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From: JudyLippincott@aol.com [mailto:JudyLippincott@aol.com]

Sent: Friday, March 17, 2006 4:32 PM

To: Clarke, Robert

Subject: Berkeley Town Meeting of February 28, 2006

Comments on USPTO Berkeley Town Meeting of February 28, 2006
Proposed Rule Changes for Patent Claims and Continuation Practice

I appreciate the opportunity to have attended this meeting and the invitation to submit comments regarding my opinion of the proposed changes to intellectual property law.

I agree with the requirement of the applicant to indicate the representative claims desired to receive initial examination, however, I think more than ten should be allowed before this designation by the applicant is required. Perhaps it only affects slightly more than 1 percent of applicants, but those applicants who objected to this rule are in highly technical fields and would be significantly impacted by this rule.

A significant number of people, myself included, objected to the “get it right the first time” mentality regarding limiting the subsequent number of Office Actions after initial examination. In my experience, the patent examination process is very subjective from examiner to examiner, so the applicant cannot know the examiner’s opinion of the application until the first Office Action is received and must rely on having the opportunity to respond to a First Office Action to clarify any underlying, basic confusion or elaborate on questioned details.

What I think is seriously lacking in the application examination process, and likely contributes to most of the backlog, is the absence of any requirements that the applicant set forth for examination the merits of the invention and the viability of the invention as a product in the marketplace, which is what the whole process is about, solving problems and commercializing the solution. I, therefore, agree with the requirement to submit an Examination Support Document. Prior art begins to address this concept, but the parameters need to be clearly defined and complied with to put the invention in perspective. Is there a demand or need for the invention (a problem)? Is it possible (the perpetual motion machine)? Are needed materials and technology available? What is the history of the technology (current or obsolete)? What products are actually in the marketplace to solve the problem and are they successful? It is of the utmost importance that we not discourage creativity and invention, but at some point we have to ask ourselves if we are creating and inventing or backlogging the system???

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