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Mail Stop Comments - Patents
Commissioner for Patent
P.O. Box 1450
Alexandria VA 22313-1450

Attn Robert A. Clarke

Ref: proposed rules of January 3, 2006

Dear Mr Clarke,

I would like to make some further comments on the proposed regulations.

I am very strongly opposed to the proposed examination support documents.

This concept would force applicants to make potentially unnecessary, prejudicial statements on the record, which would provide a virtual minefield in any litigation to enforce the patent. The need for making these statements would render any patent that issued essentially worthless. As they say in the "Miranda" warnings. "Anything you say can and will be used against you."

It is in any case essentially impossible to prove a negative, namely that patent claims are patentable. The type of requirement imposed by the proposed documentation essentially asks applicants to prove a negative.

Moreover, the PTO grossly underestimates the amount of attorney time, and therefore the cost to applicants, of preparing such documentation. Given the extreme risk of malpractice in making the required statements, attorneys would be forced to spend and bill for inordinate amounts of time in preparing patent applications. The attorney cost in preparing and application would likely at least double if not increase by a factor of 10. This would place the cost of new applications out of reach of small businesses.

I am also strongly opposed to the treatment of dependent claims in the proposed regulations. The lack of examination of dependent claims would undermine the presumption of their validity in any ultimate litigation, if the main claim were knocked out. Moreover, if, after a final office action, an applicant were newly convinced of the need to amend the independent claims, the applicant would be forced to file a continuation. Given the extreme limitations on continuation

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practice, the applicant might thus lose the opportunity to get a patent for a narrower invention that the applicant in fact deserved.

In addition, the PTO should not assume that if a single inventor files several applications in two months that these are necessarily related inventions. Some inventors are particularly prolific. Why should such inventors suffer from a presumption of double patenting?

It appears that the PTO is proposing to adopt new draconian rules, due to inability to retain staff. A 25% turnover rate has been cited. The PTO would be better able to retain well-qualified examiners, if the PTO stopped treating these highly qualified people like assembly line workers and started treating them like professionals. The pressure on examiners to increase throughput at the expense of quality, in conjunction with low civil service salaries, makes the positions unattractive. If the PTO were to allow examiners the time to do quality work, so that examiners could enjoy and take pride in their jobs, turnover rates would decrease, higher quality people would stay in the jobs, and overall throughput would ultimately increase, even though certain individual applications might take more time. Why should applicants suffer, because of the inhumane working conditions that the PTO imposes on examiners?

Very truly yours,

Anne E. Barschall