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Via Internet: ab64.comments@uspto.gov

Mail Stop Comments-Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

RE: Comments Changes to Support Implementation of United States Patent and
Trademark Office 21st Century Strategic Plan
Due: 12 November 2003
68 Federal Register 53816 (September 12, 2003)

Dear Sir:

Please consider modifying the final version of Proposed Rules 1.4; 1.55; 1.105, and 1.704 to reflect the views in this letter. Each rule addressed in this letter has the citation to the rule number and, in parenthesis, both the page number and the column number of the relevant text of the Federal Register.

Rule 1.4(h) (p. 53819, col. 3)

Rule 1.4(h) is proposed to require clarification or confirmation of a signature, where the Office has reasonable doubt about the authenticity of the signature. The example in the Federal Register states that ratification or confirmation may be required where there are variations in the electronic signature. Below, in the example and in the sentences bridging pages 53819 and 53820, the proper procedure is stated for an inventor to change his or her name on the record.

As such, this notice presents a perfect opportunity to clarify the regulations in this area. According to the Federal Register and the MPEP § 605.04(c), an inventor who changes his or her name and “desires” to change his or her name in the record must do so by petition. The word “desires” means that the inventor may choose to change his or her name on the Office record but that person does not have to change his or her name on the Office record. In other words, the procedure is optional and is left to the inventor’s discretion.

More importantly, the situation may arise where an international application is filed and inventor has a particular name when the request as filed, but when the application enters the national stage, the inventor has a different name. For example, the inventor’s name when the Request was made could have been Jones, but some time before entering the national stage the inventor’s name has changed to Smith, e.g., by changing marital status. In this example, the inventor would have to file an oath or a declaration under Rule 497. Rule 497(a)(2) requires the oath or declaration to

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identify the inventor. How should the inventor be identified? Smith or Jones? Should the inventor be identified by the name as of the date of execution of the declaration? Jones? Or should the inventor be identified as the inventor's name on the Request? Smith?

It seems a more detailed procedure is required to avoid any confusion. It is recommended that for international applications the inventor should not have to petition to change his or her name if the rules require the applicant/inventor to identify himself or herself with his or her name as of the date of entering national phase or the execution of the declaration under Rule 497. Alternatively, the inventor should be allowed to identify himself or herself by using either name, so long as somewhere in the application papers it is clearly stated that the inventor has changed his or her name.

Rule 1.55 (p. 53825, col. 2)

Rule 55(a)(1)(ii) is proposed to be amended such that the time period for a claim to foreign priority under 35 U.S.C. § 119(a)-(d) is presented in sufficient time to permit publication of an application at eighteen months from the earliest claim of priority under 35 U.S.C. § 119(a)-(d). In addition, the priority claims must be presented in a timely manner in an international application filed under 35 U.S.C. § 363 to determine when the application should enter the national stage.

Along these lines, the Office noted that section 13205 of Public Law 107-273 amended section 45808 of AIPA to make the 18-month publication applicable to international applications during the international stage so long as those applications designated the United States.

Clearly such publications of international applications that designate the USA, even if they are not written in English, will be prior art under 102(e)(1). The Office should clarify that these publications will be given a § 102(e)(1) date as of the international filing date, not as of their publication date.

Rule 105 (p. 53832, col. 1)

Rule 105 is proposed to be modified to seek stipulations, e.g., about knowledge of those of ordinary skill in the art, and to "require" responses to interrogatories, e.g., about applicant's understanding of the level of knowledge of persons of ordinary skill in the art. This proposal is not only a bad idea but also an attempt to shift the burden of a prima facie rejection.

Interrogatories and stipulations are legal tools to be used by lawyers, not examiners. Indeed, according to Office statistics, most examiners do not have a law degree. Group Art Unit 1600 Open House, October 29, 2003. Thus, it would seem that there would be a high potential for the procedure to be misused.

Even worse, this procedure may further hinder the efficient prosecution of applications by encouraging the collection of irrelevant information. The types of information the Office wants to request are shown in the paragraphs bridging columns two and three of page 53832. The Office wants to give itself authority to request stipulations and interrogatories to elicit information about applicant's interpretation of the distinctions among claims. Applicant's interpretation, however, is

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totally irrelevant. The proper standard is that claims are given their ordinary meaning. MPEP § 2111. When comparing two claims, the Office should have examiners that are at least capable of distinguishing the differences between the limitations of two sets of claims.

Additionally, the Office wants authority to request stipulations and interrogatories to elicit information about precisely which portions of the applicant's disclosure provide the written description supporting the enablement for each claim. Yet claims are presumed enabled. MPEP § 2163. Such a procedure, if given to the examiners, will instantly be used to shift the burden to applicant to respond to baseless rejections of nonenablement or a lack of written description. This information is not reasonable necessary to examination until the Office makes its prima facie case of lack of written description or nonenablement. Without the proper factual predicate from the Office, the procedure just serves to shift the burden of establishing a rejection to the applicant.

Additionally, the Office seeks stipulations and interrogatories to elicit information about applicant's interpretation of claim terms. Applicant's interpretation, however, is totally irrelevant, as claims are given their broadest reasonable meaning absent a clear definition in the specification. Furthermore, applicant's intent about a claim's meaning is totally irrelevant to the broadest reasonable interpretation.

Furthermore, the Office wants to seek information about applicant's interpretation of which portions of each claim correspond to the admitted prior art in this specification. Is the Office also trying to motivate applicants to remove any reference to prior art documents in the specification?

The Office also wants authority to question applicant's interpretation of the specific utility provided by his claimed subject matter. Again, this item is not reasonably relevant to examination until the Office makes its prima facie case non-utility. MPEP § 2007. At that point, applicant should be asked to identify a specific utility provided by the claimed invention. It is also noted that if the applicant does not provide a specific utility or at least allege a specific utility in a specification, the examiner's burden is rather easily met. However, in specifications that allege a specific utility, it is the Office's burden to provide evidence and explain why the specific utility is not what it is alleged to be.

Finally, the Office's proposed rule about requesting stipulations and interrogatories to elicit information will foster litigation according to Rule 56. Applicants are under a duty of candor. Any requests for stipulation and interrogatories would also presumably fall under Rule 56. As a result, such requests for stipulations and interrogatories would naturally lead to a very large amount of inquiries into inequitable conduct in both interference proceedings and litigations. Thus, the Office may create as much work as it tries to save with this proposal.

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Rule 1.704(d) (p. 53843, col. 1)

Rule 704(d) is proposed to be amended to state that an applicant who fails to cite a prior art document within 30 days of receipt by an individual designated in Rule 56(c) of a first communication from a foreign patent office in a counterpart application citing the document will be penalized under the patent term adjustments. Thirty days, however, does not reflect the realities of international prosecution. Nor does 30 days agree with the three-month time frame in Rule 97(e)(1).

For example, working in Washington, D.C., the undersigned representatives have typically received correspondence from the Office within two weeks of its mailing from across the river in Virginia. Typically even slower are the mailings in our foreign counterpart applications. As a result, thirty days is a very short period of time for a foreign agent to get his file and determine whether or not the documents were disclosed to the U.S. attorney, and then communicate that information to the U.S. attorney.

Even worse, after the U.S. attorney receives the communication from the foreign agent, there is more work to be done. Specifically, the U.S. attorney, in accordance with Rules 97(e)(1) and 10.18 and must determine whether or not the information was previously presented to the Office less than three months earlier.

In short, the Office's proposal would place an undue burden on U.S. attorneys and support staff to hastily submit publications even if they were previously cited. Thus, it is proposed that the Office allow longer time window, e.g., three months in accordance with Rule 97(e)(1), for applicants to submit such communications from foreign patent offices.

In view of these comments, please consider modifying the final version of these rules.

Respectfully Submitted,

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