

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

**From:** Clarke, Robert  
**Sent:** Tuesday, May 02, 2006 4:09 PM  
**To:** AB93Comments; AB94Comments  
**Subject:** FW: Comment on the rule changes

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

**From:** Ali, Jahanara PhD [mailto:AliJ@HSS.EDU]  
**Sent:** Tuesday, May 02, 2006 3:28 PM  
**To:** Clarke, Robert  
**Subject:** Comment on the rule changes

Dear Mr. Clarke,

I am writing to comment on the impact the proposed rule changes will have on universities/hospitals. In summary:

1. USPTO will only review a maximum of 10 claims initially.
  - a. Many of the inventions in the life sciences are quite complex, and therefore often need more than 10 claims to cover fully. The proposed change states that if a university wishes to have more than 10 claims reviewed initially, a patentability report must be submitted. This would be an additional expense that a university would have to bear. Furthermore, it puts the onus of doing a proper search on the university, rather than on the patent office.
2. Only *one* Continuing Application (Continuation, Divisional, CIP or RCE) filing is permitted (except under certain situations)
  - a. This will limit the ability of a university to get patents on new matter. It would be the university's obligation to think of all the ways a particular invention can be used upfront (not always feasible).
  - b. This can potentially decrease the value of technology (patents) that university licenses to companies, especially in cases where there is new matter that was not addressed in the one allowed continuation.

I hope the patent office will reconsider making the two changes highlighted above, as they are likely to have a negative impact on the universities ability to successfully protect and license inventions.

Regards,  
Jahan

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