

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

From: Frank H. Foster [mailto:ffoster@ohiopatent.com]

Sent: Tuesday, January 24, 2006 5:59 PM

To: AB94Comments

Subject: Comment: Initial examination of representative claims

Attn: Robert A Clarke

Initial examination of representative claims sounds like an excellent idea to reduce examiner work load and, hopefully, improve the quality of examination. I wish to express one concern.

The notice often repeats the idea that examination of the non-designated or non-representative dependent claims will be held in abeyance until the application is otherwise in condition for allowance. However, what does that mean in the event an examiner initially rejects all the designated, representative claims over prior art and the applicant agrees that the examiner is correct. Does that statement mean that an applicant is foreclosed, because the case is not otherwise in condition for allowance, from presenting a new independent claim that incorporates the previously presented but non-representative dependent claim and arguing that the new independent claim is patentable? Perhaps the fact that the new claim added in a response to a first office action is independent assures that it will be considered. Perhaps the problem is prevented by something in the details that I did not see. The point is that an applicant should be able to respond to a first action by arguing the patentability of the subject matter of ANY dependent claim even though the case is not in condition for allowance and the subject matter argued to be patentable was not in a representative claim.

Thank you,

Frank

Frank H. Foster

Patent, Trademark and Copyright Law

Intellectual Property Law

Kremblas, Foster, Phillips & Pollick Columbus, Ohio

7632 Slate Ridge Blvd. Reynoldsburg, OH 43068

email: ffoster@ohiopatent.com

voice: 614/575-2100 fax: 614/575-2149

Web Page: <http://www.ohiopatent.com>