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November 22, 1996

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Attention: Jeffrey V. Nase

Post-It* Fax Note	7671	Date	11/22/96	# of pages	2
To	Jeffrey V. Nase	From	Philip B. Polster		
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Re: PTO Proposal To Amend Patent Rules Of Practice  
OG October 22, 1996

Dear Mr. Nase:

For the most part, the proposed rule changes seem to me to be helpful. However, I have found the following to be either ambiguous or objectionable. I have not had time to comment on all of the provisions about which I have questions.

In § 1.53(3) I assume that the filing date of the continued prosecution application is significant only in establishing that it was filed within an appointed time, and not that a new filing date for determining the length of the life of the patent is established.

In §§ 1.113 and 1.116, the restriction of the reply after final to cancellation of or appeal from the rejection of each rejected claim or the complying with any requirement of form expressly set forth in a previous office action, is going to work hardship on the Applicant, especially a small entity. This requirement will make it virtually a necessity to file a continued prosecution application, particularly in those cases where the amendment of a claim or claims following the first office action is said by the Examiner to have required a new search, which elicits new references, and which the Examiner makes final. The proposed rule change precludes making a reply distinguishing the new references or amending the claims to do so. One way to avoid this latter problem is to prohibit the Examiner's making final an action in which a new reference is cited.

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In § 1.121(a)(1)(iii), it is not clear to me in what form these amendments to sentences, paragraphs, or pages are to be. It would seem to be simpler simply to submit a re-written page, regardless of the extent of the amendment.

In § 1.121(a)(2)(i)(B)(C), the mechanics of the setting out of all of the claims is unclear to me. Are the amendments to claims to be indicated on a page that includes all of the claims, amended or not?

In § 1.121(a)(2)(iv), this is a trap for the unwary, and a burden for those attorneys who are not equipped with word processing equipment on which the claims of the application being amended are stored. This is not a problem for our office, although there is always the danger that a claim be inadvertently omitted, but it may well be a problem for some sole practitioner.

I believe that in view of the amount of revision proposed, and the length of time that has been allotted those of us who want to comment, an extension of time within which comments can be made would be useful. I have not had time to comment on all of the matters about which I have questions, although I have read the entire proposal. Another month or so would give us needed time to comment in ways that might well be helpful to the PTO.

Respectfully submitted,



Philip B. Polster