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Mr. Jeffrey V. Nase
Assistant Commissioner for Patents
Washington, D.C. 20231

RE: Comments to Notice of Proposed Rulemaking, published at 1191 OG 105

Dear Mr. Nase:

Please consider the comments submitted herewith that respond to the Notice of Proposed Rulemaking, published at 1191 Official Gazette 105 (60 Federal Register 49820). These comments represent views of a committee of patent attorneys here, after two meetings on the subject.

Although we raise a number of concerns in our submission, we commend the Office, taking the changes as a whole, in its attempt to simplify and to remove unnecessary rules.

As requested in the notice, I have enclosed a paper copy as well as an electronic copy on a 3¼ inch DOS-formatted disk.

I am available to answer any comments or questions regarding the attached submission. Thank you.

GREENBLUM & BERNSTEIN, P.L.C.

James L. Rowland

Enclosures: Comments, paper copy + electronic copy on 3¼" disk

JR/sw
(J104901.L04)

Comments on Proposed Rulemaking
Published at 1191 OG 105 on October 22, 1996 (60 FR 49820)

Submitted by GREENBLUM & BERNSTEIN, P.L.C., Reston, Virginia

The following comments are directed to proposed changes in 37 CFR Part 1 (no comments are directed to Parts 3, 5, or 7).

For each section of the rules that is addressed, the specific section of the rules is first identified, followed by a statement of our position regarding the PTO's proposed change, followed then by comments, explaining our reasoning behind our position.

Section 1.111(b)

Position

The following sentence, proposed to be added in §1.111(b), should be deleted: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over the applied references."

Comments

The proposed sentence is believed to be unnecessary and, particularly regarding newly presented claims in a response, it is at odds with the fact that the PTO carries the burden in the first instance of explaining any objection or rejection of an applicant's claims.

Section 1.111(b) already places an adequate requirement on an applicant in responding to an Office action, *viz.*, that (1) the reply must distinctly and specifically point out the errors in the

examiner's action and (2) the reply must respond to every ground of objection and rejection in the prior Office action.

The proposed sentence is of a type that belongs in the MPEP, if needed at all, as a suggested guideline. In this regard, the proposed rule change, particularly with regard to the addition of the proposed sentence, would be contrary to the objective stated in the first page of the proposal (*i.e.*, 1191 OG 105) that the proposed changes are directed toward "...(3) removal of rules and portions thereof that merely represent instructions ... more appropriate to inclusion in the ... [MPEP]".

Further, in the sentence proposed to be added to §1.111(b), the expression "the applied references" is misleading since it implies that every examiner's action includes "applied references". To impose a requirement, ostensibly in every reply, that "the reply must present arguments" regarding "the applied references" would therefore be illogical.

Still further, even if references were applied in a particular examiner's action, there are instances in which it is possible to prove a rejection erroneous for reasons other than due to "specific distinctions ... over the applied references". For example, if a rejection under 35 USC 103 were to be based upon an improper combination, *e.g.*, one in which a secondary document is from a non-analogous field of endeavor from the first, there might be no "specific distinctions" that could be relied upon that would render the claims patentable. In such an instance, the proposed sentence would impose a requirement on an applicant to engage in argumentation that might be inapplicable or inappropriate.

Other instances include one in which an applied reference fails to antedate an applicant's invention. No requirement should be placed upon an applicant in such an instance to "present arguments" regarding "specific distinctions".

Section 1.116(a)

Position

The proposal in §1.116(a) to limit amendments after final rejection or final action to (1) cancelling claims or (2) complying with requirements of form is not believed to be justified, even based upon the Office's explanation; the limiting proposal should not be made.

Comments

First of all, it is noted in the Office's discussion (on page 1191 OG 113) that the change "would not affect the authority of an examiner to enter in an application under final an amendment that places the application in condition for allowance, but does not strictly meet the requirements of §1.116(a)." If this is the Office's intention, it is contrary to the literal meaning of the proposed language, *viz.*, "to limit" the types of amendments after final.

In the Office's discussion (on page 1191 OG 113) of the rule change it is argued, with regard to the existing practice under §116, that "a significant burden on Office resources" is placed thereon in the expedited handling and consideration of amendments after final and that delays in the issuance of the application as a patent are caused "since applicants will await a ruling on whether such amendment will be entered prior to deciding whether to obtain the entry of such amendment through the filing of a continuing application."

In response, if an examiner were allowed to enter an amendment that "does not strictly meet the requirements of §1.116(a)", *i.e.*, amendments other than those to which the proposed rule change "limits" an applicant, applicants will still await the examiner's

ruling on whether an amendment will be entered (and the application allowed) despite the proposed change to §1.116. Therefore, the expedited handling of such amendments would still be required.

In this regard, amendments after final are less often filed with the sole objective of having such amendments entered for the purpose of appeal; more often, such amendments are filed with the primary objective of having the application allowed and, failing in obtaining allowance, applicants then resort to the secondary objective of having such amendments entered for appeal.

From an applicant's perspective, the concern for "expedited" handling might be lessened if the Office were to change §1.116(a) so that the filing of a timely and responsive amendment to a final Office action avoids the need for an extension of time (or an additional extension of time if the amendment were filed with an extension) in the event the application were not allowed by virtue of the amendment. That is, if an application were not to be allowed in response to an amendment after final, the time period for filing a continuation or for taking appeal would run from a new shortened statutory period set, *e.g.*, in an Advisory Action.

The stated *quid pro quo* for the purported strict limitation of after final practice, *viz.*, the elimination of first action final practice, is not believed to be satisfactory due to the excessive fee required to continue prosecution ($770.00 filing fee + claim fees over the minimum of 20 claims and 3 independents, for non-small entities). A more moderate fee for continuing prosecution (or for entry of amendments after final that do not meet the requirements of §1.116) would be more reasonable.

In addition, as explained below in our comments pertaining to the proposed rule change to §1.191(a), the proposed strict limitation of after final practice could have an adverse affect on a timely resolution of an appeal in certain instances.

Section 1.121(a)(2)

Position

In new §1.121(a)(2)(i)(A), the proposed rule that a claim may be cancelled by merely "omitting the claim when submitting a complete copy of all pending claims as required by (a)(2)(ii) of this section" should not be made. Likewise, new §1.121(a)(2)(iv) (providing for a failure to resubmit a previously submitted claim when submitting a complete copy of all pending claims to be construed as a direction to cancel such claim) should not be adopted. Instead, cancellation of a claim should be accepted only by an explicit direction to cancel the claim.

Comments

A clear understanding between the applicant and the examiner would be facilitated by an explicit, rather than an implicit, intention as to whether claims are to be cancelled.

First, consider the situation in which explicit instructions to cancel claims were required, rather than the Office's proposed rule: if, in an applicant's reply, an inconsistency were to be found by the examiner between an applicant's explicit instructions to cancel certain claims and the submitted complete copy of all pending claims, such inconsistency could be easily resolved by either a telephone call, fax, or other examiner communication.

On the other hand, according to the Office's proposed rule: if an applicant inadvertently omitted a claim not intended to be cancelled from his/her submission of a copy of all pending claims, such inadvertent omission would either go unnoticed and the application would be allowed and a patent issued without such claim (perhaps requiring a reissue patent to be pursued) or, if the inadvertent omission were noticed by the applicant after the

amendment were filed, the applicant might be forced to file a continuing application in order to re-introduce the omitted claim, particularly if the aforementioned rule change to §1.116(a) were adopted, limiting after final practice. Either penalty for an inadvertent omission of a claim would be arbitrarily harsh and unnecessary, particularly when a better alternative rule is available.

Section 1.191(a)

Position

In the proposed change to §1.191(a), directing when an applicant, whose claims have been twice rejected, can appeal, the insertion of the expression "in a particular application or patent under reexamination" should not be made, since the addition of the expression would render the section contrary to the meaning of 35 USC 134 and, further, the proposal could result in unnecessary additional costs of prosecution for an application and it could create unnecessary delays in taking an appeal.

Comments

The proposed change to §1.191(a) is contrary to the construction of the meaning of 35 USC 134 according to both the Commissioner and the Board of Patent Appeals and Interferences (including the Chief Administrative Patent Judge) and, in addition, would serve to create unnecessary delays in prosecution of applications in certain instances.

In Ex parte Philippe LEMOINE, Appeal No. 94-0216 (Board of Appeals and Interferences), decided December 27, 1994 by an expanded panel including the Chief Administrative Patent Judge, and submitted for publication in a letter dated June 10, 1996, in determining whether it had jurisdiction of the appeal, the Board

interpreted the meaning of the term "claims", as used in 35 USC 134. §134 reads as follows:

> An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

The Board decided that, unlike the use of the term "claims" in 35 USC 112, ¶2 (*i.e.*, "one or more claims particularly pointing out and distinctly claiming the subject matter" of the invention), the word is instead properly interpreted in §134

> in a more general sense to refer to claims 'for a patent' as it is used in 35 U.S.C. §132. In this latter sense, the word is synonymous with a request or demand for a patent.
> ... We conclude that 'claims' in §134 should be construed consistently with its use in §132 to mean 'claims for a patent' rather than particular 'claims of an application.'

Ex parte Philippe LEMOINE, pp. 8-9.

In LEMOINE, the applicant took appeal from a first action non-final rejection in a continuation application. He had had a number of discussions with the examiner during prosecution of the parent application. In the final personal interview with the primary examiner in the parent application, it was determined by both the examiner and the applicant that no further arguments could be presented that would convince the examiner that the applied reference was defective. Therefore, it was decided by both the examiner and the applicant that an appeal would be necessary if the allowance of the application were to be pursued. However, a File Wrapper Continuation application was filed with a preliminary amendment to add certain claims and amend others, although no change was expected, nor was a change made, in the examiner's position as reflected in his first (non-final) Office action in the continuation. There being no need to further argue his position,

the applicant filed a notice of appeal instead of further arguing his position.

The timeliness of the filing of the notice of appeal was challenged by the examiner, who held the application abandoned several months after the notice was filed, although the timeliness was upheld in a favorable decision on petition to the Commissioner, who directed that the holding of abandonment be withdrawn. Thus, both the Commissioner and the Board have decided that an appeal can be taken after an applicant has been twice rejected, whether the rejections have been made in one or plural applications.

In addition to the fact that the proposed change in §1.191(a) is contrary to recent decisions of both the Board and the Commissioner, arguments opposing the proposed change are strengthened further when the proposed change to §1.191(a) is considered in conjunction with the proposed change to after final practice, discussed *supra* in connection with the proposed change to §1.116(a).

In this regard, consider an amendment filed after a final Office action which, although not resulting in the allowance of an application, would be entered under current practice as presenting the claims in better form for appeal. Such an amendment, under the proposed after final practice must be filed in a continuation application. However, the applicant would not, under the proposed change to §1.191(a), be permitted to take appeal until after he/she were to present further arguments before the examiner. No reason is given by the Office in requiring such further prosecution.

If an applicant (and, possibly the examiner as well) were to believe that all issues have been thoroughly argued in the parent application, the proposed requirement of an additional reply by the applicant and an additional Office action by the examiner would merely delay the resolution of the matter at appeal. As stated by

the Office (at 1191 OG 113) in its discussion of its proposed change to §1.116, "[t]his procedure [would cause] delays in the ultimate issuance of the application as a patent."

Section 1.193(b)

Position

The proposed change to Section 1.193(b) that replaces the filing of a reply brief, with entry at the discretion of the examiner, with a substitute appeal brief, with entry as a matter of right, should not be made. Instead, a right of entry of reply briefs should be adopted.

Comments

No reasons are given in the Office's discussion of this proposed rule change as to why a substitute appeal brief is favored over a reply brief. The concern over controversies as to whether a reply brief is directed only to new points of argument could just as easily be resolved by giving an appellant a right to the entry of a reply brief.

Further, the provision of a substitute brief instead of a reply brief would not likely serve to motivate an examiner to ensure that he/she has issued complete and understandable Office actions. Instead, if an appeal were to be taken, the change would likely encourage certain examiners to treat the issues fully only after receiving an appeal brief. Under the current practice, the possible submission of a reply brief, that could list numerous new points of argument, thereby at least implicitly demonstrating that the final Office action was less than a complete treatment of the issues (such complete treatment only being made in the Examiner's Answer), serves to motivate certain examiners to treat the issues fully in the final rejection, if not sooner.