

**From:** Allen Wood [mailto:Allen@rabinchamp.com]  
**Sent:** Saturday, March 25, 2006 8:23 PM  
**To:** AB93Comments  
**Cc:** Steven Rabin; Robert Berdo, Jr.; Nick Bromer  
**Subject:** Comments regarding proposed rules changes

Dear Sir or Madam:

These comments are presented in response to the notice of proposed rulemaking published January 3, 2006 at 71 FR 48.

The proposed rule to limit continuations should be rejected. If continuations are limited, applicants would naturally want to avoid squandering them, in case they might be needed later. This would likely lead to strategies that would tend to **retard the progress of science and the useful arts**. For example:

A researcher employed by a company conceives an invention on January 1, 2010. The company's patent department files a regular patent application a week later, on January 8. This constitutes a constructive reduction to practice and thus establishes a date of invention. The application is published a year and a half later, on July 8, 2011, and this is the first public disclosure of the invention (the company does not permit its inventors to so much as mention their inventions to outsiders until publication). With publication, the invention as described in the application has now become prior art under 35 USC 102(e), but not to the inventor. A week less than a year later, on July 1, 2012, the company re-files the same application as a provisional application. That is, the provisional application is filed before the publication of the regular application has become prior art under 35 USC 102(b).

A week less than a year later, on June 24, 2013, the company files a second regular application with the same disclosure. It claims the benefit of the provisional application but not the first regular application. Shortly thereafter an Office Action issues on the first regular application. The company abandons the first regular application and files an IDS in the second regular application with the references that were cited in the Office Action. The company also files a preliminary amendment in the second regular application, essentially responding to the Office Action and advancing the prosecution of the second regular application.

In the above example, the second regular application is entitled to a date of invention that was established by the filing of the first regular application, and also receives the benefit of a first examination. Yet filing the second application did not use what would be the company's only by-right continuation under the proposed rule. This strategy would have the added benefit (from the company's point of view) of starting the term of a patent granted on the second regular application almost three and a half years later than if the second regular application had been filed as a continuation of the first regular application. Unfortunately, the strategy requires that the invention be kept secret for a year and a half. In contrast, companies are presently inclined to let their inventors disclose their inventions publicly as soon as an application is filed.

The proposal to limit RCEs is also misguided. Section 706.07 of the MPEP states, "The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal," but the sad fact is that a growing number of examiners are holding that virtually any claim changes in response to a final rejection (in the second Office Action) raise new issues that would require further consideration. Frequently, there is no effective way to seek review of an examiner's decision not to enter an amendment after final rejection. If an amendment after final rejection is filed at the end of the third month from the Office Action and an advisory action issues three or four weeks later, a request for reconsideration followed by a petition would run the risk of an abandoned application or large extension fees. As a result,

RCEs are becoming a fairly routine part of prosecution, at least in foreign-origin cases. (A colleague of mine reports that he once filed an amendment after final rejection in which he amended independent claim 1 to include the subject matter of dependent claim 2, and the examiner contended that this raised a new issue since the scope of dependent claim 3 had now been changed).

The whole tenor of the proposed rules changes seems to be that the purpose of the PTO is to process patent applications quickly and efficiently. I disagree. The true purpose should be to permit applicants to formulate claims that adequately protect their inventions while protecting the public from claims that are too expansive. To the extent that speed and efficiency conflict with the true purpose of the PTO, speed and efficiency should give way to the true purpose.

Sincerely,

Allen Wood