Silverberg, Fred

From: Metzger, David R.
Sent: Wednesday, May 03, 2006 2:19 PM
To: 'Robert.Clarke@uspto.gov'
Subject: Comments on Proposed Changes to Practice for the Examination of Claims in Patent Applications, Notice of proposed rule making

Dear Mr. Clark:

Please find attached my comments regarding the Proposed Changes to Practice for the Examination of Claims in Patent Applications.

Regards,

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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
Mail Stop Comments
P.O. Box 1450 Alexandria, VA 22313-1450

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

Re: Comments on the Proposed changes to Practice for the Examination of Claims in Patent Applications, 71 Fed. Reg. 61 (3 Jan 2006)

Dear Under Secretary Dudas:

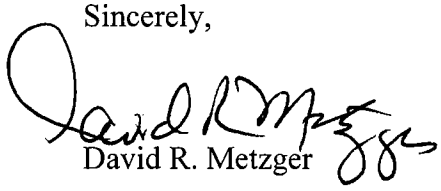
This is to express my full support and adoption of the testimony and comments submitted by the American Intellectual Property Law Association (AIPLA) and Mr. Robert Vanderhye in opposition to the above-identified proposed rule-making. I incorporate herein by reference the AIPLA's and Mr. Vanderhye's comments.

I also note that claims are tricky because of the inherent ambiguities in the English language. The English language has long incorporated words from many languages, often with different words having similar but slightly different meanings. Indeed, a given word often can be interpreted differently by different persons. Accordingly, we have long used multiple claim drafting as a way to deal with the possibility of such different interpretations much later in the life of a patent, usually much later that the 2 year window within which a so-called "broadened" reissue can be filed.

The proposed rule penalizes multiple claiming and will introduce unnecessary and wasteful machinations in order to both limit claims and deal with the peculiarities of the English language. In the end, for the reasons noted by the other commentators, it will not help the USPTO reduce its backlog problem.

For the reasons expressed by the commentators, and the AIPLA's and Mr. Vanderhye's reasons in particular, I submit that the proposed rules not be adopted, but that the USPTO first deal with it internal workforce and funding issues. Patent applicants can ride out a few years of backlog in order to retain our very good system that is highly effective at protecting innovators and their innovations.

Sincerely,



David R. Metzger