Robert W. Bahr

I have the following comments on the proposed sec. 1.251:

1. The Office's attempt to improve the efficiency of its internal operations is laudable. Also, it is not unreasonable to ask beneficiaries of those services to assist in reconstruction, provided the Office is willing to mitigate the adverse impact of such requests and to more clearly state the parameters of the applicant/patentee responsibilities.

2. The rule does not state a consequence for failure of a patentee to comply with the requirements, but it may be easily be misread to imply that a patent would lapse for such failure, a consequence which the Office cannot impose. The rule should expressly state: in (a) that the applicant must comply and a patentee is requested to comply; and in (c) that the in the case of a patent there is no consequence for failure to comply. Alternatively the Office should obtain congressional authorization to impose a consequence on the patentee. In the case of a patentee it would be necessary to establish that the notice had actually been received by the current owner.

2. The Office is imposing a burden on applicant's of correcting the errors of the Office. The Office should make an attempt to at least mitigate this burden. Copy and postage costs should be rebated to the applicant. Further there should be no reduction in patent term extension time which would otherwise become available. The entire delay, including the delay time for the initial search and for the compliance response is Office time.

3. The rule should expressly state what the response time for such demands will be. Note that records may be scattered between multiple companies and law firms, particularly in the case where foreign companies or individuals are involved. Communications may need to be had sequentially with foreign associates; their corporate client IP staff; their corporate R&D management; the inventors. These people can be located in two, three or even more countries. A period of at least 3 months should be permitted.

The problem can be much worse with patentees, since the patent may have changed hands multiple times with the file location becoming increasingly harder to track. In the case of a patentee the minimum period should be no less than 5 months.

Extensions should be available.

The response times should be stated in the rule, rather than buried in the MPEP, or left to the ad hoc discretion of an Official in the reconstruction group. These are your errors, you are shifting the responsibility on us to fix them. Bind yourselves to exactly how this will be done. Burying the procedure in the frequently changed MPEP, which does not bind the Office anyway, or leaving it up to individual discretion, opens up this process to arbitrary and capricious action by individuals in the office. Personal experience verifies that even relatively benevolent bureaucracies which strive to create an environment of service to their customer base (as the Office usually

does reasonably well), occasionally mount actions reminiscent of a Franz Kafka novel. No point in tempting such actions here.

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