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From: Hersh, Joyce C. [mailto:jhersh@klng.com]
Sent: Wednesday, May 03, 2006 4:32 PM
To: AB94Comments
Cc: Grant Houston
Subject: BPLA Comments on Examination of Claims

Dear Sir:

Attached are the comments of the Committee on Patent Office Practice of the Boston Patent Law Association, concerning the rules proposed in “Changes To Practice for the Examination of Claims in Patent Applications,” published in the Federal Register on January 3, 2006.

We appreciate the opportunity to offer our comments and would greatly appreciate confirmation that they have been received.

<<BPLA_Claims.pdf>>

Kind regards,

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TO: The Honorable Jon Dudas
Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office
AB94Comments@uspto.gov
Attn: Robert W. Bahr, Senior Patent Attorney

FROM: Boston Patent Law Association,
Committee on Patent Office Practice

DATE: May 3, 2006

RE: Comments on Proposed Rules, "Changes To Practice for the Examination of Claims in Patent Applications" 71 *Federal Register* 61 (Jan. 3, 2006)

Dear Sirs:

The Boston Patent Law Association (BPLA) appreciates the opportunity to offer comments regarding the "Changes To Practice for the Examination of Claims in Patent Applications" published in the *Federal Register* on January 3, 2006.

The BPLA is a regional (Federal First Judicial Circuit) association of intellectual property professionals which provides educational programs and a forum for the interchange of ideas and information concerning patent, trademark, and copyright laws. Its members include attorneys, agents, and students practicing in all areas of technology, at law firms, corporations and academic institutions.

The comments and suggestions which follow are from our members, and were compiled and are submitted below. In general, the proposals appear to be targeting "outlier" behavior of a few applicants. Our members believe that the proposals, if adopted, are likely to exacerbate the current pendency problems within the U.S. Patent and Trademark Office's (USPTO; the Office), and result in piecemeal examination and appellate practice. Our members recommend that the Office tailor the proposals more narrowly to directly address particular situations.

Comments on the Proposal:

The Proposal Does not Indicate Whether or Not Increased Claims Fees Have Reduced Claim Counts

Claim fees were recently increased for applications containing more than three independent claims or more than twenty total claims. The proposals do not indicate whether or not the increase in fees has had an effect on reducing the number of claims in applications. One of the drafters of these comments has clients who require that all applications filed on its behalf contain no more than twenty claims, unless advance approval is obtained.

We therefore recommend that the Office study (if it has not done so already) the claim counts of applications filed since the new fees went into effect, to determine if the increased fees have altered applicants' filing behavior. If it has, then it would be a simple matter for the Office to revise the fees yet again to further change applicants' behavior.

The Proposal is Likely to Create More Work for Examiners

For applications where an Examination Support Document (ESD) is required, the proposals are likely to create more work for the examiners, rather than less.

The ESD will require some level of review by an examiner to determine if the search conducted by the applicant was sufficient. A prudent examiner may still wish to do a search to ensure that only a quality patent issues under his or her name, thus negating any time savings from the applicant providing the ESD.

The Proposed Rules Are Likely to Have a Disproportionately Harsh Impact on Small Entities

The proposed rules would be retroactive for many applications. Any application which has been filed, and in which no substantive examination has yet occurred, will require the applicant to select ten representative claims or submit an ESD.

Thus, small entity applicants who have already paid their attorneys to prepare and file an application will now be required (at the very least) to have their attorneys prepare and submit a preliminary amendment designating ten claims for examination. The proposed rules, if adopted, will amount to a retroactive rule change and cause small entities to incur additional costs for which they had not planned.

It Is Unclear How Examination Will Be Conducted If the Proposals Are Adopted

While the proposal lays out changes to the rules, it is unclear how these changes would be put into practice.

The proposals offer no guidance as to what constitutes a "representative" claim, or what would be done should the examiner disagree with the applicant's choice. It is also unknown if some amendments might cause a claim to no longer be "representative."

We recommend that additional information be provided to the public on the subject of selection of representative claims.

The Proposed Rules May Result in Appeal of Unexamined Claims

The proposal states that the ten representative claims will be examined, and once they are allowable, the remaining claims will be examined.

However, it is not clear what would happen should the applicant and examiner be unable to come to an agreement. If the ten claims are twice rejected, the applicant would be justified in appealing the rejection. In such a situation, the Board of Appeals would be reviewing a case which contained as-yet unexamined claims. Such cases would always need to be sent back for examination of the remaining claims. It is theoretically possible for a single application to be appealed multiple times as the various claims are examined.

We recommend that the proposals be revised to take appellate practice into account, to prevent any possibility of such piecemeal examination / appeal cycles.

Alternative Suggestions:

Require Additional Information Under 37 C.F.R. § 1.105

The drafters of these comments suspect that poor claim drafting on the part of some applicants and practitioners is causing the problems that are mentioned in the proposals. However, it seems inequitable to punish those who strive to draft clear, concise and reasonably-sized claim sets in order to proscribe the actions of a few.

We therefore recommend that for large claim sets, or applications where the invention cannot be understood from an attentive reading of the specification and claims, the Office may wish to encourage examiners to use 37 C.F.R. §1.105 to require that the application provide a concise, plain-English explanation of the invention and the claim set. Although the examples provided in rule 105 do not include a description of the invention, it can be fairly said that an understanding of the invention is "information . . . reasonably necessary to properly examine or treat the matter."

Require Continued Legal Education (CLE) for Practitioners

Many jurisdictions in the U.S. require attorneys to obtain CLE credit in order to maintain bar membership. The BPLA offers a wide variety of educational programs and informational seminars, and many of its members take advantage of these opportunities. Nevertheless, there is no requirement that patent practitioners do so.

We therefore recommend that the Office study the possibility of requiring a minimum level of CLE for practitioners, either through local bar associations, law schools, or online. Care should be taken to not disadvantage part-time practitioners or those living in geographic areas where local learning opportunities may be limited. The Office could tailor its requirements to suit its needs by requiring, for instance, education in drafting of claims, or roughly parallel claim sets based on varying independent claims.

Form a Patent Practice Advisory Committee

Most good practitioners have excellent reasons for following particular filing and prosecution strategies, and would be happy to explain the reasons behind them. Most practitioners would also take a dim view of those applicants who do indeed absorb a disproportionate amount of patent resources or abuse the patent system.

We recommend that the Office solicit volunteers from the patent bar to form a rotating Committee for the purpose of studying problems experienced by the USPTO and proposing

solutions tailored to address those problems. We believe that the Office would have no shortage of volunteers for such a committee.

We appreciate the opportunity to provide comments on the proposed rules, and we hope that our suggestions are helpful to the Office. Please feel free to contact us, if we can be of further assistance.

Sincerely,

Committee on Patent Office Practice,
Boston Patent Law Association

/Joyce C. Hersh/ /Grant Houston/

Joyce Hersh Grant Houston