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To: AB94Comments

Subject: Comments on Notice of Proposed Rule Making: "Changes to Practice for the Examination of Claims in Patent Applications"

Attached are Microsoft's Comments on Notice of Proposed Rule Making: "Changes to Practice for the Examination of Claims in Patent Applications." We appreciate the opportunity to provide these comments. Please do not hesitate to contact us should you have any questions concerning our comments.

Best regards,

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April 28, 2006

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Comments on Notice of Proposed Rule Making: “Changes to Practice for the Examination of Claims in Patent Applications”
Federal Register/Vol.71, No. 1/January 3, 2006

Microsoft appreciates the opportunity to offer comments on the notice of proposed rule making relating to changes to practice for the initial examination of designated claims published in the Federal Register on January 3, 2006. In concert with our comments below, we generally support the proposed changes relating to the designated claim practice, and commend the USPTO for its commitment to do a better, more thorough examination and thereby improve the quality of issued patents.

Within the past several years, Microsoft has grown to be one of biggest customers of the USPTO. In 2005, we had the third largest number of published patent applications by the USPTO and are currently prosecuting well over 10,000 pending applications. We employ the services of over 100 patent practitioners around the country, were the 18th largest recipient of U.S. patents for 2005, and just recently received our 5,000th U.S. patent.

As articulated in the Notice, the proposed rules are to focus the initial patent application examination by limiting the number of claims to no more than 10 representative claims, and if applicant wishes more than 10 claims be examined, an “examination support document” must be provided. The Office states that the changes would permit them to do a better, more thorough and reliable examination since the number of claims receiving examination will be at a level which can be more effectively and efficiency evaluated by an examiner.

We are totally supportive of this type of initiative that will deliver these types of objectives. Enhancing the quality of granted U.S. patents is vital to the proper functioning of the patent system, and we take that responsibility very seriously. We have consistently, and openly, supported initiatives that improve the quality and efficiency of the examination process.

We agree with the Office that efficiencies can be gained by limiting the number of claims to be examined, and the claim breath available from the examination of at least 10 independent claims should be sufficient to cover the majority of inventions from a myriad of perspectives. As pointed out by the Office in the Notice, “this proposal will allow for the examination to every independent claim in 98.8 percent of the applications filed since January 1, 2005, without any additional effort by the applicant.” To maintain this efficiency gain throughout the prosecution process, the Office needs to address and specifically account for the possibility that limitations from unsearched dependent claims are incorporated into an independent claim in response to an Office action. Examiners may have to repeat searches and thereby lose any efficiency gain that may have been realized in the initial examination.

The proposed rules provide that a dependent claim will be considered to be an independent claim should the dependent claim not incorporate by reference all the limitations of the claim it references or the dependent claim is directed to a different statutory class of invention than the claim from which it depends. The proposed rules also provide that multiple dependent claims will be considered to be the number of claims to which direct reference is made for purposes of calculating the 10 representative claims. Microsoft supports both of these requirements as being fair and consistent with the intent of the proposed changes.

The availability to an initial examination of representative claims including all the independent claims and designated dependent claims up to a total of 10 without the submission of an “examination support document” will address the vast majority of the inventions being claimed in Microsoft patent applications being filed today. The Office has indicated that the examination of the dependent claims that are not designated for initial examination will be deferred until the application is in condition for allowance and will be examined for compliance with 35 U.S.C. 101 and 35 U.S.C. 112. This does raise an issue that needs to be addressed before final implementation of the rule changes. Since non-designated dependent claims will not have received a patentability determination over the prior art, this may create a cloud of uncertainty on the presumption of validity of those dependent claims should the independent be found

unpatentable over prior art in litigation. Additional procedures may have to be put into place to either address this issue before the application is allowed by the examination of the claims at least with respect to the art of record, or through a revision of the reexamination procedures.

We support the proposed changes to 37 C.F.R. 1.105 that applicant may be required to set forth where in the specification of the application written description support can be found for the invention defined in the claims when it is not readily apparent in clear, concise, and exact terms as to enable a person skilled in the art to make and use the invention under 35 U.S.C. 112 (1). These changes help both the quality and the efficiency of the examination process.

The proposed changes set forth a new section under Rule 1.261 requiring applicant to prepare and file an “examination support document” should applicant request the examination of more than 10 claims. Microsoft is supportive of such an initiative since it places the option on the number of claims being examined in the hands of the applicant without absolute limits on the number of claims that will be examined, and it helps the Office in sharing the responsibility for the efficiency and quality of the examination process. In order to make the “examination support document” less of a liability on applicants and their counsel, the Office needs to provide a certain amount of duty of candor safeguards in 37 C.F.R. 1.56 for good faith efforts by individuals responsible for filing and prosecution of the patent application. Also, in those situations where the number of claims designated for examination is greater than 10, but an “examination support document” has been omitted, the Office notice requesting the document should allow for a longer period to respond to the notice than a non-extendable one month time period. The notice should at least allow for an extension of time similar to extension of time procedures in reexamination practice.

While we appreciate the intent of the proposed changes to 37 C.F.R. 1.75(b)(4), the simple criteria of an application containing similar disclosure, one inventor in common, possible support under 35 U.S.C. 112(1), and common assignment does not automatically lead to a conclusion that the claims are patentability indistinct since only slight dissimilarities in the disclosure can lead to distinct claim breath and support. Proper statutory support for the claims in one application may be totally different than the statutory support for the claims in a similarly disclosed, but not identical, application. This issue may be addressed by an obviousness-type double patenting rejection by the examiner during the examination process and answered by applicant’s response. This may be also an opportunity for the granting of a pre-first office action personal interview to review the inventive concepts claimed in the applications and save the examiner time in delineating the differences.

The proposed changes are to be applicable to any application filed on or after the effective date of the final rule, as well as, “to any application in which a first Office action on the merits was not mailed before the effective date of the final rule.” The Office specifically requests suggestions for ways to make the changes in the final rule less burdensome to applicant as they effect pending applications. One way to address the

burden, and also create a level playing field for all applicants, is to make the changes applicable to applications filed on or after the effective date of the final rule, as well as, to exempt applications having a filing date older than one year from the effective date of the final rule. This treats all applicants and technologies equally, irrespective of the backlog differences across all technology areas, and addresses a significant portion of the backlogs now pending with the Office.

We appreciate the opportunity to provide comments on the proposed rule changes and commend USPTO's efforts to provide for a more focused, efficient, and improved quality examination process. Should you have any questions concerning our response, please contact us at the address below. We are always available to assist the USPTO in any further partnership needs.

Respectfully submitted,

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