EXHIBIT 9

IPBIZ

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WEDNESDAY, JULY 05, 2006

More on USPTO proposed rulemaking on continuing applications

from a board:

At the ABA meeting in Boston [ABA section on IP law, June 22, 2006], Solicitor Whealan made it clear that reducing patent pendency/backlog was NOT the reason behind the proposed "No continuations past one without our permission" rule. Instead, it is being promulgated to prevent applicants from surprising the public with new claims in a continuation several years after the filing date. Commissioner Doll spoke about the rule, but only as a way to reduce pendency/backog. Looking back at the rulemaking package, there are mentions of both rationales, but reducing pendency is what I think everyone thought it was really all about. Comments?

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On a panel with Whealan were Steve Caltrider, Mark Garscia and David Westergard.

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IPBiz notes that in the notice of proposed rulemaking (71 Fed. Reg. at 49), there is a statement:

However, the practice of maintaining continuing applications for the purpose of adding claims after such discoveries is not calculated to advance prosecution before the Office.

The issue that the USPTO raised in the Federal Register was NOT one of "surprising the public" but to stop multiple continuing applications

ABOUT ME

LAWRENCE B. EBERT

I'm a patent lawyer located in central New Jersey. I have a J.D. from the University of Chicago and a Ph.D. from Stanford University, where I studied graphite intercalation compounds at the Center for Materials Research. I worked at Exxon Corporate Research in areas ranging from engine deposits through coal and petroleum to fullerenes. An article that I wrote in The Trademark Reporter, 1994, 84, 379-407 on color trademarks was cited by Supreme Court in Qualitex v. Jacobson, 514 US 159 (1995) and the methodology was adopted in the Capri case in N.D. Ill. An article that I wrote on DNA profiling was cited by the Colorado Supreme Court (Shreck case) and a Florida appellate court (Brim case). I was interviewed by NHK-TV about the Jan-Hendrik Schon affair. I am developing ipABC, an entity that combines rigorous IP analytics with study of business models, to optimize utilization of intellectual property. I can be reached at C8AsF5 at yahoo.com.

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UNLESS necessary for effective examination. The practice of maintaining continuing applications FOR THE PURPOSE OF ADDING CLAIMS was not considered something calculated to advance prosecution.

A legal issue here is whether the USPTO's desired goal of advancing prosecution through effective examination trumps the rights of patent applicants to submit continuing applications in conformity with the statute codified at 35 USC 120. Can the USPTO interpret 35 USC 120 in such a limiting way under Chevron?

POSTED BY LAWRENCE B. EBERT AT 4:46 AM

0 COMMENTS:

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