

From: Edward Sandor
Sent: Monday, March 5, 2018 2:05 PM
To: RegulatoryReformGroup
Cc: Edward Sandor; Steve Lundberg
Subject: Comments Concerning Ideas to Improve, Revise, and Streamline Regulations

March 5, 2018

Via Electronic Delivery
RegulatoryReformGroup@uspto.gov.

United States Patent and Trademark Office
Mail Stop Comments-Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Raul Tamayo, Senior Legal Advisor, Office of Patent Legal Administration

RE: Comments Concerning Ideas to Improve, Revise, and Streamline Regulations

Dear Mr. Tamayo:

Schwegman Lundberg & Woessner, P.A. ("SLW") thanks the United States Patent and Trademark Office ("the Office") for the opportunity to comment on its proposed changes to eliminate unnecessary regulations set forth in 83 FR 2759. Although we take no issue with the proposed rulemaking set forth in 83 FR 2759, we appreciate the Office's desire to receive other comments concerning ideas to improve, revise, and streamline other USPTO regulations. Accordingly, we request that the Office consider the attached comments concerning the following regulations:

- (1) Content of Information Disclosure Statement, 37 CFR 1.98(a)(2)
- (2) Content of Drawing, 37 CFR 1.83
- (3) Certified Copies of Foreign Applications, 37 CFR 1.55
- (4) Defective Declaration after payment of the Issue Fee, 37 CFR 1.53(f)(3)(ii)

Respectfully submitted,

Edward J Sandor

Principal

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I. Content of Information Disclosure Statement, 37 CFR 1.98(a)(2)

The Office has gone to great lengths to improve the information-sharing capabilities of the international patent system, including establishing an Office of International Patent Cooperation (OIPC), which has undertaken a number of initiatives, including the Collaborative Search Pilot Program (CSP), the Cooperative Patent Classification (CPC), Global Dossier, and the Patent Prosecution Highway (PPH), among others. Because of these efforts, the requirement

under 37 CFR 1.98(a)(2) that Applicants continue to provide the Office copies of foreign patent documents cited in prosecution of related-international applications for which Applicants have otherwise notified the Office is now unnecessarily burdensome.

We propose that either:

- (1) 37 CFR 1.98(a)(2) be removed (that legible copies of patents, publications, or other information be provided in an information disclosure statement filed under 37 CFR 1.97); or
- (2) 37 CFR 1.98(d) be expanded to cover any application (including later-filed or co-filed U.S. or international applications) properly identified in the information disclosure statement, and that the requirement that the application “is relied on for an earlier effective filing date under 35 U.S.C. 120” be removed.¹

II. Content of Drawing, 37 CFR 1.83

Applicants are required under 35 USC 113 to furnish a drawing “where necessary for understanding of the subject matter sought to be patented.” 37 CFR 1.83 additionally requires that the drawings in a nonprovisional application “must show *every feature* of the invention specified in the claims.” Applicants are often required by the Office to create Replacement Drawings to show even trivial elements from the claims that are not necessary for understanding the subject matter sought to be patented, and then further amend the specification to support such Replacement Drawings. Such changes, outside of those required by 35 USC 113, are a burden to Applicants, do not benefit those seeking to understand the subject matter sought to be patented, and are often unnecessary and wasteful.

We propose that 37 CFR 1.83 be removed, leaving 35 USC 113 (“where necessary for understanding of the subject matter sought to be patented”) in place.

¹ Proposed changes to 1.98(d):

“(d) A copy of any patent, publication, pending U.S. application or other information, as specified in paragraph (a) of this section, listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an ~~earlier~~ application, unless:

- (1) The ~~earlier~~ application is properly identified in the information disclosure statement ~~and is relied on for an earlier effective filing date under 35 U.S.C. 120~~; and
- (2) The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.”

III. Certified Copies of Foreign Applications, 37 CFR 1.55

35 USC 119 provides that the Director *may* require a certified copy of a foreign application, if desired by the Office. However, 37 CFR 1.55(e)(2) requires that a certified copy of the foreign application must be provided with any delayed priority claim. Applicants commonly receive copies of foreign applications from clients and foreign agents. However, acquiring *certified copies* of foreign applications requires additional cost and time, a burden to Applicants, with trivial benefit over non-certified copies, especially in light of the improved information-sharing capabilities of the international patent system.

We propose that each instance of *certified* in 37 CFR 1.55 be removed, and that 37 CFR 1.55 instead require only a *copy* of the foreign application.

IV. Defective Declaration after payment of the Issue Fee, 37 CFR 1.53(f)(3)(ii)

Applicants are required, by 37 CFR 1.53(f)(3)(ii), to file an oath or declaration in compliance with 37 CFR 1.63, or substitute statement in compliance with 37 CFR 1.64, no later than the date on which the issue fee for the patent is paid. If one has not been filed by the notice of allowability, the Office notifies Applicant of such. To avoid abandonment, Applicant must file an oath or declaration, or substitute statement, no later than the date on which the issue fee is paid. This time period is not extendable. If Applicant makes a bona fide attempt to file such oath, declaration, or substitute statement no later than the date on which the issue fee for the patent is paid, and the Office deems it defective after the date at which the issue fee is paid, the application is abandoned, and Applicant must revive the application to correct the defect, at a substantial burden to both the Applicant and the Office.

We propose that 37 CFR 1.53(f)(3)(ii) be amended to allow a time period to correct a defective oath, declaration, or substitute statement submitted no later than the date on which the issue fee for the patent is paid, but found defective after the date at which the issue fee is paid.²

² Proposed change to 37 CFR 1.53(f)(3)(ii):

“(ii) The applicant must file each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, no later than the date on which the issue fee for the patent is paid. If the applicant is notified in a notice of allowability that an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each named inventor has not been filed, the applicant must file each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, no later than the date on which the issue fee is paid to avoid abandonment. If a bona fide attempt to comply with this section is made at or prior to the data on

Respectfully submitted,

/Steven W Lundberg/

Steven W Lundberg
Managing Shareholder
Schwegman Lundberg & Woessner, P.A.

which the issue fee is paid, a shortened statutory period of 30 days may be given to enable full compliance to avoid abandonment. This time period is The time periods referred to in this paragraph are not extendable under § 1.136 (see § 1.136(c)). The Office may dispense with the notice provided for in paragraph (f)(1) of this section if each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, has been filed before the application is in condition for allowance.