

-----Original Message-----

From: Wright, Lee [mailto:LWright@whdapatentlaw.com]

Sent: Wednesday, May 03, 2006 11:44 PM

To: AB94Comments

Subject:

Please consider the following comments.

Lee Wright

41,441

VIA EMAIL: AB94Comments@USPTO.gov

May 3, 2006

Attn: Robert A. Clarke

Comments on Proposed Rules: "Changes to Practice for the Examination of Claims in Patent Applications" 71 Fed. Reg. 61 (January 3, 2006)

I do not believe that the ten representative claims proposal will lead to examiner efficiency. Under the proposed rules, an applicant may present four sets of claims. An applicant may change the representative set of claims to include pending claims that were not in the original representative claims. Under the current system, those claims would have been searched. Under the new system, the new representative claims may require a new search because the Examiner did not consider the elements of the non-representative claims. It is possible that an examiner may have to do four searches under the proposed rules.

The rule that for a dependent claim to be representative claim, all the claims from which it depends must be designated as representative claims is based on a distinction that is without merit. Any dependent claim dependent on an intervening dependent claim may be easily written so as to not depend on an intervening dependent claim. Thus, any good practitioner could render such a rule meaningless. However, ease of claim drafting and clarity may be lost by the proposed rule.

The USPTO is proposing to limit initial examination to ten representative claims. Currently all claims are supposed to be examined. However, it is clear that some examiners do not examine the dependent claims, but only examine the independent claims. As a trade off for examination of less claims, I propose that the USPTO guarantee that the ten representative claims be examined and that the examiners present a patentability determination on each of the representative claims. This may be done by amending 1.104.

The one month period to respond to a notice under 1.75(b)(3) is too short a period to conduct a search and do the patentability analysis.

Page 64 of the Fed. Reg. states that one month extensions of time are available under 1.136(b) for responding after a notice by the USPTO. However, the proposed rules do not positively so state. Contrast 1.550(c).

1.142 should be amended to indicate that a restriction requirement must be made on all the pending claims, not the representative claims and that applicant has the right to change the representative claims following a restriction requirement.

Thank you for your consideration.

Respectfully submitted,

Lee Wright

41,441