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**Sent:** Wednesday, May 03, 2006 5:56 PM

**To:** AB94Comments

**Cc:** Tanner, Daniel A.; Miller, Robert A.

**Subject:** Comments Relating to Proposed Rules Docket No.: 2005-P-067

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MESSAGE:

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Please see the attached Comments.

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**By E-mail**

Attn: AB94Comment@USPTO.gov

Re: Comments Relating to Proposed Rules  
Docket No.: 2005-P-067

Dear Sir:

Please consider the following comments relating to the January 3, 2006, proposed rule changes entitled "Changes to Practice for the Examination of Claims in Patent Applications."

I am very concerned that the outlined provisions will prove extremely prejudicial to virtually all Applicants attempting to effectively and efficiently seek protection for their inventions, while at the same time decreasing the efficiency of the Patent Office and increasing its backlog. Additionally, careful review of the proposed rule changes indicates that Applicants, and Practitioners alike, will have to be very wary in complying with the rules, if they are amended in the manner suggested, or they will leave themselves open to improper charges of inequitable conduct.

I offer the following detailed analysis regarding why I believe that these proposed rule changes should be scrapped altogether. Failing that, I offer alternatively suggestions regarding significant modification to the proposed rule changes to better focus on the real issues without introducing gross burden and prejudice to Applicants in the preparation and prosecution of virtually every patent application.

**I. The Proposed Rule Changes Do Not Address The Problem**

Generally, I cannot understand (1) how these proposed rule changes are reasonably envisioned to decrease the backlog in examination, an objective to which I understand they are directed; and (2) how a problem that, by any measure, is estimated to affect less than two percent of pending patent applications should be addressed by sweeping rule changes that will increase the workload of Applicants, Practitioners and Examiners in the formulation, filing, prosecution and examination of virtually every patent application, *i.e.*, every application with more than ten total claims. I believe that the proposed rules changes will significantly increase rather than decrease the workload on the examining force.

A realistic result of the proposed rule changes is that they will add to an Examiner's already burdensome workload rather than streamlining it. An Examiner must: (1) still consider the totality of the claims presented for a Restriction and/or Election of Species Requirement; (2) review the number of claims and their designations as independent or dependent; (3) review related applications for related claims that may result in a determination, albeit subjective, that an Applicant has attempted to have initially examined more than ten claims directed to a single invention; (4) levy a requirement for an Applicant to designate representative claims and/or to produce examination support documents based on the analysis under (2) or (3); (5) consider the sufficiency of the examination support documents, when filed; (6) issue communications challenging the sufficiency or completeness of Applicant's designations and any associated documents; (7) potentially re-restrict an application; (8) perform a complete independent search and examination of designated claims, or ten-plus total claims regardless of any information or patentability assertions made in examination support documents; (9) perform a different search and examination of claims designated after amendments are made in response to an Office Action; and (10) once having searched and examined the designated claims and found them to be allowable, go back and search and examine the remaining undesignated dependent claims.

The Office's overall workload will also be increased, at least initially, because the proposed rule changes will result in significantly increased petitions practice. Petitions to have information considered and petitions to withdraw holdings of abandonment, at a minimum, will be necessitated in a substantial number of cases. Processing each of these petitions will reduce the efficiency of the Office as a whole. The Office, in fact, recognized the gross inefficiency in petitions practice for routine matters years ago when petitions to justify every request for an extension of time were eliminated. The burden of processing those petitions was deemed to great. Such consideration needs to be given to this practical effect of these proposed rule changes. Applicants and Practitioners will have to completely rethink the manner in which they draft and prosecute patent applications. This is particularly important because the proposed justification requirements open everyone up to exposure to charges of inequitable conduct for innocent oversight, rather than any action by which an Applicant or Practitioner may be adjudged to truly be acting inequitably.

## **II. The Proposed Rule Changes Transform The Role Of The Patent Office**

It is my belief that the Patent Office, if these rule changes are implemented in any manner close to that which is proposed, should remove all of the signs in its hallways and offices that allude to the Patent Office's mission being one of granting patents. The difficulties and procedural impediments that these proposed rule changes will create conceptually shift the Patent Office from a patent granting organization to a patent denying organization. Paraphrasing a position that I have heard from other practitioners, these proposed rule changes virtually codify piecemeal patent prosecution.

**III. The Proposed Rule Changes Are Confusing And Incomplete**

The proposed rule changes are sweeping. I am troubled that such significant effort seems to have been expended in addressing ways by which Applicants and/or Practitioners may be predicted to later try to "game" the system. This focus has resulted in the proposed rule changes being unclear and/or incomplete in addressing several issues. Principal among these are questions regarding prosecution practice, and specifically the effects of the proposed rules changes when claims are canceled or amended. For instance:

a. If a designated claim is canceled, is it necessary or possible for the Applicant to designate other claims?

b. In amending claims, is there a difference between incorporating subject matter directly from the specification, or amending, for example, designated independent claims to incorporate the subject matter of non-designated dependent claims?

c. If there are eleven independent claims, why is justification required for all eleven claims rather than just the one that the Applicant may wish to file over the ten that the Applicant should be allowed given any interpretation of the proposed rule changes?

d. Why can Applicants not receive substantive examination of claims for which they have paid the appropriate fees?

e. What precisely is the status of the undesignated claims after a second action Final Rejection of the designated claims? In other words, is prosecution closed as to those claims as well?

f. Related to e. and given the coupled proposed limitations on continuations practice, will Applicants be afforded any opportunity to amend claims that already exist, re-designate claims and/or file one or more continuation applications directed to subject matter that may have otherwise been deemed "allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims?"

g. Will Applicants be permitted to completely amend their designations, *i.e.*, designate an entirely different set of claims, in view of a rejection, or will the designation be deemed to carry the weight of, for example an election under Restriction or Election of Species practice?

Applicants and Practitioners alike will need clarification of all of these issues should these proposed rules changes be maintained in any manner close to that which is proposed.

**IV. Patent Office Internal Review Should Be Undertaken  
As A Precursor To Any Other Proposed Rule Changes**

In an April 25, 2006 Town Hall Meeting regarding the proposed rule changes at the U.S. Patent and Trademark Office, Commissioner Doll indicated that the Office would be willing to "trash" the current proposal if better suggestions were provided. The presentation that day went on to indicate that other proposed rule change packages are in progress. I am intrigued that on the list of other areas requiring review was an indication that a proposed rule change package would be forthcoming regarding internal Patent Office procedures. The fact that a review of internal Patent Office procedures is contemplated is heartening. On the other hand, I sincerely believe that such a review, and any proposed rule changes to arise from such a review, should be undertaken first rather than last as was intimated by the presentation. Certainly, such a review and any proposed rule changes should predate any other proposed broad changes in the current rules.

**V. The Limitation Of Claims Should Be  
Structured To Address The Specific Problem**

In specific reply to the Commissioner's challenge, I believe that proposed rule changes regarding designating a number of representative claims, if some form of their implementation is unavoidable, should be reserved to only those patent applications that create real problems. Patent applications with ten, twenty, thirty, even fifty total claims are not the real problem. A better solution would be to have the proposed rule changes apply only to patent applications with more than twelve independent claims, or applications with some inordinately high number of total claims, *e.g.*, in excess of 50. At least for the reasons set forth below, the number of total claims identified as representative, and therefore warranting initial examination must be some number greater than the twenty claims for which Applicants pay for examination under the current fee structure. I adamantly support AIPLA's position, as an absolute minimum, that any patent application with six or fewer independent claims, and thirty or fewer total claims, should be exempted from any of the proposed additional requirements set forth in the rule making package.

**VI. The Adverse Impact Of Retroactive Implementation Is Incalculably High**

Also, I am most emphatic in my concern that any proposed rule changes in this regard should not be imposed retroactively. The potential administrative burden to Applicants, Practitioners and particularly the Patent Office for retroactive implementation is literally incalculable. Applicants would be required to either designate ten representative claims, or to justify why more than ten claims should be initially examined, in a substantial percentage of an estimated 700,000 pending patent applications. Examiners would have to review each pending patent application to identify those to which some additional pre-examination administration may apply based on the proposed rule changes. Patent Office communication would be required

regarding the identified patent applications. Applicants would then have to respond according to the proposed rule changes. The flood of additional paperwork that would be required by retroactive implementation of any proposed rule changes in response to this determination has the potential of bringing the Patent Office to its knees for years to come.

Additionally, there is no indication regarding whether priority would be given to (1) adjudication of the requirements imposed by the rule changes with respect to the substantial, and as yet unidentified, percentage of 700,000 pending patent applications thereby further forestalling prosecution on these pending applications, or (2) intake of new patent applications, and examination and allowance of non-involved pending patent applications.

Moreover, not only should any such proposed rule changes not be retroactively applied to patent applications that are already filed, but I propose that they be given effect only as to new patent applications filed after some period of time has elapsed subsequent to when the final rule changes are promulgated. My plea for a waiting period subsequent to the promulgation of the final rule changes is based on my belief that significant changes will be required to the procedures by which we draft and prosecute new patent applications. Based on the sweeping effect that any version of these proposed rule changes has the potential to introduce, some period of transition is an absolute requirement. Practitioners will need to evaluate the effects of these changes and be afforded an opportunity to advise their clients appropriately. Also, the system cannot afford for Practitioners to halt ongoing efforts in preparing pending, unfiled patent applications. In other words, everyone will need a minimum of six months from promulgation of the final rule changes to the rule changes being given effect to respond to the rule changes while limiting the burden on the Applicants to any extent possible.

## **VII. The Proposed Rule Changes Are Contrary To The Law And Precedent**

Modifying the rules in the manner suggested, *i.e.*, requiring Applicants to designate claims in a patent application as representative, has the potential to structure the examination of patent applications in a manner that was never envisioned, nor can reasonably be considered to be sanctioned, by the law. Specifically, 35 U.S.C. §102 provides that a person "shall be entitled to a patent unless..." It is incumbent upon Applicants to structure their applications with claims that best define their inventions. Requiring Applicants to designate "which" of these claims are "representative" restricts Applicants' ability to claim the subject matter of their inventions in compliance with 35 U.S.C. §112, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs, and in a manner that may actually support effective and efficient prosecution. The proposed one-size-fits-all approach of ten representative claims simply does not work, and is not sanctioned by the law, as it exists today.

Under the current version of the proposed rule changes, examination will not proceed regarding the totality of the claimed invention against the totality of the prior art in virtually any patent application. Rather, examination will be broken up and directed in a manner that is based on incomplete knowledge of what may or may not exist in the prior art. Applicants may choose

representative claims that are closer to, or just as easily farther from, the prior art than others. The totality of the claims may never receive a fair hearing based on those claims that the Applicant designates prior to any search or examination. This is the very definition of piecemeal prosecution. Rather than the ultimate patent claims being based on a full analysis of the relevant prior art, many claims will never be searched. An unwanted side effect will also be that designated claims have the potential, initially, or more importantly, later in litigation, to be considered "more important" than others on a basis not reflected by strictly patentability issues.

A rationale of burden sharing for examination on the Applicant is contrary to the mandate of Congress in 35 U.S.C. §102. That statute mandates that an Applicant is entitled to a patent "unless...." The "unless" does not place upon the Applicant the burden of proving entitlement to a patent on unexamined claims, particularly when such burden may potentially lead to diminution of the Applicant's rights based on actions that the rules may require Applicants to undertake. Such diminution would inevitably arise from admissions that an Applicant would be required to make to obtain full examination of his or her claims, which admissions will be construed as sworn statements by the Applicant and/or Practitioners, that will later be used against them. These points alone require, in my opinion, a rethinking of the objectives and the structure of these proposed rule changes.

### **VIII. The Practical Effects Of The Proposed Rule Changes Have Not Been Evaluated**

Virtually all Applicants and Practitioners will be required to re-evaluate the manner in which they file patent applications. A decision will have to be made regarding whether to file an application with only ten claims to avoid the rule changes completely. This is particularly important given the other tentacles of the proposed rule changes, as apparently, for example, an evaluation of other related patent applications will be undertaken to determine whether an Applicant has attempted to file more than ten claims to a single invention in two separate patent applications. In some yet to be defined manner, related patent applications will be separately evaluated. These applications may then be linked for initial examination and only ten claims will be reviewed from the combination of applications. The proposed rule changes provide for such a review, but the mechanics of this review are unclear. The Office seems to be imposing on itself additional administrative burdens not related to substantive examination of claimed subject matter on the merits.

Under the proposed §1.75(b)(2) when a dependent claim depends from a claim of a different statutory class, *i.e.*, a proper dependent claim referring to an independent claim of a different class, it will be treated as an independent claim for fee calculation purposes under §1.16 and for the purposes of claim counts under §1.75(b)(1). This is not only a tricky fee structure but it is a trap for the unwary regarding dependent claims in a different statutory class being designated differently than they were when filed. It should be recognized that this determination of whether claims are independent or dependent is today a clerical, administrative or ministerial decision that does not require Examiner involvement. Under the proposal, an Examiner's evaluation will be required to determine claim classification and the associated fees. This

concept increases an Examiner's non-substantive examination workload and also may be contrary to the judicial precedent set forth in *In re Ochiai*. Treating such a determination of the nature of claims differently under a new set of rules than it has been treated in the past for either fee calculation purposes or for examination purposes will further burden the Office.

Many other additional pre-substantive examination steps are proposed as well. Dialogue between an Examiner and an Applicant, for example, has the potential to go as follows. An Applicant files a patent application and designates ten representative claims. The Examiner then restricts some of these claims. The Applicant, in response to the Restriction Requirement, designates other claims because some of the claims that the Applicant designated initially are restricted out. The Examiner then evaluates this new set of claims. It is unclear from the rules whether a subsequent Restriction Requirement may be issued. If so, it is equally unclear whether a subsequent response may include further re-designation of yet other claims. And, these additional steps take place before substantive examination commences.

The other and even more burdensome scenario to both Examiners and Applicants is one in which the Applicant chooses not to designate ten representative claims, but rather attempts to justify reasons for the examination of more than ten claims. First, this is a trap for the unwary, particularly in consideration of the potential for a charge of inequitable conduct. Such a change may arise when, as part of the justification that the Applicant must provide, an Applicant must search and provide justification for every feature recited in the claims. Showing support for each feature, given a "broadest reasonable interpretation in light of the specification," will significantly increase costs to Applicants. Debate is likely to ensue based on an Examiner's (and later a litigation opponent's) assessment of the information for its completeness. The Examiner may likely later assert, in response to the Examiner's search, that the Applicant's search was flawed and, therefore, the Applicant has not met his or her burden. The threat of abandonment based on such a scenario is a strong motivation to be as thorough as possible, but, as will be discussed below, is too harsh a remedy.

#### **IX. The Justification For The Proposed Rules Changes Is Flawed**

An alleged benefit of the proposed rule changes is to "allow the Office to do a better, more thorough and reliable examination." This benefit is, at best, speculative. It is absolutely unclear that these proposed rule changes address this objective. Even if it is assumed to be true, however, such rationale should not be used as justification for levying such onerous burden on, and/or potential prejudice to, virtually every Applicant. Equally speculative is the conclusion that "these changes will mean faster more effective examination for the typical Applicant." It is incorrect that these benefits will accrue "without any additional work on the Applicant's part." There is no evidence available, much less has any been presented, to support either conclusion. As to the latter, at every turn these proposed rule changes impose additional burden on, and work for, the Applicant.



The supplementary information provided with the proposed rule changes indicates that about 1.2% of all non-provisional patent applications include more than ten independent claims. If it were relevant, this statistic alone would make it incredible to me why the proposed rule changes are even required, and what practical effect they may actually have on the body of pending patent applications, or allowing the Office to do a better, more thorough and reliable examination. In fact, however, the more relevant statistic is how many applications include more than ten total claims, all of which are presently designated for examination.

**X. References To Procedures Before The Board And Courts Are Misplaced**

The supplementary information indicates that the Patent Office conducted a random survey of 500 patent applications where an Appeal Brief was filed, and found that the average and median numbers of representative claims were 2.73 and 2, respectively. In support of the approach taken in the proposed rule changes, the supplementary information points to the use of representative claims by the Board and the courts. However, reference to procedures used by the Board of Patent Appeals and Interferences or the courts are grossly misplaced.

By the time any patent application reaches the Board, the application has already undergone examination of all of the claims, and at least two actions that narrow the focus to representative claims in accordance with the rules and procedures structure, as it exists today. The above-quoted numbers and percentages regarding Appeal practice, as well as the references to Appeal practice procedures, must be read in the context that these inputs are post-examination, post-Restriction and/or Election of Species Requirement, post-Amendment and are applicable where Applicants have decided to continue to pursue patent protection in the face of specific rejections of specific claims based on specific prior art references and specific sections of the patent statutes. Likewise, by the time an application or patent reaches the courts, the Applicant or patentee has already expended significant time and effort evaluating the patentability, and economic and/or business value, of each and every claim involved, vis-à-vis the objectives of the particular court action. These decisions are made in the face of a prosecution history of examination of all claims, often augmented by extensive litigation discovery.

As a result, the Board and/or courts typically do not examine all claims in a patent application or patent, nor are they called upon to do so, in view of a number of other considerations. Rather, designation of representative claims, such as in an Appeal Brief, is in view of the cited prior art and prosecution history, rather than an up front blind guess as to where the examination should be directed. For example, Applicant may designate only specific claims as representative in an Appeal to the Board based on an assessment that only those claims need to be separately argued (1) against a specific rejection made by the Examiner and (2) relying on particularly identified prior art. Such an informed designation of representative claims cannot be made before examination begins where there are no specific rejections and no particularly identified prior art references. For all these reasons, the burden placed upon Applicants at the point of supporting a rejected application on Appeal, or in court, is so markedly different than

that placed on Applicants in initially filed patent applications that the procedures employed before the Board, or in court, cannot reasonably be imputed to initial examination of any, much less virtually every, patent application.

Similarly misplaced are references to the provisions of procedures for requesting accelerated examination, *i.e.*, to make special, which are voluntary for Applicants who wish to avail themselves of the procedures. In circumstances where an Applicant voluntarily chooses to petition for the patent application to be made special, the Applicant is afforded some consideration (*i.e.*, expedited examination) in return for admissions and concessions that the Applicant is required to make under the provisions of the rules to make special. Any reference to these voluntary procedures as applicable to the mandatory procedures imposed on all Applicants by the proposed rule changes is not appropriate. The burden of submitting a statement under the provisions to make special, if undertaken, is voluntary on the part of the Applicant and undertaken in a small percentage of patent applications. Furthermore, unlike with respect to the combination of rulemakings being proposed, the subject Applicants can file continuation applications to pursue other claims for which expedited examination is not needed.

**XI. A Related Proposed Rule Change Was Previously Abandoned**

The supplementary information provided with the proposed rule changes indicates that the Office previously abandoned a proposal to limit the number of total and independent claims that would be examined in a patent application. The rationale for the abandonment of that proposal should be reviewed in light of the current proposal. Specifically, it was deemed inappropriate to limit the number of total and independent claims that would be examined in a patent application. A real result of the proposed rule changes is to effectively limit the number of total and independent claims. If limiting the number of claims presented in an application was deemed inappropriate, it would seem equally inappropriate in an application to limit the number of total and independent claims that would be initially examined where there is no requirement to otherwise restrict the claims on the basis of their subject matter.

**XII. Applicants Should Not Have To Do What The Patent Office Is Paid To Do**

Applicants are essentially being tasked to determine the patentability of any of the pending claims, or the extent of the prior art, by conducting a search. The proposed rule changes would necessitate an Applicants' search on virtually each and every patent application. Search is the job of the U.S. Patent and Trademark Office. See 35 U.S.C. §131. Resources for searching are allocated through claim fees. These claim fees have been arrived at through an assessment of the burden imposed on the Office regarding search and examination of independent and dependent claims. The recently revised fee structure was, we were given to understand, put in

place based on a determination of this allocation of resources. That new fee structure does not appear to have been taken into account in the proposed rule changes.<sup>1</sup>

The proposed rule changes are inconsistent with the recently enacted modifications to the fee structure for fiscal years 2005 and 2006, in which fees were significantly increased for filing additional independent and dependent claims, as well as for filing lengthy patent applications. These changes to the fee structure may result in Applicants voluntarily limiting the number of independent and dependent claims in new patent applications. For example, an application filed in fiscal year 2004 with 7 extra independent claims (10 total independent claims) would have incurred an extra claim fee of \$602. Under the current fee schedule, that same application would incur an extra claim fee of \$1,400. This discussion of proposed rule changes that limit initial examination to a subset of the claims that an Applicant has paid for is, therefore, premature, at least until any effect of the fee increases can be assessed. While limiting the number of claims filed was not defined as an express reason for the fee increases, it is reasonable to believe that the fee increases will have this effect in many cases. To assert that Applicants should not "get what they pay for" is simply unfair.

Additionally, with respect to PCT National Phase applications, for example, required search and/or examination fees may be reduced in certain circumstances surrounding, for example, providing documentation that is much less burdensome than that spelled out in the proposed rule changes. For example, the search fee is reduced by 20% if a copy of the International Search Report is provided, and is reduced by 80% if the International Search Fee was paid to the USPTO. Still further, the search and examination fees are completely waived where the USPTO acted as the ISA or IPEA, and found the claims favorable in terms of novelty, inventive step, and industrial applicability. This fee structure reasonably allocated resources where they are needed.

### **XIII. Applicants' Search And Justification Requirements Are More Extensive Than Those Placed On Examiners**

With regard to the support documentation requirements under §261, Applicants should not have to admit what is disclosed. They should only have to point out examples of what is not disclosed. The requirement that an Applicant's search cover all the features disclosed and/or recited in the claims has the potential to lead to significantly increased workload over that

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<sup>1</sup> I recognize that proposed rule change package discusses the patent fee provisions of the Consolidated Appropriations Act in the context of the request for refund procedures under §1.117(c). These provisions authorizing refunds for canceled claims are applauded and should be continued. Because the current provisions are set to expire, however, on September 30, 2006 and I am given to understand that an earliest implementation date for any proposed rule changes is October 1, I do not further discuss these provisions as discussed in the proposed rule change package.

presently required by Patent Examiners. As discussed above, charges regarding inequitable conduct on the part of Applicants and Practitioners who are attempting to do the best job that they possibly can are likely to ensue as well, particularly given the scope of the Applicants' additional disclosure requirements. Applicants and Practitioners may conduct a search that for some reason is considered not to cover all of the relevant features and/or prior art documentation. If an Examiner subsequently uncovers relevant documentation that seems to cover the subject matter of any of the pending claims, is the Office then going to levy charges against the Applicant or Practitioner for the incompleteness of the search? A litigation opponent certainly will. As defined by the proposed rule changes, an Applicant's search must be more extensive than any ever undertaken by the Office. For example, if the Office is satisfied that a feature is not found in, or obvious from, the prior art, it need not, and does not, waste resources searching for and documenting the existence of every other feature in the prior art. Also, given that the subject matter of pending claims is viewed under a broadest reasonable interpretation in light of the specification, and that this is a subjective measure, it is unreasonable to assume that the Examiner's interpretation will be the same as the Applicant's and/or Practitioner's interpretation. Were this the case, under current practice there would be no reason for Office Actions to be issued at all.

With regard to the subject matter of the pending claims being supported by the specification, the proposed rule changes provide a requirement for a detailed explanation of how each of the independent claims and designated dependent claims is patentable over the references cited and a showing of where each limitation of the independent claims and designated dependent claims finds support under 35 U.S.C. §112, first paragraph. This latter provision clearly requires a subjective analysis and fails to address the fact that it is the specification as a whole that must support the claims. Applicants and Practitioners do not draft patent applications to claim subject matter that they believe is not supported by the specification. It is reasonable, therefore, in response to this last provision for the Applicants and/or Practitioners to assert that the claims are amply supported by the entire specification. This should be the case and should normally be the correct response. A specification may be written in such a manner to identify exemplary embodiments yet cover more than merely the exemplary embodiments. Requiring an Applicant and/or Practitioner to identify specific words in the specification as support for the claim features will lead to debate in prosecution, and later in litigation, that the subject matter of the pending claims is limited by those references in the specification that the Applicant made of record. This flies in the face of "broadest reasonable interpretation in light of the specification."

Extremely troubling also is the provision that the pre-examination search required under §261 must involve not only U.S. patents and patent application publications, but foreign patent documents and non-patent literature "unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated source." This proposal appears to indicate that Applicants will be required to not only search a broader body of prior art that an Examiner may be required to search, but also that, in order to meet the requirements, an Applicant will be required to obtain translations of foreign

documents for evaluation as well. In addition to this, given that "[a] search report from a foreign patent office will not satisfy the requirement," the burden on Applicants is not only higher than that placed on the Examiner, but also appears to imply that the burden on the Applicant is higher than that which may be imposed by any foreign patent office, or by the U.S. Patent and Trademark Office in considering the same inputs from a foreign patent office.

With provisions that the pre-examination search must encompass all of the features of the independent claim and designated dependent claims, and that a search report from a foreign Patent Office will not satisfy the requirements for a pre-examination search, and other such provisions for an Applicant's search, these proposed rule changes place an unprecedented and absolutely unacceptable burden on Applicants to the point that an Applicant is almost forced to designate ten representative claims. The cost otherwise is too extreme. In addition, a non-extendible one-month time period to reply when an Examiner deems an Applicant's initial justification insufficient, a conclusion which the proposed rule changes could justify in literally every case, makes it impossible to correct the difficulty. This action forces the Applicant, under the threat of abandonment, to simply designate ten representative claims and be done with it. In other words, the extensive search and justification requirements, coupled with such a foreshortened time period for rectification, under the threat of abandonment, virtually nullify all of the additional provisions of the proposed rule changes regarding any practice other than designating ten representative claims.

#### **XIV. Chemical Cases Present A Particularly Acute Problem Regarding The Proposed Rule Changes**

The limitation of ten claims is particularly onerous in chemical cases where full protection for an invention often requires Applicants to claim a compound and a composition, directly and with product-by-process claims, a method of making, and a method of use. According to the proposed rule changes, each of these claims will either be initially designated as an independent claim or upon review, because they are in different statutory classes, be deemed to be an independent claim subject to fee and claim counting issues under Rule 75. The practical result is that in any individual patent application, the chemical Applicant and/or Practitioner will be unable to obtain patent protection at the same level as do other Applicants.

#### **XV. Applicants' Burden Increases Inexorably In The Face Of An Overly Harsh Penalty**

Abandonment is an unjustified remedy in a situation where individual Applicants may have provided documentation that the Examiner deems insufficient. A one-month non-extendible period to satisfy the significant search and reporting requirements that are more onerous than any requirements now shouldered by the Office does not help. Practitioners and Examiners will not agree regarding the substance of the support documentation, views on which will be highly subjective. This debate will inevitably take time and effort away from substantive

examination. If agreement is not reached, even after additional documentation is provided, the Applicant faces abandonment. A petition to revive will likely be the Applicant's next action.

I believe that a more reasonable approach under these inherently unreasonable proposed rules is that, should the Applicant's justification, when made, be deemed insufficient, once the Applicant is afforded an opportunity to undesignate certain claims over ten, the Examiner should be directed to undesignate claims and proceed with examination, rather than to abandon the application. Additionally-provided documentation should then be viewed as an aid in streamlining the examination process. Abandonment, and/or the one-month non-extendible due date to correct the documentation to avoid abandonment, are highly arbitrary and significantly prejudicial to Applicants in their honest attempt to exercise their constitutionally mandated right to have their intellectual property protected.

**XVI. Restriction Practice Will Be Disrupted And Made More Laborious for Examiners and Applicants**

The law (35 U.S.C. §121) and the rules (37 C.F.R. §§1.141 and 1.142) already provide a mechanism by which a set of claims that is considered to create an undue burden on Patent Office resources can be modified. The Examiner assesses the totality of the filed claims to determine whether the number of claims to be examined on the merits should be reduced by imposing Restriction or Election of Species Requirements. Imposition of these requirements is often needed when large numbers of independent and/or dependent claims are presented in a single patent application. In fact, Patent Examiners already use the Restriction and Election of Species practice extensively to manage the search and examination of applications.

The proposed provisions leave unchanged the criteria for making a Restriction and/or Election of Species Requirement. Any Restriction or Election of Species Requirement would be based on all the claims pending in the application. In this manner, the Applicant may be required to designate claims for initial examination and yet the Examiner may impose a Restriction or Election of Species Requirement that is independent of this designation. The Applicant will be afforded an opportunity, in replying to a Restriction or Election of Species Requirement, to designate "other" claims, drawn to the elected invention and/or species, for examination subsequent to the Restriction or Election of Species Requirement. On its face, this provision unnecessarily complicates the examination process by increasing the necessary dialog and response requirements between Applicants and Examiners surrounding restriction practice. Applicants may be required to produce multiple responses that the Examiner must then independently review the sufficiency of and consider the effects on the overall claim set in potentially multiple steps prior to substantive examination.

**XVII. Dependent Claims Are Not Filed As Mere Throw-Away Claims Or To Waste Time Or Effort On The Part Of Applicants or Examiners**

The opening assertion in the supplementary information provided with the proposed rule changes is that the current practice for examination of claims in patent applications is less efficient than it could be because it requires an initial patentability examination of every claim in an application. Notwithstanding, the assertion continues, that this effort is wasted when the patentability of the dependent claims stands or falls together with the independent claim from which they directly or indirectly depend. This represents an oversimplification of the examination process. First, it presumes that all of the claims receive that first substantive look individually, which is not the case. Second, it presumes that Examiners do not recognize redundancy in dependent claims and examine accordingly. Again, this is simply not the case.

Based on ever increasing levels of sophistication in technology, and an effort on the part of Applicants to most efficiently prosecute their patent applications, dependent claims are included as reasonable "fall back positions" should the independent claims from which they directly or indirectly depend be deemed unpatentable in light of the prior art. Dependent claims are added to make more efficient the examination and allowance process. Examination of all dependent claims often leads to better understanding of the scope of independent claims and better search and examination of both. Recently, in a patent application with 48 claims, I had an Examiner assert that at least claim 42 was allowable if rewritten in independent form. This helped me focus my efforts in prosecution in consideration of the Examiner's assertion regarding the subject matter of that claim. This is an input that I may not have received under the proposed rule changes, as claim 42 may not have been one of the ten designated claims.

The position that the Office takes with the proposed rule changes could be construed to deem dependent claims, particularly those not initially designated by the Applicant, as mere afterthoughts not worthy of substantive examination. Later, should the independent claim and the series of dependent claims designated by the Applicant be challenged, it would not be unreasonable to argue that full consideration in the examination process was not given to other patentable, and now patented, dependent claims. The features of such dependent claims may, however, be very important in independently preserving an Applicant's rights. The challenge may be to overcome, for example in litigation, why an Applicant did not designate these now all-important claims initially as "most relevant" or "representative of the invention."

Moreover, there may be a patentably distinct feature in one or more of the non-elected dependent claims that may not initially be appreciated by Applicant, like claim 42. These features are examined today. Under the rules as proposed, if the independent claims, and those other dependent claims designated by the Applicant are deemed not patentable, the other dependent claims may never be substantively examined for their independent patentability, regardless of the true state of the prior art. The Office in "proposing to delay the patentability examination of most dependent claims until the application is otherwise in condition for

allowance" would in such a case render the patentability examination of such dependent claims, a nullity, *i.e.*, a step in the examination process that is never reached. This is just wrong. Applicants should be afforded the opportunity to claim their inventions in any manner that the law supports and should be further afforded the opportunity to have each of their claims considered on its merits. That is what Applicants pay for.

### **XVIII. The Proposed Rules Changes Force Applicants And Practitioners To Become More "Creative"**

It is reasonable to conclude that more patent applications will be filed with ten or fewer claims. For example, two patent applications with ten claims each may be filed rather than a single patent application with twenty claims. This practice would avoid a need to (1) designate claims and/or (2) submit a search report, thereby avoiding creating potential estoppels. As such, these proposed rule changes appear to directly conflict with the concurrently proposed rule changes that are intended to control, for example, the total number of patent applications before the Patent Office by modifying continuations practice. As indicated above, current Restriction and/or Election of Species Requirements should adequately limit patent applications that are considered to have too many claims. This practice provides not only appropriate control over numbers of claims, but also over the scope of related patent applications. Divisional applications result rather than multiple initially prepared and filed claim-limited patent applications.

The proposed rule changes seem to cover a number of anticipated potential loopholes by which clever Applicants and/or Practitioners may attempt to circumvent the rules. There is a difficulty with this approach. The Office's focus on attempting to cover all of these bases (1) suggests the rule changes are overly burdensome in their proposed form, and therefore are anticipated to lead to efforts to avoid their impact, requiring additional and ever-increasingly complicated schemes by which to attempt to mediate the potential for abuse; and (2) given the jaded view that the labyrinth of intertwined proposed rule changes suggests that the Office feels is necessary to attempt to close all of these loop-holes, an ever-increasing burden of "policing and enforcement" will be placed on the Patent Office with little consideration afforded to the concerns of the Applicants.

### **XIX. Markush Claim Practice Should Not Be Changed**

The Patent Office requested comments on how claims written in alternative form such as claims in an alternative form permitted by *Ex parte Markush* should be counted for purposes under the proposed rule changes, indicating that the Office may choose to count each alternative in the claim as a separate claim. This interprets *Ex parte Markush* in a manner that was never anticipated. The Markush claim should be treated as one claim regardless of the number of alternatives. In such cases where Markush claims are included, the Examiner can still determine that the Markush claim is improper under existing standards, or require an Election of Species among the alternatives encompassed within the claim.

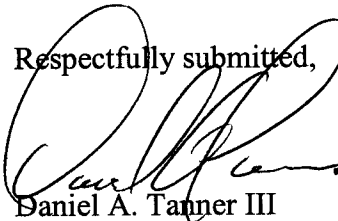


**XX. Conclusion**

In summary, I am gravely concerned regarding the proposed rule changes imposing additional, unwarranted, and significantly prejudicial, burden on Applicants and the Office when (1) any potential benefit of the imposition of such additional burden is purely speculative; (2) the broad implications of requiring the additional burden in virtually all cases, *i.e.*, where a patent application presents more than ten total claims, is not supported by the marginal percentage of patent applications that are deemed to be the cause for concern; (3) reference to voluntary procedures for Applicants incumbent with petitions to make special, and/or representative claim practice post-examination during Appeal and litigation processes, are not germane to the discussion; and (4) other procedures, *e.g.*, fee changes, have been recently enacted that may obviate the purported difficulty therefore rendering the current discussion premature. Again, I cannot overstate my concern regarding the prejudicial effects of the imposition of additional burden, the speculative effects of these rule changes, and the additional administrative burden that they will bring not only on Applicants but on Examiners as well.

I appreciate the opportunity to express my concerns, and the rationale behind those concerns, as outlined above.

Respectfully submitted,



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