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**From:** Mr. Eurica Californiaa, Amb.

**Sent:** Sunday, August 19, 2007 9:38 PM

**To:** Markush.Comments

**Subject:** Markush Comments

RE:

37 CFR Part 1

[Docket No.: PTO-P-2006-0004]

RIN 0651-AC00

Examination of Patent Applications That Include Claims Containing  
Alternative Language

Attn: Kahler Fonda, Legal Advisor, Office of the Deputy Commissioner for  
Patent Examination Policy.

To the Commissioner:

I am an independent inventor who has prosecuted a number of patents pro se. These include US 7,121,998 for a vented microcradle for prenidial incubator, US 6,959,314 for a method of translating Boolean algebra into basic algebra, US 6,694,175 for a method of monitoring the body temperature of human embryos and hatchlings, and US 6,285,303 for a gate table data compression and recovery process. I received an honorable mention from the Invent Now Challenge for my Boolean translator (US 6,959,314).

Authorities agree that independent inventors account for about 50% of the most significant inventions. In contrast, they only account for about 8% of the nonprovisional applications for utility patent filed. If we create a statistic known as the significance ratio (SR), figured as a group's share of significant inventions divided by its share of patent applications filed, then application-for-application it turns out you are 11 times more likely to pull a

significant invention out of the pile of applications labeled "independent inventors" than you are from the pile labeled "non-independent inventors". To review this calculation, the SR for independent inventors is 50/8; in other words, they account for 50% of the most significant inventions distributed among 8% of the applications filed. In contrast the SR for non-independent inventors is 50/92; in other words, they account for 50% of the most significant inventions distributed among the remaining 92% of the applications filed. From this it is determined that the SR for the independent inventors is 11 times greater (or more precisely 11.5 times greater) than the SR for non-independent inventors.

Because the SR for non-independent inventors is comparatively low, it is fair to say that, application-for-application, non-independent inventors introduce a greater burden of non-significance at the Patent Office. In other words, to patent the same number of significant inventions, the Office has to go through 11.5 times more applications from non-independent inventors than it does from independent inventors.

Ironically, people often complain that applications from independent inventors acting pro se take more time to examine, due to prosecutorial inadequacies. However, in view of their superior SR, one infers that if all things were to be equal, it would be fair for the Office to spend as much as 11.5 times the effort in examining applications from independent inventors as compared to examining applications from non-independent inventors. The rationale behind this observation is that then the same amount of examination time would be spent in order to patent the same number of significant inventions from either group. Of course, another alternative would be to improve the SR of applications filed by the non-independent inventors.

Because of their superior SR, applications submitted by independent inventors should be considered to have exceptional value. For this reason, efforts to reduce the backlog of applications and other examination difficulties should be mainly focused on non-independent inventors. Instead, it is fair to say that the independent inventor is under attack.

For example, recently the Office changed the rules for an application made special, such that even seasoned attorneys are apprehensive about filing under the new rule for an accelerated examination. Under the new rules it is all but impossible for independent inventors acting pro se to have their applications promptly examined. Since applications by independent inventors offer such astounding significance, as measured by their SR, it is equally astounding that their access to accelerated examination would be crippled in this fashion. Obviously, it should be an object of the Patent Office, being headed by the Department of Commerce, to bring the most significant inventions to the public as swiftly as possible. But, ironically, because independent inventors are adversely affected, changes such as those provided by the new accelerated examination procedure will actually slow the patenting of many of the most significant inventions!

For similar reasons, I am especially apprehensive about the new changes proposed for the examination of patent applications that include claims containing alternative language, especially because no exception is made for applications filed by independent inventors, particularly those prosecuting their applications pro se. Because the SR of small entities is similarly high compared to large entities, analogous argument may be made in favor of small entities as well. Based on differences in the SR of applications presented, it stands to reason that the Office should be willing to spend a proportionately greater amount of effort in examining

applications from high SR groups as compared to low SR groups.

In this way, the Office will be focusing on the overall "significance" being presented to the public by applications via the patenting process, rather than on the amount of "time" spent on individual applications themselves. For in view of huge discrepancies in the SR's of applications presented by different groups, it is clear that all applications are not equal. Thus, it makes sense that the Office would preferentially devote its resources to applications from high SR groups.

In addition to the compelling interest of promoting significance, basis for a distinction between independent and non-independent inventors is also provided by the U.S. Constitution. The Constitution provides that an "exclusive right" is to be provided to "inventors", not to assignees. Thus, independent inventors have a constitutional "right" to prosecute an application, whereas for assignees the ability to prosecute an application is only a "privilege". Accordingly, it would not be fair for the privileges accorded to assignees, who control the applications of non-independent inventors, to be allowed to interfere with the constitutionally protected rights of inventors pursuing their own applications, whether with an attorney or acting pro se.

It may also be noted that the proposed amendments favor seasoned attorneys over independent inventors acting pro se, because seasoned attorneys will be more apt to find arguments as to why "there is no other practical way to define the invention", as one exception reads. Thus, independent inventors acting pro se will find themselves more limited by the proposed amendments than applicants employing seasoned attorneys who can more easily benefit from such exceptions.

It may also be noted that the proposed amendments go beyond the subject of alternative language in the claims, by adding obstacles to an applicant's efforts to traverse a restriction requirement, which is particularly disadvantageous to both independent inventors acting pro se and small entities alike. Ironically, unnecessary divisional applications increase the backlog of applications!

For these reasons, I am opposed to the new amendments, which stand in need of revision in order to achieve fairness.

Sincerely,

/EC/

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