

Comment 1

Subject: Comment on proposed amendment to 37 C.F.R. 1.111(a)(2)

The Notice of September 12, 2003 proposes to amend 37 C.F.R. 1.111(a)(2) to disallow supplementary amendments after the expiration of the six-month statutory period for response. I believe that this will overall reduce efficiency. A cutoff date for amendments is a good and necessary reform, but it should be a date tailored to the harm identified in the proposal - the cutoff should be the last date that does not cause the PTO to discard work already started. For example, Rule 111 might be amended to provide that a preliminary/supplemental amendment will be refused if it is entered into PALM after the examiner has taken up the application for its next round of examination. But an amendment should be entered of right if it can be entered with at most a modest effect on the examiner's efficiency.

A basic criterion for efficient use of the PTO's resources is that the examiner should work on the claims that the applicant wants. There are many good reasons that preliminary/supplemental amendments are filed after the deadlines outlined in the proposal: prior art may come to light, information may come to light with respect to one application may alter the strategy for a sibling application, the applicant may redesign its commercial product in a manner that requires an amendment to the application, the competitive landscape may change, some external factor may trigger a recognition that the claims should be amended, there may be a change in the law, etc. etc. It would be wasted work for an examiner to examine claims that the applicant is no longer interested in, merely because of some arbitrarily-set too-early cutoff date.

The proposed change will in some cases affect patent term, when a supplementary amendment cannot be entered because it is after the proposed cutoff date, forcing an RCE and the loss of term adjustment. Procedural rules should not have such remarkable effects on substantive rights, unless no alternative with less effect exists. Here, there is a good alternative, and the rule as proposed should not be adopted.

As a practical matter, I urge the PTO to consider whether any significant number of totally arbitrary supplemental amendments are filed. At least for those of us in private practice, most of our clients are quite cost sensitive. We have essentially the same incentives to consolidate our work that the PTO has. At least in my case, when I file a supplementary amendment, it is always directed to advancing prosecution toward the conclusion that my client wants. Reducing the right of applicants to put their very best before the examiner will reduce efficiency of the whole process.

The comments describe the hardship on the Office that arises when "a supplemental reply [is] received after the examiner has already conducted an updated prior art search and drafted the next Office action." This definition of the problem seems to be a good definition of the solution as well.

Comment 2

Subject: Comments on proposed amendment to Rules 57 and 115

Has the Office assured itself that it has the authority to bind courts by the proposed amendments to Rules 57 and 115? 35 U.S.C. s 2 only gives the Office the authority to make procedural rules. What would be the effect of adding a priority claim after initial filing? Aren't these proposals merely an invitation to applicants to invalidate their own applications? Recall the former rule that abstracts would not be used to construe claims. The PTO should not invite applicants to rely on procedural rules that will have contrary substantive effect.

A much safer solution is to add a priority claims section to form PTO/SB/05 that allows an applicant to list all parent applications (foreign, U.S., or provisional), and includes an "incorporated by reference" check-box for each parent application.

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