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From: Grant Green [mailto:gdgreen@sbcglobal.net]

Sent: Friday, April 28, 2006 11:03 PM

To: AB94Comments

Subject: Comments regarding proposed claim examination practice

Dear Mr. Clarke,

I am writing as an individual practitioner (reg. no. 31,259), mainly for lack of time to have my comments considered by other members of my department. For that reason, my comments should not be construed as having been made on behalf of my employer.

As with the proposed changes to continuation practice, I believe that attempts to reduce USPTO workload and application pendency by adding more requirements is counterproductive.

The stated purpose of this proposal is to increase efficiency (by not searching or examining dependent claims, whose patentability will mainly depend upon independent claims), and to assist with examination of large cases by providing an examination support document (ESD) in cases having more than 10 independent claims or designated claims.

As an initial reaction, I believe that deferring examination of the dependent claims will actually extend prosecution and increase pendency. In my experience, a thorough search of all claims often reveals that several dependent claims are free of the prior art, even though the independent claims from which they depend are not. It is then often a simple matter of amending the independent claims along the direction of the allowable dependent claims, and canceling unpatentable subject matter. If only the independent claims are searched, this guidance would be lost. A likely response would be to amend the independent claims to incorporate the limitations of one or more dependent claims, which would then necessitate another search. If the applicants had not picked dependent claims that were free of the art,

this would result in additional rejections, and necessitate additional amendments. Given that the Office concurrently proposes to severely limit continuation and RCE practice, this unguided flailing around would likely result in the loss of rights in numerous cases.

I believe that complex applications will continue to be complex, regardless of whether they contain more than 10 or less than 10 independent claims. Thus, there is likely to be little or no benefit to the proposed rules. On the other hand, additional tasks are laid on the Office – that of determining whether or not an ESD should be required, and whether or not an ESD is sufficient. Arguments and petitions over such decisions can only extend application pendency.

The one month deadline, with no possibility of extension (§1.75(b)(3), 1.261(c)), is unduly harsh. I see no rationale for treating the absence of an ESD any differently from other filing informalities, such as unsigned declarations.

It is unclear what purpose for proposed §1.75(d) is intended. Is "patentably indistinct" intended to apply statutory "same invention" type double patenting, or "obviousness-type" double patenting principles, or something different? Both forms of double patenting are already fully addressed by the rejections available in each case. To the extent that these "patentably indistinct" claims cover the same or overlapping subject matter, the examiner will surely be aware that all art and rejections applied against one set of claims are likely to be equally applicable against the other sets of claims. Thus, this situation should not unduly burden the examiner or the Office. However, applying §1.75(d) in the case where "patentably indistinct" claims are not eliminated then requires the examiner to determine whether or not an ESD is required, and then to issue notices in each affected application – each giving the applicant only one non-extendable month to respond. This, again, diverts prosecution into a battle over form and formalities, rather than substance. Applicants are

already required to bring all such applications to the examiner's attention: if all such applications are assigned to the same examiner for prosecution, this would minimize any burden on the examiner and the Office for the reasons set forth above.

Given the small number of applications that would be affected (1.2% is cited by the Office), these provisions are likely to operate only as a trap for the unwary and the pro se applicant.

Thank you for your consideration.

Respectfully submitted,

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31,259

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