

From: richard.lazarus@BTLaw.com  
Sent: Wednesday, June 11, 2003 2:19 PM  
To: Unity Comments  
Subject: Comments re Study of Unity Changes.

This is in response to the request for comments at 68 Fed. Reg. 27536 (May 20, 2003). My comments are as follows.

Issue 1: Examination of only independent claims would create inefficiencies in the examination process and defeat the whole concept of compact prosecution where examiners are supposed to indicate allowable subject matter at the onset of examination. Examiners who do not review and search the more specific dependent claim subject matter would be less able to be aware of, and indicate, allowable subject matter. This would lead to more independent claims and longer prosecution.

Examination now has far too many delays. As an alumni, and strong supporter, of the USPTO I am embarrassed when speaking with clients and other patent attorneys (from the US and other countries) regarding delays at the USPTO. Delays have occurred for so many years that they are accepted as part of the process, yet they reflect a low level of operations at the USPTO. Rather than exacerbate the delay, an effort to shorten the delays would be preferable.

Issue 2: The underlying premise that the USPTO does not have, and will not have, sufficient resources to examine applications in a timely fashion is not acceptable. The USPTO should increase and maintain a sufficient staff (examiners and clerical) to examine applications with no more than a one-month turn around. Abdication of this standard has led to too many problems. No new statutory change (patent term extension) should be proposed. Such change unduly complicates the current process, adds unnecessary work to the already overburdened USPTO and adds further delay to patent prosecution. US divisional practice should be maintained whether or not unity practice is adopted.

Issue 3: No. The applicant should be afforded the opportunity to elect the invention to be prosecuted.

Issue 4: Examiners should always strive to do the "best possible search", not a "partial search". The goal is to prosecute the application as quickly and as efficiently as possible. A "partial search" is not consistent with efficient examination.

Issue 5: An answer to this issue requires an understanding of the

reasons for so many different types of fees. No explanation for how each of these fees is supposed to contribute to revenue neutrality is provided. Probably because none exists. If adoption of unity practice causes an increase in costs, the fees should be increased and it doesn't matter which fee. The fees should be simplified by dividing the costs by the total number of applications and assessing the resulting filing fee. Maintenance fees could be used to reduce small entity fees. An issue fee could be used to further reduce the filing fee. The issue fee would take into account the number of claims, pages of application, extensions of time, etc. during prosecution, thus eliminating the need to collect a fee (and the ensuing delay and extra work) with every paper filed.

Issue 6: Examining teams make sense so long as at least one of the team has knowledge of the relevant art area. Patentability reports rarely worked effectively, maintaining the assigned examiner who may not have sufficient art experience does not offer the best quality examination and "some other" option is too indefinite.

Issue 7: This option would appear to delay allowance of the previously allowed claims. This would not be desirable.

Issue 8: The additional option appears to add flexibility to the process and would, for this reason, be acceptable.

Issue 9: No statutory change should be sought. The current restriction/unity practice is acceptable and no change should be made unless some clear benefit is realized without incurring delays or other drawbacks.

Issue 10: Yes.

Thank you for consideration of my thoughts on this matter.

Richard

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