

**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Testimony of

Harold C. Wegner

Responsive to the Proposed Rulemaking

**Changes to Practice for the Examination of
Claims in Patent Applications**

71 Federal Register 60 (January 3, 2006)

electronically submitted as claimsAB94wegner at AB94Comments@uspto.gov

Thank you for permitting me to testify concerning the captioned rule-making. This testimony is complementary to the prior submission responsive to *Changes To Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims*, 71 Federal Register 48 (January 3, 2006) – the “Continuation Testimony”, which is available on the Office website, http://www.uspto.gov/web/offices/pac/dapp/opla/comments/fpp_continuation/wegner.pdf

EXECUTIVE SUMMARY

The proposed reform is, *arguendo*, within the statutory authority of the Office; yet, it would be a mistake to short-circuit statutory reform, with serious global repercussions. *See Global Repercussions of an Uninformed Solution* (page 4). A *statutory* solution that would permit up to three independent and a total of ten total claims is proposed for immediate *statutory* implementation. *See “Early Harvest” Statutory Reform* (page 5). Viewed *in vacuo*, limiting a patentee to ten claims may place a case by case burden on an individual applicant; yet, overall, a limitation *for everyone* would share burdens and on balance represent a distinct improvement for both Examiners and industry alike through a simplified understanding of patent scope.

PRO BONO PRESENTATION OF THIS TESTIMONY

I acknowledge my positions as former Director of the Intellectual Property Law Program and Professor of Law at the George Washington University Law School with which I remain affiliated and also as a current partner in Foley & Lardner LLP. The testimony here is *pro bono* and does not necessarily reflect the view of any organization nor colleague nor client thereof.

A MOVE TOWARD PATENT WORKSHARING

As explained in the *Continuation Testimony*, any change should be consistent with the “patent worksharing” goals that should be paramount to any reforms. With respect to a ten claim limitation, this is a step in the right direction *toward* patent worksharing. There will be maximum opportunity for sharing search and examination results only when there is a reasonable cap on the maximum number of claims in a patent.

“CLAIM GAMING”: ENDING AN ABUSIVE PRACTICE

In recent years, there has been incredible “claim gaming” where literally *hundreds* of claims are presented in a single patent application: The name of this claims game is to obtain *one* claim that may be valid, and then to enforce that *one* claim that somehow slips through the patent examination noose... and which may escape detection by industry that is trying to do an intelligent job of policing third party patents but somehow misses the significance of “claim 293” in a 600 claim patent. Claim gaming is an evil that *must* be terminated forthwith.

THE PATENT-DEFEATING RIGHT OF THE FULL DISCLOSURE

As explained in my letter dated February 15, 2006, to the Hon. Jonathan W. Dudas, Under Secretary of Commerce for Intellectual Property, captioned *A Preliminary Response to the Proposed Rules*, “[t]here has been much criticism voiced of the limitation of the total number of claims. Yet, most of the critics are patent agents or attorneys who practice in the electronics or mechanical arts who devote their practice, either due to the limited scope of their licensure or through choice, to grinding out large numbers of patent applications that are keyed to massive disclosure documents provided by corporate departments. If there are, say, 95 separate

embodiments in the disclosure document, then the goal is to have 95 separate claims, plus more for generic coverage and still more for combinations and subcombinations. Yet, this is a misguided goal that does little for the corporate applicant and, in fact is very hurtful as a matter of American public policy: Applications which routinely have, say, one hundred claims are totally unsuited for routine foreign filing. Thus, the American applicant who seeks global protection sends a totally unsuited case to his foreign associates for filing.

“More importantly, anyone who drafts claims which merely ‘fingerprint’ the exact embodiments has no understanding of the role of patent claims which are to *exclude others* from practice of *their* future innovations. (Some have said that if a claim is not made for every one of the, say, ‘95’ embodiments, then a competitor may file a claim to cover that embodiment. To the extent that the competitor’s application is junior to patentee’s filing date, the patentee has a *patent-defeating right* as of his filing date to bar the competitor’s claims. To the extent there is a common feature for a group of claims, then this common feature may be in a subclaim.)”

To be sure, there is a discrimination against a patent based upon a foreign priority application because the United States, in violation of Art. 4B of the 1934 London Revision of the Paris Convention, denies any patent-defeating effect as of the priority date under *In re Hilmer*, 359 F.2d 859 (CCPA 1966).

AN EQUAL BURDEN FOR EVERYONE

There are *some* cases where an applicant would like to have more than ten claims. Yet, the same applicant is prejudiced when his or her opponent has a 200+ claim patent that must be analyzed. Everything should balance out for everyone.

ENDING RESTRICTION ABUSE WITHIN THE OFFICE

As explained in the *Continuation Testimony*, any reform must be *subordinate* to an immediate end to the unrealistic disposal goals faced by Examiners that invariably leads to gaming the system to split applications into multiple units and hence multiple disposals. While the continuation and continuation-in-part practice has its own set of evils, the same problem

stems directly from unfair and arbitrary restriction and election requirements that lead to multiple applications.

Beyond the elimination of extra disposals for continuing applications, there should be *no credit* for divisional applications. If there is a limit of ten claims per application – and only three independent claims per application – this should substantially eliminate any undue disposals hardship on Examiners an application by application basis.

Above all, it should be made absolutely clear that restriction practice should follow Patent Cooperation Treaty Rule 13.1 that permits claims in one case that are linked by a “single general inventive concept”. Also, the “improper Markush” and other rejections or requirements that seek to split a generic claim into component parts must be abolished, which is contrary to statute. Harold C. Wegner, *The Right to Generic Chemical Coverage*, 6 AM. INTEL. PROP. L. ASS'N. Q. J. 257 (1978).

GLOBAL REPERCUSSIONS OF AN UNINFORMED SOLUTION

As stated in my letter to Under Secretary Dudas, “[t]hrough the *in terrorem* proposal [of the proposed rules] ... the limitation is achieved by draconian requirements for additional information on the part of the applicant where he exceeds a certain number of claims. This is an at best thinly disguised and arbitrary measure to achieve a laudable goal. Yet, such gamesmanship on the part of the Office has already been admitted by members of the management team in explanations of the practice and, clearly, any imposition of this practice via rulemaking will be subject to an administrative challenge in the Alexandria division of the Eastern District that will ultimately reach the Federal Circuit – and provide several years of administrative uncertainty and chaos.”

If the present proposal is indeed implemented, this will create an unfortunate model for *ad hoc* reform by *other* countries that will most of all harm American industry – the largest group of users of the world patent system.

“EARLY HARVEST” STATUTORY REFORM

A simple statutory solution should henceforth bar the presentation of more than three independent claims as part of a total of ten claims, provided that amendments may be made in the regular course of prosecution or post-grant reexamination or reissue which may substitute or amend claims within this limit. The change should be *prospective* for any regular application (including any continuing application) or any patent reexamination or reissue patent application filed after a fixed date, e.g., six months from the date of enactment.

Despite wildly optimistic projections from industry, the bar and academia that greeted the initial 2005 release of the comprehensive patent reform proposal in the House of Representatives, it was clear that there were far too many controversial issues that doomed enactment of the overall package. If not all, undoubtedly most involved with the legislative process *now* understand that there is zero point zero chance of enactment of a comprehensive package in the current legislative season.

Yet, there is much where *everyone* on a *prospective* basis should be able to agree *should* be enacted, and that this should occur as soon as possible. Already, the patent system has fallen into disrepute and is frequently challenged in *The New York Times* and *The Wall Street Journal* and – presently – is under the greatest challenge of all before the United States Supreme Court in the pending *Metabolite* and *eBay* cases. We cannot wait another moment to fix those aspects of the system that deserve an *immediate* change – and where *all* sides to the debate should be able to agree on a *prospective* basis.

Clearly, an important element of an “early harvest” should be an immediate end to the freedom to have unlimited numbers of claims: “Claim gaming” must, in particular, be stamped out immediately.