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From: Gerald J. Stanton [mailto:gstanton@hspatent.com]

Sent: Saturday, January 28, 2006 10:45 AM

To: AB94Comments

Subject: Comment on Proposed Rulemaking

RE: Proposed Rulemaking for Examination of only Representative Claims:

Comments:

Issued patent claims carry a presumption of validity because they have been examined by the PTO. Assuming that all independent claims are in condition for allowance, then any unexamined dependent claims are patentable for their dependence from the allowed claims. The proposed rule effectively avoids any substantive examination of the non-representative dependent claims. There must be some mechanism to ensure that Examiners actually perform a substantive examination on such dependent claims, else they will merely concede patentability based on dependence from the examined and allowed independent claims. A substantial problem would otherwise arise with patent claim enforcement. If there is no forced substantive evaluation of a dependent claim, it appears that courts would over time weaken the presumption of validity for those claims not "examined" until their parent independent claim is allowed.

Further, the very election by the applicant of which claims are representative might be used against the applicant once a patent is issued. This rule would tend toward courts considering those claims not asserted as representative as being outside the protectable "invention" as opposed to those asserted as representative. The comparison to appeals to the Board of Patent Examiner's fails to account for the fact that in such an appeal, the Applicant is apprised of specific prior art whereas in an application, often the Applicant has not conducted his/her own search and must determine representative claims with much less relevant information.

The proposed rulemaking asserts that a small percentage of applications take up inordinate examiner resources. Rather than burden all applicants with the requirement of choosing which claims are representative, perhaps a better solution would be only to require excess claims over a certain number will be examined only when they are filed with an independent search report, similar to one aspect of the proposed rule.

Respectfully,

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