

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

From: Alun Palmer [mailto:palmer@lacasse-patents.com]

Sent: Wednesday, January 04, 2006 9:30 AM

To: AB94Comments

Cc: elektros@mdo.net

Subject: Representative claims

Dear Sirs,

I believe the proposed changes to examination would cause delay rather than reducing it. Examining only representative claims would result in piecemeal examination, a practice that examiners are currently warned against in the MPEP.

Further, it would eliminate in many cases the indication of allowable subject matter that would otherwise appear in office actions. For example, if say claim 4 dependent from claim 1 was allowable if rewritten in independent form, but was not designated as a representative claim, then it would not be examined in the first office action, and so could not be rewritten prior to a final office action, therefore necessitating an RCE that could otherwise be avoided.

The practice of initial examination of only representative claims is therefore highly undesirable as it is dilatory and would definitely lead to unnecessary continuations.

This could only be corrected with further changes, for example allowing unlimited amendments to undesignated claims after final. I am very much in favor of relaxing after final practice, but that is not apparently under consideration here.

As to the argument that representative claims are used before the Board and in court, this is a different situation, as prosecution is closed, albeit when before the Board that may be more in theory than in practice. When prosecution is closed it may be appropriate to consider only representative claims, but when the final form of the claims is still in play it is not, as limitations in the dependent claims may still be added to the independent claims, hence those limitations still have to be considered.

Regards, Alun Palmer

Reg. No. 47,838

These comments represent my personal views, and not necessarily those of the firm with which I am associated.

Alun L. Palmer
Registered Patent Agent

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From: Alun Palmer [mailto:palmer@lacasse-patents.com]

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