

October 30, 1996

Via E-mail: [regreform@uspto.gov](mailto:regreform@uspto.gov)

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

Dear Mr. Nase:

This is a comment with respect to the proposed rule making dated September 10, 1996 published in the Official Gazette on October 22, 1996. It is believed that this rule making is referred to as [docket no. 960606163-6163-01] RIN: 0651-AA80.

This comment is directed at the format of the proposed amendment of the rules rather than content.

It is recommended that long and complex rules having many subparts be broken up into separately numbered rules. Patching together too many subjects in a single rule makes them much harder to remember, refer to or understand. This will be burdensome on practitioners and probably on the administrative staff of the PTO.

Rule 53 is a prime example of a rule that is too complex. Adoption of such a complex rule could earn the PTO as much a derision as directed at the complex regulations promulgated under the Internal Revenue Code. A rule that runs 3½ columns in the Official Gazette is prima facie too complex. This complexity is demonstrated in the explanations accompanying the proposed rule making where reference is made to "Section 1.53(b)(3)(i)(C)", or for another example "Section 1.53(b)(3)(vi)(A) to (D)". As published in CFR, these rules are very difficult to use. Current Rule 97 is an example where different submissions are required under different circumstances, and it always takes extra time to assure that the rule is complied with.

The rules as they presently stand are straightforward with respect to filing applications. A new application is governed by Rule 53. One type of continuing application is governed by Rule 60. Another type of continuing application is governed by Rule 62. It is straightforward for a practitioner to refer to the single rule that governs a given situation. It is probably simpler for the PTO staff to identify a particular type of filing by noting in the cover letter that an application is

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being filed under Rule 60, for example. This is far simpler than trying to figure out which of the long string of alphanumeric characters under a single Rule 53 might be applicable to a continuing application.

Rule 121 is another good example. This rule includes distinct and easily separable parts such as: how to amend the specification; how to amend claims in a non-reissue application; and how to amend a reissue application or application in reexamination.

It is recognized that splitting up long complex rules may introduce some redundant language which is applicable to each of several different situations. This is a small price to pay for ease of understanding and use by practitioners. The complex rules foster the possibility of technical errors that will be burdensome to not only practitioners, but also to the administrative staff of the PTO who must assure compliance with the proposed rules. A little effort splitting up the rules at this time will pay off handsomely with simpler processing of applications.

Sincerely,

Richard D. Seibel

RDS/cg

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