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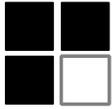
**To:** AB93Comments

**Subject:** Comments on Proposed Rule Making

Attn: Robert W. Bahr

Please accept the attached comments.

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## INTELLECTUAL PROPERTY LAW

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Attn: Robert W. Bahr

Re: Proposed Rule Making

Dear Commissioner Doll:

The Office proposed rule changes for continuation practice at Federal Register volume 71, pp. 48-61, on January 3, 2006. We submit the following comments on our own behalf and on behalf of our firm. We note that the comments were prepared as part of a review by the Intellectual Property and Information Technology Section of the Virginia Bar Association, and approval of submission of the comments is pending at the Virginia Bar Association. If the submission is approved we will duly supplement this filing.

We recommend that the proposed rules be withdrawn and reevaluated in light of the following deficiencies.

First, the proposed rules are not supported by a balanced presentation of evidence. Applicant abuses are noted, but no mention is made of comparable errors by examiners that extend prosecution without advancing applications toward resolution. Even as to applicant abuses the evidence as to the extent and scope of these abuses is not presented.

Second, the proposed remedy is similarly unbalanced. The rules propose that the applicant make a "showing as to why the amendment, argument, or evidence presented could not have been previously submitted." There is no consideration of comparable rules for dealing with errors by examiners that extend prosecution without advancing applications toward resolution.

Third, the requirements of the proposed rules cast a much wider net than is justified by alleged applicant abuses. The burden of the proposed standard ("... could not have been previously submitted") will fall not simply on those cases where a "second or subsequent continuation" is actually requested. It will be necessary for practitioners to subject the general

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run of cases to the additional review (and expense to the client) required by the proposed standard, because it is difficult to predict which prosecutions may encounter a legitimate need for a further continuation in order to obtain adequate consideration of the application. The additional “amendments, arguments, and evidence” generated under pressure of the proposed standard will also burden examiners. The proposed rules have not been crafted to correlate the additional burdens on applicants and the PTO with those cases where a “second or subsequent continuation” is actually requested, much less to those cases where a “second or subsequent continuation” is in furtherance of an alleged applicant abuse.

Fourth, while the rule making argues that the proposed rules will reduce unwarranted continuation practice and thereby enable the PTO to reduce its backlog, this logic is not adequately supported. The evidence presented does not support the conclusion that the extent of unwarranted continuation practice (as opposed to continuations necessary to obtain adequate consideration of the application) is significant enough that its elimination will enable the PTO to reduce its backlog. Indeed, the rule making argues that only a small percentage of applications would be affected by the rules, which cuts against the asserted administrative advantages. Further, no consideration is given to the reasonableness of the balance between the burdens placed upon applicants (and the PTO) and the benefits of eliminating unwarranted continuation practice. Note, for example, the burden of filing a Notice of Appeal and fee to guard against the uncertainty over whether or not a given second or subsequent RCE will be effective.

For example, the evidence does not indicate whether the burden in one case where the continuation practice is warranted is balanced by eliminating ten unwarranted continuations – which would be obviously efficient – or whether the burden in ten cases must be absorbed in order to eliminate one unwarranted continuation – which would be highly inefficient. While any practical patent examination system will have its burdens, it is appropriate to evaluate the incremental balance between burden and benefit of the proposed rules. The evidence of record does not support such an evaluation, and no such evaluation is attempted in the proposed rule making. This deficiency could be corrected by withdrawal and reevaluation of the current rule making.

Fifth, justification for the proposed rules fails to address whether the proposed rules will advance PTO discharge of its responsibilities under 35 U.S.C. Part II, Chapter 10. The primary purpose of the patent examination system is to examine patent applications and issue patent grants that properly conform to the metes and bounds of the inventions disclosed in these applications. The arguments presented in the proposed rule making deal with administrative procedure but do not address the effect of the proposed rules on the basic policy objectives of the PTO.

It is desirable that the examination system be efficient. However, it is not desirable to achieve nominal efficiency improvements at the expense of the basic charter to “promote the progress of science and useful arts, by securing for limited times to ... inventors the exclusive right to their ... discoveries” (U.S. Constitution, Article 1, §8). The flexibility of the current

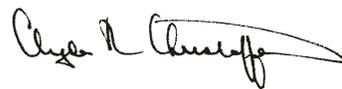
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continuation system is forgiving of mistakes of both applicants and examiners in the difficult but important tasks of crafting and reviewing claims that define the metes and bounds of inventions. The proposed rules significantly reduce the flexibility of continuation practice. Absent a tighter logic than is evident in the current rule making, it is likely that the proposed rules will simply be less forgiving of mistakes, to the detriment of inventors and basic patent grant policy. A withdrawal and reevaluation of the rule making would permit proper consideration of this issue.

Sixth, it is evident from the context of the rule making that the proposed rules may have been designed in part to respond to concerns about the finality of the “metes and bounds” of patents that have reached the marketplace. If a continuation is waiting in the wings, negotiating a settlement regarding allegations of infringement on the issued parent patent may be more difficult. These are important concerns, but are obscured by the broad scope of the proposed rules. If these concerns were addressed directly, it might well turn out that a more focused rule – or some combination of a rule and improvements in examination strategy and resource allocation – might better serve the PTO, inventors and the public. Again, withdrawal and reevaluation of the present rule making would allow a more forthright consideration of these concerns.

We submit the foregoing comments in the spirit with which they were solicited, and in the hope that our patent examination system will be improved.

Respectfully submitted,



Clyde R Christofferson



Marshall M. Curtis