Publication of applications already provides sufficient public notice of patent claims. It is suggested in the Notice that “the possible issuance of multiple patents arising from [continued examination] tends to defeat the public notice function of patent claims in the initial application.” But this assertion makes little sense in view of the expected increase in restrictable species in the initial application. See discussion supra. Moreover, under the 18-month publication provisions, the public already receives adequate notice with respect to the claims.

When pursued, a string of continued examination filings often is completely warranted. The USPTO states in the Notice that “the exchange between examiners and applicants becomes less beneficial and suffers from diminishing returns as each of the second and subsequent continuing applications or requests for continued examination in a series is filed.” This statement vastly oversimplifies the “exchange” that many applicants experience during the application process. Continued examination filings not only guard against occasional lapses in the examination process but often can bring focus to the examination process.

The proposed rules will undermine efforts to increase patent quality. The Notice argues that the proposed rules “should also improve the quality of issued patents, making them easier to evaluate, enforce, and litigate.” However, there is no correlation between the proposed rules and the evaluation, enforcement, or litigation of patents. The root problems to poor patent quality are found in the onerous time constraints placed on patent examiners for alleged reasons of efficiency as well as patent examiner training and retention issues. The proposed rules do not address or solve these root causes of poor patent “quality.”

Continued examination practice does not burden innovation. The USPTO claims that continued examination practice imposes “a burden on innovation.” Nothing can be further from the truth. Continued examination practice encourages early disclosure of multiple embodiments of inventions developed through the iterative design process. It is well-known that the body of United States patents forms the greatest technical knowledge-base in the world. By permitting continued examination, applicants are encouraged to “disclose” more of their inventive concepts in a patent application (to be the possible subject of future claim prosecution in continuing applications) rather than maintain their inventions in secret. Continued examination practice can be a great asset to the U.S. patent applicant and to the public.

Alternatives to the proposed rules would have far greater support and impact. If the pace of examination is a central concern of the USPTO, and there is a genuine interest in decreasing the backlog of pending applications, other creative and more widely effective solutions should be considered in lieu of the proposed rules. Such alternatives include:

- * mandatory examiner interviews (telephonic or in person) after each non-final Office Action to help crystallize the issues and facilitate consideration of the prior art;
- * eliminating certain types of restriction requirements such as directed to independent claims for a method and an apparatus presented in the same application;
- * requiring expedited responses from continued examination patent applicants, much like the rules for *ex parte* reexamination proceedings in which extensions of time under 37 C.F.R. § 1.136(a) are not available;

- * increasing fees for continued examination to provide further incentive for applicants to wind-up prosecution;
- * ensuring that related applications are assigned to the same patent examiner;
- * modifying “after-final” practice to permit substantive changes to the claims without the need for filing a Request for Continued Examination (RCE) so that applicants can have more than one bite at the apple to amend claims during examination without being forced to file an RCE;
- * permitting greater tolerance for minor “variations” in filings by applicants so that fewer notices of non-compliance are issued causing further delay in prosecution on the merits;
- * budgeting an increased time burden for examiners to handle prosecution of each patent application;
- * increasing attention to examiner recruitment and retention, including increased financial incentives for examiners to remain at the USPTO for longer tenures; and
- * increasing the training of examiners.

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In summary, because the proposed rules likely will not produce any of the beneficial effects contemplated by the USPTO, they should be completely rejected.

Respectfully submitted,

/ Seth A. Watkins /

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