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April 28, 2006

VIA E-MAIL AND REGULAR MAIL

The Honorable Jon Dudas
Under Secretary of commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
Mail Stop Comments
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Robert W. Bahr
Senior Patent Attorney
Office of the Deputy Commissioner
for Patent Examination Policy

Re: Comments on Proposed Rules: "Changes to Practice for the Examination of Claims in Patent Applications"
71 Fed. Reg. 61 (January 3, 2006)

Comments on Proposed Rules: "Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims"
71 Fed. Reg. 47 (January 3, 2006)

Dear Under Secretary Dudas:

The comments recently provided by the American Intellectual Property Law Association (AIPLA) regarding the above proposed rules express my opinion most eloquently. I strongly recommend that they be given due consideration.

I also have additional comments that warrant your consideration. The first relates to the inclusion of a Request for Continued Examination (RCE) with the other continuing applications in the proposed rules. I think that is a mistake. The RCE has been a very effective tool for efficient patent prosecution. Very frequently the examination of a patent application cannot be completed in the sequence of an initial office actions, a response by applicant and a final rejection. The only way to receive consideration of claim amendments by the Patent Office Examiner for a second, after final response under the present rules is to file an RCE or file an

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appeal. The latter is not very efficient prosecution. Filing an RCE with an amendment after final frequently results in concluding the examination. To include the RCE as a continuing application in the proposed new rules can prelude an applicant from effectively covering other aspects or embodiments which are disclosed in the application. To that end, I would recommend that the RCE be deleted from the list of continuing applications from the new rules.

Secondly, I would like to provide an example of the application of the present rules and their beneficial effects for an individual inventor. The inventor developed an improved intracorporeal/intravascular catheter that has been most successful in angioplasty, stent delivery and other procedures. An initial application was filed, three additional continuing applications were necessary for the first allowance and thirteen additional patents issued to cover the various embodiments disclosed in the original application. A list of the issued patents are attached hereto. If the proposed new rules were in effect at the time these applications were filed, the applicant would not have the patent protection he has today. Several of the patents have been litigated and found to be valid and infringed by both the District Court and the Federal Circuit Court of Appeals. They have been widely licensed throughout the medical device industry for substantial royalties. It is truly an example of the U.S. patent system working as it should be working for the individual inventor. The proposed new rules will not due that. They will benefit primarily those large companies who wish to use the developments of others but do not wish to pay royalties for them.

The solution to the Patent Office problems set forth in the AIPLA comments regarding the above is a sound one. Substantially higher fees for claims, both independent and dependent over a certain amount would significantly reduce the Examiner workload. The European Patent Office has found that to be effective. The U.S. Patent Office should try the AIPLA solution before such drastic changes are made in the practices for continuing applications and the examination of claims.

Sincerely,

Edward J. Lynch
Esquire

EJL/aml
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LIST OF PATENTS

5,061,273
5,300,085
5,350,395
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5,685,312
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6,165,197
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