

Fawcett, Susan

From: Glenn Foster [Glenn@intven.com]
Sent: Friday, August 08, 2008 3:20 PM
To: Fawcett, Susan
Cc: Dale Cook; Casey Tegreene; Steve Malaska
Subject: 0651-00xx Board of Patent Appeals and Interferences Actions Comments
Attachments: wspla_RuleComments.pdf; FosterRuleComment.pdf

Dear Officer Fawcett:

Thank you for the opportunity to resubmit Responses to the PTO's Federal Register/Vol. 73, No. 111/Monday, June 9, 2008. Please find attached a Response from Washington State Patent Lawyer's Association, as well as my Response. Feel free to contact me or otherwise respond if you have any comments or questions.

Best Regards,
Glenn

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8/11/2008

-----Original Message-----

From: Kevan Morgan [mailto:kevan@cojk.com]

Sent: Wednesday, May 03, 2006 4:40 PM

To: AB93Comments; AB94Comments

Subject: WSPLA Comments on USPTO Proposed Rules Changes (2006)

Robert W. Bahr, Senior Patent Attorney
Office of the Deputy Commissioner for Patent Examination Policy
Robert A. Clarke, Deputy Director
Office of Patent Legal Administration

Dear Mr. Bahr and Mr. Clarke,

Attached please find Comments of the Washington State Patent Law Association relative to the rules changes proposed by the United States Patent and Trademark Office at 71 Fed. Reg. 48 (January 3, 2006) and 71 Fed. Reg. 61 (January 3, 2006).

We have an active Legal Affairs Committee and Board of Directors who contributed to these comments. We appreciate the opportunity to have our thoughts and experience considered.
Sincerely yours,

Kevan L. Morgan
President
Washington State Patent Law Association

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2005-2006

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May 3, 2006

Via E-Mail Communication Only: AB93Comments@uspto.gov
AB94Comments@uspto.gov

Mail Stop Comments – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Robert W. Bahr, Senior Patent Attorney
Office of the Deputy Commissioner for Patent Examination Policy

Robert A. Clarke, Deputy Director
Office of Patent Legal Administration

To the Commissioner for Patents:

On behalf of the Washington State Patent Law Association, and representing the views of its Board of Directors, I respectfully submit the following comments regarding the Proposed Rule Changes To Continuation Applications of the United States Patent and Trademark Office (USPTO) 71 Fed. Reg. 1, 48 (2006), and the Proposed Rule Changes to Practice for the Examination of Claims in Patent Applications 71 Fed. Reg. 1, 61 (2006) (hereinafter referred to singly or in combination as "Proposed Rule Changes"). Although we appreciate the immense challenges faced by the USPTO and the Commissioner's genuine efforts to address those challenges, I wish to offer our perspective on the Proposed Rule Changes, and to explain why we oppose the Proposed Rule Changes as overly detrimental to many seeking to protect intellectual property, and thus, overly detrimental to innovation.

The Washington State Patent Law Association is an organization serving the needs of over 300 patent practitioners in and around the Pacific Northwest, a region widely recognized as a center of excellence and strategic importance for innovation and world trade. The Association holds regular continuing education seminars focusing on the changing interests and needs of our constituency. Our members are involved in both private and corporate practice and are actively

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engaged in all aspects of procurement and commercialization of patents, both domestically and internationally. As patent practitioners in one of the leading technology centers in the United States, the impact of the Proposed Rule Changes on many of our constituents would be direct, immediate, and highly detrimental.

The Washington State Patent Law Association opposes the Proposed Rule Changes for the following reasons.

1. Current USPTO practices compel applicants to file continuation and divisional applications.

Recent claim fee increases for examination of an application serve to penalize applicants who describe and claim multiple embodiments of technically complex inventions. Zealous use of restrictions and increasingly abbreviated prosecution through final rejection often require applicants to undesirably reduce the scope of the claims (often based on an examiner's subjective, seemingly arbitrary determination) and to resolve prosecution quickly, often at the expense of legitimate claim scope. These practices compel applicants to file continuation applications to ensure adequate portfolio coverage. Therefore, the Proposed Rule Changes are at odds with current USPTO practices that result in filing of continuation applications, and if adopted, will serve to weaken patent protection and discourage innovation.

As noted above, multiple continuation and (divisional) applications are filed, in part, because of the USPTO's restriction practice. For an applicant to prosecute all the "separate inventions," the applicant needs to file continuation and divisional applications. Many applicants choose to file these applications sequentially, in great part, because of budgetary constraints. In addition, as a result of the current fee structure, applicants file multiple applications with twenty or fewer claims because this filing strategy, in many instances, is more financially feasible and prudent than filing fewer applications, each with more than twenty claims. Sequential filing may also provide efficiencies, as lessons learned in prosecution of earlier applications are immediately applied in subsequent applications to speed prosecution.

The practical effect of the Proposed Rule Changes that (1) limit applicants to only those continuation applications that can be supported by a showing that the amendment, argument, or evidence

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presented could not have been previously submitted and (2) deny applicants the benefit of a parent application's filing date for divisional applications not filed during the pendency of the parent application denies applicants the right to patent their inventions, thus discouraging innovation. Particularly, applicants without abundant capital (such as individual inventors, small businesses, and start-up companies) would be significantly impacted. Moreover, if the Proposed Rule Changes are adopted, we assume that some, if not most, applicants will file multiple divisional applications to maintain the benefit of the claimed priority date; therefore, the workload of USPTO personnel will not decrease, but will likely increase.

2. Patent scope is being restricted by the courts.

The courts have become less inclined to interpret the scope of an invention beyond the literal meaning of the claims, precluding claim scope that at one time was captured under the Doctrine of Equivalents. As a result, applicants are forced to file continuation applications directed to multiple related embodiments to prevent competitors from usurping what patent exclusivity that patentees may have otherwise enjoyed. In view of the philosophy of restrictive claim interpretation by the courts, the Proposed Rule Changes, if adopted, will have an overly detrimental impact on patentees because limiting applicants to only those continuation applications that can be supported by a showing that the amendment, argument, or evidence presented could not have been previously submitted would eliminate a vast number of legitimate continuation applications needed to provide coverage of alternate aspects of an invention. Furthermore, requiring applicants to identify a subset of representative claims for initial examination unduly provides an infringer with an artificially-imposed defense to present to a court regarding what the patentee may have initially considered "representative" of the scope of the invention. Consequently, the courts will likely continue to interpret claims more narrowly, further discouraging innovation.

3. Incentives for companies dependent on R&D are reduced.

At the time of filing an application, the claim scope that provides the most suitable protection of the invention may be uncertain. Companies who diligently protect their intellectual property often file patent applications containing claims that encompass

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embodiments that later, for one reason or another, fail the rigors of product development. The applications, however, may also support alternate claims that are worthy of prosecution and entitled to patent protection. If the Proposed Rule Changes are adopted, the burden of compliance unduly penalizes applicants, particularly R&D companies innovating at the edge of uncertainty, and unfairly weakens the incentive that drives this sector of the economy: an opportunity to obtain adequate and appropriate patent exclusivity. Accordingly, if the USPTO institutes the Proposed Rule Changes, the question arises whether the government will be complying with the Constitutional mandate to promote the progress of science and the useful arts.

4. Additional bureaucratic review, arbitrariness, and delay will result.

The time for review of patent applications by the USPTO is already excessive. If the Proposed Rule Changes to the practice of continuation applications are effected, the change in procedures will further delay application review by necessitating review of petitions supporting the filing of continuation applications. Inevitably, the length of time for prosecution of an application will increase while decisions on such petitions are debated and appealed. The added layers of review and the arbitrariness associated with the new requirements will increase burdens on the USPTO.

5. The USPTO has other, more appropriate ways to improve its processes.

For the foregoing reasons, the Washington State Patent Law Association respectfully submits that the USPTO should look to other, more appropriate ways of improving its internal processes, including:

- (1) instituting a process by which applicants may elect to defer examination (perhaps with appropriate fee incentives for doing so), effectively reducing the number of applications examined, or requiring applicants to formally request examination within a certain timeframe;
- (2) revising the system for evaluation of examiner performance to remove aspects that may undesirably promote inefficiencies (e.g.

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(3) inappropriate restrictions, premature final rejections, etc.); and hiring additional examiners to adequately staff art units.

In conclusion, the Washington State Patent Law Association wishes to reiterate its appreciation of the challenges faced by the USPTO, and of the Commissioner's genuine efforts to address those challenges. We believe, however, that the Proposed Rule Changes are overly detrimental to the legitimate protection of intellectual property, and thus, to innovation.

Respectfully submitted on behalf of the Board of Directors of the Washington State Patent Law Association,



Kevan L. Morgan, President

-----Original Message-----

From: Glenn Foster [mailto:Glenn@BerkeleyTechLaw.com]

Sent: Wednesday, May 03, 2006 4:40 PM

To: AB93Comments; AB94Comments

Cc: Howard A. Skaist; Glenn Foster

Subject: Glenn Foster Personal Comment Against USPTO Proposed Rule Change

Attached is a copy of my personal comments against the USPTO Proposed Rule Changes.
Please respond if you cannot open the attachment.

Glenn

Glenn Foster
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Comments Opposing Proposed Rules of Practice in Patent Cases

The following comments are submitted by the person listed below to the Proposed Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims, Notice of proposed rulemaking, first published in the Federal Register at 71 Fed. Reg. 48 (January 3, 2006) and then published in the Official Gazette at 1302 Off. Gaz. Pat. Office 1318 (January 24, 2006).

The views expressed herein are those of the signatory in my individual capacity as a lawyer admitted to practice before the USPTO, and are NOT to be taken as representative of the view of any client(s) of the signatory, past or present. These views do not necessarily reflect the opinion of my employer, Berkeley Law and Technology Group, LLC.

Respectfully Submitted by: Glenn Foster
Date: May 3, 2006

Comments Opposing Proposed Rules of Practice in Patent Cases

Submitted By: Glenn Foster

This comment relates to the Proposed Changes To Continuation Applications of the United States Patent and Trademark Office (USPTO). This comment also partially pertains to certain aspects of the Proposed Changes to Practice for the Examination of Claims in Patent Applications. This comment against the Proposed Rule Changes is intended to respectfully indicate that the USPTO and the U.S. Patent System is not broken, and indeed would both be severely challenged if such Proposed Rule Changes are implemented.

I have been a Patent Examiner with the USPTO for four years in the early 1980s, in the Railroad Arts and the Sorting Device Arts (Art Unit 312). My technical training and education is in mechanical engineering, electrical engineering, and computer science. After leaving the USPTO, I have worked for the vast majority of this period as a Patent Attorney, both in corporate and firm environments. As such, I have a considerable amount of prosecution and other patent-related experience from a variety of viewpoints and a variety of technologies.

I sincerely believe that the proposed rules, if implemented, would not lead to the sought-after improved efficiency within the USPTO. Many of these proposed rules relate to increasing non-examination related aspects within the USPTO, such as have recently been performed by contractors or clerical personnel within the USPTO. Such non-examination aspects within the USPTO rarely, if ever, improve overall efficiency within the patent system (within and out of the USPTO). These proposed rules, if implemented, would likely confuse the examination process, cause additional unnecessary layers of bureaucracy within the USPTO, and make our practices as patent lawyers and agents more difficult, uncertain, and expensive.

Considering the tenor and number of comments provided to the USPTO against the proposed rule changes in the USPTO web page as compared with the numerically fewer comments for the proposed rule changes, as well as the many discussions I have

had with a variety of patent attorneys and examiners as to this issue, the patent community appears strongly in disfavor of the proposed rule changes.

While the USPTO does have a great challenge to improve efficiency, there are less obtrusive and objectional ways than many of the techniques of the proposed rule changes. I wish to assist the USPTO by providing advice on more effective techniques to reduce the backlog and pendency of the patent applications within the USPTO. I will thereby proceed by responding to each of the following bulleted highlighted points.

- **The Continuation Rule Changes would not improve efficiency at the USPTO, and would cause considerable expense, inefficiency, and uncertainty to the patent system within the U.S.**

The reasons why practitioners file continuation applications vary considerably from technological improvements or modifications, breaking up a complex application into a suitable number of claims, and/or responding to prior rule changes. Certain ones of the continuation applications may not even claim directly-related subject matter, but practitioners may feel constrained to follow for priority-document purposes.

Inventors, by definition, are continuously deriving improvements. The number of utility patents which are "pioneer invention" patents as compared to improvement patents are exceedingly small (some percentage of 1 percent). Virtually any of these improvement patents having any common ownership could arguably form the basis of a continuation patent application. With the ever increasing pressure on the inventor/attorney to disclose related applications also comes the tendency to classify questionably-related applications as continuations or CIPs.

Patent practitioners who zealously represent their client's interest are often forced to file a number of continuation applications, largely as a result of the diminishing doctrine of equivalents. Additionally, the filing fees have increased at the USPTO by an alarming rate, such that it often becomes economically preferred to file two or more applications, compared to one having a larger but sufficient number of claims. If the Courts are not going to read any equivalents into the claims, then to fully protect the invention and to avoid malpractice, patent practitioners are forced to file claims protecting each reasonable embodiment. This represents one example of how one poorly

thought-out action by the USPTO (increasing the fees) directly led to a Pandora's Box of unintended consequences (more applications filed to adequately protect inventions and a larger backlog). I submit that the increase in continuation filings is largely a result of this unintended consequence.

- **U.S. Inventors, Companies, and the Public has a Right to Obtain Patents in an Unimpeded Fashion from the USPTO**

Article I, section 8, the U.S. Constitution states, in part:

Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

The USPTO does have the responsibility to provide patents. Us practitioners, as well as our inventors and represented companies, have a right to a patent system that can provide patents without undue burdens. The bedrock of the Patent system is the examination process. I submit that anything within the USPTO that improves the examination process is good, while anything within the USPTO that detracts from the examination process should be limited. The proposed continuation rule changes, in particular, will not improve the examination process.

Patents were granted such a high placement by the founding fathers as to be expressly mentioned in the Constitution. It rightly requires some similarly significant justification to alter the patent rights of the inventors provided by the Constitution. Abridgement of such rights should only be performed by Congress following serious consideration and deliberation. For the USPTO to significantly alter the examination process should be considered deeply and avoided if possible.

- **The USPTO is only one of the participants within the patent system. The Proposed Rule Changes Effects other parties, as well, which also have to be considered**

While the USPTO does play a vital role in the patent system, it certainly does not play the only role. Considering the role of Courts, if a patent practitioner was to agree to a more limited protection than their client felt was due, then the practitioner could be committing malpractice. Congress and/or the Courts should make any respective law or determination relating to abrogating of such vital individual, property, and Constitutional Rights. The USPTO should not forget that practitioners typically consider the patent application based on how it will be interpreted in the Courts, not within the USPTO.

- **Various Proponents of the Proposed Rule Changes are under the misconception that almost any idea can be sufficiently protected with a relatively few number of claims. Practitioners are keenly aware that numerous claims are sometimes necessary to protect important inventions. Patent courts often have different holdings for slightly differing claims.**

Patent practitioners who follow patent litigation understand that patents are only as good as their claim language. Consider how carefully courts consider the language of the claims. I, as a patent practitioner, understand that the USPTO and the Courts are often not in complete concurrence relating to claim construction, Doctrine of Equivalents, and many other patent issues. Many litigated patents have been prepared years or decades before, and yet follow today's rules. Patent law evolves considerably from era to era. As such, it can be extremely difficult to determine which patent applications cover critical technologies and what effect the nuances of claim language can have in prosecution, enforcement, licensing, and other patent aspects.

As such, practitioners prepare patents not only considering prosecution, but also considering enforcement and licensing. The time-tested method of patent preparation for those patents that may be litigated (and potentially each patent may be litigated) involves claiming a variety of claim sets each directed at different scopes and levels. For example, different claims can be directed broadly and/or narrowly, with varying elements, and

different claims can be directed at different potential infringers, etc. An apparatus claim may be more effective against a particular potential infringer, while a method claim may more suited for another. Means plus function claims, while disfavored at certain times by certain practitioners, have often been applied in extremely important cases (e.g., State Street Bank, etc.). Asking patent practitioners to abide by many of the proposed rule changes in limiting the number of claims is akin to asking us not to consider that many of us are drafting patent applications according to how they can be enforced in courts, and only considering whether they can pass through the USPTO quickly to obtain a "quicky-patent".

Our clients (both corporate and individual inventors) have a different focus than the USPTO does, since obtaining quality enforceable patents is almost always more critical than obtaining quick patents.

There are those that contend that almost all applications can be drafted in ten to twenty claims, or less. Most experienced practitioners could not disagree more. By forcing us to limit the claims to some arbitrary number (depending upon the invention) is akin to asking us to commit what amounts to malpractice in an effort to gain some slight efficiency within the USPTO.

The USPTO has to remember its duty to allow us to submit and prosecute patents which can allow us to adequately prosecute, enforce, and/or license our patents. The USPTO is one part of the entire U.S. Patent System, such actions would result in a unilateral decrease in the enforceability of patents that would not likely be followed or enforced by other participants of the U.S. Patent System. The interest of the other integral participants of the U.S. Patent System has to be considered.

- **Consider the Metrics the USPTO is Using in Measuring Efficiency**

The Director of the USPTO and others have traveled to a number of forums (Washington, Chicago, and San Francisco) in an attempt to sell these proposed rule changes. In general, the response among the practitioners has been cold (at best) to these proposed rule changes. In these forums, the roadshow appear to be arguing that the pendency of the patent applications to the first office action is the true metric by which the USPTO's performance is to be evaluated. The Director et al. are contending that

there is some crisis in pendency within the USPTO, and use as an illustration one art unit that has a pendency of over ten years. I submit the situation within the USPTO is far from a crisis, and the best situation is to administer the USPTO more effectively.

According to the forum handouts, the majority of the pendency appears to be within the 0 to 3 year range. The USPTO has indicated it to be in its hiring mode. The USPTO can direct new Examiners within those art units of the USPTO that have the greatest pendencies. This is an obvious part of administration of the USPTO that will improve efficiency. I submit that the system is not broken, and the USPTO is not in need of these drastic rule changes.

An even more important metric for the USPTO, from the practitioner's viewpoint, is the time to issue. The proposed continuation rule changes would likely extend this metric since it appears that additional non-examination as well as examination processes appear likely. Such holding-up examination by non-examiners leads to confusion and uncertainty among companies, practitioners, examiners, and inventors.

The continuation process within the USPTO has undergone surprisingly few substantive changes within the 200 plus years of the U.S. Patent System. Before the USPTO undertakes some draconian restructuring of the patent continuation process, there certainly are sufficient slight modifications that can be performed that would be less obtrusive.

• **Over the years, the Filing and Maintenance Fees Within the USPTO Have Increased Exponentially.**

Not that long ago (a decade or so), the filing fees and maintenance fees did not support all of the expenses of the USPTO. As such, the government allowed money to sink into the USPTO to promote the useful arts (e.g., patents). That is not the case any more, and in actuality, a considerable amount of the money from the filing fees and maintenance fees being directed to the USPTO appear to be diverted from the USPTO into other branches of government. Such increase in fees have been particularly excessive within the last few years.

It has always been indicated to us practitioners from the USPTO that the increases in filing fees were intended to improve the quality of patents. By such an increase in

fees, the USPTO can increase the number of examiners within the USPTO. Us practitioners, companies, inventors, and firms are left to query where the large increase in filing and maintenance fees are going within and outside of the USPTO.

As the number of filing fees and maintenance fees on patents has increased, there has been a tendency among many practitioners to segment applications into multiple related applications, each having 20 claims or so. This segmenting of applications has contributed significantly to the increased number of filings within the USPTO. Reducing the filing and maintenance fees would have the opposed effect of reducing the number of filings (which the USPTO claims it is seeking).

- **A vibrant patent system has traditionally helped U.S. companies, as well as individual inventors. Continuation patent applications are a vital part of the patent system.**

There appears to be an argument, which has recently become more vocal, that patents are generally bad largely since they represent a monopoly. Alternately, larger companies can be sued by smaller companies or individuals. These general arguments are flawed.

The art of invention naturally leads to improvements. Patents do not exist in a void. As improvements are derived, it is important that such improvements that are worthy of patent protection can be protected. Practitioners understand that most patents are derived in groups or families. To provide solid patent protection, it is important to ensure that technologies are adequately protected by patents, and often groups of patents. Often, the development or inventive process leads to improvements. Companies and inventors realize the dangers inherent with limiting inventions to original application concepts. Such modifications and/or "tweaks" within families of patents can have a profound effect for an owner or company financially.

To emphasize the financial effects of such modifications, consider the railroad spike technology. That this mature technology is still active with a number of patent applications filed indicates what an effect tweaks and slight redesigns can have on technology. Considering the large number of miles of track with such railroad spikes (amounting to considerable money) emphasizes the importance of many mature

technologies. Railroad spikes are an illustration of many mature technologies that are protected largely based on such minor improvements as may utilize the continuation practice. As such, patents can be vibrant even in more established and mature technologies.

The continuation practice is a vital part of protecting such technologies within the patent system. To place such restrictions on the continuation practice would force the inventors, and their companies, to settle for an earlier unimproved version of their technologies. This hardly benefits the patent system.

Patents in general, including continuations, have and continue to protect both big business and small inventors alike. For example, many fortune 500 companies in many technologies have prospered immeasurably on their patent licensing. Additionally, small business and individuals, who represent the lion's share of technological development and improvement in this country, can only be protected by intellectual property. To limit filing of many of these patents for companies and/or individuals can only frustrate the Patent System.

A few larger companies appear to be supporting the Proposed Rule Changes in an effort to reduce litigations against them by smaller companies. Numerically more larger companies appear against the proposed rule changes, understanding that the proposed rule changes would only provide temporary uncertainty into the patent system. Consider, however, that most larger companies have relied on the patent system to become larger companies. In addition, those larger companies of the future (which are now smaller companies) may be limited from achieving their growth as a result of the difficulty in obtaining suitable patent protection. Consider how many companies there are in the software, semiconductor, video, medical, medicine, and other growth technologies whose names were unknown twenty years ago. The proposed rule changes appear directed at limiting the number of medium and smaller companies that can grow to become larger companies, yet not providing any impetus for the larger companies to remain technologically competitive, and thereby remain as larger companies.

The U.S., as well as the USPTO, is not alone in the world anymore. I submit that the proposed rule changes and the resultant difficulty in obtaining patents will result in making the United States less competitive technologically. As Europe, Japan, China, and

India continue to grow technically and continue to develop their reliance on their own patent systems, I hope the U.S. is not sticking its head in the technical sand by following such devices as the Proposed Rule Changes.

Many efforts to characterize certain patents as good (e.g., my patents) while other patents are bad (e.g., anyone else's patents) lead to poor enforceability, lack of trust in the USPTO, and general degrading of the technology base of the USPTO. Poor USPTO Rules, such as the proposed continuation modifications, generally are terminated eventually. The only uncertainty is when. Unfortunately, poor USPTO rules can burden *different parties unevenly and lead to durations of uncertain enforceability*. One poor USPTO Rule was the regulation against computer inventions (hereinafter the (anti)computer rule). Those companies having practitioners and litigators with sufficient foresight and savvy felt that the USPTO (anti)computer rule represented bad law, and continued to file a large number of patent applications that violated those rules. These companies were betting that the USPTO (anti)computer rules would be overturned, which they assisted in doing. Many of these patents were the ones that these technically savvy companies used to get in the technological door first, and were licensed by such companies to obtain their huge licensing royalties. Many other computer companies, who dutifully followed the USPTO (anti)computer rules, ended up being driven from the computer marketplace. The USPTO Rules can therefore have huge and lasting effects on the marketplace, and poor USPTO Rules should be avoided whenever possible.

Many companies in many industries have benefited greatly from effective use of patents. Many of the companies that started from small companies have been leveraged into much larger companies by the use of patents. Virtually each successful high-technology company has improved their market share and/or received considerable licensing revenues directly as a result of patent licensing and/or limiting competition. Many of these patents forming the portfolios of the companies are continuation patents. A continuation patent on a commercial success can provide considerably more technological advantage than certain technologically challenged pioneer inventions. The USPTO is in a poor position to evaluate the worth of many patents.

Many of the larger companies rely heavily on R&D developed from individuals and smaller companies outside the company. It is worth noting that many large

companies develop from small companies that have some technological advantage. In certain instances, the technological advantage is provided from patents. Consider where the computer, software, electronics, biotechnology, and other industries were 20 years ago (as well as many of the present corporate giants in these technologies). Much of the developmental push of the companies in these industries has been provided by patents. Without adequate protection by patents, there would be no mechanism to ensure the smaller inventors as well as companies in smaller or developing technologies are properly remunerated for their technological improvements, and that these companies and individuals can financially continue their development. Without adequate patent protection, many of these unprotectable inventions would not be disclosed. As such, the U.S. would lose much of the competitive advantage that it has enjoyed over the years.

While it is evident that no one is submitting eliminating continuation patents in general, it appears likely that the proposed continuation rule changes would have a considerable chilling effect. When the prosecution of certain types or classes of patents become subject to some non-examination related criteria, this chilling effect applies to patents in general. I submit that the USPTO is not the place to provide such a chilling effect, and the USPTO is obligated to follow its charter "to promote the useful arts".

- **Many aspects of the proposed rule changes have been attempted to be included in prior-failed proposed Congressional Budget Legislation. As such, the USPTO should not attempt to implement such previously-failed legislation. (Self Explanatory)**

The proponents of the Proposed Continuation Rule Changes have repeatedly tried to implement these rule changes, and have been constantly fought back. Why should the USPTO follow such an unpopular set of rules.

• **Providing arbitrary examination processes would only hurt the examination process entrusted to the USPTO. The addition of contractors and others within the USPTO has made the overall patent system less efficient rather than more efficient.**

The proponents of the Proposed Continuation Rule Changes argue that modifying the continuation practice in the USPTO would improve efficiency within the USPTO. Such modification of the continuation process adds additional uncertain steps into the examination process, and as such can only make the examination process more unwieldy and uncertain to patent practitioners, inventors, and companies. The USPTO should not consider letting such an inefficient "increase in efficiency" as the Proposed Rule Changes be a determining factor such that the fair prosecution of patent might suffer. Patent practitioners realize that brevity and efficiency are not as important within the USPTO as performing a thorough and just examination.

Is filing continuation applications really an undue burden on the Examiner? It typically requires less time for a patent examiner to examine a continuation application than it does an original application. As such, Examiners generally prefer to prosecute continuation applications since they are more easily examined.

In the USPTO Roadshow, the USPTO's Director, et al. argued that it is largely the Patent Examiner Union (POPA) that is pushing these Proposed Rule Changes. As an ex-examiner, I understand the challenge that patent examiners are provided with in meeting their examination quota. In the railroad arts, for example, my quota was 10.6 hours per balanced disposal (which includes the examination process, the first and subsequent office actions, the issuance or abandonment for each office action, interviews, etc.). While this was a while ago, the examination quotas have not changed considerably. This is not much time to do a thorough and complete examination/issuance/allowance/abandonment on an average patent application. POPA is not a typical union in that it does not have the ability to go on strike (consider its charter and the effects of the air traffic controllers strike). POPA, in general, has been fighting over the years for such things as increasing the hours for balance disposal, allowing examiners to receive more pay than other federal employees considering their

engineering background, and other such examiner-related issues. I know as an examiner that the last thing that I would have wanted is to have some non-examination group (such as the pre-examination group) interfere with the examination process.

Wouldn't following some of POPA's requests such as increasing the hours per balanced disposal and increasing examiner pay to attract and retain more qualified examiners do more to improve the USPTO than such band-aid efforts as the Proposed Rule Changes?

- **The USPTO and Practitioners each have distinct functions that we all should not blur. For example, the USPTO should not attempt to dictate how to draft patent applications. Similarly, corporations, firms, or individual patent practitioners should not attempt to dictate to the USPTO how to examine patent applications. Such distinctions are muddled by increasing non-examination-related groups within the USPTO**

The USPTO should not attempt to dictate to patent practitioners how to draft patent applications (except formal aspects). Many of these applications often are prepared with enforcement and/or licensing considerations. Similarly, corporate, firms, and individual patent practitioners should not attempt to interfere with the examination process within the USPTO that is better left to the patent examiners. Such delineations between examiners and practitioners may be effected by an increase in the non-examination-related bureaucracy within the USPTO.

It is exceptionally difficult for patent practitioners to determine the true value of a patent since enforcement often occurs so long after the drafting stage, and commercial acceptance of the related product or process is often uncertain. It is even more difficult for the USPTO to make such a determination. There are often sufficient inventive distinctions to justify filing a continuation application that are not evident to the USPTO, and I believe would be strongly effected by a chilling continuation rule change.

- **Substituting bureaucratic patent considerations, and more non-examination-related contractors, is not a viable alternative and would damage the patent system.**

In an example of a poor attempt at "efficiency", a pre-examination group has been established at the USPTO. Most of the responses by this pre-examination group relate to issues that have little to do with patent examination, drafting, and/or other important USPTO roles. Many of the inexperienced contractors who perform this pre-examination function are poorly paid, have little or no examination ability, and appear to focus on nitpicking.

It appears to us that many of these contractors think they can hold up prosecution indefinitely for extremely questionable reasons that experienced examiners or practitioners would never consider. Such delay of prosecution by the contractors to hinder obtaining patent (property) rights raises Constitutional considerations. As such, practitioners may be forced to compromise the record to get the application examined (leading to another serious malpractice issue).

The pre-examination group within the USPTO has done little to lead to real improved efficiency either within the USPTO; or within companies and/or firms. For companies and firms, this group requires expensive practitioner time be spent dealing with the consequences of the group contractors' flawed interpretations. There is no reason to believe that a modified continuation practice would be better implemented than the pre-examination process, and would only confuse and compromise the patent application records and process. I believe that a continuation rule modification group would likely be implemented in a similar manner as the pre-examination group. Such groups are far from efficient, and the salaries of many of the employees in such groups could be better spent in hiring examiners.

I do not agree with the assessment that the USPTO is broken and need to be drastically changed. Slight modifications can be far less obtrusive, and can be easily implemented. Above all, the USPTO has to remain responsive to practitioners.

- **The Continuation Rule Change would not improve harmonization between the USPTO and other International Patent Offices.**

In general, the European Patent Office, the Japan Patent Office, and the other Patent Offices of the developing and developed countries of the world are increasing their patent protection. Why should the USPTO consider going in the reverse direction by following the Proposed Rule Changes?

- **There are a Considerable Number of Alternatives within the USPTO to the Proposed Rule Changes**

In an attempt to improve efficiency, the USPTO should focus on one metric that relates ultimately to efficiency: time for patent to issue. Focusing on other band-aid metrics as time to first office action can be misleading, and can also be easily adjusted by shifting examiners among groups.

While I generally disagree with the proposed claim examination rule changes as well, I understand how such rule changes could be implemented carefully and improve examination. The USPTOs current requirement that each claim be thoroughly examined leads to considerable boilerplate and a number of estoppels in the Office Actions, as well as require considerable Examiner's time (to prepare the Office Actions) as well as practitioner time (to respond to the Office Actions). As such, perhaps some examination process can be provided whereby the examiners are not required to examine (and respond to) each and every claim. There should be some mechanism to indicate some potentially allowable subject matter in such non-elected claims that might make non-allowable independent claims allowable, if the examiner so deems. Interviews provide an excellent technique to obtain such information, especially since many portions of them are "off the record".

Another potential improvement that would improve efficiency is to allow certain patent application owners to "defer examination" of certain applications. Not every patent application is valuable at this time, but many of these may become valuable in the future. Perhaps the USPTO should establish such a class of deferred-examination applications, and perhaps modify the publication and/or prosecution rules (as well as the fees) for these applications.

If improperly implemented, the limited examination of the Proposed Examination Rule Changes may lead to undesired examination consequences and decreased efficiency within the USPTO and the patent field. If properly implemented, such Examination Rule Changes could improve the examination process and streamline the Office Actions.

- **The most reliable way to improve efficiency at the USPTO is to hire and train a suitable number of qualified patent examiners. All other proposed rule changes represent a band-aid solution to the real problem.**

There are many things that could be done at the USPTO to increase efficiency and reduce backlog, while not potentially confusing patent prosecution. Recall that Congress is held by the Constitution to establish a patent system. If the USPTO is serious about decreasing the examination backlog, then the fees on multiple claims could be reduced so that the inventions can be adequately protected at a reasonable cost in the minimum number of applications. If the USPTO is serious about improving efficiency, then a larger number of more skilled Examiners need to be hired. If the USPTO is serious about examining applications quickly, then perhaps shorter Office Actions, similar in structure to the EPO, can be prepared allowing for more examination time to locate better prior art.

The proposed modification to the continuation practice would lead to poor administration of the patent system by the USPTO. The USPTO has demonstrated that such attempts to increase efficiency are counter-productive within the USPTO, and are downright damaging for the inventors, large and small companies, practicing practitioners, technology investors, courts, and other parties involved in the overall patent process. The results on all parties to the Patent System must be considered during such a drastic proposed rule change, especially one that has so many negative aspects.

Only partially in jest, if the USPTO is to implement such Proposed Rule Changes, perhaps it should consider changing its name from the "United States Patent and Trademark Office" to the "United States Resistance Against Patent and Trademark Office".

For the U.S. Patent System to maintain its vitality, companies and inventors should not be constrained to their original inventions, and thus be forced to ignore their improvements and/or otherwise be forced to accept patents having a limited scope. The USPTO should direct its focus at improving examination aspects, while limiting other non-examination related aspects.

Respectfully Submitted,

A handwritten signature in cursive script, appearing to read "Glenn B. Foster".

Glenn B. Foster

USPTO Reg. No. 32,676

Dated May 3, 2006

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