

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:

USPTO Docket No. 010606145-1145-01
RIN 0651-AB37

For: **Notice of Proposed Rulemaking:
Elimination of Continued Prosecution
Application Practice as to Utility and
Plant Patent Applications**

66 Fed. Reg. 35763 (2001)

***Comments In Reply To the Notice of Proposed Rulemaking Regarding
Elimination of Continued Prosecution Application Practice as to Utility and
Plant Patent Applications***

Commissioner for Patents ab37.comments@uspto.gov
Washington, DC 20231

Sir:

In reply to the Notice of Proposed Rulemaking published July 9, 2001, at 66 Fed. Reg. 35763 (2001), Sterne, Kessler, Goldstein & Fox P.L.L.C. submits the following comments.

Introduction

The U.S. Patent and Trademark Office ("the Office") proposes to eliminate Continued Prosecution Application (CPA) practice in favor of Request for Continued Examination (RCE) practice. The Notice states that it has been determined, ". . . that CPA practice for utility or plant applications is redundant (in view of RCE practice). . . ."

We respectfully disagree and respectfully request that the Office to reconsider. We request that the Office keep CPA practice for all utility applications, or, at a minimum, for pre-GATT utility applications. Alternatively, RCE practice should be made available to pre-GATT utility applications.

CPA Practice is not Redundant with RCE Practice

CPA practice for utility applications is not redundant with RCE practice. The American Inventors Protection Act of 1999 (AIPA) implemented many benefits for utility applications filed on, or after, the relevant effective dates. Such benefits can be substantial, and include, for example, publication, intervening rights, and patent term adjustment rights. CPA practice is still the only way to "re-file" a pre-AIPA utility application and gain the benefits of the AIPA, while maintaining the stage of prosecution and file history. Such benefits do not occur with RCE practice. Thus, the effect of filing a CPA is not redundant with RCE practice.

Eliminating CPA Practice for Utility Applications Will Severely Compromise Pre-GATT Applicants

Eliminating CPA practice for all utility applications will severely compromise pre-GATT applicants who must re-file the application. A patent that issues on an application filed prior to June 8, 1995 (i.e., prior to implementation of GATT, "pre-GATT"), is entitled to a patent term that runs 17 years from the date of issue. However, pre-GATT applications that are re-filed are brought under the new patent term that runs 20 years from the filing date of the earliest non-provisional U.S. priority application.

RCE practice is not available for a pre-GATT application. Instead pre-GATT cases must utilize the provisions of 37 C.F.R. 1.129(a). These provisions allow the pre-GATT applicant to withdraw finality only two times during prosecution.

Pre-GATT applications are now already so old that to force the applicant to give up on the current prosecution, and to re-file the application and start prosecution over, would significantly compromise the patent term of the resulting patent. CPA practice maximizes the patent term of a pre-GATT application that must be re-filed. This is because no time is lost in pre-examination processing, and CPA practice continues the on-going prosecution. For example, an applicant who files a CPA can immediately request an interview, and/or respond to issues that might be outstanding from a prior office action. Thus, CPA practice is the preferred procedure if a pre-GATT application must be re-filed.

If CPA practice is eliminated, the pre-GATT applicant who desires to re-file the application will be forced to file a new copy of the application, spent unnecessary time in having the initial formalities reviewed, and begin prosecution anew. Thus, elimination of CPA practice unnecessarily and unfairly compromises the patent term of the pre-GATT applicant who must re-file the application.

Therefore, at a minimum, even if the Office eliminates CPA practice for other utility applications, CPA practice should be continued for pre-GATT applications. Alternatively, the rules should be amended to allow pre-GATT applicants to utilize RCE practice.

Voluntary Publication is not a Satisfactory Alternate for Publication Via Filing a CPA

It is true that a pre-AIPA applicant can request voluntary publication rather than utilize a CPA to enter the publication system. However, voluntary publication does not make the application eligible for patent term adjustment. Therefore, voluntary publication is not a satisfactory substitute for filing a pre-AIPA utility application via a CPA.

Additionally, a voluntary publication request must be filed electronically, along with the appropriately packaged application. The packaging and electronic filing of applications at the USPTO is still fraught with difficulties, and can be quite expensive and time-consuming to prepare. Thus, requesting voluntary publication is far more complicated, more time-consuming, more expensive, and has a significantly greater chance of applicant error than simply filing a CPA.

CPA Practice Results in Higher Fees than RCE Practice

The Office states that the publication of a CPA "is both costly and inefficient." However, neither of these would seem to be improved by elimination of CPA practice in favor of RCE practice. With regard to cost, any adjustment in the cost of handling a CPA can be passed back to the applicant. Therefore, this should not be a reason to eliminate CPA practice.

Further, it is unclear why the Office finds CPA practice costly. Currently, the applicant pays a new application filing fee for a CPA - including the basic filing fee plus excess claims fees. The fee for the RCE is not adjusted for the number of claims. Therefore, the fee for filing many RCE's will be less than that of a CPA.

The Office proposes to keep CPA practice for design patents. As a result, the administration of CPA requests will still be maintained at the Office even if the proposed rules are made final. Thus, elimination of CPA practice for utility applications seems to be more costly, as the Office must maintain support for CPAs *per se*, but would lose the revenue from the payment of excess claims fees for CPA of utility applications (since design patents have only one claim).

CPA Practice Avoids Initial Application Processing and Thus Increases Efficiency of Office Operations

With regard to efficiency, efficiency in prosecution can only be decreased if CPA practice is eliminated. Under the proposed new rules, if CPA practice is eliminated, a pre-AIPA applicant who desires to take advantage of publication and publication's intervening rights and/or patent term adjustment, will be forced to re-file a new specification. Such re-filing would start prosecution over from the beginning, as with the filing of any new continuation application, including formalities review. It is clearly inefficient to take an application that has a long file history and to start prosecution anew.

Additionally, CPA practice enhances efficiency when it is desired to abandon a pending application in favor of a divisional application. CPA practice offers the option of filing a

divisional application, while RCE practice does not. Filing a divisional application by using a CPA maximizes Office efficiency because the CPA specification has already been scanned into the Office's records and the formalities review has been completed.

Summary

It is respectfully submitted that CPA practice is not redundant with RCE practice, and that the benefits of CPA practice, especially efficiency of prosecution, compel reconsideration and maintaining CPA practice for all utility applications. However, even if CPA practice is eliminated for most utility patent applications, we respectfully request that CPA practice be maintained for pre-GATT applications. Alternatively, RCE practice should be made available to pre-GATT utility applications.

Consideration of the above comments is respectfully requested.

Respectfully submitted,

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