

To: ab37.comments@uspto.gov
Subject: RIN 0651-AB37

Box Comments- Patents
Commissioner for Patents
Washington, DC 20231

Dear Sir,

The Procter & Gamble Company's comments on the proposed rule concerning elimination of continued prosecution application practice as to utility and plant patent applications, are as follows:

The United States Patent and Trademark Office has proposed amending 37 C.F.R. §1.53(d) to eliminate continued prosecution application (hereinafter "CPA") practice for utility and plant patent applications. It is the Patent Office's position that CPA practice for utility or plant applications is redundant in view of request for continued application practice (hereinafter "RCE").

It is our view that CPA practice is not redundant in view of RCE as there are two key features of current CPA practice that would not be available under RCE. The first feature relates to the new 35 U.S.C. §103(c). As part of the American Inventors Protection Act of 1999 (hereinafter "AIPA"), 35 U.S.C. §103(c) was amended. The old 35 U.S.C. §103(c) disqualified commonly owned/assigned subject matter that qualified as prior art only under 35 U.S.C. §102(f) or (g). The new 35 U.S.C. §103(c) as amended by the AIPA adds the additional disqualification of commonly owned/assigned subject matter that qualifies as prior art under 35 U.S.C. §102(e).

Eliminating CPA practice will prevent some pending patent applications from qualifying for the new 35 U.S.C. §103(c). The new 35 U.S.C. §103(c) applies only to applications filed on or after November 29, 1999. A CPA filed on or after November 29, 1999 is subject to the new 35 U.S.C. §103(c). Under the current rules, if a patent application was filed before November 29, 1999 and on or after June 9, 1995, the application can qualify for the new 35 U.S.C. §103(c) by filing a CPA on or after November 29, 1999. However, under the proposed rulemaking, if an application is pending in which there has been no CPA filing either on or after November 29, 1999, the only way for this application to qualify for the new 35 U.S.C. §103(c) is to file a continuing application under 37 C.F.R. §1.53(b). In many instances this is an undesirable alternative as it requires that prosecution be started all over again. This is counter to an objective of advancing prosecution as it results in a more costly protracted prosecution which is an inefficient use of both the examiner's and the attorney/agent's time. This is especially true in instances where the application is close to allowance and would be allowable under the new 35 U.S.C. 103(c).

The second feature of current CPA practice that would not be available under RCE practice relates to the patent term adjustment provisions (hereinafter "PTA") of the

AIPA. The PTA provisions of the AIPA which became effective on May 29, 2000, apply to utility and plant applications filed on or after May 29, 2000. Filing a CPA under 37 C.F.R. §1.53(d) on or after May 29, 2000 will qualify an application filed on or after June 8, 1995 and before May 29, 2000 for PTA. Conversely, RCE practice will not qualify the same application for PTA.

In summary, we understand that by introducing RCE practice the Patent Office's original objective was to phase out CPA practice over time. Phasing out CPA practice over time allows for the natural transition into RCE practice. However, the proposed premature elimination of CPA practice will result in many pending applications having no efficient mechanism to qualify for the provisions of the new 35 U.S.C. §103(c). This in effect will place an unnecessary burden on both examiners and the patent practitioners involved in the prosecution of these pending applications. Furthermore, short of filing a continuing application under 37 C.F.R. §1.53(b), the elimination of CPA practice will prevent an application filed on or after June 8, 1995 and before May 29, 2000 from qualifying for PTA.

Fundamentally, we have no issues with the elimination of CPA practice as long as there is some alternative efficient mechanism in place that addresses pending applications which otherwise would not qualify for 35 U.S.C. §103(c) or for PTA. We ask the Patent Office to reconsider the proposed abrupt elimination of CPA practice in favor of a natural phase out of CPA practice as originally planned or alternatively to provide a means for an application to qualify for the new 35 U.S.C. §103(c) and for PTA which does not require that prosecution be restarted.

Sincerely,

Julia A. Glazer
Counsel- Patents
The Procter & Gamble Company