

-----Original Message-----

**From:** Janal Kalis [mailto:JKalis@slwk.com]

**Sent:** Friday, January 06, 2006 12:21 PM

**To:** AB94Comments

**Subject:** Comments Regarding Proposal to Require a "Patentability Report" when Filing a Patent Application

Dear Sir,

I am a patent attorney in private practice. My clients question all fees--the USPTO fees, my fees, contractor fees. I have always been able to justify the Patent Office filing fees by explaining to the clients that these fees pay for a patent office search. This type of search is of the highest quality and cannot be easily challenged. I think that the big filers also have recognized that the filing fees pay for the search. If we have to do the searching, what is the justification for the filing fee--especially the searching fee?

Furthermore, I do a lot of patentability searching in the normal course of business. I am constantly surprised, however, by references cited by the Examiner. They are usually very pertinent references that I did not identify in my search. If our searches miss an important reference under the proposed rule, we are exposed to a charge of committing fraud on the patent office or malpractice because someone will argue that a reasonable searcher would have found the reference. The Patent Office has immunity from these types of charges.

I appreciate the backlog problem at the Patent Office but the case that requiring applicants to do their own patentability searches and submitting them to the PTO will solve the backlog problem has not been made.

Janal Kalis

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**From:** Janal Kalis [mailto:JKalis@slwk.com]

**Sent:** Friday, January 06, 2006 2:17 PM

**To:** AB94Comments

**Subject:** Comments Regarding Proposal to Require a "Patentability Report" when Filing a Patent Application

`Dear Patent Office,

I have just been discussing this matter with my colleagues in the law firm. If the "Patentability Report" rule is implemented, we will probably file PCT's as the first application and designate the Korean Patent Office as the Search Authority. When we enter the national phase, we will submit the search report as the "Patentability Report." This is the safest course for us and other private practice firms.

Janal Kalis