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August 22, 2005

Director, U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: AB79.Comments@uspto.gov

Re: Comments Relating to Proposed Rules Docket No. 2004-P-038

Sir:

Please consider the following comments regarding the June 21, 2005, proposed rule changes entitled "Changes to Implement the Patent Search Fee Refund Provisions of the Consolidated Appropriations Act, 2005."

As a general matter, the proposed rule changes appear to be carefully thought out and well drafted. However, I believe that there are certain issues raised in the proposed rule changes that would benefit from clarification, either in the rules themselves or in the commentary accompanying the final rules. Specifically, I believe that the proposed rule changes can be improved with respect to the following matters.

(1) Rule §1.138(d) provides for "a refund of any search fee paid in the application." However, this proposed rule change does not define "any search fee." Thus, it is not completely clear that the entire search fee paid in the application will be refunded. The rule should provide for a refund of the entire search fee paid in the application.

(2) The proposed rule changes also do not address refunding other fees, such as the extra claims fee, even though such a refund would also seem to be warranted. The justification for the extra claims fee is to cover its burden in examining more than (3) independent and/or (20) total claims. Abandonment prior to substantive examination obviates this justification. Thus, the USPTO should also refund the extra claims fee upon submission of a Declaration of Express Abandonment prior to substantive examination.

(3) Rule §1.138(c) indicates that a $130.00 fee set forth in §1.17(h) is due when filing a Declaration of Express Abandonment by way of a Petition to Avoid Publication. However, it appears that no petition fee is specifically required by §1.138(d) to obtain a refund of the search fee. It would be helpful in the commentary to confirm that no such petition fee is required by §1.138(d).

(4) Rule §1.138(d) requires the submission of "a petition and declaration of express abandonment in sufficient time to permit the appropriate officials to recognize the abandonment before the application has been taken up for examination." The commentary explains that an application has been "taken up for examination" when the application is placed on an Examiner's docket for action. However, this deadline appears to be unreasonably early. Forcing applicants to submit the Petition and Declaration before the application has been placed on an Examiner's docket seems unnecessarily arbitrary, because applications can be placed on Examiners' dockets months or years before actual substantive examination begins. It would seem more appropriate to only require these documents to be filed and processed before substantive examination begins.

Respectfully submitted,

Eric D. Morehouse