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To: AB94Comments

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Subject: Comments on Changes to Practice for the Examination of Claims in Patent Applications

The undersigned hereby comments on the notice of proposed rulemaking entitled Changes to Practice for the Examination of Claims in Patent Applications, 71 Fed.Reg. 61 et seq. The undersigned is a partner in the Fish & Neave IP Group of the law firm of Ropes & Gray LLP. However, these comments are those of the undersigned alone and do not necessarily reflect the views of Ropes & Gray LLP.

The proposed rules limit the number of claims that will be examined in an application to ten claims, unless an "examination support document" is filed. In public statements subsequent to publication of the notice of proposed rulemaking, the opposition of the patent bar and the applicant community in general to being forced to take positions on claims prior to examination have been clear. Accordingly, the undersigned will not repeat in these comments the many well-publicized reasons that the applicant community is opposed to the proposed rules. However, the undersigned agrees with those reasons.

Congress has provided (35 USC 41) that an applicant is entitled to twenty claims in an application without paying further fees. Accordingly, if there is to be a limit to the number of claims examined, that limit should be twenty, not ten. The Office would no doubt say that it will be examining all twenty claims, and more, once the patentability of the initial ten claims is established. That is not a real examination, insofar as, except for Section 112 issues, no real examination of dependent claims would take place once the corresponding independent claim is determined to be patentable.

This will disadvantage both applicants and the Office. Under current practice, in which all dependent claims are examined, an examiner may suggest that the limitations of a certain dependent claim are patentable even where the independent claim is not deemed patentable. While admittedly in many cases, the applicant in such a situation will continue to fight for the unamended independent claim, in many other cases, the proffered dependent claim is considered good enough by applicant, and the limitations of that allowable claim are added to the independent claim, disposing of the application. The opportunity for such situations will be reduced if not all dependent claims are examined and the claim that the examiner would have approved is not among the designated claims. This will therefore increase, rather than decrease, pendency in many cases.

Under proposed section 1.75(b)(1)(i), an examination support document would be required if an application that did not initially require one were amended to contain more than 10 independent claims. Although the proposal calls for only 10 total claims to be examined, it is possible that in acting on the ten designated claims, the Examiner may make a suggestion that involves rewriting more than one dependent claim in independent form, and the suggestion may apply to claims beyond the ten designated claims (e.g., after examination of the initial ten claims is concluded). If these rules are enacted, an examination support document should not be required where an amendment that increases the number of independent claims above ten results from compliance with an Examiner suggestion regarding patentability of dependent claims.

Proposed section 1.75(b)(4) is troubling. The undersigned understands the Office's desire to prevent "end runs" around the ten-claim limit by use of multiple applications. But the Office's record in dealing with distinctness of different groups of claims has not been stellar (e.g., in restriction and election-of-species practice). If these rules are enacted, the Office would have to undertake better training of Examiners in that area before applicants could be sure this provision

is fairly administered. Frequently, when an invention involves a large system, the most efficient way to write applications on the various aspects of the system is to write one large specification which is filed as several applications with different claim sets. Such applications are of course commonly owned and by definition all support all the different claim sets. Unless better training is provided, one can envision an Examiner unfairly applying the ten-claim limit across those multiple applications, even though the situation described clearly is not the one at which the rule is aimed.

Respectfully submitted,

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