-----Original Message-----
From: Mark Harrington [mailto:mharrington@hspatent.com]
Sent: Thursday, January 05, 2006 5:29 PM
To: AB94Comments
Subject: Changes to Practice for the Examination of Claims in Patent Applications

Dear Sirs:

This is in response to the Notice of proposed rule making dated January 3, 2006 "Changes to Practice for the Examination of Claims in Patent Applications". This proposed rule, in combination with the proposed rule for "Changes To Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims" is horrible. The USPTO's duty is to examine all the claims of a patent application; not just representative claims. This proposed rule appears to have been suggested by a bureaucratic paper pusher rather than someone familiar with the give and take exchange between the examiner and an applicant.

What are you going to do, limit the review of claims by the CAFC and BPAI to not include all of the claims. Since when does the USPTO make rules for the Federal Courts? The CAFC will just return the application to the USPTO to complete examination of all the claims. Are you going to limit issues on appeal to the BPAI to only representative claims? How can an appeal then be taken to the CAFC on non-representative claims? Do you have authorization from Congress to limit the scope of appeal which the CAFC can hear?

The USPTO collects a fee for all claims filed in a patent application. This fee is for examination of the claims. Failure to examine claims for which a fee has been paid amounts to an illegal act. Are you proposing to charge claim fees for only representative claims and not charge for non-representative claims?

This proposed rule, in combination with the proposed rule for limiting filing of continuations, is ridiculous. If you attempt to implement this proposed rule we will go to Congress to have it changed.

Why doesn't the USPTO just hire people to do its job rather than trying to find ways to avoid doing work?

Mark F. Harrington
Harrington & Smith, LLP
4 Research Drive
Shelton, CT 06484-6212

USA
Telephone: 203-925-9400
Facsimile: 203-944-0245
Email: MHarrington@HSpatent.com
www.hspatent.com

-----Original Message-----
From: Mark Harrington [mailto:mharrington@hspatent.com]
Sent: Friday, January 06, 2006 1:14 PM
To: AB94Comments
Subject: Changes to Practice for the Examination of Claims in Patent Applications

Dear Sirs:

This is in response to the Notice of proposed rule making dated January 3, 2006 "Changes to Practice for the Examination of Claims in Patent Applications".

How will the rule affect examination of claims in a national stage application based upon a PCT International Application? If not all of the claims are examined, will this violate the PCT treaty? If all the claims are examined during the International Phase, shouldn't the USPTO examine all of the claims in the National Phase (the search has already been done)? If so, what is to prevent an applicant from having all claims examined by merely entering the U.S. through a first filed PCT application; thereby avoiding the "representative" claim limitation?

Currently, U.S. law provides a presumption of validity to the claims of an issued patent. Is the USPTO proposing that the Federal Courts or Congress change this presumption of validity to only apply to the examined "representative" claims, and change U.S. law such that there is no presumption of validity for non-examined claims?

Mark F. Harrington
Harrington & Smith, LLP
4 Research Drive
Shelton, CT 06484-6212
USA
Telephone: 203-925-9400
Facsimile: 203-944-0245
Email: MHarrington@HSpatent.com
www.hspatent.com