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Subject: Comments

Attached are the compiled comments from the firm.
The document is in WordPerfect 5.2 format.

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[Part 2, Application/MAC-BINHEX40 22KB]
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The following comments to the PTO PROPOSAL MAKING MISCELLANEOUS AMENDMENTS TO PATENT RULES OF PRACTICE - 1996 are being submitted by George E. Oram, Jr., Registration No. 27,931 on behalf of the firm of NIKAIDO, MARMELSTEIN, MURRAY & ORAM, LLP. Each comment is preceded by the rule concerned.

1.4(d)1(ii) line 2 appears redundant "Be a copy ~~>~~of a copy of a copy<."

1.48 Correction of inventorship to simplify the procedure in the manner proposed could lead to questionably invalid patents. That is, removal of the requirement for all of the inventors to aver that the error arose without deceptive intent, opens the situation where deceptive intent is present and the removed inventor is being unilaterally and improperly removed using 1.48(b).

1.48(f) providing the automatic correction of inventorship on an application filed without declaration under 1.63 may be difficult to administer without additional procedures to ensure that the declaration is actually being filed in the correct application.

1.53(b) (3) replaces 1.62, except for major potential problem with 53(b) (3) (i) (A) proposing to use the same application number as the parent application. Instead of considering the procedure to be a refile of the application, why not simply use a procedure similar to 1.129(a) and just literally continue prosecution in the same application. That is, do not include the procedure under this rule, but rather make its own rule (perhaps 1.61, to make it clear that it is not under the old rules). There is nothing in the rule as proposed that has any advantage to the Office or to the applicants. Further, this would avoid any confusion as to 35 U.S.C. 120 or 121 with respect to identification of the prior application.

1.53 The phrase "most immediate prior national application" is proposed in the new amendment rather than "prior application" to accommodate those situations in which the prior application was filed under current 1.60 or 1.62, or where the prior application was itself a continuation or divisional application and filed with a copy of the executed oath or declaration from a prior application pursuant to 1.53(b) (1) (i). This is difficult to understand, and does not seem to be explained clearly. If the applications were prior 1.62 applications, there is no copy in that complete application of the declaration or oath filed in that application.

1.53(b)(1)^(v) The filing of copy of unexecuted oath or declaration that is alleged to be true copy of one subsequently executed and filed to complete the prior application is strange at best since the applicant or attorney should have a copy of the declaration that was filed to complete the prior application or could obtain a copy from the Office records.

1.53(b)(1)(ii) If adding inventor, or CIP then new oath or declaration is required. Does this have to be signed by all the inventors or only by the newly added inventor(s)? 1.53 needs to be consistent with the changes to 1.48. ^{yes} ~~no~~

1.63 Why is there a continued requirement for the residence of an inventor? It is not required by statute or even by logic. A postal address is sufficient for the Office to communicate with the inventor(s) if necessary and will also identify where the applicant is at the time of filing the declaration.

1.101, 1.104, 1.105, These removed rules, while in the province of the Commissioner and do relate to the function of the Office, do have far more force with respect to the actions of Examiners than that of the MPEP. Additionally, they are useful in convincing Judges of the procedural aspects of the PTO and carry far more weight than that of the MPEP.

1.101, 1.104, 1.105 need to be retained because they do direct the examiner to perform certain actions in certain manners. If examiner fail to follow such procedures, a petition under 1.181 can clearly be used. If the rules are removed, there is no minimum requirement for the examining corps. This may result in a flood of petitions under 1.182 since it will no longer be provided for under the rules. While the MPEP is a useful guide and is the basis for the examiners to operate under, it does not have the force of rule.

1.104(d) should be retained to have a basis for applicants to be able to request an International-type search report, especially if 1.104(c) is deleted.

1.104(e) should be retained or at least the definitions should be kept some where in the rules (perhaps 1.9) so that there is clarity for examiners and applicants.

1.113 Propose a new simple rule that if new reference cited against the claims for the first time the office action cannot be final. The examiner should be examining the application, not just the current claims. The best art against the "invention" should be in the case.

1.113 The elimination of all after final amendments that do not cancel claims on rationale that can always file continuing prosecution application coupled with 113(c) addition of no finals on first action would be a more significant waste of resources worse than current practice. Currently, there is incentive for clerical personnel and examiners to expedite and move 1.116 amendments through. Savings under new rules would be lost with more repeated first non-final actions. Applicants would have to wait two additional office actions to have amendments considered by BPAI instead of having amendments entered that place application into better condition for appeal. It is believed that the current practice is less burden on the Office than the proposal, since there would be more substantive and effective examination prior to appeal.

1.113(c) is not clear for continued prosecution application as to whether the action specifically is a "first" action. If so, then there is a difficulty with respect to appealing that action under 1.191.

1.116 Part of the difficulty in the assumptions behind some of these rule changes resides in whether there is a "right" to have amendments entered after the second action. It seems to be assumed that all applicants have a full appreciation for the scope of their invention and submit a range of claims that runs from the extremely broad to the narrowest possible and remain less than several pages. Following first action, replies are made taking into account what the examiner has done. However, most practitioners are not mind readers of examiners and do not know what other art may be not yet cited and so do not generally submit claims that they may not consider necessary. This may be come a bigger factor depending upon how the final form of 1.121 ends up. 1.116 should be amended to allow entry of additional amendments but do not require the examiner to have to give new action, and do not require the examiner to withdraw the final in an advisory. The examiner could

give reason and issues remaining to permit meaningful appeal. It is felt that the alleged "new issue" under current practice generally comes from responding to something said by examiner or examiner finds new "reference" necessitated by amendment.

1.116 "Section 1.116, as proposed, 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)" but there is no incentive for the Examiner to even look closely at any amendment.

1.121(a)(2)(ii) would require that when a previously submitted claim is amended, or when a new claim is added, applicant must submit a separate copy of all pending claims to include all newly rewritten claims, all newly added claims, all previously rewritten claims that are still pending and any unamended claims that are still pending. In the event that only a minor amendment is made to one claim, in cases with a large number of claims the paperwork would clog the Office. Instead, perhaps only the sheet(s) of paper that has an amended claim(s) should be filed as an addendum to the reply with the application number and date of reply at the bottom so that a set of complete current claims can be kept on one side of the file wrapper.

1.121(a)(2)(iv) would provide that the failure to submit a copy of any previously submitted claim would be construed as a direction to cancel that claim. There could be an inadvertent error that would substantially prejudice applicant rights. Perhaps this should be a rebuttable presumption that could be corrected upon the next paper in the prosecution.

1.121(b)(1)(ii) would require that all amendments including deletions be made by submission of a copy of the rewritten paragraph(s) with markings. This would generate more tons of paper in the Office. Perhaps substitute pages, with an application number and date at the bottom of the page, could be filed. However, there still remains the thickness of file problem.

1.121(b)(2)(ii) would require that each amendment submission set forth the status of all patent claims and all added claims as of the date of the submission. This makes good sense if all claims

(including non-amended claims) are not required to be presented with each submission. However, it is redundant if all claims are required to be submitted each and every time at pain of loss of claims.

1.121(a)(1)(iii) is unclear as to how to identify the specific rewritten sentence, paragraph or page. Why not require simple substitute pages in all cases with page marked at bottom with "SUBSTITUTE" , the application number, and the date of the change.

1.121 should require a status listing of the claims rather than submit every pending claim every time (like reexam and reissue, brief).

1.122 needs to be retained since it is useful to have to explain to courts what all the markings in the file history are and how they arose.

1.125(b)(2) is potentially confusing with regard to exactly what is to be given to the Office with the substitute specification, even though section (c) requires it to be in clean form without markings. Isn't this doubling the amount of paper being submitted?

1.135 New section 135(c) would be good for realistic corrections of inadvertent omissions or oversights in responding to an non-final Office Action, but seems susceptible to intentional misuse. Current practice forces correction as soon as possible with minimal passage of time for both the applicant and the Office.

1.136(a)(1) It is good to explicitly provide for a fifth month of extension of time at a fee, rather than require pre approval. It is only to the loss of the applicant for the extra month, in view of the 20 year term. However, there is no statutory authority for the amount of \$2010, under 35 U.S.C. 41(a)(8)(C). Subsequent petitions should be at specific increases. It is not understood how the increase of \$540 over the fourth month level was calculated.

1.137(a) The provision of time period within which to file a petition to revive an unavoidably abandoned application or unintentionally abandoned application is good as long as it is rebuttable. Three months seems reasonable but there could be a

situation where both the delay in responding to the outstanding requirement and the delay in filing the petition following notification were unavoidable. One example might be multiple hospitalizations of the representative. A mis-mailed Notice of Abandonment as well as original office action even though the Office had been properly notified as to attorneys change of address, could be another. While the use of 1.182 petitions for waiver may be one route to ease such a situation, this still costs an additional petition and petition fee for something that presumably is at no fault of the applicant or his/her representative.

1.137 If there is to be no time limit for the filing of a petition to revive an application, some provision for intervening rights needs to be added to protect the innocent "infringer". This will be especially needed following passage of 18 month publication.

1.137(b) In order to have a time certain, it is probably better to base it on the date of notification, if that can be certain. However, in the case where the Notification was mailed to a wrong address and the Notice of Abandonment is very late in arriving, the applicant could be out of luck.

1.175 The making of 175(a) easier with regard to specifying how each and every error arose and how it was discovered without deceptive intent is proper under the statute and would end the current practice where form rules over substance.

1.175 It is felt that do not need final declaration, only initial one. The final declaration addressing all of the changes made during prosecution of the reissue application does not really accomplish anything. It is believed that this was the practice in the Office over 10 years ago.

1.175 An alternative at the end of prosecution of the reissue application would be a statement by the attorney that on information and belief that not aware of deceptive intent.

1.181(d) should be retained since it gives fair warning to all and gives the consequences of failure to pay the fee.

1.181(e) should be retained since it pre-empts actions suing the Commissioner attempting to force an Oral Hearing.

1.181(g) should be retained since it gives explicit authority to whomever the Commissioner decides should have it under a specific rule. While this is somewhat of a bootstrap lifting argument, it does add weight.

1.184 should be retained since it makes clear the policy of the Office and sets the standard for review. While 1.184 may be internal instructions to the Commissioner and the Office, it is effective notice having the rule of law for the rest of the world. Eliminating it serves no purpose and raises a question as to whether it would be possible. Further, it not a bad idea to limit future Commissioners. Additionally, rules 351 and 352 serve as notice to courts and rest of world of how the procedure is to be. Mere internal practice of the agency, the Office, may be open to a lot more challenge.

1.191 Why not permit appeal following second rejection of the claims in either this application or a predecessor application, for example following first action (non-final under 1.113(c)) but actually the second action with the same rejections since the final in the parent may have been the same. The applicant should not have to file a pro forma response or to repeat a response with the subsequent delay in the Office and on the side of the applicant.

1.193(b)(1) Substitute briefs seem to be a good idea since it does get the latest, yet complete paper before the Board and there would be no need to tie together the arguments or to debate whether a particular point is a new ground of argument.

1.193(b)(2) If the Primary Examiner reopens prosecution after an appeal brief has been filed, this rule or 1.113 should state that the action cannot be final.

1.196(d) would appear to allow the applicant to reopen the record and have materials never before the Examiner be considered by the Board. The citation of case law, whether newly created, (recent CAFC cases or other precedental Board cases) would be appropriate, but the addition of test data or known prior art would be to place

the Board as an initial fact finder rather than the Examiner. It may be better to develop a procedure to return the case to the Examiner to reopen prosecution or at least reconsider the rejections. The standard could be good and sufficient reasons why the information was not earlier presented.

✓ 1.530(d)(6) is a good clarification that leads to clearer status of materials in the record and the patent.