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From: Cameron Weiffenbach [mailto:camweif@comcast.net]
Sent: Thursday, May 04, 2006 12:28 PM
To: AB93Comments
Subject:

The Honorable Jon W. Dudas
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
Mail Stop Comments
P.O. Box 1450
Alexandria, VA 22313-1450
Attention: Robert W. Bahr

Re: Comments on Proposed Rules: "Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims," 71 Fed. Reg. 48 (January 3, 2006)

Dear Under Secretary Dudas:

I am a registered patent practitioner and Of Counsel with the firm of McDermott Will & Emery LLP. My comments below are directed to the proposals on claims in patents applications that were published at 71 Fed. Reg. 48 on January 3, 2006. I realize that these comments are being presented after the May 3rd deadline, but I had May 5th as the deadline on my calendar. I would appreciate it you would read my comments in any event.

I support appropriate actions to reduce the increasing number of unexamined patent applications. However, for reasons set forth below, I do not feel that the proposed actions by the Office of limiting the number of continuing patent applications will have the effect of reducing the increasing backlog of applications.

The Office has proposed to restrict the number of continuations and RCE's that can be filed. In particular, the Office proposes to limit an applicant, as a matter of right, to one continuing application or one RCE.

The data set forth in the proposed rule package shows that in fiscal 2005, there were 317,000 applications filed wherein 18,000 were divisionals and 44,500 were straight continuations/CIPs. This represents 20% of the filings (6% divisional applications and 14% straight continuations/CIPs). The 2005 data also shows that 52,000 RCE's were filed and, according to the Office, examining these RCE's hindered the Office's ability to cut into the backlog of new applications. The data further shows that 11,800 of the continuation/CIPs were second or subsequent continuation/CIP applications while about 10,000 second or subsequent RCE's were filed. Assuming that the Office grants 20% of the second or subsequent continuations/CIPs, the backlog should be reduced by about 9,500 applications or 3% of the total filings. This would not put a significant dent into the backlog. Assuming that 20% of the second or subsequent RCE's filed are granted

under the proposed rules, then the number of RCE's considered would be reduced by 15% or 7800. This figure does not appear to be significant since the Office would still be handling 44,200 RCE's per year as opposed to the current 52,000. I do not see the benefit of the new procedure or that it will have a significant impact on the backlog.

The Office has characterized the RCE's and continuation applications as "reworking continued examination filings." The Office is assuming that all final rejections are proper and that applicants are merely filing RCE's and continuations to further prosecute instead of appealing final rejections. The Office's own data shows that where appeals are taken, only 40% of the appeals are taken the BPAI after an appeal conference. The 60% remaining are either passed to issue or prosecution reopened. Of the appeals taken, the examiner is reversed 60% of the time. What this data should be indicating to the Office is that most final rejections are not proper.

Because of present after final practice, applicants are forced to continue prosecution using RCE's and continuing applications. Where an applicant amends claims to overcome prior art and the examiner withdraws his/her original rejection and introduces a new ground of rejection over new prior art and makes the rejection final, the applicant cannot as a matter of right amend the claims. Accordingly, applicant is forced to file an RCE or continuation to further amend the claims to overcome the prior art. This is not "reworking" prosecution. If amendments are proposed to overcome the art rejection, examiners will not consider any amendments unless formally presented. Accordingly, applicants are forced to file an RCE or a continuation to have the amendments considered. This is not "reworking" prosecution. Many, if not most, RCEs and straight continuations are filed in an effort to find allowable subject matter. Thus, after final practice is a major factor contributing to the number of RCEs and straight continuations being filed.

In order to reduce the number of RCE's and straight continuations, the Office should consider the changes in after final practice. If an examiner finds that there is allowable subject matter if the claims are amended in a certain manner, the Office should encourage examiners to suggest amendments that could place the claims in condition for allowance. Twenty-five years ago, examiners were encouraged to make such suggestions to expedite prosecution. The Office made a significant dent in the number of appeals pending at the BPAI by reintroducing three person appeal conferences. As a result of such conferences, I have experienced that 80% of my appeals result in allowance of applications without having an examiner's answer filed. Similar such conferences could be extended to final rejections. Twenty years ago, about 70% of examiner's rejections were affirmed by the Board. Today, it is about 40%. This statistic coupled with Office data showing that the examining corps is only going forward with appeal in 40% of the cases where appeal briefs are filed is a clear indication in my mind that something is wrong with after final practice and that most final rejections are not proper. Apparently, applicants are realizing this fact because they are filing RCE's and continuations to find allowable subject matter. As for limiting a divisional application to one application, this practice would not be permitted under 35 U.S.C. § 121 which allows the applicant to file a divisional application on each invention restricted out. Restrictions today are far more complex than they used to be. It is not uncommon today to be faced with a 4 to 10 way restriction

requirement coupled with an election of species within the restriction. It is also not uncommon today for an examiner to make a further restriction after the first examination on the merits.

Restriction practice today is a product of the present production system employed to evaluate examiner performance. Examiners use the system to their benefit to increase their productivity and to reduce the scope of their searches. The Office has encouraged this practice. The current restriction practice encourages the filing of divisional applications which add to the backlog of applications. The Office has looked into changing restriction practice, but it does not appear that the Office will change the practice. While only 18,000 divisional applications were filed in fiscal year 2005, there is no data with respect as to how many of these applications may have been subject to further restriction and election requirements on top of requirements that may be made in new applications.

In my opinion, the Office should be determining whether its own restriction and after final practices are causing the increase in the filings of divisional, straight continuations and RCEs, and not limiting the applicant to one continuation. Further, in my opinion, the Director lacks statutory authority to regulate the number of continuation and divisional patent applications that can be filed.

A "continuation", "continuation-in-part," or "divisional" is merely a name given to an application claiming priority under either 35 U.S.C. §§ 120 or 121. There is nothing in the patent statutes (35 U.S.C. §§ 111, 120 or 121) that limit a patent applicant to a specific number of applications or give the Director of the USPTO authority do so. Under 35 U.S.C. § 132(b), the Director of the USPTO has regulatory authority to provide for continued examination of patents at the request of an applicant. Therefore, Director may have authority to regulate requests for continued examination only. The statute does not provide authority for the Director to regulate the number of patent applications on an invention that can be filed.