

From hamlet@mwzb.com Mon Nov 25 08:47:09 1996
Date: Fri, 22 Nov 1996 18:45:37 -0500
From: hamlet@mwzb.com
To: regreform@uspto.gov
Subject: Comments Re: 1996 Proposed Rules Changes

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November 22, 1996

BOX COMMENTS -
Assistant Commissioner for
Patents
Washington, D.C. 20231
Attn: Jeffrey V. Nase

Sir:

The following are comments on the PTO's proposal for amendments to the patent rules.

37 C.F.R. 1.4 - Nature of Correspondence and Signature Requirement

In 1.4(d)(2), the phrase "formed after an inquiry reasonable under the circumstances" should be deleted as it is too vague as to what is meant by "reasonable" and too burdensome in requiring an inquiry where unnecessary. Similar language was proposed for Rule 56 and was not accepted.

1.41 - Applicant for Patent

The proposed amendments to this section eliminating the requirement to identify the inventors prior to filing the oath is endorsed.

1.47 - Filing when an Inventor Refuses to Sign or Cannot be Reached

No advantage is seen in publishing information on all applications where an inventor is "nonsigning". If "nonsigning" inventors are mailed notice and a receipt has been returned, then publication is extraneous. This is especially the case since the unnecessary dissemination of information about applications is detrimental to the confidentiality in applications.

1.48 - Correction of Inventorships in Patent Applications

The language of 37 C.F.R. 1.48(b) should be changed so that an inventor can be deleted when necessary due to amendments to the claims irrespective of whether the correct inventors were named when originally filed. For instance, if the application was filed with incorrect inventorship and a

subsequent correction was made by adding an inventor, the literal reading of the proposed rule would not allow removal of an inventor if necessitated by a subsequent amendment.

Proposed language: "If the correct inventors are named in a nonprovisional application [when filed] and the prosecution of [the] a >nonprovisional< application results in the amendment or cancellation of claims so that less than all of the >originally< named inventors are the actual inventors ..."

1.53 - Application Number, Filing Date and Completion of Application

The procedures for a continued prosecution application under 1.53(b)(3) suffer in requiring that priority be claimed under 35 U.S.C. 120 and that an examination be made to determine compliance with 35 U.S.C. 1.51(a)(1). For example, requiring the statement "this is a continuation/divisional of prior application number #####, filed #####, now abandoned," to claim priority under 35 U.S.C. 120 will cause confusion since the same application number is retained for both the abandoned and pending applications. A procedure more favorable would be one analogous to that under 37 C.F.R. 1.129 for continued examination after final rejection. Under 37 C.F.R. 1.129, the application number is not changed, there is no need to claim priority under 35 U.S.C. 120 and the submission need not be reviewed for compliance with 35 U.S.C. 1.51(a)(1).

If the need to claim priority to a parent application is retained in these procedures, the required statement should indicate it is a "continuation prosecution application" and reflect the status of the prior application as "now refiled" in lieu of "now abandoned".

Proposed Rule 1.53(b)(3) governing continuing prosecution applications is limited to applications filed after June 8, 1995, "so as to avoid any dispute as to whether the application is subject to [the] 20-year patent term ...". However, the proposed rules eliminate Rules 60 and 62 for all applications. Therefore, the only way to continue prosecution of an application filed before June 8, 1995, is to file under 1.53(b)(1) where a new serial number is assigned. Since these applications are the oldest ones before the office, the need for expediting prosecution (as under current 1.62) stated by the PTO to be the reason for the continued prosecution practice of proposed 1.53(b)(1) is the greatest. Therefore, 1.53(b)(1) should be available or 1.62 should be grandfathered in for such applications.

1.111 - Reply by Applicant or Patent Owner

The requirement that the reply "must present arguments pointing out the specific distinction believed to render the claims, including any newly presented claims, patentable over the applied references" is unduly burdensome, requiring that arguments be presented when unnecessary, e.g., where a prima

facie case is not adequately established and/or motivation for continuation or modification of references is lacking. In such situations, it should be sufficient to state these facts rather than to engage in differentiation of claims. Otherwise, the requirement will interfere with meaningful communication with the examiner. Moreover, it is not clear whether the phrase "specific distinction" would cover all aspects of argumentation, e.g., lack of motivation, unexpected results, etc.

1.113 - Final Rejection or Action

The proposed amendment to this section with respect to eliminating first action final rejections is endorsed.

1.115 - Amendment

The proposed amendments to this section with respect to requiring that terminology used in the claims appear in the specification are seen as unnecessary and impose an undue burden on the applicant. Parrotting the language of the claims will not enhance the disclosure or help satisfy the requirements of 35 U.S.C. 112, first and second paragraphs, but will jeopardize the validity of all claims if the language added to the specification from a new claim is later found to be new matter, whereas currently the presence of new matter in a claim will not jeopardize other claims not similarly affected.

1.116 - Amendments after Final Action

The proposed amendments to this section pertaining to limiting amendments after final to canceling claims or complying with any requirement of form expressly set forth in a previous office action will limit the ability to reduce issues on appeal, e.g., by eliminating a rejection under 112. The examiner is in the best position to expedite prosecution of an application after final and the entry of amendments after final should be left to his or her discretion.

1.121 - Manner of Making Amendments

Regarding the automatic cancellation of a claim by failure to include it the fully retyped version of the claim, we propose that a very liberal procedure be adopted for reinstating unintentionally omitted claims. For example, when there is no direction to the PTO to cancel a claim but the claim does not appear in the claim set, the PTO should permit reinstatement, without any fee over the normal claim fee, merely with a statement that the claim was unintentionally omitted. Perhaps an "undue burden on the examiner" test could also be included.

1.135(c) - Abandonment for Failure to > Reply < [respond] Within Time Period

The PTO comment regards the change as a remedial change for the benefit of the applicant. However, in cases where, in the past, it was possible to cure an inadvertent omission in a response to any office action, by the examiner giving the applicant a 30 day period to cure the defect, the new rule proposes that the remedial action be limited to replies to "non-final" actions. This is objectionable because, if the case is placed in condition for allowance except for an inadvertent omission, it would be to the benefit

of all concerned to permit the inadvertent omission to be remedied in the same manner as a response to a non-final office action.

Also, 1.135(c) is supposed to provide the applicant with the opportunity to supply the omission or to file a continuing application instead. However, because of the use of the word "may", the practice will not be standardized throughout the PTO. Consequently, it would improve the rule to replace "may" with "shall". Also, the rule now states that the applicant may be given a new time period...to supply the omission or to file a continuing application.... This may be interpreted by examiners as giving them the option of deciding whether the applicant will receive the opportunity to file only a continuing application -- rather than supplying an omission. Thus, it would be beneficial for the rule to be worded after 1.134 by the inclusion of "at applicant's option". Thus, 1.135(c) would be benefitted as reading as follows:

When action by the applicant is a bona fide attempt to reply and to advance the case to a final disposition, and is a substantially complete reply to the office action, but consideration of some matter or compliance of some requirement has been inadvertently omitted, applicant shall be given a new time period for reply under 1.134, to supply the omission or to file a continuing application at the applicant's option.

1.136 - Filing of Timely > replies < [responses] with petition and fee for extension of time...

The proposal to amend this section to permit an omnibus authorization, in writing, for charging future extension fees is endorsed.

1.193 - Examiner's Answer > Substitute Brief <

The proposed amendments requiring reopening prosecution when a new ground of rejection is set forth and allowing submission of substitute brief are endorsed.

1.197 - Action following Decision

The proposed amendments with respect to empowering the Board to consider submissions relating to a new ground of rejection over allowed claims is endorsed.

1.291 Protests by the Public Against Pending Application

The revised paragraph (c) is unclear as to the circumstances under which a subsequent prior art submission will be considered. The PTO comment states that entry of later submitted prior art does not assure its consideration by the examiner if submitted late in the examination process.

At the very least, the proposed language should be amended to define a time after which submissions will be deemed "late" and not guaranteed consideration. It is suggested that the words --which will be considered if filed before a final office action or notice of allowance is issued-- be inserted after "except for additional prior art." Further, protestors

should be given the opportunity to obtain consideration of late-filed references with payment of a fee; otherwise, protestors will merely file a new protest under the revised rules allowing more than one protest per protestor.

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.