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Subject: Rule Which SHOULD Be Amended

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November 22, 1996

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I would like to comment on a Rule which I think should be amended along with the other changes proposed in the 1996 Changes to Patent Practice and Procedure, published for public comments at 60 FR 49820.

I propose that Rule 1.129 be amended to apply to applications which claim priority to applications that were over 2 years old on June 8, 1995, in which a Notice of Allowance has been issued, whether or not the issue fee has been paid, in which it becomes necessary to withdraw the case from issue, so that such applications do not lose patent term. It does not make sense that this safe harbor provision protects applicants who have not managed to present claims to allowable subject matter after at least three and a half years of prosecution, while applicants who have advanced prosecution to allowance are penalized by losing patent term for doing so, when they then discover a need to continue prosecution.

In order to get an IDS entered after a Notice of Allowance (and before payment of the issue fee), one must be able to make the certification under 1.97(d). If the certification cannot be made, applicant can submit the reference(s) to the PTO, but in accordance with 1.97(j), the IDS will simply be placed in the file but will not be considered by the Examiner. In order to have the IDS considered, a continuation application must be filed, thus subjecting the applicant to loss of patent term in a Pre-GATT filing that was pending over 2 years on June 8, 1995.

MPEP 1308.1, Rejection after Allowance, states that:

When a new reference is discovered [it does not specify by whom], which obviously is applicable to one or more of the allowed claims in an application in issue, a letter is addressed to the group director, requesting that the application be withdrawn from issue for the purpose of applying the new reference. This letter should cite the reference, and, if need be, briefly state its application. ... the application is thus restored to its former status as a pending application awaiting action by the examiner. The examiner at once writes a letter in the case stating that the application has been

withdrawn from issue, citing the new reference, and rejecting the claims met thereby.

This seems to contradict the spirit of 1.97(i), which states that late references which are not submitted in compliance with 1.97(d) will not be considered without the filing of a continuation application.

However, since the cure for not being able to make the certification after issuance of a Notice of Allowance is to file a continuing application (MPEP 609B(3)), it would seem that there should be a parallel transitional route for getting limited reexamination OF THE SAME APPLICATION in applications pending over 2 years, which are comparable to refiling the application, for allowed applications in which, for example, new references come to light, without subjecting the application to the 20-year term.

Note that reference is made to MPEP 706.07(b) for when a first action final rejection would be proper in a continuing application; that section refers to situations "where the continuing application contains material which was presented in the earlier application after final rejection OR CLOSING OF PROSECUTION, but was denied entry because (1) new issues were raised that required further consideration and/or search, or (2) the issue of new matter was raised." 60 FR 20199 states that "The identical procedure will apply to examination of a submission considered as a result of the procedure under 1.129(a)." Certainly in the case I am focusing on, in which a pre-GATT application has been allowed, prosecution has been closed.

Moreover, the rejection under 1308.1 should not (could not?) be made final, since the reference was never considered. Yet MPEP 706.07(b) states, in discussing when a first action final rejection would be proper in a continuing application, refers to situations "where the continuing application contains material which was presented in the earlier application after final rejection or closing of prosecution, but was denied entry because (1) new issues were raised that required further consideration and/or search. This certainly seems to imply that there are circumstances "after closing of prosecution" where entry of some sort of submission would be acceptable (i.e., a 1.312 amendment that complies with that rule) and some where it would not (i.e., a 1.312 amendment that does not comply [more than matters of form, or why the amendment is necessary and not presented earlier]).

MPEP 706.07(g) notes that in view of [the magnitude of] the fee under 1.17(r), — any IDS previously refused consideration in the application because of a failure to comply with 1.97(d) will be treated as though it has been filed within one of the time periods set forth in 1.97(b), upon the filing of the fee and the required submission. Why should that only be true in an application in which the claims were NOT allowed, but not in one in which they WERE allowed? I don't see any policy justification for there being such a big difference in the punishment for failing to timely submit the references. In the latter case, the punishment is far more severe, because you have to

pay the big fee just to get consideration AND you lose patent term. In the former case, you had to file the big fee anyway, because your claims were still in poor shape, but you get the bonus of a free ride for any references which do not comply with 1.97(d).

Therefore, I submit that the safe harbor of Rule 129 should be extended to any pre-GATT application which was pending over 2 years on June 8, 1995, and not limited to applications which are finally rejected. It is noted that the requirement that this paper not be submitted for purposes of delay would apply.

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