

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

From: Kerry Broome [mailto:klbroome@hotmail.com]

Sent: Wednesday, May 03, 2006 11:36 PM

To: AB94Comments

Subject: Comments to "Changes to Practice for the Examination of Claims"

Dear Mr. Clarke,

Attached are comments in response to the Changes to Practice for the Examination of Claims in Patent Applications, Notice of proposed rule making, first published in the Federal Register at 71 Fed. Reg. 61 (January 3, 2006).

Sincerely,

Kerry Broome
Reg. No. 54,004

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 A. Clarke
Deputy Director
Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent
Examination Policy

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

Dear Under Secretary Dudas:

I hereby submit the following comments in opposition to the current version of the proposed revision of the patent rules of practice entitled "Changes to Practice for the Examination of Claims in Patent Applications" (the "Proposed Revision"), published by the U.S. Patent & Trademark Office ("USPTO") on January 3, 2006, at 71 Fed. Reg. 61. While I support the USPTO's goals of promoting Examiners to do a better, more thorough and reliable examination, I respectfully disagree with the Proposed Revision because it is too restrictive. The Proposed Revision does not provide patent applicants with sufficient latitude to claim various different embodiments of any technology.

I believe the Proposed Revision's requirement of limiting the number of representative claims to ten is too restrictive. However, I do agree that some restriction may be helpful to patent prosecution.

Based on the current USPTO fee structure for claims, patent applicants are allowed a maximum of three independent claims and twenty total claims for new applications without requiring any additional fees. Therefore, the requirement of the Proposed Revision of allowing patent applicants to designate only ten representative claims seems to be contrary to the USPTO's previous acknowledgment that twenty total claims, with three of those claims being independent, are not an undue burden on Examiners for initial examination.

I recommend that the Proposed Revision should be changed to increase the number of representative claims that will receive initial examination to no less than twenty total claims, with a maximum of three patent claims being independent. This change to the Proposed Revision would then accurately reflect or appropriately match the current fee structure for newly filed patent applications.

In the alternative to my proposal of three independent claims with a maximum of twenty claims for each newly filed patent application, I recommend the USPTO to adopt the American Intellectual Property Law Association (“AIPLA”) proposal that applications with six independent claims and thirty total claims should be exempt from the requirement of designating representative claims. Thus, all presented claims falling within these parameters would be examined.¹

As stated above, I support the USPTO’s goals of promoting Examiners to do a better, more thorough and reliable examination. The Proposed Revision, however, runs contrary to those goals. Therefore, I request that the USPTO to not adopt the Proposed Revision in its current form but to instead adopt my proposal of limiting examination to a maximum of three independent claims and a maximum total of twenty claims.

If Under Secretary Dudas or any of his subordinates would like to discuss any of the issues with me that I present in this letter, please call me at my Atlanta office number of 404-572-4647. Please note that the information and opinions expressed in my letter are my personal views and they do not necessarily reflect the positions or views of my employer.

Respectfully Submitted,

Kerry L. Broome
Reg. No. 54,004
(404) 572-4647

¹ AIPLA’s Comments on the Proposed Rules, April 24, 2006, pgs. 5-6.