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From: Mullen, James J. [mailto:jmullen@mofo.com]

Sent: Wednesday, May 03, 2006 6:13 PM

To: AB94Comments

Subject: Comments Regarding Proposed Changes to Practice for Examination of Claims in Patent Applications

Mail Stop Comments-Patents

Commissioner of Patents

P.O. Box 1450

Alexandria, VA 22323-1450

Attn: Robert A. Clarke

Re: Comments Regarding Proposed Changes to Practice for Examination of Claims in Patent Applications

The U.S. Patent and Trademark Office (PTO) has requested comments regarding proposed changes to the current continuation practice. The notice of proposed rule making of January 3, 2006 (71 Fed. Reg. 61) announced the PTO's intention to focus its initial examination of patent applications on a set of ten claims designated by the applicant as "representative claims." It is the PTO's view that limiting initial examination to these ten representative claims (unless an examination support document is provided) will increase the efficiency of examination.

The PTO argues that the Board of Patent Appeals and Interferences (BPAI) and the courts commonly employ some form of representative claims to focus and manage issues in a case. While this observation is correct, minimally as it applies to the BPAI, the issues involved with an appeal differ from those at play when claims are being examined. Generally, only a single issue or a small set of issues are considered when a case is advanced to appeal. In contrast, claims under examination are reviewed for novelty, nonobviousness, written support, enablement and utility. Forcing applicants to designate representative claims in an application bears little resemblance to the appellate process. Thus, using appellate procedures makes little sense in the patent examination context.

The PTO has alleged that forcing applicants to identify representative claims will ease the burden of examination. However, any perceived benefits to the proposed system are illusory. The PTO's proposed system will perform an initial examination on the representative claims and then a secondary examination after the representative claims have been found patentable. This process will force examiners to repeat their efforts as they review non-representative dependent claims for the indicia of patentability. This proposed bifurcation of examination adds more work to the examination process, thus adding delays and lengthened pendency for patent applications.

An additional and unintended consequence to the proposed rule change is that it will encourage the preparation and filing of claim sets designed to provoke restriction requirements. The proposed rule making notes that few patent applications filed under the present rules contain more than ten independent claims. However, in view of the PTO's intention to limit continuation practice and to limit the number of claims considered for examiner, applicants will be incentivized to draft ten independent claims to maximize coverage for the disclosed invention. Patent examiners, in an attempt to issue a first Office Action within fourteen months of the filing date, will continue the

present practice of issuing a restriction requirement as the first Office Action in the case, dividing the claims at least ten ways. Applicants will then have the right to file nine divisional patent applications, each with ten more representative independent claims, which will prompt ten ten-way restrictions, and so forth. The number of potential divisional applications will increase exponentially, and rather than focusing the examination process, the PTO will force patentable subject matter through a sieve, like meat through a grinder.

With regard to the examination support document which would be required for consideration of more than ten representative claims, it is extremely unlikely that any applicant would willingly submit such a document. The detailed showing under proposed section 1.261 requires an applicant to 1) conduct a preexamination search, 2) file an information disclosure statement indicating the most closely related art to the designated claims, 3) identify the limitations in each of the representative claims that are disclosed by the cited references, 4) provide a detailed explanation of how each claim is patentable over the cited references, 5) provide a concise statement of utility for the claims, and 6) provide a showing of written support in the specification. The costs for making such a filing are so high, that they will effectively prevent any applicant from including more than ten representative claims in an application.

In addition to the representative claims proposal, the PTO has requested comments regarding how claims written in the alternative form, such as Markush claims, should be counted. The PTO asks whether each alternative should be counted as a separate claim. The PTO also asks whether each alternative should be counted as a separate claim, unless the applicant shows that the alternatives include a common core structure and common core property or activity.

If the PTO adopts the proposed representative claims rule, it will move U.S. patent practice toward the European style claim sets, but without the benefit of multiple dependent claims and claims stated in the alternative. The adoption of the proposed representative claim strategy without the ability to claim in the alternative puts all the burdens of the European system on applicants without any of the benefits.

Rather than adopting the proposed rules, the PTO should adopt a new fee structure that imposes an ever increasing cost on applicants who file more than ten representative claims.

Respectfully submitted,

James J. Mullen, III

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