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May 3, 2006

Robert J. Spar, Director
Office of Patent Legal Administration
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P.O. Box 1450
Alexandria, VA 22313-1450

Re: Comments on Changes to Practice for the Examination of Claims
in Patent Application
Federal Register Volume 71, No. 1, Page 61, Tuesday, January 3,
2006

Dear Mr. Spar:

The Webb Law Firm is a mid-sized law firm with a domestic and international practice in intellectual property representing a diversity of clients ranging from large corporations to individual inventors. We have the following comments based upon our experience with such clients.

The Office has proposed focusing its initial examination on no more than ten claims designated by the Applicant as representative claims or, in the alternative, more claims will be examined if the Applicant provides an Examination Support Document that covers all of the independent claims and the dependent claims designated for initial examination.

Problem: Some Applicants are submitting too many claims for Examiners to perform a reasonable search and examination within their allotted time. Under 35 U.S.C. §131, the Director shall cause an examination to be made of the application and the alleged new invention and if upon such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor. Requiring the Applicant to designate ten representative claims which will be examined finds no support in the statute since the invention is defined by all of the claims.

Robert J. Spar, Director

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Suggestion: We suggest focusing more upon the individual applications containing excessive claims rather than forcing the entire patent community to modify its practice in a manner that is neither supported by statute nor will truly reduce the pendency and backlog of applications before the Office. The action of a few applicants should not be the basis for limiting a practice which has been acceptable for many years. In our experience, patent applications that have twenty or fewer claims are sufficient for the large majority of the applications we prepare. For applicants who believe that more than twenty claims are desired or necessary, consideration should be given to providing additional time for the Examiner to act. An additional fee is already being charged for examination of additional claims.

This limitation of ten representative claims, coupled with the concurrently proposed restriction for continuation practice places the applicant in a difficult position. If all ten representative claims are rejected in a first Office Action, the Applicant may submit an Amendment limiting those rejected claims with the features of other dependent claims that were presented but not examined in the originally filed application. Now, when the applicant, who in the past would have received a non-final Office Action, receives a Final Office Action for claims that rightfully should have been examined with the first office action, he or she may well be pushed into filing an RCE to have the claims examined.

Problem: Applicants may circumvent the requirement to select ten representative claims for examination in a United States application.

Suggestion: Until such limitations are placed on PCT applications, Applicants may file a PCT application with as many claims as they wish, designating the US as the searching authority. In essence, that will provide to the Applicant a United States examination with which he or she may then enter the national stage in the United States. This does not relieve the burden for the Office, but provides to the Applicant an examination performed by United States Examiners.

Problem: The representative claim requirement will be retroactive for all applications for which a first Office Action on the merits has not been mailed as of the date the new rule may go into effect.

Suggestion: Although we oppose the limitation of ten representative claims, if this limitation is implemented, it should not be retroactive. Applicants have invested substantial time and money in developing independent and dependent claims with the belief all of the claims will be examined in a first Office Action on the merits. Some of these applications were filed as long as four years ago. It is not fair to change the rules on those Applicants. These Applicants should not be blindsided by an attempt to remedy this problem. Applicants have already paid excess claim fees implemented in 2005 and have every right to expect that each claim will be fairly examined.

Problem: Although the Office will, under the current rules, permit applications to be filed with more than ten representative claims, it will require the Applicant to

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submit an examination support document (ESD), through which the Applicant submits the results of any pre-examination search, as well as provides extensive details on how the references identified within the search are relevant to the pending claims.

Suggestion: We believe there should be no requirement to submit an ESD. For applicants who believe that more than twenty claims, which is the current standard, are desired or necessary, consideration should be given to providing additional time for the Examiner to act. An additional fee is already being charged for examination of additional claims. Preparation of an ESD not only requires extensive time and resources on behalf of the applicant, but furthermore, appears to be a much more extensive analysis than is generally provided by the Examiner in an Office Action. To the extent an Applicant would like a patent to stand on its own with minimal prosecution history, such an ESD is undesirable.

Overall, we believe that forcing Applicants to select ten representative claims is a draconian solution to address what appears to be a small number of applications that have an excess number of claims. The most effective and practical way to address this problem is to focus upon the relatively few applications being filed with such claims and address them directly.

Very truly yours,

/JGP/

James G. Porcelli