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From: Cameron Weiffenbach [mailto:camweif@comcast.net]

Sent: Thu 5/4/2006 12:39 PM

To: AB94Comments

Cc:

Subject:

The Honorable Jon W. Dudas
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
Mail Stop Comments
P.O. Box 1450
Alexandria, VA 22313-1450
Attention: Robert A. Clarke

RE: Comments on Proposed Rules: "Changes to Practice for the Examination of Claims in Patent Applications," 71 Fed. Reg. 61 (Jan. 3, 2006)

Dear Under Secretary Dudas:

I am a registered patent practitioner and Of Counsel with the firm of McDermott Will & Emery LLP. My comments below are directed to the proposals on claims in patents applications that were published at 71 Fed. Reg. 61 on January 3, 2006. I realize that the comment period ended yesterday, but I had the comment period ending on May 5th on my calendar. I would appreciate it if you would read and consider my comments in any event.

I support appropriate actions to reduce the increasing number of unexamined patent applications. However, for reasons set forth below, I do not feel that the proposed actions by the Office will have the effect of reducing the increasing backlog of applications or resulting in a more thorough and reliable examination of patent applications.

The Office has proposed to reduce the number of claims examined to 10 or less. It should be noted that the CCPA has stated: "As a general proposition, an applicant has a right to have *each claim examined on the merits*" (emphasis in the original). *In re Weber*, 198 USPQ 328, 331 (CCPA 1978).

If the Office has its way, applicant will not get an examination on the merits of all of the claims presented for examination. Independent and dependent claims not selected for examination, which could contain allowable subject matter based upon the examiner's search of the prior art, will not be examined. Applicant would have to have a crystal ball to predict which claims an examiner may consider as containing allowable subject matter. The purpose or intent of the patent statute is to have each claim examined on its merits. 35 U.S.C. § 112, second paragraph, states that the "specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter *which the applicant regards as his invention*" (emphasis added), and not what claims the Office imposes on the applicant to choose for examination.

There is nothing in the proposed rules that would require the examiner to notify applicant if any unexamined independent and dependent claim contains allowable subject matter. Only if the examiner finds that all of the selected claims are allowable or if the examiner's decision on appeal is reversed, will the applicant get an examination of all of the unexamined claims. Current statistics show that the examiner is reversed in 60% of all appeals. Such reversals will only lead to lengthening the prosecution because Examiner's would have to examine the unexamined claims. There is nothing in the proposed rules that would preclude an examiner, after a reversal from the BPAI, from making a new ground of rejection of the original elected claims and adding the unexamined claims to the rejection. In any reversal, prosecution could not have been closed because there were unexamined claims in the application.

Furthermore, if on appeal the examiner's decision is affirmed, then applicant will not have any examination on the merits of the claims not elected for examination unless the applicant files a continuation application, in which case, under the proposed rules, the applicant would not be able to file an RCE or another continuation as a matter of right. The procedure proposed by the Office would appear to lengthen prosecution, as opposed to streamlining it for those cases which are not allowed after the second action on the merits. If the rejection of the claims in the continuation application is appealed and the examiner's decision reversed, then the procedure has not saved any time for the Office, but has added significant expense to the applicant and possibly reduced the patent term since it is unlikely that applicant will be given an extension of term for the first appeal.

The Office is making an assumption that if a base claim is allowable, then the dependent claim is also allowable assuming it meets the requirements of 35 U.S.C. §§ 112 and 101. This is not realistic. Presently, it is not uncommon for an examiner to reject dependent claims over prior art and not include the base claim in the rejection. I have encountered this situation on many occasions in my practice. If the examiner finds the elected claims allowable, examining the non-elected claims under 35 U.S.C. §§ 112 and 101 only as proposed in the rule package will open applicant in subsequent litigation to challenges that the dependent claims are unpatentable over the art of record in the application. Because the non-elected claims were not examined under 35 U.S.C. §§ 102/103, the presumption of validity (35 U.S.C. § 282) of the non-elected claims issued in a patent is non-existent.

The Office presented statistics that 1.2% of the 216,327 nonprovisional applications include 10 or more independent claims and that, therefore, their proposal "will allow for examination of every independent claim in 98.8% of the applications filed since January 1, 2005, *without any additional effort by the applicant*" (emphasis added). The Office is naïve if it believes that the proposed rules will not require additional efforts by the applicant. With the preparation and filing of the first application, patent counsel and his or her client would have to plan a patent strategy as how to present the claims in the application or in a series of applications to get the best protection for the invention. This will require a substantial time and effort additional effort on the part of applicant and counsel (time is money) as well as looking into a crystal ball to predict what to expect

during prosecution. Therefore, prosecution of patent applications will be far more expensive than it is under the present procedures.

The Office is of the opinion that restricting the number of claims initially examined would "allow the Office to do 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 the examiner." The Office has not presented any data to show that the proposed examining procedure can reasonably be expected to have a significant effect on examination effectiveness and efficiency or provide a more thorough examination. Since under the proposed rules the Office management will expect examiners to produce more first actions on the merits because there are less claims to examine, I do not see how examination can be expected to be a more thorough and reliable examination.

As for the proposed filing of an Examination Support Document for examination of more than 10 claims, this proposed procedure will open patent applicant and the patent practitioner to allegations in future litigation of deliberately doing an inadequate search, especially where prior art that comes to light in the litigation is missed in the original search. The Office can expect that under this procedure all of the prior art will be cited irrespective of the analysis since no practitioner is going to make an independent judgment as to materiality because the risk of being later accused of violating Rule 56 or being accused of inequitable conduct is too great. The proposed procedure also has Festo ramifications since any analysis of the references associated with the claims could be interpreted by the courts as being file wrapper estoppel.

In summary, I do not see that the proposed rules will effectively reduce the backlog and examination time per application or result in a more thorough examination of patent applications. The procedures have no benefit to the patent applicant, either financially or in subsequent patent litigation. The procedures will provide for more allegations of inequitable conduct and file wrapper estoppel. In addition, the proposal will have a significant effect on the presumption of validity defense (35 U.S.C. § 282), that is the courts may not rely on the defense where there is an allegation that claims which were not elected for examination are alleged to be unpatentable over prior art of record in the patent.