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From: Walker & Jocke LPA [mailto:iplaw@walkerandjocke.com]

Sent: Monday, April 24, 2006 2:47 PM

To: AB94Comments

Cc: Carrol.Barnes@SBA.gov

Subject: USPTO Proposed Rules

To: AB94Comments@USPTO.gov

cc: Carrol Barnes Bascus

Mail Stop Comments - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Attn: Robert A. Clarke

Re: US PTO Proposed Rules Regarding Practices for the Examination of
Claims in Patent Applications

Sir:

I write to express opposition to the proposed rule changes presented in the Notice of proposed rule making published January 3, 2006 by the Patent and Trademark Office (PTO), entitled "Changes to Practice for the Examination of Claims in Patent Applications." The proposed rule changes should be rejected because they would impose an undue burden on patent applicants, massively increase the cost of patent prosecution and prevent many patent applicants, particularly small businesses, from obtaining the full scope of patent protection to which they are entitled.

The proposed rule changes would limit the initial examination of claims in patent applications to ten representative claims. A patent applicant would be limited to having ten representative claims examined by the PTO in the current manner, regardless of the number of patent claims that the applicant has paid the PTO to have examined. Under the proposed rules, if patentable subject matter is not acknowledged by the PTO in the ten representative claims, the patent applicant is given one month to conduct a detailed worldwide search and analysis of all possible relevant art to the other pending claims. Within this same one month period, the patent applicant must present to the PTO a detailed examination support document showing how the application supports each

claim and the reasons why each pending claim in the application is patentable over all prior art. The one month period for the applicant to do this is generally not extendable.

The proposed rule changes would also authorize the PTO to require a patent applicant to eliminate from co-owned patent applications, any claims which the PTO considers patentably indistinct from claims in another of the applicant's patent applications. A failure to cancel such claims from all but one application will result in the claims that the PTO considers indistinct being automatically included in each of the inventor's other applications. This would enable the PTO to avoid examining the claims in the other applications that the applicant wishes to have examined. The PTO has concurrently proposed rule changes that would preclude applicants from filing any second Requests for Continued Examination (RCEs) or continuing applications that could otherwise be filed by applicants in order to have all their patent claims examined.

The goal of the U.S. patent system is to enable inventors to attain appropriate patent protection for their inventions. Patent applicants should retain the right to file the number of patent applications and claims necessary to obtain the full scope of patent protection to which they are entitled. In recent years Congress has allowed the PTO to dramatically increase its fees for the purpose of hiring an adequate staff of patent examiners to handle the number of patent applications that are filed. PTO fees now reflect at least the actual cost that the PTO incurs in examining applications.

The PTO's proposed rules would deny many patent applicants the right to adequately protect their inventions. To only have ten claims examined in a patent application in accordance with the current practice will not allow the majority of inventions to be adequately protected. In addition, limiting initial examination to a small subset of claims will result in many situations in which patentable subject matter will not be indicated after the patent examiner has reviewed the ten claims. At this point, the patent applicant will face the expensive and virtually impossible task of within one month (a) conducting a worldwide search of all relevant art, and (b) preparing a detailed written explanation of how the application supports each of the unexamined claims, and (c) preparing a detailed explanation that shows how each unexamined claim is patentable over everything found in this search. The cost associated with complying with this requirement will be excessive and beyond the financial means of many patent applicants. In many cases compliance could not reasonably be achieved within the one month time period provided. This proposed rule changes in combination with the PTO's other

proposed rules which would limit the number of RCEs and continuing applications, will result in many patent applicants being denied the opportunity to adequately protect their inventions. The proposed rules would be particularly harmful to small businesses by driving up costs and by making it impossible for many small businesses to afford obtaining patent coverage.

The PTO should not ignore the widespread public opposition to these proposed rules. The recent statements by PTO officials that the PTO will enact these rules despite overwhelming opposition, and despite the PTO's acknowledgment that the proposed rules will provide no benefit to patent applicants, suggest a need for the PTO to consider that it exists to foster innovation by enabling inventors to protect their inventions.

The proposed rule changes should be rejected. The PTO should to continue its efforts to hire and retain an adequate staff of patent examiners for which Congress has provided funding. The PTO should address its backlog of patent applications, not by imposing additional burdens and costs on patent applicants, but rather by reducing the number of needless multiple nonfinal office actions and reopenings of prosecution after appeals.

Very truly yours,

Ralph E. Jocke