

EXHIBIT

4-a



The Role of the Solicitor's Office

John M. Whealan

Deputy General Counsel for IP
Law and Solicitor

EXCERPT

Major Responsibilities of the Solicitor's Office

1. Litigation: Represent the agency in federal court litigation & advise DOJ on I.P. cases where PTO is not a party
2. Advice: Provide legal & policy advice to senior management on complex legal/technical issues
3. OED: Prosecute practitioners who violate OED rules and assist in the administration of the registration exam

2. Legal Advice

- Promulgate and implement rules – e.g., proposed rules regarding continuations, claims and IDS
- Guidelines – e.g., 101 guidelines, utility guidelines
- Review petition decisions likely to be litigated
- Review patent/trademark applications raising important or unique legal questions
- Advise on complex policy questions

Latest Rules Proposals

- Latest rules proposals address (i) continuations, (ii) claims, and (iii) IDS practice (coming soon)
 - Solicitor's Office brought in early
 - Importance of rules to practitioners
 - Anticipated legal challenges
- Minimal impact on majority of cases
- Make examination more focused/efficient
- Reduce effect of atypical cases
- Will also help reduce backlog

Let's Look at the Numbers

- 384,228 applications filed in fiscal 2005
 - 30,767 were continuations (non-CIP)
 - 6,411 were 2nd or higher in a cont chain
- 54,495 Requests for Continued Examination
 - 10,370 were 2nd or higher RCEs in a series
- Thus 4-5% of applications (16,781/384,228) have already been through two or more complete examinations

a. Set reasonable limits on continuation practice

- One continuation or RCE as of right
- For 2nd and subsequent continuations
 - Petition and show why it is needed “to obtain consideration of an amendment, argument, or evidence that could not have been submitted” earlier in series
- No first action finals (4 bites at the apple)
- Office-ordered divisionals treated as separate applications

a. Limits on continuation practice --cont'd

- No voluntary divisionals
 - Presumption of double patenting when two applications
 - Filed same day
 - Same assignee
 - Common inventors
 - Substantial overlap in disclosure
 - Rebut presumption by showing that claims are patentably distinct

b. Representative Claims

- Patent Board uses Rep Claims
- District Court uses Rep Claims
- CAFC uses Rep Claims
- Examiner and Applicants will use 10 representative claims
 - Consider how much examiner time is wasted when applicants amend all independent claims in response to first office action

b. Representative Claims –cont'd

- No claim will issue without complete examination!
- Initial examination will focus on 10 representative claims
 - all independent claims
 - others as selected by applicant
 - remaining claims held in abeyance until representative claims ready for allowance
- Applicants who want immediate examination of all claims will have to:
 - Conduct a Search
 - File Examination Support Document showing patentability of all claims over closest art