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Sent: Tuesday, May 02, 2006 12:11 PM
To: AB94Comments
Subject: rule change comments

Attached please find the rule comment for John James McGlew

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DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Part 1

[Docket No.: 2005–P–067]

RIN 0651–AB94

Changes to Practice for the Examination of Claims in Patent Applications
COMMENTS SUBMITTED BY JOHN JAMES MCGLEW

The USPTO is responding to the apparent difficulty in providing quality examination at the rate applications are being filed. The solution proposed attempts to limit claims examined. Reference is made to the grouping of claims by the Board of Appeals. However, such grouping is not the same as what is being proposed. The proposal is limiting the claims considered. This is arbitrary and does not have any relationship to the needs of the particular situation, namely the requirements as to the invention presented.

The USPTO has an effective system at present, namely charging for claims in excess of twenty or charging for independent claims in excess of three. This presents a relationship between cost and the extra examination work. The idea that this system is to be discarded is unsettling as it indicates that the USPTO does not care about the fees and simply wants to lower the workload. This appears to be shortsighted and to be clearly the wrong approach.

The USPTO should at least maintain the tradition of examining twenty claims including three independent claims. This claim number is believed to come from what has been traditionally needed for most cases, to effectively present the application for examination. Where more claims are needed, the applicant should pay. However, claims should not be ignored. The filing fee should be set to cover the costs. If the backlog is increasing and costs are rising, the fee can reflect this and the appropriate efforts should be made for building up the Examining Corps. The fee for extra claims should be linked to the extra costs.

Instead of focusing on building up the Examining Corps the proposed changes essentially seek to limit the depth and extent of prosecution and examination. Resources should be directed toward examination. A good Examining Corps is a national resource. If the new application backlog is growing, the USPTO has faced this problem before. The traditional approach of growing the USPTO and building up the Examining Corps provides more certainty than rationing examination.

It could be said that besides the growing backlog of cases, there is another linked problem, namely political pressure focused on numbers rather than quality of examination. This is particularly a problem with there being no link between revenue from fees and the funds available to maintain the Examining Corps. The real thing that needs to be changed is to hire and train more Examiners and to make the USPTO a place where technically trained people want to work. Examiners must feel that there is a significant purpose to what they do and be rewarded financially and by a sense of job well accomplished. The staggering rate at which Examiners have left in recent years points to not only a problem of pay but also a problem of work

environment.

The rules should not be changed as proposed. The USPTO proposal is too drastic with the result unknown. The USPTO needs to be patient. New technologies should still have a significant positive impact on costs and efficiency, as new systems become more familiar. With electronic filing now more user friendly, there will be time savings for the USPTO and the applicants. Foreign office searches can never be given full faith and credit (because of law differences and claim differences). However, systems that present the US examiner with all prior art considered in related matters will have a positive effect as to efficiency. Shrinking and stabilizing the backlog is possible. More resources should be directed now toward the Examining Corps.

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