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**From:** Kolker, Daniel E.  
**Sent:** Tuesday, May 02, 2006 4:37 PM  
**To:** AB94Comments  
**Subject:** Comment on proposed rule changes/ Examination Support Document

Commissioner for Patents  
Mail Stop COMMENTS  
PO BOX 1450  
Alexandria VA 22313-1450

By email: [AB94Comments@uspto.gov](mailto:AB94Comments@uspto.gov) <<mailto:AB94Comments@uspto.gov>>

Re: Comment on proposed rule changes

The proposed rule changes published in the Federal Register, identified as Docket No: 2005-P-067 RIN 0651-AB94, and published on 3 January 2006 are the subject of these comments. The Office states that the proposed changes “will allow the Office to do a better, more thorough and reliable examination” by reducing the number of claims an applicant may submit and by requiring an examination support document in those cases where applicants submit an excessive number of claims.

I fully support the Office’s attempts to reduce pendency by modifying how applicants can claim their inventions. As a Patent Examiner in workgroup 1640, I am well aware of the large backlog of cases and find persuasive the Office’s argument that it is impossible to hire enough examiners to work through the backlog. However, the proposed changes will not, in my opinion, significantly expedite prosecution.

As written, the proposed rule requires that if an application contains more than ten claims an examination support document must be filed. This document would most likely be so meaningless as to be useless. Currently, applicants are required under rules 37 CFR 1.56, 1.97, and 1.98 to file Information Disclosure Statements in which they are to disclose all information that they are aware of relevant to patentability. In my experience, applicants frequently blatantly disregard this requirement by failing to include on such statements publications that they must have been aware existed. The most frequent oversight is the failure to include the inventors’ own work, either in published or scientific abstract form. See for example patent application number 10/737262 (applicants failed to disclose their own abstract, published more than one year before the filing date, which discloses the most specific embodiments of the invention), 10/683451 (applicants failed to disclose their scientific abstract published more than one year before the filing date, which discloses many if not all features of the invention). In each of these cases, I as the examiner had to conduct a thorough search in order to find these articles. Applicants already had a duty to disclose them to the examiner, but chose not to. While the current rules do not require that applicants undertake a search, it seems impossible to believe that a search was necessary to reveal these documents as in each case the applicants were the authors of the publications. Thus undertaking a search, as required by the proposed rule changes, would still not be likely to reveal the most pertinent art in these cases. If applicant chooses not to disclose his own work in the absence of a search, and he must have been aware of the existence of such work, conducting a search will not lead him to disclose the work, as the search would not reveal

articles about which he was not previously aware. The two cases I have cited above are exemplary and do not reflect the complete set of all cases in which I have found applicant's own undisclosed prior art.

Because the Examination Support Document is no more likely to contain the most pertinent art about which applicants are already aware, consideration of this document would occur in addition to, not instead of, an examiner's search. By increasing the number of uninformative documents an examiner is required to consider, the examiner will have to spend more time per case. This will slow prosecution on each case rather than speed it. Since the proposed rule changes implicitly acknowledge the need to expedite prosecution, the proposed changes appear to be incapable of achieving these ends.

There are other ways to discourage applicants from filing excessive claims that would not have the same effect on increasing the amount of time each case must be considered by an examiner. Currently, the fees for claims in excess of twenty are very low (\$50 per claim for a large entity, \$25 per claim for a small entity). This fee could be increased significantly. In the alternative, a stepwise increase in fees over a certain number of base claims might better serve to discourage filing excessive claims. For example, the Office may consider charging \$50 each for claims 21 - 25, \$100 each for claims 26 - 30, \$200 each for claims 30 - 40, and \$500 each for claims 41 - 50. The exact amounts of course are not particularly important, but rather the idea that a steeply graduated fee increase would provide a strong incentive against filing excessive claims. Such a mechanism could hold down the number of claims, would provide the Office with additional funds, and would not slow prosecution by forcing the examiner to consider an additional document.

Most sincerely,  
Daniel E. Kolker, Ph.D.

*Daniel Kolker, Ph.D.  
Patent Examiner, Art Unit 1649  
Remsen 4A54 mailbox 4C70  
U.S. Patent and Trademark Office  
571-272-3181  
daniel.kolker@uspto.gov*