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**From:** Wright, Lee [mailto:LWright@whdapatentlaw.com]

**Sent:** Wednesday, May 03, 2006 11:45 PM

**To:** AB93Comments

**Subject:**

Please consider the attached comments.

Lee Wright

41,441

Via Email: AB93Comments@USPTO.gov  
May 3, 2006

Attn: Robert W. Bahr

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)

### **37 CFR 1.78**

I do not think that the USPTO has the statutory authority to adopt the proposed changes to 37 CFR 1.78. 37 CFR 1.78 as proposed would conflict with the rights provided in the statute, including 35 U.S.C. §§ 120, 121, and 365(c). I will not present arguments redundant to others, including the AIPLA, who have argued this issue. However, I would like to add that the position of the U.S. Congress, Committee on the Judiciary, has been that the USPTO does not have the authority to make such changes, without statutory approval. See the June 1, 2005 version of the ‘Patent Act of 2005’.

#### “§ 123. Limitations on Continuation Applications

The Director may by regulation limit the circumstances under which an application for patent, other than a divisional application that meets the requirements for filing under section 121, may be entitled to the benefit under section 120 of the filing date of a prior-filed application.

No such regulation may deny applicants an adequate opportunity to obtain claims for any invention disclosed in an application for patent.”

It is my understanding that this section was deleted from later versions of the bill following public hearings. It is also my understanding that this section of the bill was deleted following unfavorable public opinion.

### **After Final Practice and Examiner Production**

The USPTO recently severely restricted Applicants’ ability to present arguments and evidence after final rejection. See Rules of Practice Before the Board of Patent Appeals and Interferences (Federal Register / Vol. 69, No. 155, August 12, 2004). A direct result of limiting after final practice is the need for applicants to file more continuation applications and more RCEs. Having forced applicants to file more continuation applications and more RCEs, the USPTO is now complaining that too many continuation applications and too many RCEs are being filed. It is confusing how less than two years ago the USPTO takes action that creates the need for more continuations and RCEs, then now desires to take action to limit the availability of continuations and RCEs, the very thing they are forcing on applicants.

Further, in the “old days” it was common for an examiner to allow an applicant “one shot after final.” Those days are long gone, and with many examiner’s it is impossible to obtain consideration of anything after final. With the current USPTO production system there is clear motivation for an examiner to deny entry of anything after final and to have an applicant refile the application as a continuation or an RCE.

It appears that the USPTO has a problem with its examiner production system. The time needed for search and analysis for a first office action on a new original application is greater than that needed for updating of a search and the analysis for a continuation or an RCE. However, the examiner counts are the same for both.

Instead of severely limiting the rights of applicants, I propose that the USPTO review its production system to give examiners more credit for a first office action on a new application or on a new divisional application. This would provide more incentive for examiners to work on new original applications and bring down the perceived backlog in new applications waiting for action.

The USPTO should exhaust all internal possibilities prior to severely limiting applicants' rights.

### **37 C.F.R. §1.78(d)(1)(ii)**

The proposed rule to require applicants file all divisional applications from a single prior filed application would lead to earlier and more frequent filing of divisional applications. This would lead to a great increase in application filings, which is in direct conflict with the USPTO's stated goal to reduce pendency.

Further, such a requirement would lead to a great burden on the small inventor, who has fewer resources to file a large number of divisional applications in a short period of time.

### **By-pass Continuations**

The proposed rules treat a by-pass continuation differently than a national stage application in that the by-pass continuation is counted as a continuation and therefore the by-pass application would not have the right to file an RCE or continuation.

By-pass continuations allow an applicant to make amendments to place the claims in better form for examination and for US practice. Restricting by-pass continuations would be counter to the USPTO position that literal translations of foreign applications prolong or hinder prosecution.

By-pass continuations also allow an applicant to focusing the issues in view of information available after the original PCT filing date. I would recommend that by-pass continuations be treated like any other new U.S. application.

### **Implementation of the Rules**

One USPTO slide from "town hall" meetings implied that the new rules would be effective for any application filed after the date of promulgation, including all continuation, divisional and CIP applications. The USPTO proposed implementation of the rules would result in them being retroactive to nearly all applications.

Such an implementation would cause severe problems for applicants. For example, a divisional application filed after the date of implementation could not be filed if the first parent application was already issued, even if there are other continuation applications pending.

An applicant would not be able to file a continuation application following the implementation of the new rules if he had already filed two continuations.

I propose that the first RCE, continuation, divisional, CIP or new application filed after the implementation of the proposed rules be treated as equivalent to an original application (and allowed the automatic RCE or continuation, etc.).

**Voluntary Divisional applications**

The restrictions on filing a continuation application to claim subject matter that was not previously claimed would stifle invention in the US.

**Rissue applications**

Will the new rules apply to reissue applications? For example, will only one continuation or RCE be allowed in a reissue application?

Voluntary divisionals are no longer permitted. Is a reissue application that claims previously unclaimed subject matter permitted? That is, is such an error correctable via a reissue application?

Thank you for your consideration.

Respectfully submitted,

Lee Wright  
41,441