

From: Mikio Ishimaru [mailto:mikio@ishimarulaw.com]
Sent: Thursday, March 30, 2006 11:48 PM
To: Clarke, Robert
Subject: Comments Regarding Claims Practice

Dear Mr. Clarke,

I enjoyed the Town Meeting Tuesday at Berkeley and hope there will be meetings in the future to explain USPTO planned changes.

By way of background, I've been practicing patent law over 30 years in both corporate and private practice. Most recently, I was Director of Technology Law for Advanced Micro Devices, Inc. and am the managing partner of a small law firm representing major corporations in patent prosecution, licensing, and strategy.

I have some questions and comments:

1. RE: Quality - What happened to the USPTO proposal to have examiners and practitioners take periodic tests to respectively continue in the USPTO and maintain licensing? This seems like the best way to improve patent quality by improving prosecution quality on both sides at the most critical point in the process.
2. RE: Pendency - Prosecution seems to be reopened frequently. This just extends prosecution and increases the work load in the USPTO. What happened to the idea of one thorough search rather than many less than thorough searches?
3. RE: ESD - If an Examination Support Document is required, is there any reason not to file a Petition to Make Special at the same time? The extra cost for the Petition would be small after the cost of an ESD and the incremental extra cost for faster prosecution would be easily justified. Wouldn't the proposed ESD increase pendency since more Petitions to Make Special would be filed.
2. RE: Continuations - For continuations, would there be a possibility of paying an extra fee and getting a different examiner? A continuation is often due to the examiner not understanding the invention and it would be nice to get a second, fresh bite at the apple.
3. RE: Pre-Appeal Brief Program - Most practitioners I've talked to like the Program and would like to see it continued.
4. RE: Volume - To reduce the number of applications, I would recommend deleting the current product and process restriction requirement. It is not in keeping with Harmonization and with computer searching, an examiner can easily search process and product claims simultaneously as was done before the mid-1970's. Eliminating this type of restriction would probably eliminate 25% of the backlog in the semiconductor art units.

Thank you,
Mikio Ishimaru (Mr.)