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April 24, 2003

The Honorable James E. Rogan
Under Secretary of Commerce for Intellectual Property
And Director of the U.S. Patent and Trademark Office
Box Comments - Patents
Attn: Robert Clarke
Washington, DC 20231

Re: Notice of Proposed Rulemaking Changes to Implement Electronic Maintenance of Official Patent Application Records, 68 Fed. Reg. 14365 (March 25, 2003)

Dear Director Rogan:

Intellectual Property Owners Association (IPO) supports the efforts of the Patent and Trademark Office (PTO) to improve processing of patent applications generally, and specifically to enable and facilitate beginning-to-end electronic processing of patent applications. IPO appreciates the opportunity to comment on changes in procedures that are being considered by the PTO before they are implemented.

Comments on specific proposals are provided below.

Rules 3, 17, 59, and 99. These rules are proposed by the PTO to be amended to, *inter alia*, delete provisions directed towards return of certain submissions or expunged documents, and instead simply provide that such submissions or documents will “not be entered.” IPO requests clarification as to how notice will be provided as to the status of such submissions or documents in the absence of returning the documents in accordance with past procedures. While in future cases (i.e., once electronic processing procedures are fully implemented) there may in fact be no original paper record to return when an electronic record is expunged as noted in the comments to the proposed rules changes, it appears reasonable that a copy of the material to be expunged may be made and returned to provide a record to the applicant of the documents expunged.

Rule 14. IPO generally supports the proposed revisions to this rule. In particular, IPO specifically encourages rules changes such as proposed § 1.14(e) that would enable and facilitate sharing of information between the PTO and other IP Offices in order to enhance world-wide patent prosecution efficiencies.

IPO believes, however, that the regulations providing access to applications should also include providing access to application file contents of any patent application, regardless of its status, that is a parent application of an issued patent or published

patent application. The prosecution history of such parent applications may be very important in many aspects of claim construction and enforcement with respect to applications that claim priority of such parent applications. The inability to obtain access to the file contents of an unpublished pending parent application potentially leaves a substantial void in the prosecution history that makes an assessment of the published patent claims' (or of the potential claims of a published application) validity, scope and enforceability speculative at best.

Having been granted a patent that relies on another patent application (or having willingly published a patent application that provides provisional rights that relies on another patent application), the patent or publication owner should not be in a position to withhold relevant information from the public. There is no sound public policy or unusual PTO burden that should prevent public access to a copy of the file contents of an unpublished pending application which is itself relied upon as a priority document in another patent publication. Accordingly, similar to the proposed change in § 1.14(a)(1)(iv) with respect to unpublished abandoned applications, IPO would encourage additional rules changes under proposed § 1.14(a)(1)(v) to make a copy of the file contents of unpublished pending applications, along with the application-as-filed, available to the public where the pending application is relied upon under 35 U.S.C. §§ 119(e), 120, 121 or 365 by an application that has issued as a U.S. patent or in an application that has published as a SIR or with effect as a U.S. application.

Rules 71 and 72. IPO requests clarification as to whether the Title is considered an “other part” of an application relative to the specification, and which accordingly may not be included on the first page of the specification under proposed § 1.71(f), or whether the practice of including the Title as a heading on the first page of the specification would still be permissible in accordance with § 1.72(a).

Rule 97. Absent evidence of abuse of the PAIR system with respect to current IDS mailing date requirements, IPO does not support the proposed change. Under current practice, an applicant may check the status of an application and rely upon that status report in preparing an IDS. This IDS would then be appropriate based on such checked status, even if the status is changed later that same day after the applicant has prepared and mailed the IDS. We are not aware of any need for changing the practice.

Rule 121. In order to simplify amendment procedures and aid the PTO in accurate printing of patent claims, IPO generally supports the proposed revisions to this rule, subject to the following recommendation. To reduce possibilities for confusion, inadvertent error, and unnecessary procedural burden that may result from any required use of the proposed list of 11 specific claim status identifiers (particularly with respect to applicability of the proposed rules to continued prosecution of applications that have already been prosecuted under the current amendment

procedure rules), we recommend decreasing the number of proposed identifiers to four of those specifically set forth in the proposed rule. The identifiers should be limited to “new”, “currently amended”, “canceled”, and “withdrawn,” along with a fifth identifier (e.g., “as previously presented”) to cover all other pending claims that are simply being represented in the amendment document in unchanged form relative to the immediate prior version as part of the required complete listing of all claims in the application.

A single, more general designation for all pending claims not currently being amended would serve the desired purpose (i.e., indicating the claim is not currently being amended relative to a previously presented claim), without requiring applicants to determine a specific sub-status of such claim and possibly face negative inferences if such specific sub-status was inadvertently incorrectly reported. Further specifics along the lines of the more detailed claim status identifiers proposed by the PTO could be presented by applicants in the amendment remarks submitted along with the amended claim set when applicants believe further specifics would be of help to the Examiner in consideration of the amendment.

We hope these comments are helpful. We note that 30 days is a short time period for a national association such as IPO to analyze a Federal Register notice, collect suggestions from its diverse membership, and review and adopt a position. In order to encourage as many comments as possible, we suggest a policy of normally giving the public at least 60 days to comment on Federal Register notices.

Sincerely,

A handwritten signature in black ink that reads "John K. Williamson". The signature is written in a cursive style with a large, stylized initial "J".

John K. Williamson
President