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COMMENTS ON CHANGES TO IMPLEMENT THE PATENT SEARCH FEE REFUND PROVISIONS OF THE CONSOLIDATED APPROPRIATIONS ACT , 2005

In providing for the refund, the identical wording "... **before an examination has been made of the application**" is employed in both the Consolidated Appropriations Act, 2005 and the Patent Statute (35 USC 41(d((1)(D)), clearly indicating that Congress intended to refund Applicants for Patent Office tasks paid for, but not performed - an admirably equitable policy of value given for money paid.

Now, after a delay of no less than 6 months after the enactment, to implement the Statue, the Patent Office proposes to change such wording to "**taken up for examination"**, presumably to account for the practical situation where examination is partly, but not entirely completed.

However, the Patent Office further proposes to interpret their changed wording **"taken up for examination**" as meaning "..**when the application is placed on the Examiner's docket**", as apparently reflected by an entry in the PALM computer system "Case docketed to Examiner in GAU" .

Clearly, such interpretation does not require that any portion of examination whatsoever has been performed by the examiner for a refund to be denied - merely the release of the application file to the GAU. As such, the Patent Office "interpretation" is so distinct and distant from the original wording reflecting the intention of Congress, as to effectively frustrate the expressed will of Congress.

Reasons advanced by the Patent Office for adopting such approach are that as the Act is (at present) of only 2 years duration, the expense of **"information technology necessary**" for implementation cannot be justified - and further that, somehow, the opportunity of checking a Private Pair entry before filing an Express abandonment would "save" the Applicant from irrevocably abandoning the application without chance of refund.

In advancing such hypotheses, the Patent Office has apparently overlooked or disregarded the practical aspect that although, theoretically, a 17 month window from filing would otherwise be available to applicant to effect abandonment before publication, the period before the application is passed to GAU may be as short as 2 months from filing (or even less), which, when allowing also for a period of 2 weeks to receive an application number and another 2 weeks for petition review, (recently a simple petition to revive took 7 months), closes the window of opportunity to a slit so narrow as to effectively negate the possibility of refund in most instances. Applications, usually rest undisturbed on the examiner's docket for several months longer, often currently years,

(fasteners/business methods), so that in many cases no diminution of the window would occur if the original standard of "... **before an examination has been made of the application**" were adhered to.

Thus, the proposed rule diminishes the window of opportunity for obtaining the refund anticipated by Congress so severely as to frustrate the expressed will of Congress

As to the "**information technology investmen**t" necessary for implementation not be justified, it is pointed out that a simple telephone call to the examiner (or supervisor) by the petitions examiner on receipt of the petition can determine whether substantive examination has been started. An inter office email would also probably be effective. Such technology exists and no information technology investment is required, The cost of the telephone call or email would be covered by the petition fee of $130, the granting of the petition otherwise seeming a routine "rubber stamp" operation.

Alternatively, it would seem simple for an examiner to place an entry on the PALM system when a particular application was taken up for action.

According to the understanding of the undersigned, it is the function of the Patent Office to conceive and apply practical solutions for implementing, not changing, Patent Law, and, without abridging rights afforded by Congress. It is therefore hoped that these comments will provide some simple insights which will facilitate such approach.

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