

From: Moore, Steven J.
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To: Markush-irfa.comments
Subject: [Docket No: PTO-P-2006-0004];[FR Doc: E8-04744];[Page 12679-12684]; Examination of Patent Applications That Include Claims Containing Alternative Language

The Honorable Jon W. Dudas

Dear Under Secretary Dudas:

On behalf of my many biomedical clients, particularly those that are categorized as "small entities", I appreciate the opportunity to further offer comments to the U.S. Patent and Trademark Office's Proposed Rule entitled "Examination of Patent Applications That Include Claims Containing Alternative Language," as published at 72 Fed. Reg. 41472 et seq. on July 30, 2007, and as published at 73 Fed. Reg. 12679 et seq. on March 10, 2008. These particular comments are directed to the USPTO's purported Initial Regulatory Flexibility Act submission.

First, I would like to point out my continuing disagreement with the USPTO's position that no other alternatives to this rule exist which would accomplish the stated objectives, and yet would minimize any significant economic impact of the proposed rules. I maintain my position, which is supported by numerous studies, as well as by POPA itself, that the USPTO asserted objective of this rule, that is "to improve practices ... in a manner that will enhance the Office's ability to grant quality patents that effectively promote innovation in a timely manner" (col.3, p. 12680), will not be obtained by this rule change, or any other, until the USPTO fixes its examiner retention problem. This problem can only be fixed if the USPTO jettison's its broken examiner examination quality measurements, taking into account the actual time an examiner needs to review an application. In short, the hiring of more examiners, ALONG WITH, a reduction in turnover at the USPTO, would not only meet the objective set forth in the proposed rule set, but would also do so with a far more minimal economic impact on small entity filers.

Second, the entire IRFA is based on assumptions unsupported by the USPTO's data set, and based on inappropriate statistical analysis. The office suggests that with respect to the applications in its sample "the median number of divisional applications required to maintain the scope of the application was 5, although some applications would have required more than 100 divisional applications to maintain scope." The USPTO then uses the median number, which would not correlate with the mean unless the population of applications fit a normal distribution (which apparently they do not - but again the USPTO does not provide the raw data to the public which is needed to make a full assessment), to assert that it "believe[d] that an applicant would need to file at most approximately seven divisional applications following an examiner's restriction." The disconnect is obvious. An IRFA should be based on a reasonable interpretation of data, not on unsupported "beliefs." No analysis is made as to the loss to small entities that would occur due to the loss of patented subject matter if an applicant could not afford to file the up to 100 divisional applications during the life time of the patent application. Nor, is any analysis made as to respect of the economic effect such rule would have on small entities coupled with the finalized continuation/claim rules. Such is entirely ignored.

Furthermore, the public is put in a serious bind in respect to effectively responding to the IRFA as information pertaining to the sampled applications is not provided by the USPTO. It appears that the applications were selected based on having some particular terms embedded in their claims ("the Office examined a sample of 102 FY 05 small entity applications with alternative language from the biotechnology /chemical arts and 57 FY05 small entity applications with alternative language from the electrical/mechanical arts"). No effort appears to have been undertaken to

determine from a representative random sample of applications how many of the applications actually contained alternative language. Nor, does their seem to be any effort undertaken to determine the various ways in which an applicant might assert in the alternative, other than using the term "or" or such other search term. Thus there is serious questions raised with respect to the base on which all of the USPTO's analysis lies.

It is also entirely unclear how the USPTO could extrapolate data form one particular year (Fiscal Year 05) to all other years without checking whether such year was typical or atypical in respect of alternative claiming.

In short, with the utmost respect, the IRFA is totally inadequate under the law.

Sincerely,

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