

Proposed Changes to Practice for the Examination of Claims in Patent Applications  
From: ESteen@inco.com  
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To: AB94Comments  
Subject: Proposed Changes to Practice for the Examination of Claims in Patent Applications

Attn: Mr. Robert A. Clark

Greetings:

Although I appreciate the difficulties facing the PT0 when examining unreasonably large numbers of claims in individual patent applications, it strikes me that the above proposal penalizes patent applicants and will result in unduly narrow patents.

The notion of selecting only 10 representative claims for examination is troubling because that number may be too low to afford an applicant the opportunity to obtain a patent of sufficient breadth. Moreover, in my experience that examiners while rejecting independent claims will often advise that selected dependent claims are patentable. These suggestions are very helpful. If the applicant did not select the "right" representative dependent claims, it is likely that a first action which only reviewed several independent claims ("n" independent claims) and a few remaining so-called representative 10-n dependent claims will be a rejection leaving the applicant with no idea that the examiner believes that some of the non-representative claims may be patentable.

Filing an examination support document to include more claims is a time consuming and expensive burden. The applicant has to now conduct an extensive costly prior art search in order to justify the examination of additional claims. In our corporate department, we typically conduct general survey prior art searches before filing an application. If the results merit an application, the search results are submitted to the PT0. However, under the proposal, if we wish to select additional representative claims and file the support document, a much more extensive search and study must be completed. Drafting the examination support document will cause delay, add to the cost of filing and possibly raise the issues of estoppel or fraud if the applicant missed or misunderstood the prior art. The burden of examination is being shifted further on to the applicant. And we still don't know if we picked the right dependent representative claims.

I suggest that if this flawed proposal is finalized, the number of representative claims be raised to 25. This number is still modest and likely reflects many applications while still reducing the workload facing each examiner.

A better alternative to the proposal is for the PT0 to raise its relevant fees to discourage prolix applications.

The fact that no public hearing is planned on this paradigm shifting change of examining procedure of long standing is disturbing. I imagine that the various professional associations will wish to make their views known in a public forum.

Respectfully submitted,

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