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From: Fred Gibb [mailto:Gibb@GibbIPLaw.com]

Sent: Tuesday, May 02, 2006 1:08 PM

To: AB94Comments

Subject: Comments on Rule 75

Attached find my comments on the proposed rule changes to Rule 78 that appeared in 78 Fed. Reg. 61, on January 3, 2006, Docket 2005-P-067. The attached is in Word format. I have also repeated the same text at the end of this e-mail; however, the formatting of the Word document should be easier to work with. Please let me know if you would like it in a different format.

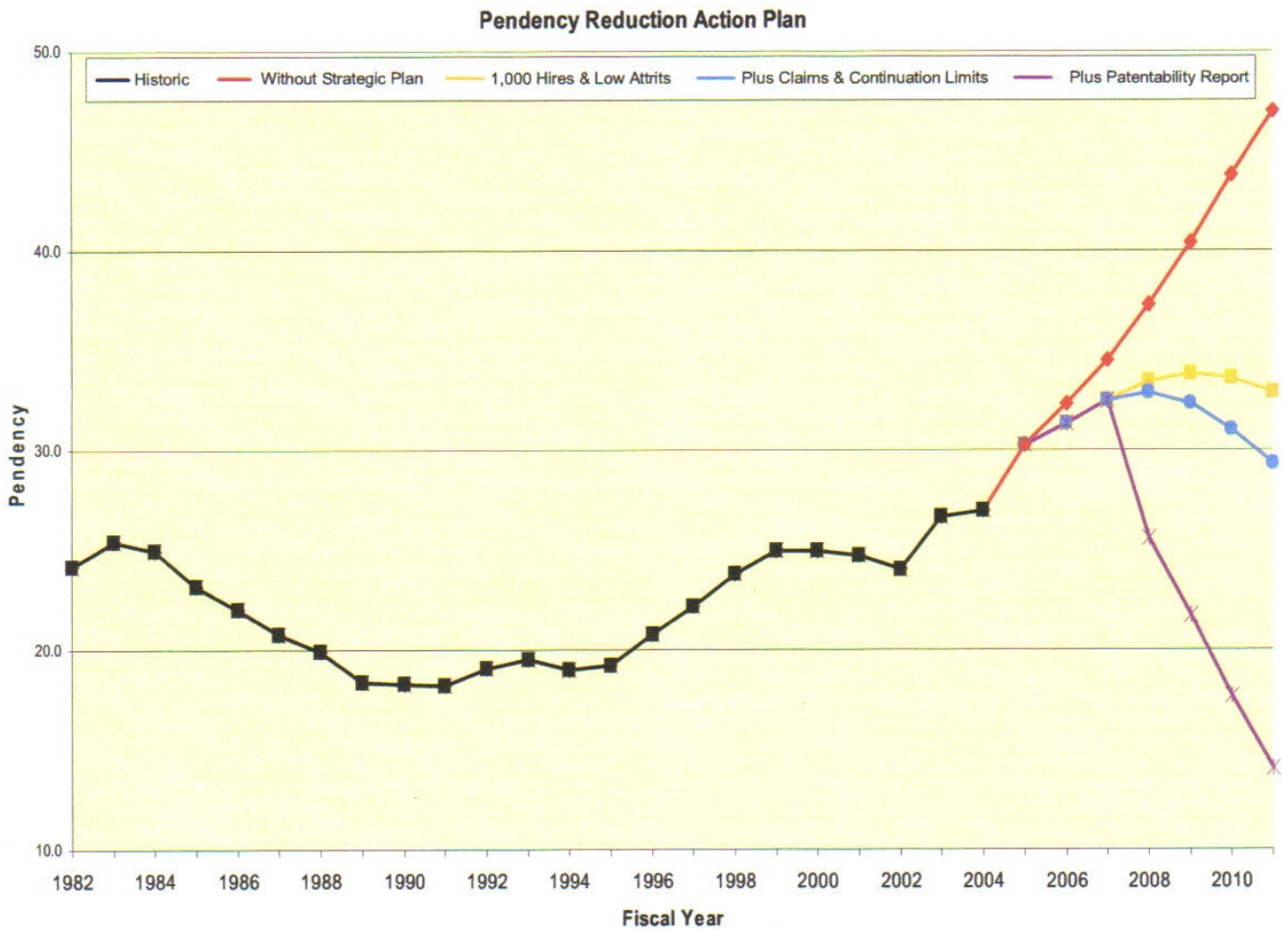
Thank you.

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Comments on Proposed Rule 75

While I generally applaud the Office's continuing efforts to increase quality and decrease pendency through efforts such as these proposed rules, I am in disagreement with some aspects of these proposals. Overall, my biggest fear is that many of these proposed rules will have little practical effect on pendency and will actually decrease patent quality.

From the Office's own estimates, hiring 1000 examiners per year will produce, by far, the greatest impact on pendency and the hiring alone will, in a few years, reverse the trend of increased pendency. As shown in the Office's chart below, the estimated pendency problem does not need any solution other than increased hiring and retention and the proposed rules only aid in the trend established by the hiring.



The impact on pendency of most of the proposed rules will be slight at most and the proposed rules do not concretely address quality. Instead, much greater gains in quality can only be had through changes made to practices that affect the examiners themselves, not by placing burdensome requirements on the applicants. Some of the

most important areas that can be addressed to increase the quality of examination include revising the collective bargaining agreement with the examiners to provide a variable point system depending upon the number of claims examined, the complexity of the application, etc. Further, increases in training (such as training changes being currently implemented by the Office), increases in salaries and benefits for the examiners, and revisions to working conditions for the examiners will increase retention and allow a greater number of more seasoned examiners to make higher quality examinations, resulting in an overall increase in patent quality. In addition, requiring the examiners to conduct a telephone interview to generally discuss the claims and learn about the application from the applicant or his representative before examination has also been proposed as an alternative to help increase quality and decrease pendency.

With respect to the proposal of limiting the number of claims that will be examined (Rule 75 (b-c)), the proposed rule initially appears to provide an opportunity to increase Office production by taking less time to examine each application. However, because the agreement currently in force with the examiners allots a specific amount of time for examination of each application, it is unclear what the examiners will actually do with the additional time this proposal may produce. It is not certain that production will actually increase and that pendency will be reduced. All that is certain is that less claimed features will be examined. Thus, I oppose this rule unless it can be combined with some changes to the agreement with the examiners to ensure that the time savings will be used to increase office action production and thereby decrease pendency.

I further oppose limiting the number of claims that will be examined because such action will decrease the number of first office action allowances and thereby potentially increase the number of final office actions and continuations. Often a first office action will reject all independent claims, but allow some of the more narrow dependent claims. Many applicants then rewrite the allowed dependent claims into independent form or incorporate the limitations into the rejected independent claims allowing the applications to be disposed of without another substantive action. When the number of dependent claims that are examined is limited, less dependent claims will be allowable and more final rejections and continuations will ensue, which will increase, not decrease, pendency.

With respect to the Examination Support Document and the statements of relevance for excessive IDS prior art references, while currently proposed to be used in limited situations, if applied generally would damage the "quality" of all issued patents by creating substantial prosecution history estoppel. A true high quality patent is one that is not only examined thoroughly in light of a good prior art search so that it can stand the later scrutiny of post-issuance litigation, but is also one that has market value. Therefore, the claims need to be as broad as the prior art will allow for quality to truly exist. As has been consistently held by the Federal Circuit, statements made during prosecution of a patent application narrow the claims. This estoppel can narrow the claims in a way that may not have been intended by the applicant or the examiner and that was not necessary in light of the most applicable prior art. Thus, the proposed Examination Support Document may cause the practitioner to unintentionally and unnecessarily narrow the claims through the effect of prosecution history estoppel, thereby decreasing the commercial value of the patent and decreasing the patents "quality." Further, because the effect of such statements made in the Examination Support Document may not be known

until subsequent future litigation, such statements tend to decrease the certainty of the patent, which also decreases the "quality" of the patent.

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