

From:

Sent: Tuesday, June 15, 2010 3:47 PM

To: Restriction_Comments

Subject: What should be included in an OA?

Dear Ms. Therkorn:

I have been admitted to practice before the PTO since 1973 and I am speaking only for myself. I have one simple request. The standard paragraphs, used by examiners to discuss an election of a group of claims when there is a restriction and to discuss an election of a species when there is an election of species requirement, are not as clear as they could be. In my view, the use of the word "election" throughout the Office Action is confusing to staff members of both law firms and clients. Although attorneys can discern the difference, often administrative nonattorneys cannot make the distinction between a restriction and an election of species.

Therefore, I want to suggest that the words "selection" and "select" be used whenever a restriction requirement is discussed. Thus, the applicant will be required to "select" (not elect) an invention defined by a group of claims. I suggest that the use of the words "election" and "elect" be limited only in reference to an election of species requirement.

Pick up any Office Action where there is both a restriction and an election requirement and put the letter "s" in front of the words "election" and "elect" when discussing the restriction and I believe that you will see how much clearer the Office Action will be in distinguishing the restriction from the election of species requirement.

Joseph Scafetta Jr.

Reg. No. 26,803