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**To:** AB94Comments

**Subject:** Comments on proposed rules changes for examination practice

The proposed rules will unduly increase the burdens and costs of practitioners and patentees, without providing practical relief for the USPTO. Instead, the rules will simply shift the backlog from examiners to the BPAI and to those deciding petitions, and will bog down applications in the discussion of trivia not materially related to patentability.

The USPTO's estimate of the monetary cost of preparing an Examination Support Document (\$2,500) is totally inadequate. As suggested by the AIPLA in its Comments on Examination of Claims Practice, the Document will more likely cost on the order of \$18,000. However, it is unlikely that many such documents will be prepared, as the requirements are so odious, and create such extensive estoppel, that it would be borderline malpractice to actually attempt to prepare such a document for submission to the USPTO. Instead, the requirements will create a *de facto* rule that no more than 10 independent claims may be presented for examination in an application. This limit is especially troubling when combined with the other proposed rule to limit continuations, as it effectively creates an absolute limit of 20 independent claims for any given area of inquiry (since the continuation rules may require merger of applications with overlapping disclosure even when their claims do not overlap).

Even if applicants limit their applications to 10 independent claims presented for initial examination, it will not significantly reduce the burden on examiners in searching or in examination. It appears that the Office envisions that the rules will relieve examiners from having to "chase down" a reference for each limitation of each dependent claim in an application. However, if an applicant desires a full initial search of all possible limitations of a claim, he can simply make one of his 10 elected claims a "picture claim" containing every limitation he believes might reasonably distinguish over any art that might be uncovered in examination. This practice will obviate any savings of time or effort for the examiner, and will enable the applicant to obtain a full search and examination. Although it has no real legal benefits outside of patent prosecution, it can be expected to become standard practice if the new rules are put into effect. This is particularly true if the proposed rules on continuation practice are also adopted, since the very limited number of exchanges with the examiner that would be permitted would create a strong incentive to have every conceivable potential issue before the examiner from the first action.

Even if an applicant does submit an Examination Support Document, it will not eliminate the examiner's obligation to search and to independently examine the application. The examiner should still be required to search, at a minimum, for "hidden prior art" under 35 USC 102(e). However, the existence of an Examination Support Document may motivate the examiner to skip doing an independent search, and to simply take the applicant's word for the content of any references, leading to lower issued patent quality.

Finally, especially when combined with the proposed limits on continuation practice, the proposed new rules will simply create new battlegrounds for issues that do not ultimately relate directly to patentability. Applicants will have a much greater incentive to fight every determination that cases have "substantially overlapping disclosures," every determination that a dependent claim will be treated as independent for claim counting purposes, every restriction requirement, and every determination that a Markush group is too extensive for the initial patentability search. While it is not clear which of these decisions would be petitionable under the rules, and which appealable, it is certain that practitioners will take every avenue to contest them in the attempt to vigorously represent their clients' interests. Such disputes are ultimately irrelevant to what should be the goal of the USPTO: issuing patents covering that which has actually been invented, no more and no less.

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