-----Original Message-----
From: Clarke, Robert
Sent: Thursday, April 27, 2006 1:57 PM
To: AB93Comments; AB94Comments
Subject: FW: Comments on proposed rule changes relating to Claims Practice AND Continuation Practice

-----Original Message-----
From: Patrea Pabst [mailto:Patrea@pabstpatent.com]
Sent: Thursday, April 27, 2006 11:31 AM
To: Clarke, Robert
Subject: Comments on proposed rule changes relating to Claims Practice AND Continuation Practice

1. Claims Practice

Federal Register - 71 *Fed. Reg.* 61 (03 January 2006)

Official Gazette

Topics:	**Changes to Practice for the Examination of Claims in Patent Applications, Notice of proposed rule making (03Jan2006) [PDF]**

2. Continuation Practice

Federal Register - 71 *Fed. Reg.* 48 (03 January 2006)

Official Gazette

Topics:	**Proposed Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims, Notice of proposed rulemaking (03Jan2006) [PDF]**

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April 27, 2006

Att: Robert A. Clarke
On behalf of the Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

Re: Proposed Rules relating to 37 C.F.R. 1,
Changes to Practice for the Examination of Claims in Patent Applications, RIN 0651-P-067
Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims, RIN 0651-AB93

Dear Sirs:

I have been practicing in the patent field since 1983, primarily on behalf of universities, start-ups, small companies, and independent inventors, with respect to biotechnology, medical, pharmaceutical and chemical technologies, for the most part invented and developed within the United States. My practice was initially with a small IP law firm, then with large general practice lawfirms, and now again with a small IP law firm.

It is my opinion that the Patent Office, in an effort to deal with the impossible financial limitations imposed upon it by Congress, and the incredibly high turnover in examiners, is unfairly penalizing applicants with these proposed rules. We are not the enemy, but it appears we are to be the scapegoats. No other patent office that I have dealt with penalizes applicants in this manner.

I. Examination of Claims

Currently, we believe that it should be possible in most cases to define an invention in twenty to thirty claims. This would be even easier if we could define subject matter under U.S. practice the same way we can outside of the United States – using multiple dependent claims, and claims such as "A method

of using the composition of any of claims 1-19 for ..." treated as one claim; not an additional 19; and where restrictions are made based on the concept of unity of invention, not the arbitrary and bizarre practice currently in use in the US, where the invention is defined differently by each examiner who picks up the same case. This will be even more problematic in the case of Markush claims, which are now used to minimize the number of claims and to facilitate prosecution, if each member is to be treated as a separate claim, rather than a representative embodiment elected, as is the current practice. The constant turnover in examiners is a major factor in both claims practice and continuation practice, since each time this occurs, one must reeducate the examiner and make amendments to accommodate differences in style. Of course, the frequent policy changes in the biotechnology field, and what phrases are currently in favor, also affects how often the claims must be amended.

Under current US law, each claim is to be examined separately for patentability, validity and infringement. If we must now explain to the Patent Office that only our independent claims should be examined, then how will the courts enforce our dependent claims, should those independent claims be invalidated?

In the biotechnology and medical fields, it is mandatory that applicants file as soon as possible, particularly those who are operating within a university environment and must publish their results. Further studies are invariably conducted which are determinative of which embodiments are of greatest importance and likely to be commercialized. These applicants will be greatly penalized if they are required to designate at the time of initial examination only those claims to subject matter known to be of greatest importance, even though other embodiments, subsequently determined to be of more value, are equally disclosed and defined by dependent claims.

II. Continuation Practice

Many of the same comments apply to the continuation practice. We file very few continuations, believing it is better to go on appeal if the examiner is maintaining an improper rejection. However, particularly in the biotechnology and medical fields, it is sometimes necessary to provide additional evidence to demonstrate efficacy or for comparative purposes, and these tests are not only very expensive, it takes a long time to get the results. These rules greatly prejudice the applicants in these fields of technology and may prevent patent protection from being obtained on important drugs and medical treatments.

We also agree with others who have submitted comments that multiple amendments are not made either because we do not think they are required and wish to exhaust our arguments before giving up what may be important claim scope, or do not want to create file wrapper estoppel, which the courts have so recently broadened in ways that eviscerate the scope of the patent claims. These rules focus solely on the convenience of the examiners, not on the needs of the public to have enforceable, useful patents.

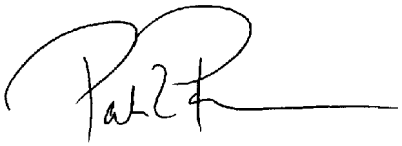
Moreover, while the current analysis of claims includes many "double patenting rejections", which would lend support to the premise that the claims in many of these continuation applications are not distinct, we believe many of these rejections are made improperly, to create additional revenue for the Patent Office, not because the claims are truly indistinct. This is an area where all would benefit from better training of the examiners.

Prior to June 1995, Applicants could benefit from filing of divisional and continuation applications. Indeed, it would have been negligent on our part not to suggest filing of continuations and divisionals to extend patent term. That is no longer true. It is expensive to file continuations and divisionals, and one obtains no additional patent term. These are not being filed with little consideration, when filed, but due to necessity. The few who do file continuations to seek delay, such as those where a continuation is filed and no response to a substantive office action is filed, should be penalized; not the majority who do so only out of necessity.

We hope you will take these comments into consideration and not implement these rules. We continue to believe that the best deterrent to the problem of too many claims and too many continuations is financial – where those who misuse the system must pay to do so, but those who must make such filings are not prohibited from doing so or made to expend a fortune in time and money to seek authorization to do so.

Very truly yours,

PABST PATENT GROUP LLP



Patrea L. Pabst