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TO: Robert A. Clarke FROM: **William K. Weisenberg**  
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COMMENTS:

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THANK YOU



May 1, 2006

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

Attn: Robert A. Clarke

Good Morning:

I write to express the opposition of the Intellectual Property Law Section of the Ohio State Bar Association 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 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 a different approach to managing the PTO.

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 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

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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. In addition, 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 the current manner will not allow most 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 limited time period provided. This proposed change 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.

The proposed rule changes should be rejected. We encourage the PTO to continue its efforts to hire and retain an adequate staff of patent examiners for which Congress has provided funding. We also encourage the PTO to 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 or prosecution after appeals.

The Ohio State Bar Association Intellectual Property Section has more than 800 members who represent businesses of all sizes, independent inventors, and academic institutions. The

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Ohio State Bar Association, founded in 1880, is a voluntary association representing approximately 25,000 members of the bench and bar of Ohio, as well as nearly 4,000 legal assistants and law students. Through its activities and the activities of its related organizations, the OSBA serves both its members and the public by promoting the highest standards in the practice of law and the administration of justice.

Sincerely,



E. Jane Taylor  
President

cc: The Honorable Mike DeWine  
The Honorable George Voinovich  
Howard S. Robbins, Esq.  
Ralph E. Jocke, Esq.