

From Paul_Morgan@mc.xerox.com Tue Oct 15 09:02:58 1996
Date: Mon, 14 Oct 1996 14:22:24 PDT
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Subject: PTO Proposals For 1996 Rules & Practices Changes

This is an informal and purely personal initial response to the extensive PTO Rules amendment proposals recently posted on the PTO internet Web Site, internet labeled <http://www.uspto.gov/web/offices/com/sol/notices/aa80.txt>. [I experienced rule insert (> <) symbols conversion errors in downloading]. This new set of proposed 37 CFR changes and accompanying comments prints out as 91 pages, single spaced, in a small font, and I was informed that the PTO's internal typed draft was about 200 pages. These proposed new rules are indicated to have been formally published in the Federal Register on Sept. 23, as "1996 Changes to Patent Practice and Procedure." They have subsequently been published in the BNA PTCJ, Volume 52, No. 1295, dated September 26, 1996. It is noted that these extensive PROPOSED rule changes are in addition to a set of FINAL new PTO Rule changes recently published.

In this PTO announcement, comments were requested to be made by email, to the above email address.

First, it is respectfully submitted that the indicated November 22, 1996 deadline for sending in comments is insufficient for such a large number of changes in PTO practices, especially for organized responses by patent bar organizations.

Secondly, although several of these proposed changes are commendable improvements, I have already heard strong expressions from several other practicing patent attorneys adverse to the following two particular such PTO proposals:

(1) the PTO proposals to effectively eliminate almost any Rule 116 amendments after final, even (especially) where the examiner has raised new grounds of rejection for the first time in the second office action; and

(2) the elimination of reply briefs in appeals, and making applicants re-file new main briefs instead.

Item (1) is viewed as actually counterproductive, in that it will increase application delays and backlogs and increase costs by increasing unnecessary continuations and appeals. In particular, while present 116 amendments can quite often result in prompt patent issuances, especially where the problem was second office action errors or misunderstandings, this rule change will instead force applicants into increased unnecessary appeals, or the filing of unnecessary, costly, and time consuming continuations, in almost every original application not allowed in a first or second office action. Each such added continuation will cause PTO continuation assignment and handling delays, plus delays for two more office actions and their

responses and considerations. Either such forced alternative will consume several more years of application prosecution delay in each case. {Further comments and preferred alternatives are discussed below}

Re item (2), it is believed that this will not only be a burdensome increase in paperwork, it will cause more time delays for everyone than a reply brief, and lead to new arguments over the revisions to the main brief. One of our most experienced PTO practitioners has a comment, in the form of what seems to be a better alternative for the public as well as the PTO, than this PTO proposal to prohibit any reply briefs, AND to make applicants retype, recopy and re-submit another entire, revised, main brief instead (which seems hardly in the spirit of the Federal Paperwork Reduction Act). He submits that the real problem the PTO is facing with reply briefs (but does not admit in its Comments) is that the present PTO internal procedure causes the entire file in many instances to be sent back to the examiner when a reply brief is filed, whereupon many of those examiners then simply sit on the file, for up to a year in some cases. The better fix would thus be to simply have reply briefs mailed to and entered by the Board WITHOUT sending the file back to the examiner, a quick fix not requiring any rule change. Additionally, if the PTO thinks some reply briefs are too long, the better fix for that would be for the PTO to put a reasonable page limit on the length of reply briefs, like most other judicial systems do these days. Last but not least, the PTO should also bar examiners from citing new references for the first time in examiner's answer briefs, which is a primary cause of longer reply briefs, without a good explanation by the examiner as to why those references were not cited earlier, and why they are any better than the references already of record on which the rejection appealed from was based.

Further Comments:

Some brief personal preliminary initial observations are listed below, in the rough order of what seems to me to be their most significant impacts on practitioners, especially their paperwork increase, and to summarize their main impacts on practitioners in much briefer and plainer English, in hopes that that will inspire further public input.

If these PTO rules are formally adopted [and I assume that most will be, given the usual apathy of most of the patent bar in personally responding to PTO rule change proposals], everyone will have to make major changes in the way they now practice, e.g.:

1. Each and EVERY AMENDMENT will be required to regurgitate ALL pending claims in the entire application, in their most recent form, not just the claims being amended. [This will presumably enable the PTO's printers and Examiners not to have to look at anything except the last papers on top of the file.] Any claim you fail to so copy and repeat in your amendment, even if previously allowed, will be treated as cancelled! Also, amendments will no longer be allowed to be made by directions for the PTO to make changes, even if less than 5 words, as at present. You will need a complete retyped amended claim for any claim amendment, and apparently new (substitute) specification pages?, or some portions thereof? if you amend the specification,

although the latter was not clear to me on first glance.

2. AMENDMENTS AFTER FINAL will be effectively eliminated, by being limited SOLELY to cancelling claims or formal corrections the examiner had told you to make. Not even allowing amendments placing the application in better condition for appeal.

As understood, even if your amendment after final was necessitated solely by a completely new ground of rejection by the examiner raised sua sponte for the first time by the examiner in the second office action, even as to original claims, you will be refused any opportunity to respond except by continuations or appeals, both of which will be greatly increased by this rule change. [Even though the examiner will nominally retain his or her authority to make amendments after final, you won't be able to get them considered.] There is also a related clause in amended Rule 116 indicating that if you want any amendment considered for anything else it must be accompanied by a request for a [new] Rule 53 "Continued Prosecution Application" (see below).

3. First Action Finals will be eliminated. {This is "linked" to 2. above}.

NOTE: In addition to the prior comments above on this point, items 2. and 3. above are "linked" In a PTO attempted rationale for Item 2. above. In what appears to me to be a hutzpah candidate or practitioner IQ test, the PTO repeatedly states as to this proposal that: ". . . the quid pro quo for the proposed strict limitation of after final practice . . ." is . . . "the elimination of first action final practice . . ." Since the only normal VALID first action final rejections are in what should be rare cases of continuations in which the attorney negligently failed to file a 116 amendment and/or continuation preliminary amendment with substantive claim changes in time, whereas Rule 116 amendments are fairly often needed, I would be tempted to question any practitioners who would seriously think this is a "quid pro quo" practice trade as to whether they might also be interested in a follow-on offer of a part interest in the Brooklyn Bridge? {I hope a little humor here will not be taken amiss.}

4. Continuation practice will be greatly changed - the present Rule 60 and 62 (FWC) Rules will be eliminated and replaced by an extensively rewritten new Rule 53, for "Continued Prosecution Applications", with a new PO "Box CPA". The same, prior, Application Number will now be retained, so that [hopefully] continuations will not delay prosecution as much as the present rules refilings do now. There appear to be two types of CPA's corresponding generally to Rule 60 and 62 types, but with differences. The treatment for applications originally filed before 6/8/95 will differ from those filed after that. And note the simplified inventorship changing rule changes noted here.

[Editorial comment: This PTO practice change of eliminating the generation of a "new" application serial number for continuations is desirable, and may even result in more honest application "pendancy" statistics. However, it will not reduce unnecessary forced continuations, and thus is not what the patent bar and the public really wanted here - namely, a simple additional fee payment for a second amendment (to reform the PTO's paradigm sua sponte practice of restricting most applicants to only a single amendment before final,

thus forcing applicants to the unnecessary paperwork, expense, and delay of tens of thousands of continuations annually just to get any further consideration of their applications and to generate phoney examiner "disposal" credits). I.e., this appears to be only a minor improvement at best, and one which will be effectively negated by the above-noted elimination of most amendments after final.]

5. REISSUES will be greatly simplified by only requiring a bare bones simple statement of lack of deceptive intent and a simple statement of the error(s) you want fixed and identification of the causes of the reissue, instead of requiring lengthy, dangerous, and often challenged declarations as to the underlying facts of their discovery, etc., as at present, although the latter is not entirely clear. The PTO is specifically asking for comments as to whether or not you want these rule changes to also apply to PENDING reissues, and I would assume that almost everyone would, except for pending litigation defendants. Also, no more title reports are required, and there are other reissue application changes, including possible restriction requirements.

The PTO also requests comments on whether or not the "special dispatch" requirements for reexaminations should also be applied to reissues, which seems an obvious "yes" to me, since so many reissues are in anticipation of licensing assertion or litigation of the subject patent by the patent owner.

6. There are several major INVENTORSHIP simplifications and impacts. You will be able to get an application filing date without identifying the inventors, in either a regular or provisional application. That is a major new advantage. Even if you do so identify them in the application, even in a regular application you can identify OR CHANGE inventorship simply by filing the declaration with the correct inventors later, without more. [But identification of at least one inventor at filing is strongly recommended for file ID purposes.] If you need to change inventorship later, even after the declaration is filed, apparently all you need is a simple statement of lack of deceptive intent, and only from those inventors being added or removed, rather than all of the inventors, even in reissue or interference. The other inventors apparently only need state if they agree or disagree with the change. If you allege in the petition requested changes in inventorship that it was due to a change in the claims you don't even need to allege lack of deceptive intent - it will be assumed. The only caveat I have is for interferences - quiry if this might make a little to easy the old interference tactic of taking a named inventor off an application when you need him or her as a corroborator instead, but I note that a motion will still be required to do that.

7. Appeal REPLY BRIEFS will be eliminated, in favor of requiring a SUBSTITUTE appeal brief if you want to respond to a new ground of rejection or have the last word. [See comments above.]

8. The BOARD will be able to enter new grounds of rejection by itself, even as to previously allowed claims not on appeal.

9. Requirements of verified statements by non-attorneys will be eliminated from several rules, but another rule change will presumably make them liable for false or misleading representations.

10. You will be able to get, if you pay for it, a 5th month extension of time to a PTO one month response period.

11. Abandoned Applications petitions practice will be extensively changed.

12. DESIGN patent application practice will have some desirable claim and specification practice changes.

As will be apparent, a number of PTO Forms will have to be changed. The whole subject of PTO customer forms is a serious problem that needs to be reengineered. Specifically, better indexing and public availability, computer reproducibility (eliminating cluttered lines and boxes, etc.), and form inconsistencies between the MPEP [which has no good subject-title index to PTO forms, and no copies at all of several forms] and the PTO's poorly advertised [unknown even to many PTO public interface employees], but presumably official, "Specimen Book of Patent Forms for use before the United States Patent and Trademark Office", June 1995 edition. [I can't resist imagining how the IRS would be if tax forms were handled the way the PTO handles PTO forms, which has resulted in a highly inefficient plethora of "do your own thing" user variant forms of various ages, origins and inaccuracies.]

P.S. I was delighted to see the PTO COMMENT that Rule 33 and 63 rule changes will now unambiguously only allow inventor(s) post office and residence address(es) to be on the inventors declaration formal papers, "and not elsewhere". [This would prevent the duplicate [and thus error prone] inventors addresses still seen on some obsolete and unnecessary "cover pages" of patent applications some patent attorneys still persist in using.] Unfortunately, the actual rule changes proposed do not appear to accomplish what this PTO comment says they do.

We will be interested in seeing the thoughts of others on these matters.

Cordially, Paul F. Morgan (716) 423-3015 Fax 423-5240

From Paul_Morgan@mc.xerox.com Wed Oct 23 08:13:24 1996
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Subject: PTO Proposals For 1996 Rule 116 Change

This is a further input to my October 14 informal and purely personal initial email response to the PTO Rules amendment proposals formally published in the Federal Register on Sept. 23, as "1996 Changes to Patent Practice and Procedure" subsequently been published in the BNA PTCJ, Volume 52, No. 1295, dated September 26, 1996.

This additional note is in reference to the PTO proposal to effectively eliminate almost any Rule 116 amendments after final, in any application, which proposal is linked by the PTO to an allegedly balancing proposal to eliminate First Action Final rejections (even though these only occur in continuing applications in which no new claims were timely presented). It was alleged in the PTO Comments that ". . . the quid pro quo for the proposed strict limitation of after final practice . . ." is ". . ." the elimination of first action final practice . . ."

I have checked my clients records and found that of 2,603 patents which issued between the dates of 1/1/91 and 12/31/95, 550, or approximately 20%, issued as a result of Rule 116 amendments [thus avoiding unnecessary expensive and prosecution delaying continuations]. Another report I obtained, from an outside law firm which combines Rule 116 amendments with interviews in almost every case, as is commonly done in many law firms, indicated that approximately 40% of their Rule 116 amendments were successful.

This further refutes the PTO representations in the Comments on this subject, in addition to the reasons noted in my prior email note.

Thank you, Paul F. Morgan (716) 423-3015 Fax 423-5240

From Paul_Morgan@mc.xerox.com Thu Nov 21 09:06:45 1996
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This is an additional informal and purely personal response to the extensive PTO Rules amendment proposals posted on the PTO internet Web Site at <http://www.uspto.gov/web/offices/com/sol/notices/aa80.txt>, formally published in the Federal Register on Sept. 23, as "1996 Changes to Patent Practice and Procedure", Re-published in the BNA PTCJ, Volume 52, No. 1295, dated September 26, 1996, and requesting comments to be made by email to the above email address by November 22, 1996.

As understood, one desirable proposed change in 37 CFR 1.136 would codify allowing a GENERAL authorization for extensions of time, and fee payments, to a deposit account. However, this appears to be conditioned on a PTO requirement for filing a separate, additional, paper to that effect in every patent application.

As a Federal Paperwork Reduction suggestion, it is respectfully submitted that this general authorization should also, and preferably, be allowed by a simple additional "check the box" paragraph on the Application Transmittal Letter, as is already being done by many applicants, rather than burdening all applicants and the PTO with preparation and filing of an additional paper in every application. A separate, additional, paper requires a checked entry for that on the customers postcards, cover letters, docket records, etc. The additional separate typing required for a separate paper can result in inconsistent case identifying information. In contrast, the Application Transmittal Letter is an existing paper, which the PTO already has to check for fee authorizations, etc.. (If the PTO wanted the general authorization language thereon highlighted or bolded, that could easily be done.)

Respectfully submitted,

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Subject: PTO Proposed Rule Changes-Dead Inventors?

This is one additional informal and purely personal response to the extensive PTO Rules amendment proposals formally published in the Federal Register on Sept. 23, as "1996 Changes to Patent Practice and Procedure", re-published in the BNA PTCJ, Volume 52, No. 1295, dated September 26, 1996, requesting comments to be made by email to the above email address by November 22, 1996.

In a departmental discussion of these Rule Proposals yesterday, it was noted that although there are many helpful reductions in customer or PTO workloads and paperwork, there is another very burdensome situation for both the PTO and its customers which was not addressed in these Rule changes, and should be.

Namely, the situations where the, or an, inventor has died before the filing of his or her application. The present Rule 42, and especially Rule 44, and the associated MPEP Sections 409 through 409.01(f) in practice makes this situation very difficult and time consuming, and often greatly delays filing dates. Often it is very difficult to determine, and/or obtain the cooperation of [or even be subjected to large fee extortions from], the Executor's attorney. The requirement for the Executor's signature on the application declaration is a de facto legal joke, since neither the Executor or their attorney normally has any technical education or only the vaguest idea of what the invention of the dead inventor was all about, even if explained. Most importantly, IN MOST CASES THE DEAD INVENTOR HAD NO EQUITABLE TITLE OR OWNERSHIP of the invention anyway, because the dead inventor was an employee with a normal inventions assignment employee agreement. Yet the present system allows the REAL owner of the invention to be "held up" by the executor's attorney, literally or figuratively.

The controlling Statute, 35 USC 117, also needs to be changed as unnecessarily burdensome, UNLESS the PTO would recognize the assignee of the dead inventor as the proper "legal representatives of deceased inventors" under the statute for the pre-assigned invention.

However, even absent a statutory change or that interpretation change, it would seem that the PTO could and should do something effective about this now. E.g., at least to allow the true owner of the invention to file and prosecute the application up to issuance without delay, without requiring any signature by an Executor until issuance, while the long process of obtaining that signature [or all the heirs signatures], is conducted. This is akin to the very desirable changes these proposed rules will make in reissue oaths and their timing.

Furthermore, and particularly, the 37 CFR 1.44 and MPEP Section 409.01(b) "Proof of Authority" paperwork requirement is not only another burdensome legalism, it is clearly inconsistent with other changes in these very Rule Proposals to eliminate "verifications" for almost all other PTO filed papers, and to rely on the proposed new 37 CFR 1.4 and/or the registered practitioners signature obligations for authentications instead.

Respectfully submitted,

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