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Sent: Wednesday, May 03, 2006 5:37 PM

To: AB94Comments

Cc: CURTIS CASTLEMAN - LEGAL; Jeffrey Thurnau; PAUL DUNLAP

Subject: Comments concerning proposed changes to claim examination procedures

Please find comments concerning the proposed changes to claim examination procedures attached.

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May 3, 2006

The Honorable Jon Dudas,  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office

Robert W. Bahr,  
Senior Patent Attorney  
Office of the Deputy Commissioner for Patent Examination Policy

RE: Comments on proposed: "Changes to Practice for the Examination of Claims in Patent Applications" (January 3, 2006)

Dear Under Secretary Dudas and Mr. Bahr,

In December of 2004 the PTO significantly increased claim fees in an effort to control the number of claims filed in applications and to more accurately compensate the USPTO for the work carried out in searching and examining claims. Now, the proposed changes that would require a designation of claims to be examined would deny applicants of the benefits purportedly proffered by the increased claim fees.

Regardless, the proposed rule changes ignore the realities of patent prosecution. Rulings by the Court of Appeals for the Federal Circuit (CAFC) and the US Supreme Court in patent matters have lead practitioners to adopt the practices they now employ. The proposed rule changes are at odds with many of these practices. For example, the requirement that an Examination Support Document (ESD) be filed to obtain examination of more than 10 claims would call on a practitioner to create an inordinate amount of file wrapper estoppel due to the very nature of the ESD itself.

Some inventions, by their nature, require more than ten representative claims to address their complexity, aspects, and/or facets. Therefore, an arbitrary limit on the number of claims an inventor of such an invention may have examined without creating undesirable file wrapper estoppel is unfair, particularly in light of prior practice which has enabled Applicants who required large numbers of claims to guarantee those claims would be examined by merely paying the requisite fees.

A further reality of patent practice is that Examiners often indicate a particular dependent claim that contains allowable subject matter. This analysis is quite valuable to the patent prosecutor in that he can make a determination of how the claims may be amended to incorporate such allowable elements, if such an amendment suits the needs of the client. By limiting the number of claims reviewed by the Examiner, this tool, used by both practitioners and Examiners, would be blunted. Some would argue that reliance on such procedure by a practitioner is somehow "lazy" or allows a practitioner the luxury of not fully exploring the invention prior to filing an application. However, this practice often provides a tool greater than merely indicating what dependent claim the practitioner should close-up into its independent claim, with the elements of any intervening claims.

This practice can aid the practitioner in not only identifying single elements that may be woven into the fabric of an independent claim, resulting in an allowable independent claim of reasonable scope, but also may give the practitioner an idea of the Examiner's perception of the invention. This might lead to a more productive dialog, with or without amendment. Sadly, under the proposed rule all these potential benefits will be lost if the subject element falls in the "eleventh" claim.

Turning to the rules related to Markush claims, the Manual of Patent Examining Procedure (MPEP) has never required that individual elements in a Markush groupings be treated separately. In short, the elements have always been treated as equivalent and once a reference teaching one element is applied all the other elements have fallen. Therefore, a one-sided approach of requiring an applicant to use-up his claim designations on the individual elements of a Markush group, while allowing the Office to depose of the claim by only attacking one of the Markush elements seems intrinsically unfair and capricious.

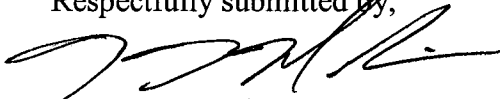
Arguably, the retroactive nature of the proposed rules amounts to a federal taking. The Applicants with pending claims have paid, relatively recently elevated claim fees, under the current rules, to have their claims examined. To arbitrarily implement an *ex post facto* rule change to limit the number of claims that will receive a substantive search and examination (particularly independent claims) will amount to a federal taking of services purchased.

These proposed rule changes call for limiting the number of claims to be examined, and thereby the number of claims a diligent patent practitioner will include in an application (to avoid placing undesirable estoppel on the record). In contrast, the companion proposed rule changes on "Proposed Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims" would seem to require an Applicant to claim all he can as early as he can and avoid the use of continuation applications. These two requirements are at odds, and especially at odds with the stated goal of reducing the USPTO's backlog. It would seem that the prudent practitioner will file multiple concurrent applications with small number of claims to avoid these rules (and contend with the proposed new rules directed to a presumption of indistinctiveness by reciting different claim limitations by rote or by filing a terminal disclaimer ), thereby increasing the USPTO's backlog.

For at least the foregoing reasons, the Office is respectfully urged to not adopt the proposed "Changes to Practice for the Examination of Claims in Patent Applications."

The views expressed above are not necessarily those of the below signed practitioners' employer, the Gates Corporation and its parent company Tomkins plc.

Respectfully submitted by,



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