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From Attention Messrs. Raja Saliba (rsaliba@sughrue.com) and Jason  
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Mion PLLC

Subject Comments on the Changes To Implement Electronic Maintenance of  
Official Patent Application Records (Proposed 37 C.F.R. § 1.121)

Date April 24, 2003

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Dear Sirs:

The United States Patent and Trademark Office (the Patent Office or the USPTO) proposes changes to the manner in which amendments are to be made to patent applications (the “proposal”).<sup>1</sup> In contrast to the current methodology used for making amendments, the Patent Office proposes to do away with (in most instances) the requirement to separately provide both a

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<sup>1</sup> See Changes to Implement Electronic Maintenance of Official Patent Application Records, 68 Fed. Reg. 57, 14365 - 14372 (March 25, 2003) (to be codified at 37 C.F.R. § 1.121).

clean and marked-up version for an amended part.<sup>2</sup> In response to the proposals<sup>3</sup> set forth by the Patent Office, the law firm of Sughrue Mion PLLC<sup>4</sup> provides the following comments.

## I. AMENDMENTS TO THE DRAWINGS

Currently, proposed drawing changes are submitted in red ink.<sup>5</sup> In contrast, the USPTO proposal states that: (1) changes to the drawings will be submitted in replacement sheet(s) which comply with 37 C.F.R. § 1.84;<sup>6</sup> (2) that changes will be explained in the Remarks section of an amending paper;<sup>7</sup> and (3) that, in addition to supplying replacement sheets in compliance with Rule 1.84, applicants may provide marked-up copies and/or marked-up copies may be required by an examiner.<sup>8</sup>

By mandating that changes to the drawings be submitted in a format which fulfills the requirements of 37 C.F.R. § 1.84, applicants will be under the potential threat of incurring an unnecessary expense. That is, by requiring all drawing changes to meet the formalities of Rule 1.84, applicants may incur the extra expense of providing formal drawings to which an examiner

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<sup>2</sup> See 37 C.F.R. § 1.121 (a - d)(current as of the Fed. Reg. dated July 31, 2002).

<sup>3</sup> USPTO Announces Prototype of Image Processing, 1265 Off. Gaz. Pat. Office 87 (December 17, 2002) and Amendments in a Revised Format Now Permitted, \_\_\_ Off. Gaz. Pat. Office \_\_\_ (February 25, 2003).

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<sup>5</sup> 37 C.F.R. § 1.121(d) (current as of the Fed. Reg. dated July 31, 2002).

<sup>6</sup> Changes to Implement Electronic Maintenance of Official Patent Application Records, 68 Fed. Reg. 57, at 14371 (March 25, 2003) (to be codified at 37 C.F.R. § 1.121).

<sup>7</sup> Id. at 14370.

<sup>8</sup> Id. at 14372.

may further object -- in which case the applicant will be required to procure a new set of formal drawings that are in compliance with Rule 1.84 and believed to cure the examiner's objections.

Although the proposal makes submission of a marked-up version permissible on applicant's part, the proposal does not permit the submission of a marked-up version as a "proposed" drawing correction without a formal drawing sheet that is compliant with 37 C.F.R. § 1.84. If applicants were allowed to submit marked-up "proposed" drawing corrections (wherein such a submission would be considered by the PTO as rising to the level of being considered responsive) without the requirement that the submission meet the formalities of Rule 1.84, it would help applicants avoid a potential double incursion of costs.

## **II. AMENDMENTS TO A WRITTEN PART**

### **A. In General**

Currently, amendments to a written part require a clean version and a marked-up version, wherein the changes in the marked-up version are shown by brackets (for deleted matter) and underlining (for added matter), or by any *equivalent* marking system.<sup>2</sup> In comparison, the proposal instructs that applicants would be required to provide only one copy of an amended part, utilizing only strikethrough (for deleted matter) and underlining (for added matter).<sup>10</sup>

In response, it is believed that the proposal's requirement for a singular and exclusive type of marking system may be inappropriate to show additions and deletions in every case, and

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<sup>2</sup> 37 C.F.R. § 1.121, subsections: (b)(1)(iii), (b)(2)(iii) and (c)(1)(ii) (current as of the Fed. Reg. dated July 31, 2002).

<sup>10</sup> Changes to Implement Electronic Maintenance of Official Patent Application Records, 68 Fed. Reg. 57, at 14370, 71 (March 25, 2003) (to be codified at 37 C.F.R. § 1.121).

the USPTO should consider maintaining the current, more permissive “equivalent” marking system. Alternatively, short of continuance of the “equivalent” marking system (and in recognition that plans at the Patent Office may include the use of a specified type of formatting to allow for computer recognition of scanned documents), the possibility remains that a limited number of marking methods could be sanctioned. In any event, an exclusive marking system is not preferred, as explained below.

The spectrum of “the Progress of Science and useful Arts”<sup>11</sup> includes “anything under the sun that is made by man.”<sup>12</sup> In general terms, this broad spectrum includes electrical, mechanical, chemical and bio-engineered inventions. Some of the inventive concepts that fall within these broad categories of patentable art comprise listings not entirely suited for a singular and exclusive method of marking. Simple examples of such include those applications making use of numerals and equations, for example, the numeral four (4) and the mathematical symbol for subtraction(-).

The following rhetorical illustration shows how the strikethrough method may result in a non-plus. (In the following example using the numeral "4," note that the numeral is not clearly shown as intended for omission (when using strikethrough) because the strikethrough overlays the horizontal portion of the numeral.) Which of the following numerals is intended to be omitted:

“4” or “4?”

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<sup>11</sup> U.S. CONST., art. I, § 8.

<sup>12</sup> Diamond v. Chakrabarty, 447 U.S. 303, 309 (1980).

Without the electronic version of this document, it is practically impossible to discern that the first numeral “4” is the numeral which is marked for omission. The identical situation could be created for the mathematical subtraction symbol (when using strikethrough) or in the case of using underscore (when using underlining). The above-three examples are perhaps narrow, but they are meant to show that not every art is amenable to a “one-size-fits-all” approach as far as markings for amendments are concerned.<sup>13</sup>

## **B. In the Claims**

The proposal states that amendments to the claims are to include a single status identifier chosen from the following group of eleven potential identifiers:<sup>14</sup>

1. Original
2. Currently amended
3. Previously amended
4. Cancelled
5. Withdrawn
6. Previously added
7. New
8. Reinstated -- formerly claim # \_
9. Previously reinstated
10. Re-presented -- formerly dependent claim # \_
11. Previously re-presented

In response, it is first presented that the eleven status identifiers in the proposal are not mutually exclusive. That is, a single claim amendment might arguably fall within the gambit of

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<sup>13</sup> Notably, in an informal survey of practitioners queried at Sughrue Mion PLLC as to which system was preferable -- the choices being an exclusive marking system or a system which allows equivalents -- all practitioners were in agreement that the equivalent system of marking was the preferred system given the wide spectrum of patentable art.

<sup>14</sup> Changes to Implement Electronic Maintenance of Official Patent Application Records, 68 Fed. Reg. 57, at 14371 (March 25, 2003) (to be codified at 37 C.F.R. § 1.121).

many of the single status identifiers. The fact that a single claim amendment could be classified by more than one identifier raises the question of which status identifier is most appropriate. Additionally, in subsequent litigation involving the patent claims and prosecution history, the specter of being charged with allegedly misleading the examiner for having chosen the “wrong” status identifier is a possibility.

Among the eleven available identifiers, at least the below-listed single status identifiers are believed to be too narrow, add little useful informational value; and can be particularly confusing for applicants, practitioners *and their staff*. Following this list please find a few rhetorical situations offered as examples of potential confusion or difficulty.

- Reinstated -- formerly claim # \_
- Previously reinstated
- Re-presented -- formerly dependent claim # \_
- Previously re-presented

A first example (representing simplicity over complexity) is the situation in which a canceled claim is reinstated. Succinctly, why not permit the applicant to use the identifier “(New)” and include a discussion in the remarks section concerning the nature of the added claim?<sup>15</sup>

A similar example includes the use of “(Re-presented -- formerly dependent claim # \_\_)” when changing a formerly dependent claim to an independent status. Concisely, why not permit the applicant to use the identifier “(New)” in the case of the claim using a new claim number or

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<sup>15</sup> Since the single status identifiers “(New)” and “(Reinstated -- formerly claim # \_)” or “(New)” and “(Re-presented -- formerly dependent claim # \_\_)” are not always mutually exclusive, if the USPTO retains the last four identifiers, the USPTO should clarify whether the applicant has the *option* of using the more generic identifier “(New)” when a more specific identifier would also apply.

“(Currently amended)” in the case where the claim retains the same claim number as in the previous version?<sup>16</sup>

A further potential problem area arises for the identifier “(Withdrawn).” Proposed Rule 1.121(c)<sup>17</sup> makes it clear that only one status identifier is to be used. But consider the case of a withdrawn claim being amended. The proposed rule change is not clear as to which status identifier applies. The “(Currently amended)” identifier may be used in the submission that actually amends the withdrawn claim; however, it remains unclear which identifier would be appropriate for this claim in *subsequent* submissions: “(Previously amended)” or “(Withdrawn).”

In light of the confusion and potential problem areas brought about by some of the single status identifiers, the USPTO should carefully consider, as to each individual identifier, whether there is an appropriate amount of material benefit to the applicant, the practitioner, or the USPTO to justify its use.

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<sup>16</sup> In the event that the USPTO retains the last four single status identifiers, the USPTO should clarify whether these identifiers are to be used in the situation where the applicant is reinstating or re-presenting a claim that is identical to the claim being reinstated or re-presented, *except for*, e.g., the correction of a minor typographical error. If the answer is no, and the applicant is required to use the identifier “(New)” in such cases, then the applicability of the last four identifiers are further limited to such a narrow set of circumstances that their use may not be warranted. On the other hand, if the answer is yes, then it remains uncertain as to what kinds of amendments are sufficiently minor to qualify for the use of these last four identifiers. Either case underscores the fact that the confusion stemming from the last four identifiers may be so great that their use might not be warranted.

<sup>17</sup> An additional question arises from the text of § 1.121(c), wherein it is stated that “[t]he status of each of the claims . . . *must* be indicated in each amendment” and “*should* be [so] indicated [by one of the identifiers]” (italics provided). The use of the term “should” suggests two issues. A first issue is that “should” is permissive language, perhaps connoting that an applicant can use multiple identifiers (e.g., “(Currently withdrawn and amended)”). A second issue rises in the context of the use of “should” along with other phraseology within § 1.121(c) wherein it is stated that “[o]nly claims of the status ‘currently amended’ shall include markings.” If applicant is currently amending a claim, and opts to not follow the permissive language of “should,” will applicant be permitted to use other phraseology to indicate the status of the current amendment, e.g., will applicant be permitted to use “(Twice amended),” as a status identifier?