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From: Robert P. Lord [mailto:Lord@oshaliang.com]

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To: AB94Comments

Cc:

Subject: Comments on Proposed Rule Changes

Please find attached comments regarding the proposed rule changes.

Best regards,

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Comments on the Proposed Rule Changes at the USPTO Regarding Representative Claims

Background

In the Federal Register Vol. 71, No. 1, pages 61-69, published Tuesday, January 3, 2006, the United States Patent Office (USPTO) outlined a series of proposed rules changes directed at reforming U.S. Patent practice. Included in the Federal Register are proposed rules 37 CFR § 1.75 and 37 CFR § 1.261. The USPTO has proposed these rule changes related to examination of claims in patent applications in an effort to enhance the quality and the speed of the patent examining process.

In particular, the USPTO has proposed rules requiring each applicant to designate a set of “representative claims” in a patent application for initial examination. The proposed rules indicate that the number of representative claims will be limited to a total of ten claims, which should include all of independent claims and some dependent claims that are expressly designated as representative claims. If the number of independent claims exceeds 10 or the applicant wishes the initial examination to involve more than ten representative claims, then the applicant is required to provide an examination support document which pertains to all of the independent claims and the dependent claims designated for initial examination.

Under the proposed rule¹, the examination support document includes six parts:

1) A statement that a pre-examination search was conducted with search field information required under § 1.261(a)(1).

2) An information disclosure statement citing reference(s) most relevant to subject matter of each of the independent claims and designated dependent claims.

3) An identification of all the limitations of the independent claims and designated dependent claims related to each cited reference.

4) A detailed explanation of how each of the independent claims and designated dependent claims are patentable over the cited references.

5) A concise statement of the utility of the invention as defined in each of the independent claims.

¹ 37 CFR § 1.261

6) Evidence of support from the specification for each limitation of the independent claims and the designated dependent claims in accordance with the first paragraph of 35 USC § 112.

According to the USPTO, the designation of representative claims would allow the USPTO to perform “a better, more thorough and reliable examination since the number of claims receiving initial examination will be at a level which can be more effectively and efficiently evaluated by an examiner.”² Although the USPTO argues that the implementation of this rule change will improve the quality of examination (which patent applicants agree is much needed) by allowing each examiner to spend more time on a subset (*i.e.* representative claims) of all pending claims during an initial examination, the proposed rule changes carry some potentially unnecessary, negative implications to patent applicants.

Comments on Proposed Rule Change

Both the USPTO and most practitioners (as well as applicants) understand that the number of patent applications with more than ten independent claims is only a small portion of pending applications (*i.e.* currently, less than two percent)³. Therefore, the USPTO reasons that the majority (98+ %) of applications will not be significantly impacted by the representative claims requirement.

In fact, the majority of applicants with applications having less than 10 independent claims *are* negatively affected. When the patent application has less than 10 independent claims and the applicant chooses not to submit an examination support document (for the reasons cited in the discussion below), the applicant will be forced to designate only a subset of dependent claims for the initial examination. Choosing which dependent claims to designate forces the applicant to make a threshold decision regarding claim scope without the benefit of analyzing cited prior art following an office action.

Assuming that a competent examiner is issuing office actions under the current examination procedure, a practitioner is able to gauge the acceptable level of claim scope after the initial office action for various reasons. The reasons include: (1) the examiner may indicate that one or more of the dependent claims are allowable if re-written in independent

² Federal Register. Vol. 71, No. 1. Page 61, column 3

³ Federal Register. Vol. 71, No. 1. Page 62, column 3

form when the independent claims are rejected; and (2) even when the examiner rejects all claims, the practitioner is able to gauge the required narrowing of claim scope based on the prior art cited and reasoning used by the examiner for the rejection of claims. Accordingly, the practical result of the proposed rule change is either forcing the practitioner to (i) guess regarding the proper scope of the claims when determining the dependent claims to designate; or (ii) perform its own prior art search prior to filing the application, which unnecessarily puts a burden on the applicant and results in the need for the applicant to file a previously unnecessary information disclosure under 37 CFR § 1.56. Additionally, the practitioner's inability to present all of potential limitations of dependent claims at once during the initial examination could, in fact, drag out the examination procedure by requiring more office actions, responses, RCE's, continuations, and appeals because the practitioner will be required to continually amend during prosecution (*e.g.*, submitting various sets of submitted claims, which were undesignated and, therefore, unexamined to the examiner for examination) to find an acceptable level of claim scope during examination.

For the minority of applications involving more than ten representative claims, the negative implications of the proposed rule changes are even greater. The examination support document required under the proposed rule⁴ will necessarily create prosecution history, which will often have a negative impact on the patent holder during litigation. A practitioner who chooses to submit the examination support document is required to provide a detailed explanation of how each of the independent claims and designated dependent claims are patentable over each relevant reference submitted. Because the practitioner is forced to characterize and differentiate the claimed invention from the submitted references even before a first office action, the potential chances of incorporating negative prosecution history is greater from the outset.

Conclusion

Patent practitioners and applicants understand the many problems that the PTO confronts today. Problems, such as a rapidly increasing backlog of applications, a longer waiting period for examinations, and a shortage of well-trained, English-speaking examiners, are forcing the USPTO to devise solutions to process patent applications more efficiently.

⁴ 37 CFR § 1.261

Nevertheless, the concept of designating representative claims has several negative implications which can actually exacerbate the very problems that the USPTO is trying to solve. Potential increases in office actions, responses, RCE's, continuations, and appeals because of the restrictive nature of examining claim sets during the initial stages of the examinations could offset the benefits of focusing on ten representative claims for a first-pass examination. Furthermore, requiring the search of relevant prior art references and the arguments for claim differentiation before the beginning of the examination for a patent forces each practitioner to create prosecution history from the outset. The penalty for designating more than ten claims for examination is excessive and places an unfair disadvantage on the applicants. Therefore, the proposed rule changes regarding the designation of representative claims do not seem to be an adequate solution for solving the problems being encountered by the USPTO today.

Potential Improvement

A potential improvement to the proposed rule is to require the applicant to designate the ten representative claims when responding to the initial office action (*i.e.*, *after* the initial office action). With the designation at this stage, the applicant will have the advantage of viewing the cited prior art and the reasoning of the examiner for rejecting each claims; thereby avoiding a guessing game resulting in overly narrow claims or unnecessarily creating negative prosecution history. The USPTO will benefit because the prosecution will be more focused and time will be saved for all future actions involving the application.

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