

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:

RIN 0651-AB32

For: **Notice of Proposed Rulemaking:  
Rules of Practice Before the Board  
of Patent Appeals and  
Interferences**

**68 Fed. Reg. 66648  
(November 26, 2003)**

***Comments In Reply To the Notice of Proposed Rulemaking Entitled "Rules  
of Practice Before the Board of Patent Appeals and Interferences"***

Mail Stop Interference  
Director of the United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Due: January 26, 2004

Sir:

In reply to the Notice of Proposed Rulemaking published November 26, 2003, at 68 Fed. Reg. 66648, the PTO Practice Committee at Sterne, Kessler, Goldstein & Fox P.L.L.C. submits the following comments.

1. The Office proposes to remove 37 C.F.R. § 1.1(a)(1)(iii), the address for correspondence intended for the BPAI. However, no corresponding new section seems to be present in § 41. Was it intended to completely removed a section that provided the address for BPAI correspondence?
2. The Office proposes to remove 37 C.F.R. §§ 1.6(d)(9) and 1.8(a)(2)(i)(B). No corresponding section seems to be present in the new rules. This implies that the interference correspondence mentioned in Rule 6(d)(9) that could not previously be faxed may now be faxed (by removal of Rule 6(d)(9)). It also implies that the correspondence mentioned in Rule 8(a)(2)(i)(B) for which a certificate of mailing was not available can now be filed under that procedure (by removal of Rule 8(a)(2)(i)(B)). Was it the intent to allow for the use of facsimile or certificates of mailing for such documents by these amendments to the rules?

3. As published, the language of proposed 37 C.F.R. § 1.36 uses language that is part of a different Notice of Proposed Rulemaking (specifically, the NPRM regarding "Clarification of Power of Attorney Practice," published June 27, 2003). The proposed rules published in the NPRM entitled "Clarification of Power of Attorney Practice" have not yet been published as a final rulemaking. Therefore, proposed Rule 36 is confusing. For example, proposed Rule 36(a) refers to § 1.32(b). However, this section, § 1.32(b), does not yet exist because it is a new section that has been presented only in the Clarification of Power of Attorney Practice Notice of Proposed Rulemaking that is not yet final. The rulemaking on the Clarification of Power of Attorney practice will need to be finalized to include new § 1.32(b) and/or § 1.32(b) will need to be added to the BPAI rulemaking package for the currently proposed § 1.36(a) to make sense.
4. As published, the language of proposed 37 C.F.R. § 1.59(a)(1) is based on an older, outdated, version of the rule. Specifically, the phrase "and returned," was taken out of this rule in a recent final rulemaking ("Changes to Implement Electronic Maintenance of Official Patent Application Records," 68 Fed. Reg. 38611 (June 30, 2003)). The text should read: "Information in an application will not be expunged, except as provided . . . ."
5. There is a typographical error in proposed 37 C.F.R. § 1.113(a). The word "applicants" in line 5 should be in the possessive form. The text should read: ". . . whereupon applicant's, or for ex parte . . . ."
6. There is a typographical error in proposed 37 C.F.R. § 1.703(b)(4). Should the phrase "was under 35 U.S.C. 134" read "was filed under 35 U.S.C. 134"?
7. Proposed § 41.37(a) refers to the "date of the notice of appeal." Is this the date the notice of appeal is signed, is filed, or is received by the United States Patent and Trademark Office (hereinafter the "Office"). Under the current practice, the two months for filing the brief runs from the date the Notice of Appeal is received by the Office, not the date it was signed or placed in the mail. Will this practice continue under the new rules?

## **Conclusion**

Consideration of the above comments is respectfully requested.

Respectfully submitted,

Sterne, Kessler, Goldstein & Fox P.L.L.C.

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and

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