

From 467061@ovmail.kodak.com Fri Nov 22 14:02:16 1996
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From: 467061@ovmail.kodak.com
To: regreformusptogov <regreform@uspto.gov>
Cc: ", " <LOCKOVM1@KA306FF4.kodak.com>
Subject: Comments re 1996 Proposed Patent Practice & Procedure Rule Change

To: OAS --MAILSERV
cc: LOCKOVM1--KA306FF4 ka306ff4

From: Gordon M. Stewart, 13/83/02201/RL (29424)
Subject: Comments re 1996 Proposed Patent Practice & Procedure Rule Change

COMMENTS TO USPTO REGARDING PROPOSED RULE AMENDMENTS OF SEPT. 23, 1996

1. These comments are submitted by Andrew J. Anderson, Francis H. Boos, Pamela R. Crocker, Robin G. Depoint, James Leimbach, Edith A. Rice, Norman Rushefsky, Gordon M. Stewart, and Peyton C. Watkins, all members of the Patent Legal Staff, Eastman Kodak Corporation, and represent the views of Eastman Kodak Corporation.

2. Whenever the PTO proposes unusually extensive rule amendments, as in the present case, further time (such as an additional month) beyond the normal two months should be granted for practitioners to provide comments. Therefore, some of the comments below leave questions for which further time for study is needed.

3. 37 CFR 1.4

Deleting the requirements for verified statements is a useful objective. However, this objective would seem to be accomplished by 1.4(3)(ii) alone. The proposed amendments to 1.4(2) appear to be unnecessary for this purpose and raise additional obligations on inventors and non-attorneys signing documents, the extent of which is not clear. For example, how much of an inquiry must a non-attorney make under paragraph (ii) regarding the claims and other legal contentions being warranted by existing law (if none, why is it needed)? Even for attorneys, it appears new obligations are created versus existing 37 CFR 10.18. For example, when an attorney argues the content of a prior art reference, is she certifying that a "reasonable inquiry" has been made as to the references content? If a reasonable inquiry has not been made, does this affect the application or issued patent?

4. 37 CFR 1.91

Does this rule as proposed, prevent the submission of 2-D exhibits as part of affidavits under 37 CFR 1.132 unless specifically required by the Office? If so, this proposal is objected to as unduly inhibiting establishing a record of the case for patentability.

5. 37 CFR 1.115

It appears that under para. (a), reference to "nonprovisional" applications not being amended, should be changed to "provisional" applications.

6. 37 CFR 1.116

The proposed restriction of amendment after final practice is objected to. The PTO comments state that amendments after final rejection under the current practice result in delay because applicants will await a ruling on whether such amendment will be entered prior to deciding whether to file a continuation application. The current 20 year patent term is sufficient incentive for applicants not to delay patent issuance. Furthermore, if any delay results, no one is affected other than applicant. The application of the proposed amended rule would be particularly harsh where a new ground of rejection is raised in the final rejection.

7. 37 CFR 1.137(b)

The PTO notes that there are already uncertainties under 1.137 as to whether an abandoned application might be revived due to the lack of a time limit under 1.137(a) and the fact that the office currently entertains petitions under 1.183. However, these at least provide some measure of assurance that a patentee cannot raise a dead application years later based on a simple statement of unintentional abandonment (although the Commissioner "may" require further information), to then enforce a resulting issued patent against a third party. In addition, 35 USC 41(c)(1) sets a 2 year limitation on reviving patents for failure to pay maintenance fees unintentionally. It would seem that a patent applicant should not be in a better position to revive than a patentee. Therefore, consistent with 35 USC 41(c), a good compromise would be to provide a 2-year limitation for revival of unintentionally abandoned applications under 1.137(b).

In any event, 1.137(b) should be amended to make it clear that a petition to revive should be filed promptly upon discovery of the abandonment, consistent with 1.137(a) and the PTO's interpretation of 1.137(b) in the Discussion relating to the proposed amendments.

8. 37 CFR 1.175

Since one can reissue a reissued patent, para. (a)(1) might be usefully clarified to state that "applicant believes the original patent or reissued patent...". Alternatively, since a reexamined patent may also be reissued, para. (a)(1) might simply state "applicant believes the existing patent...".

9. 37 CFR 1.530

Para. (d)(~~3~~) references details of paper, type size, clarity, etc. For simplicity, perhaps most or all of the requirements can be incorporated by reference to 37 CFR 1.52.

10. 37 CFR 1.177

It is not clear why under 1.177(a)(2) a petition (and accompanying petition fee) is required for each reissue divisional, particularly considering that for each a required filing and issue fee must be paid under (a)(3) in any event. If a petition on each case is appropriate, at most only one fee should be required.

11. 37 CFR 1.194

Para. (c) adds the statement that on an appeal, the Board may decide that a hearing is not necessary. The comments to the proposed addition state that this may be used where the Board decides on a remand to the Examiner. This should be stated in para. (c) rather than leaving an open statement that the Board may simply decide a hearing is not necessary.

12. 37 CFR 1.196

Added paragraph (d)(1) gives the Board authority to require Appellant to address any matter that is deemed appropriate. The corresponding Discussion seems to indicate fairly broad powers. Such a broad expansion is unnecessary and appears to place the Board into the position of being able to act as a first instance Examiner. In many cases the original Examiner is more appropriate to consider new matters raised for the first time by the Board (for example, the original Examiner may have more expertise in the particular technology than the Board members).

13. Removal of many rules on the basis that they represent internal Office practice needs further study. If this proposal is pursued, each rule proposed to be deleted must be further considered. Incorporating such rules into MPEP only leaves open the possibility of amendments without the usual publication and notice provisions.

Gordon Stewart