

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:

RIN 0651-AB19

For: **Notice of Proposed Rulemaking:
Treatment of Unlocatable
Application and Patent Files**

65 Fed. Reg. 42309 (July 10, 2000)

***Comments In Reply To the Notice of Proposed Rulemaking Regarding
Treatment of Unlocatable Application and Patent Files***

Commissioner for Patents
Washington, DC 20231

Attention: Robert W. Bahr

Sir:

In reply to the Notice of Proposed Rulemaking published July 10, 2000, at 65 Fed. Reg. 42309, Sterne, Kessler, Goldstein & Fox P.L.L.C. submits the following comments.

I. Proposed 37 C.F.R. §1.251(b)(2)

The proposed rule gives an applicant or patentee the option of producing the applicant's or patentee's records for the U.S. Patent and Trademark Office (Office) to copy. However, the proposed rule states that the applicant or patentee must also provide a statement that "the copy" is a complete and accurate copy of the correspondence.

Regarding the statement that the applicant/patentee must make, it is not clear whether the "copy" that the applicant or patentee must state is a complete and accurate copy refers to the material that the applicant/patentee provides to the Office or to the "copy" that the Office makes.

(A) If the statement is meant to refer to the material that the applicant/patentee provides for the Office to copy, the text of the rule should parallel the language used earlier in this section and recite, ". . . and provide a statement that the record that has been produced [the copy] is a complete and accurate record [copy] of the correspondence"

(B) If the statement is meant to refer to the copy that the Office makes, it is not clear when or how the applicant/patentee will be given an opportunity to review the same prior to making the statement.

II. Proposed 37 C.F.R. §1.251(b)(3)

The proposed rule addresses the situation that arises when an applicant or patentee possesses an incomplete record. The proposed rule allows the applicant or patentee to submit a copy of the incomplete record. However, the proposed rule does not provide for an option wherein the applicant or patentee could produce the applicant's or patentee's (incomplete) record for the Office to copy as in Rule 251(b)(2).

There is no reason why the option that is available to applicants or patentees that possess complete records in Rule 251(b)(2) should not also be available to applicants or patentees who possess partial records. The proposed rule should be written to allow for the applicant or patentee who possesses an incomplete record to have the option of providing the same for the Office to copy.

III. Summary

Consideration of the above comments is respectfully requested.

Respectfully submitted,

Sterne, Kessler, Goldstein & Fox P.L.L.C.

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