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Sent: Wednesday, January 04, 2006 11:26 PM  
To: AB94Comments  
Subject: proposed rule changes re: 10-claim examination limit w/o ESD

The proposed rule changes appear to be an effective way for applicants to expend a relatively small amount of energy to save the PTO a large amount of energy, yielding faster prosecution that pleases all. Note that various foreign Offices implement a variant of § 1.261 (6) (infra) by requiring reference numbers in the claims, which are allowed but not required by MPEP 609.01(m). Reference numbers in the claims guide the Examiner to quickly find the elements or equations referred to.

A primal mindset of Practitioners is that "whatever you say may be used against you." Rules containing the words "detailed" and "particularity" induce this fear. Practitioners may abbreviate their detail to the maximally-tolerated degree for fear of having their words used in some hostile interpretation in a courtroom. MPEP 609.01(m) gives a degree of protection against this fear in its last sentence: "The use of reference characters is to be considered as having no effect on the scope of the claims," allowing a Practitioner to aid an Examiner in navigating the disclosure and drawings without a concern of hostile interpretation.

§ 1.261 contains no limitations on the use of the Practitioner's candor by potential infringers. I presume the ESD would publish on the usual schedule along with the rest of the file wrapper. I would expect that the Office would receive more candid and thorough Examination support documents if Practitioners had assurances that, for instance and in varying degrees:

1. Like an IDS, nothing in an ESD is assumed to be an admission of prior art.
2. Like MPEP 608.01(m), absent a 'clear and unambiguous' definition of a claim term, nothing in an ESD would be considered as affecting the scope of the claims. (This is a double-edged sword; if the ESD is filed with the original application, it could not be relied upon to support a claim.)
3. Most extremely, the ESD is not published with the rest of the file wrapper, and Examiners make no reference to it in correspondence, although they would certainly use the ESD in guiding their work.

I believe the spirit of the Rules change would be more closely followed if the primal fears of Practitioners were addressed in the above, or some similar, manner.

MPEP 609.01(m): "Reference characters corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. The reference characters, however, should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. The use of reference characters is to be considered as having no effect on the scope of the claims."

§ 1.261 Examination support document.

- (4) A detailed explanation of how each of the independent claims and designated dependent claims are patentable over the references cited with the particularity required by § 1.111(b) and (c);
- (5) A concise statement of the utility of the invention as defined in each of the independent claims; and
- (6) A showing of where each limitation of the independent claims and the designated dependent claims finds support under the first paragraph of 35 U.S.C. 112 in the written description of the specification. If the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the independent claims and the designated dependent claims finds support under the first paragraph of 35 U.S.C. 112 in each such application in which such support exists.

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