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From: BILL LYDDANE [mailto:BLYDDANE@gbpatent.com]

Sent: Wednesday, May 03, 2006 6:37 PM

To: AB94Comments

Cc: BILL LYDDANE

Subject: Comments on Proposed Rule Changes

Greetings:

Attached are our comments on the proposed rule changes set forth in 71 Fed. Reg 61.

Sincerely,
William E. Lyddane
Greenblum & Bernstein, P.L.C.

The Honorable Jon Dudas
Under Secretary of Commerce for Intellectual Property
And Director of the U. S. Patent and Trademark Office
Mail Stop Comments
P.O. Box 1450
Alexandria, Virginia 22313-1450

May 1, 2006

Attention: Robert W. Bahr
Senior Patent Attorney
Office of the Deputy Commissioner
For Patent Examination Policy

Comments on Proposed Rules: "Changes to Practice for the Examination of Claims in Patent Applications" 71 Fed. Reg. 61 (January 3, 2006)

Dear Under Secretary Dudas:

Greenblum & Bernstein, P.L.C., the undersigned, is a law firm located in Reston, Virginia, that specializes in all aspects of intellectual property law. The firm currently employs over 35 registered attorneys and agents that engage in prosecuting and litigating in various areas of intellectual property. The firm also files well over 1000 new applications for patents each year. Thus, the firm has an avid interest in the proposed rule changes set forth in 71 Fed. Reg. 61 (January 3, 2006).

Initially, the undersigned acknowledge that the backlog of pending applications at the PTO is reaching overwhelming proportions and recognize that steps must be taken to reduce that backlog. However, it is our view that the rule changes proposed by the U.S. PTO in 71 Fed. Reg.61 (January 3, 2006) would not appear to have any significant effect on reducing the backlog, and instead, raises significant issues that will likely adversely impact on patent Applicants and increase, rather than reduce, the amount of work to be performed by the U. S. Patent and Trademark Office. The undersigned has undertaken a careful review of the proposed rule changes as set forth in 71 Fed. Reg. 61 (January 3, 2006), and

initially prepared a complete set of comments in response thereto. However, upon review of the comprehensive and eloquent comments submitted by the AIPLA on April 24, 2006, it was determined that in order to avoid redundancy and to reduce the workload of the staff at the U. S. Patent and Trademark Office that will review the comments, rather than submit our complete set of comments, it will be sufficient that we state that we generally agree with the comments submitted by the AIPLA, and support their position that the proposed rule changes should not be adopted for all the reasons stated therein.

In addition to the comments of the AIPLA, we add the following additional comments for emphasis.

Designation of Claims

It would appear that the proposed new practice of designating no more than 10 claims will itself consume a considerable amount of resources of both the PTO and the Applicants, resources which could instead be applied to making better patentability determinations. This proposal will create an entirely new layer of bureaucracy causing both Applicants and the PTO to waste valuable resources in implementing the necessary changes. The implementation costs alone of such a system, to both the Applicant and the U. S. Patent and Trademark Office, which will apparently require claim designations in the nearly 1 million backlog of pending applications that have not yet received an office action (if the rule is made retroactive), are daunting. Furthermore, it would appear that the PTO would also be required to return extra claim fees for such cases (already collected, and spent) which would immediately impact the financial resources of the PTO.

Regarding §1.75(b)(3)

The PTO has proposed to amend 37 C.F.R. § 1.75(b) to include subparagraph (3), paragraph (iii), which applies where an Applicant has been notified that an application contains or has been amended to contain more than 10

independent claims or the total number of designated claims is greater than 10.

Paragraph (iii) states that an Applicant must:

Submit a suggested requirement for restriction accompanied by an election without traverse of an invention to which there are drawn **no more than ten independent claims** as well as **no more than ten total independent claims and dependent claims designated** for initial examination [emphasis added].

However, the PTO's comments on this proposed amendment to the rules at 71 Fed.

Reg. 64 states that an Applicant must:

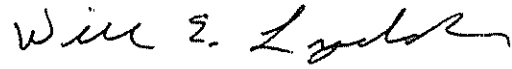
Submit a suggested requirement for restriction accompanied by an election without traverse of an invention to which there are drawn **fewer than ten independent claims and fewer than the residual number of designated claims** [emphasis added].

Thus, there are inconsistencies between the rule, which permits an election of an invention drawn to at least ten independent or total claims designated, and the comments, which indicate that the election must be to an invention drawn to fewer than ten independent or total claims. Should the proposed rules go into effect, the PTO should correct this inconsistency.

Furthermore, it is not clear why paragraph (iii) of 37 C.F.R. § 1.75(b)(3) permits submission of a suggested requirement for restriction, accompanied by an election without traverse, of an invention to which there are drawn fewer than ten independent claims and fewer than the residual number of designated claims when an examination support document is inadvertently omitted. How would an examination support document be inadvertently omitted, and how could the PTO tell when an omission of an examination support document is inadvertent or when it is a purposeful omission? Moreover, it seems incongruous to permit such a voluntary election only in the case of an inadvertent failure to file an examination support document, and not permit such a voluntary election under other circumstances.

The undersigned appreciates the opportunity to submit the above comments, and would be pleased to work with officials at the U. S. Patent and Trademark Office to help achieve the goals of reducing the backlog and reducing pendency of applications undergoing the examination process.

Sincerely,

A handwritten signature in black ink, appearing to read "William E. Lyddane". The signature is written in a cursive style with a large, sweeping initial "W".

William E. Lyddane, for

the law firm of Greenblum & Bernstein, P.L.C.