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To: AB94Comments

Subject: Comments

Attached find comments relative to the Proposed Changes to Practice for Examination of Claims.

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May 2, 2006
By email to AB94comments@uspto.gov

These comments are responsive to Proposed Rules for Changes to Practice for the Examination of Claims on Patent Applications (Federal Register Vol 71, no. 1, pp 61-69). These comments are made by Scott C. Harris, individually, as a registered patent attorney (Reg number 32,030) , and also as an independent inventor on numerous issued and pending patents. These comments are not made on behalf of Fish & Richardson PC, the law firm with which I am associated.

1. The proposed rules are completely contrary to the patent office's previously-stated goal of more complete, not less complete, examination.

These proposed rules limit the number of claims in a patent which will actually receive examination. As a direct result, certain claims in some patent applications will not be examined. Of course, any person can follow the *substantial* requirements of this rule, do an examination report, and only then obtain examination of any number of claims. This adds significant extra expense. It is unlikely that very few applicants would actually do this. The result: only 10 claims in any application will be examined. Given that the patent office allows 20 claims to be filed for the price of the basic examination fee -- this means half the claims in an application that are actually paid for in an application are likely to be examined.

The patent office has repeatedly stated that its goal is to provide better examination of patent applications, not reduced examination, as would be the result of this proposed rule. Hence, this proposed rule is contrary to the Patent Office's stated business goal.

2. Why Charge a Fee for Claims that will not be Examined?

If claims will not be examined, what is the patent office's rationale in requiring a fee for filing those claims? Either the claim should be examined (as would be expected from a fee being paid for submission of the claims), or the claims should be submitted for free. If the patent office is not going to examine these claims, then why charge for them?

3. The rule proposes double charging for searching.

Under the proposed rules, the patent office charges separately for filing and searching. In addition: there is a new search requirement required for the applicant -- if more than 10 claims are designated.

If applicants are forced to do the search, and to certify that a search has

been done, then it would duplicate the patent office's search fee. Charging both a search fee and requiring a search is duplicative, and unfair.

4. The scope of the search required by the proposed rules is excessive, and in no case should the required search be greater than that which is currently possible using the patent office's own systems.

The scope of the search contemplated by the rules requires a search of US patents and applications, foreign patents, and non patent literature. However, this would appear to be a more extensive and broader search than is even possible using the patent office's own systems. The patent office has extensive searching capabilities for the U.S., but it is believed that this kind of search, as required by the rules, is not possible using the patent office's database.

Accordingly, it is believed that this holds applicants to a higher level of search than the patent office itself uses. Certainly the publicly available portion of the patent office's searching function would not be able to make the kind of search that is contemplated by these rules.

Requiring a search that is beyond the search capabilities offered by the US patent and trademark is excessive and unfair. It is inherently unfair to the patent office to require applicants to do a more extensive search than what the office itself would facilitate. The patent office rules as they now are proposed would benefit private searchers, search firms, and searching databases.

5. There is no causal relationship between an applicants' designation of multiple claims, and its consequences

The patent office attempts to "punish" applicants for designating more than 10 claims for examination. The patent office believes that this designation will cause a patent examiner to have to do more examination or use more examination resources. Therefore, the actions should be limited to things that aid the examiner in doing the examination -- but only things that are caused by the excess claim designation.

Doing a worldwide search is certainly an aid to a patent examiner, but it is not really related to the designation of multiple claims. Rather, the designation of claims requires that examiner to do more claim examination, not more searching. There is no causal relationship between the "designation", and the examination.

There are many ways that the patent office could shift some of the burden in a way that is rationally related to the designation. The patent office could require applicants to present a claim chart showing the differences between claims. The proposal that applicants show support for the claims in the specification is certainly rationally related to multiple claims, and relieves the examiners of that burden. The patent office could require applicants to show groups of claims which are similar, that is dependent claims which define similar limitations.

These would offload a part of the examination function from the examiner related to the designation. This "punishment" would be more rationally related to the act.

6. The so-called patently indistinct rule is a contradiction of judicial precedent, and is an overly aggressive suggestion.

There is substantial jurisprudence governing a patentee's ability to patent multiple "indistinct" claims. If two claims are exactly the same, they cannot be patented because of the same invention obvious type double patenting. However, there is substantial judicial precedent holding that claims which are not patentable over one another, yet are different, should nonetheless be patentable if accompanied by a terminal disclaimer.

This proposed rule contradicts this judicial precedent. If claims are patentably indistinct, they will not be allowed for presentation. This is overly harsh, and would prevent patenting of differing embodiments, unless they were patentably distinct. This is unfair, and clearly would prevent patentees from adequately protecting their inventions.

Respectfully,

_____/SCH/_____
Scott C. Harris
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