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**Subject:** FW: POPA Comments on Proposed Patent Rule Changes  
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From: Stern, Ronald  
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Subject: POPA Comments on Proposed Patent Rule Changes  
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In response to the invitation of Patent and Trademark Office for public comments regarding the 1996 Changes to Patent Practice and Procedure published in Federal Register, Vol. 61, No. 185, September 23, 1996, the Patent Office Professional Association (POPA) hereby sets forth the following comments:

(1) Rule 1.48 Correction of inventorship in a patent application.

The proposed rule deletes the requirement for diligence and showing of facts demonstrating that the errors in inventorship arose without deceptive intent. This change would simplify the granting of a correction of inventorship.

However, the correction of inventorship may materially affect examination. Note that each inventor or assignee has the right to file separate continuation, division, and continuation-in-part applications in accordance with Rule 1.53(i). Thus, a change of inventorship may make a parent patent available as a reference under 35 USC 102(a) or 102(g). See Ex parte Ebata, 19 USPQ2d 1952 (Bd. Pat. App. & Inter. 1991) and In re Bartfeld, 17 USPQ2d 1885 (CAFC 1991). Consequently, changes in inventorship late in the prosecution of an application may require substantial rework by the examiner.

Under the proposed rules, when an inventor is to be added, a statement is required only from the inventor who is to be added. No statement is required from the inventors who have already been named. Since the addition of an inventor dilutes the interests of those inventors already named, the concurrence of the originally named inventors should also be required.

(2) Rule 1.53 Application number, filing date, and completion of application.

POPA proposes that in a continuation or division filed under 1.53, applicant be required to show what and where the changes are in the disclosure. It is easier for the applicant to supply this information than it is for the examiner to find the changes. If the applicant informs the examiner of the changes, more examining time may be devoted to search rather than to the detection of changes made by applicant. The quality of examination will be enhanced by applicant's cooperation at this stage. See Armour & Co. v. Swift & Co., 175 USPQ 70, 79 (7th Cir. 1972) and General Staple Co. Inc. v. Magnifico, 189 USPQ 679, 685 (S.D. N.Y. 1976).

(3) Rule 1.59 Expungement of information or copy of papers in application file.

PTO proposes that examiners, rather than officials in the Office of Petitions, decide the petitions to expunge.

This type of petition will be seen so rarely by examiners that it will be very difficult to produce uniform and consistent decisions. The public would be better served by having the Group Directors or the officials in the Office of Petitions make the decision.

(4) Rule 1.60 Continuation or divisional application for invention disclosed in a prior nonprovisional

application; and Rule 1.62 File wrapper continuing application.

POPA supports these changes because the establishment of Continuing Practice Applications would simplify the administrative handling of applications..

(5) Rule 1.113 Final rejection or action, and Rule 1.116 Amendments after final action:

It is important to recognize that the changes in Rule 1.113(c) that would prohibit a first Office action from being made final are integrally coupled to the changes in Rule 1.116 that require amendments after final to be limited to the cancellation of claims or compliance with any requirement of form expressly set forth in a previous office action.

It is not clear whether the proposed Rule 1.116 will eliminate the practice of entering amendments in part. If applicant submits an amendment after final that complies with some requirements, but does not comply with other requirements, would the examiner be expected to enter all or part of the amendment?

The elimination of first action finals is a viable option only if the proposed change in after final practice is amended to limit amendments to those which put the case in the condition for allowance.

For example, if applicant submits a terminal disclaimer to overcome an obviousness type double patenting rejection pertaining to one element of a Markush group in a chemical application, entry of the terminal disclaimer would require the examiner to reopen the prosecution and to examine one or more other elements in the Markush group, i.e., the examiner would have to reopen prosecution. The application would not necessarily be allowable.

If the initial condition of a continuing application is no different than it was from the parent, to do any thing other than giving a first action finals would be in direct conflict with the Office policies to expedite prosecution, discourage submarine applications, and avoid unreasonable delay. See *Ford Motor Co. v. Lemelson*, 40 USPQ2d 1349 (D.C. Nev. 1996). It requires the examiner unnecessarily to reiterate the same rejection as in the previous final rejection when applicant's claims in the continuation application are of the same or substantially the same scope as the claims presented in the parent application.

(6) Rule 1.121 Manner of making amendments.

Proposed Rule 1.121 is unclear as to whether applicant is required to submit a marked-up copy of the specification and the claims when applicant files a separate continuation application under Rule 1.53. A similar question exists when applicant files a separate continuation of a reissue application. Without a marked-up copy, there will be an undue burden on the examiner to check for new matter and/or to check for applicant's broadening of the scope of the patent claims when the patent has been issued for more than two years.

POPA proposes that in a continuation or division filed under 1.53, applicant be required to submit the amendments with a marked-up copy to show the deletions and additions. This will save time during examination. See *Armour & Co. v. Swift & Co.*, and *General Staple Co. Inc. v. Magnifico*, supra.

(7) Rule 1.125 Substitute specification.

POPA supports this change because it will save examining time.

(8) Rule 1.135 Abandonment for failure to reply to an Office action.

Paragraph (c) raises a new problem. Currently, if the applicant's response is deemed to be a bona fide response, the examiner grants applicant one free month to complete the response. The proposed rule changes a gratis month to a shortened statutory time period, i.e., applicant may buy an extension of time.

POPA opposes this change because it encourages applicant to send in piecemeal responses to prolong the prosecution. Assuming arguendo that the examiner discovers applicant's non-responsive amendment at the end of the six month statutory time period of the prior Office action, the examiner sends a Notice of Non-responsive Amendment, applicant can buy extension of time for another six months, and then send another non-responsive amendment. Then the examiner has to send out another Notice of Non-responsive Amendment, applicant can buy extension of time for another six months, etc. The proposed rule does not specify how many times the examiner can grant the shortened statutory time periods for applicant to complete the response, i.e., how many times applicant can get extensions of time

This rule, as written, could be used as a subterfuge for extending prosecution..

(9) Rule 1.137 Revival of abandoned application or lapsed patent:

The proposed rule eliminates the present one year bar for filing unintentional petitions to revive under Rule 1.137(b).

POPA opposes this proposed rule because it seems to legalize submarine patents. An applicant could easily let the application go abandoned after the first action and wait to find out if the invention is developed by other entities. Applicant could easily wait for ten or fifteen years before filing a petition to revive. See Lemelson supra.

In addition, it does not appear to be in the public interest to permit applicant to delay disclosure of an invention for a long period of time.

Long delays in reviving an application will have an adverse impact upon examiners. An examiner, if still with the PTO, will have to spend extra time to reacquaint himself or herself with the case. If a new examiner has to be assigned to the revived application, it should be treated as a new case for the purpose of production credits. This rule will wreak havoc with our current production measurement system.

We recognize that applicants often misunderstand the deadline for filing a petition to revive because they believe the one year filing period is measured from the date of the examiner's holding of abandonment rather than the date upon which the period for response in the previous Office action expired. We think that an appropriate remedy is to measure the time for filing the petition to revive from the date of the examiner's holding of abandonment.

(10) Rule 1.152 Design drawings and Rule 1.154 Arrangement of specification of design application.

The proposed rule removes the prohibition against color drawings and photographs in design applications.

However, applicant may misunderstand the implications of submitting a figure in color. If applicant files color drawings, protection is provided only for the same color. On the other hand, if applicant files black and white drawings, protection is provided for all colors. The proposed rule should give notice or warning about these consequences.

The Office should also print the design patents in color if they are filed with color drawings and photographs. Currently, even if color drawings are accepted, the patents are printed in only black and white. Color patents would make the public aware of the color that the patent covers. It also would facilitate searching for color by the public and examiners.

(11) Rule 1.165(a) Plant Drawings

The current Rule 1.165(a) forms a basis for a good many rejections over illustration content, arrangement, and clarity as plant patent examination is a very specialized practice wherein the words "artistically and competently executed" actually mean something. This language is often used in leveraging applicants to come in with new and better illustrations. Deletion of this language would give examiners less leverage, potentially making rejections weaker, and resulting in issuing plant patents having drawings or illustrations which are not competently and artistically executed. Additionally, Rule 1.84 makes no specific mention of plant patents - it merely recites the standard requirements for utility drawings. Thus, Rule 1.165(a) as proposed would lead a plant patent applicant to a section which contains no assistance for plant patents.

(12) Rule 1.167(b) Examination

Deletion of Rule 1.167(b), which provides for affidavits from expert regarding the novelty and distinctiveness, would deprive applicant from certain well established venues of arguing novelty and distinctiveness of the plant. Rule 1.132 does not appear to cover this subject matter.

(13) Rules 1.171-1.177.

The above rules are related to reissue applications. POPA supports the change in the above rules since it simplifies the handling of the oath or declaration.

(14) Rule 1.193 Examiner's answer and substitute brief.

The significant change set forth in Rule 1.193(a)(2) is that an examiner's answer may not include a new ground of rejection. If an examiner would like to make a new ground of rejection after an appeal brief has been filed, his only recourse is to reopen the prosecution.

POPA opposes this change because it will unnecessarily delay prosecution. There are many situations in which the new grounds of rejection represent such a minor change that it would not warrant the delays associated with reopening prosecution. Currently, if the examiner includes a new ground of rejection, applicant may file a reply brief accompanied by any amendment or material "appropriate to the new ground". Applicant may amend the old claims only within the scope of the examiner's new ground of rejection. See current Rule 1.193(b).

Applicant is already protected against the unwarranted introduction of new grounds of rejection in an examiner's answer by the policy set forth in MPEP 1208.01. Protection for the applicant is particularly strong because it requires the concurrence of two examiners, one of whom is a supervisor, in order to enter a new ground of rejection on appeal.

Under the proposed rule, if the examiner has to reopen prosecution, applicant is at liberty to add new claims and new issues and thereby delay prosecution even more. It is unfair to examiners since they receive no additional credit for advancing a required new ground of rejection. The policy penalizes the examiner who has a conscience and who realizes that the case on appeal can be improved.

(15) Rule 1.196 Decision by the Board of Patent Appeals & Interferences.

Proposed Rule 1.196(b) in combination with the deletion of current Rule 1.196(d) allows the Board to reject any "pending" claim, instead of "appealed" claim. As proposed, the Board may reject claims that were allowed or withdrawn due to a restriction requirement.

Because the Board would have the authority to reverse an examiner's restriction requirement, potentially a new route of appeal has been created for what otherwise has been a solely petitionable subject. To solve this problem, POPA proposes changing the term "pending claim" in Rule 1.196(b) to "examined claim."

Thank you for giving us a chance to present the views of our Association. We hope they will be helpful.