

From Barry Dove [patents@barrydove.com]  
Sent: Thursday, January 05, 2006 12:41 PM  
To: AB94Comments  
Subject: Comments

Commissioner of Patents,

This is not the solution to the problem. Reducing the number of claims per application and the number of continuations permitted will not reduce the workload of examiners because it will not reduce the number of ideas being generated. People will simply file more patent applications. For example, rather than filing one application with 20 claims, they will simply file two patents with 10 claims each, in parallel. This does not reduce the workload on the patent office, it actually increases the administrative load trying keeping up with more filings. Also, it will increase the administrative workload on everyone by changing the rules.

Limiting the number of continuations is counter to the recent action of the patent office of increasing the number of restriction requirements, which has led to more continuations and divisional applications. If such a required reduction is made on continuations and divisionals, it will be more work for the patent office to review and handle all the requests for continuations. It will not stop the number of ideas that people desire to protect. People will still fight and argue to get all of their ideas protected. This will lead to more petitions and more appeals (same number of ideas being submitted). The only ones to be hurt by this will be the smaller businesses that cannot afford to file as many applications. But most applications are filed by large companies, hence not much reduction in volume and just hurting the little guys more.

Recently, in response to the increase in restriction requirements sent by the patent office, many applicants have opted to simply file patents with limited number of claims and then hold other claims in their back pocket for filing as continuations later (if not killed by the prior found in the parent case). This spreads out the cost of filing over time. Applicants do this rather than paying for extra claims and having to cancel them due to a restriction requirement, which is ultimately paying for the extra claims for no reason. This has led to more continuations.

If the patent office limits the number of continuations, applicants will simply file more patent applications in parallel initially (same number of ideas trying to protect). Hence, this will not reduce the workload on the patent office. It will hurt the small businesses that will have to come up with more money up front to file multiple applications. It won't slow down the large companies from trying to protect all of their ideas (same number of ideas being generated and trying to protect).

The overall result of these proposed rule changes will be:

- (1) Increased administrative processing by patent office (handling more initial filings, handling petitions);
- (2) More disadvantage to the small businesses and entrepreneurs (having to file more patents initially in parallel, rather than waiting to file continuations), which will hurt America's economy by suppressing the small businesses and entrepreneurs (giving big business even more advantages);
- (3) Increasing the cost to applicants for paying attorneys to prepare and file

petitions to get continuations and for appeals to such petitions;

(4) Will result in an increase in the number provisional applications filed, leading to more initial patents filed in parallel rather than using continuation strategies for filing (same number of applications overall, because same number of ideas trying to be protected)

(5) Increased number of patent applications filed with less claims equals the same number of claims that the examiners have to process with more administrative overhead required by patent office to handle them

(6) No reduction in the number of ideas being generated and trying to be protected.

Better solution to reduce number of applications filed:

(1) Patent office should provide a better search engine (faster, more user friendly) making it easier for inventors to perform searches on their own for free on Internet to discover that their idea is not patentable over the prior art before filing the patent application.

Better way to handle the backlog:

(1) Don't change the rules making things more complicated and confusing for patent attorneys and patent examiners (more time trying to figure out and understand the new rules rather than processing cases);

(2) Pay examiners more money so you can attract more smart and more qualified employees. You get what you pay for. Examiners are extremely underpaid.

(3) Hire more examiners (increasing the pay will attract more people wanting to be examiners).

(4) Have examiners located at lower cost-of-living areas remote from DC (such as Dallas, Texas). Dallas has lots of out of work engineers and the housing market is much cheaper than the rest of the country. This will help America's economy, rather than hurt it.

With best regards,

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