

From brwdynmrk@nmaa.org Mon Nov 25 08:45:15 1996
Date: Fri, 22 Nov 1996 18:45:22 -0800
From: Roger Browdy <brwdynmrk@nmaa.org>
To: regreform@uspto.gov
Subject: Comments on Regulation Reform

Box Comments -- Patents
Assistant Commissioner for Patents
Washington, D.C. 20231

Attn: Jeffrey V. Nase

Re: - Proposed Rule Making: Changes to Patent
Practice and Procedure
Docket No. 960 606 163-6163-01
RIN 0651-AA 80

Dear Sir:

Kindly consider our comments below on the proposed 1996 changes to patent practice and procedure. I apologize in advance for not having sufficient time to comment to the depth and on all of the proposed changes I would have liked to comment on; therefore, my comments are limited primarily to those proposed rule changes which I find particularly troublesome or long overdue. However, in view of the length and comprehensiveness of the changes, an extension of the comment period is requested.

Section 1.4(d)(2): The new language, particularly the expression "formed after an inquiry reasonable under the circumstances" suggests that practitioners will now be put under the obligation of questioning their clients each time they are given information and/or instructions. If they do not, and some information received later turns out to be incorrect, and in retrospect it is determined that the information presented was not reasonable (indeed, was not reasonable at that later date, after the statement was made, but might have been reasonable at the time it was made), a practitioner could be subjected to disciplinary action. On the other hand, it is absolutely impractical to double-check with a client each time one is given information or instructions by the client; it is unlikely that any client would tolerate being questioned about every fact given. If this section were to be changed slightly to remove the wording "formed after an inquiry reasonable under the circumstances", I would have no objection.

Section 1.91: The revised text appears to prohibit the submission of exhibits. This goes to the substance of some cases, and appears to deny applicants the right to prove their cases. For example, the revised language would appear to prohibit the submission of photographs or swatches of cloths as part of a declaration or affidavit under 37 C.F.R. §1.132. Moreover, even if such a declaration or affidavit is not filed, the applicant should be able to illustrate a point by the submission of such an

exhibit, be it photographic or otherwise. Certainly no rule should be promulgated which inhibits an applicant's ability to convince the examiner of patentability. How does this rule effect making demonstrations or showing exhibits at interviews without making the exhibits themselves of record? The latter should continue to be permitted.

Sections 1.104 and 1.105: I take extremely strong issue with the removal of these sections. They set forth obligations of the PTO and its employees. There are times when personnel of the PTO do not meet their obligations such as set forth in these rules; and it is fully appropriate that these rules be retained so that an applicant, when met by a failure of office personnel to meet their obligations, can be reminded by reference to the appropriate rule. This also applies to section 1.108.

Section 1.111(b): It appears that the change in language is intended to generate more paper in a way similar to the change made several years ago with regard to briefs on appeal by requiring the applicant to point out "the specific distinctions believed to render the claims, including any newly presented claims, patentable over the applied references." In appropriate cases, any worthy attorney would do that in any event. But there are some cases and some claims where the context, and especially the arguments presented, make these distinctions clear beyond doubt. In such cases the requirement that such distinctions must be set apart merely increases the amount of work required by the attorney, generating unnecessary costs and driving up the expense to applicants, without any benefit whatsoever.

Section 1.113(c): This new section is long overdue, is certainly welcome, and will avoid much game playing when an applicant decides that a continuing application would be desirable.

Section 1.112, 1.115 and 1.116: The prohibition against amendments after final rejection (except under the very limited circumstances specified) is one of the very worst proposals of the entire package. If this rule were to take effect, it would effectively limit applicants to one chance for amendment only. Realistically speaking, and bearing in mind that examiners receive credit by the number of disposals they achieve, the strong incentive to examiners would be to apply the most strict and stringent interpretations of this rule and prohibit amendments, even if legitimate, because refusing an amendment so as to require a refiling would result in two disposals rather than one. This is truly a terrible proposal, most unfair to applicants, and it should not be promulgated.

The comments state that the elimination of after final rejection practice is a quid pro quo for the elimination of first action final rejections and that persons submitting comments objecting to this proposed limitation of after final practice should frame such comments in the context that the proposed

elimination of first action final practice by the office is coupled to the proposed limitation of after final practice. There is no good reason why first action final practice should not be eliminated without any quid pro quo. The practice is anathema to practitioners and ignores the implicit right to get a first examination and a second examination every time a full filing fee is paid. Any prolongation in prosecution will not affect the public interest in view of the new 20 year patent term measured from the date of filing. It is a totally false premise that any quid pro quo is necessary to eliminate first action final rejection practice. It should be done because it is the right thing to do. On the other hand, the elimination of after final practice is the wrong thing to do for the reasons discussed above. Furthermore, elimination of first action final practice will still eliminate all papers previously filed merely to protect against a first action final rejection.

Section 1.121: It is understandable that the PTO would like to reduce the clerical time presently needed for "entering" amendments, but the proposed revisions in Rule 121 would in many cases be extremely burdensome on the applicant, would result in many more "messed up" files in the PTO, and might not save that much clerical time in the PTO because of the need to shuffle so many more extra pages which would be required if this rule change were enacted. Providing substitute pages creates entire new opportunities for mistakes to be introduced into official PTO files.

With regard to part (B) of Section 1.121(2)(i), the rule change would require more and more pages of paper which add nothing to the file, whereas the rules should instead encourage the reduction of the amount of paper required.)

The need for additional useless paper is exacerbated by the proposed Section 1.121(2)(ii). This is a total waste of paper and clerical effort for no apparent advantage. One can particularly foresee the added difficulties in so-called "jumbo" cases where there may be 50 or more claims; bear in mind the problems that this proposed rule would create if one word in one claim in a 50 claim application needed to be changed.

As regards Section 1.121(2)(iv), a simple mistake by an applicant could result in an applicant having to refile his application and go through an entirely new examination, simply because of a clerical error omitting a claim which should have been present (and would have been allowable) if it had not been missed because of a clerical error. This is an onerous rule change.

Section 1.137: The comments provide that the Office is proposing to either (1) eliminate the time period requirement for filing a petition pursuant to 1.137(b) or (2) provide comparable time period requirements for filing either a petition pursuant to §1.137(a) and/or §1.137(b), which period will be based upon the

date of the first Office notification that the application had become abandoned. The Office has invited interested persons to comment on each of these proposals. We believe that the first proposal should be adopted, particularly in light of the requirement that the entire delay be either unintentional or unavoidable. It would be inappropriate to set a time period from the date of the first Office notification as situations arise in which that notification was misfiled by the recipient; or due to some unintentional or unavoidable problem in the office of the patent attorney, the attorney in charge or the applicant is never notified of its receipt. In such circumstances, if the latter proposal were adopted, such situations would require extraordinary petitions, which does not seem to be within the spirit of the rule change. It would be better to simply eliminate the time period for filing a petition pursuant to 1.137(b) and require a statement that the petition was promptly filed after the applicant was notified of, or otherwise became aware of, the abandonment or lapse.

With respect to §1.137(c), the requirement for a terminal disclaimer for applications filed before June 8, 1995, should take into account that regardless of the term of abandonment, an applicant should always have at least twenty years from date of filing. Thus, any terminal disclaimer should only be for any term of the patent which may extend beyond 20 years from date of filing with such a disclaimer from that date on being only for the length of time that the application was abandoned. To the extent that a patent filed before June 8, 1995, is relying solely on its 20 year term, as is its right, it should not be treated any differently from an application filed after June 8, 1995.

Section 1.193(b)(1)

The proposed procedure for filing a substitute appeal brief would create many more problems and difficulties for applicant than it is intended to solve. The Board is used to following a thread of argument from an appellant's brief to the examiner's answer to an appellant's reply brief. Courts, such as the Federal Circuit, permit briefs and reply briefs. This is a very common procedure. Why is the Patent and Trademark Office seeking to adopt a new procedure which is totally different from common procedure? The Board will not have the benefit of the examiner's answer which responds to the points of arguments in the applicant's brief in a logical manner if a new brief is submitted in light of the examiner's answer to which the examiner has not responded.

The point that needs to be addressed is the right of an examiner to refuse entry of a reply brief. It is not appropriate for a party to the appeal to decide when another party's paper should be considered by the Board. This must be determined by the Board itself. The rule that a reply brief should respond to new points of argument by the examiner should be left but the examiner's discretion to refuse should be removed and the Board should simply decide how much weight should be given to the

arguments in the reply brief. This will help the Board in that it will leave the thread of argument in the response and reply, to which the Board can relate. Requiring an applicant to file an entire new brief when it only desires to respond to one point of the examiner is a waste of paper, resources and time on everyone's part. Why would the Board want to consider a fifty page brief instead of a five-page reply? This a bad idea and should be dropped.

Thank you for considering our views.

Respectfully submitted,

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