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From: Bryan Ruffner [mailto:uspto_posting@ruffner.net]

Sent: Tue 5/2/2006 9:37 PM

To: AB94Comments

Cc:

Subject: Comments regarding proposed rules published at 71 Fed. Reg. 61

I am an independent inventor who has been granted seven U.S. patents. I appreciate this opportunity to submit my comments regarding the proposed rules published at 71 Fed. Reg. 61.

The premise for the proposed rule change is that patents with large numbers of claims are responsible for the current examination backlog. I disagree for the following reasons:

An examiner will usually divide an application with a large number of independent claims into a set of Divisional applications. The applicant must pay a separate fee for each Divisional.

Any claim dependent on an allowed claim is by definition allowable because it is narrower in scope. The applicant has an interest in including claims that are narrower in scope than that for which he feels entitled because these claims can be used as a fallback position if the patent becomes subject to litigation. The examination of such claims is perfunctory. They do not clog the examination process.

An application with several tiers of dependent claims can move more quickly to allowance because it gives the examiner greater resolution in separating the submitted art from the prior art. For instance, the examiner may state, "Claim 1 is rejected, but Claims 6 and 7 would be allowable if submitted as independent claims incorporating the limitations of the claims from which they depend."

Many patent lawsuits have focused on how well an applicant has conformed to Rule 56. As a result, applicants are protecting themselves by citing every conceivable reference in their applications. The examiner must review each document no matter how trivial it may be to the examination. Rule 56, not excessive claims, is clogging the review process.

If an applicant wants the examiner to review more than ten claims, the proposed rule change would require him to specify the prior art search he did and compare his claims against what he decides are the closest prior art. When Rule 56 met the courts, the examiner's workload soared. If this proposed rule meets the court, the results will be worse. Through this rule, the USPTO is asking the applicant to do the examiner's job and every statement the applicant makes will come back to haunt him in court. The applicant's legal costs will soar. Applicants' attorneys will develop a defensive strategy. I cannot say what that strategy will be, but if Rule 56 is an indicator, it will cause a net loss in examination efficiency.

I feel that a solution to the backlog problem should be found through improved training, and higher retention, of examiners. The USPTO is investing precious resources training

examiners who quickly exit to become patent attorneys or pursue other careers. Experienced examiners are stressed because they are spending a substantial percentage of their time supervising and training new recruits.

The USPTO has experimented recently with an in-house training academy. I strongly support this approach. I think recruits would benefit from the camaraderie of being part of a class being taught by select experienced examiners who enjoy, and are skilled at, teaching. The USPTO should consider teaming with one of the local universities to provide such training as part of a degree program. George Mason University, in Fairfax, would be a logical choice. Academy graduates would enter the USPTO much better trained. They would provide useful output more rapidly and be far less of a drain on the time of more experienced examiners. This change would improve morale. The better work environment and a step up in salary would substantially reduce attrition. The net result would be an improvement in patent quality and a reduction in backlog.

An applicant, in many other countries, can defer the examination of his patent through the payment of a small annual fee. I think applicants, and the USPTO, would benefit from the adoption of such a program here in the United States.

Few patent holders make a profit from their invention. Two positive outcomes would result if patent holders were allowed to defer examination until they are able to license or manufacture their product. First, applicants could make sure they are only spending legal fees pursuing patents linked to profitable products. Second, the number of examinations requested would drop dramatically because only profitable products would be examined.

Deferring examination until a revenue stream exists would enable even independent inventors to be able to afford a higher examination fee. The examiners would then have more time to spend on fewer applications. The result would be better quality patents. Better quality would, in turn, make it more difficult to challenge patent rights in court. A reduction in patent litigation would encourage innovation and be beneficial to the business community.

The deferred examination program could be easily implemented. The complicating factor concerns publication. Applicants will want publication deferred as well, but the patent system is premised on the concept of providing IP protection in exchange for disclosure. In his PCT application WO 00/77713 A2, Frampton Ellis provided innovative strategies for handling the publication of applications for which examination has been deferred.

In summary, I feel that the proposed rule changes regarding claims will be counterproductive. Instead, I think the USPTO could eliminate their backlog by expanding their training-academy program and implementing a deferred examination option.

Sincerely,

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