

Greetings!

I have several clients who prefer to file more than 20 claims in their patent applications, and they pay the extra claims fees.

It has been recognized that Examiners tend to use restriction practice to narrow the number of claims for examination. For example, it is believed that some "savvy" examiners use restriction requirements as a means to delay or circumvent the work required in examining the applicant's claims. For this reason, I advise my clients to keep patent applications under 20 claims total and under 3 independent claims, but my clients do not always listen.

The thing is, if paying extra claims fees, the examiners should not be getting away with reducing the number of claims examined by affirming a restriction requirement (specifically when the restriction is not supported by the rules).

i.e. it appears that examiners are often abusing the restriction practice to narrow the work related to examining certain patent applications.

When facing a restriction requirement after paying for additional claims, the Applicant is not currently entitled to a refund, and the Applicant is forced to elect one of the examiner's "distinct inventions" for prosecution.

I propose that in the event of a restriction requirement after paying extra claims fees, that an applicant should be given an opportunity to receive a refund for the extra claims fees paid, or a credit toward a divisional application.

Thanks for considering the above topic.

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