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Attention:
Robert W. Bahr
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Comments of IBM Corporation to Notice of Proposed Rule Making "*Changes To Implement the Patent Law Treaty*", 78 Fed. Reg. 21788 (April 11, 2013)

Introduction

IBM supports the vast majority of the proposed changes to the Rules for implementing the changes in the Patent Law Treaty (PLT) and title II of the Patent Law Treaties Implementation Action of 2012 (PLTIA), but recommends the following changes and clarifications.

Proposed Modified Rule 1.53 (b), (f) – Claim not required for establishing a filing date

The proposed modification eliminates the need for including a claim to be entitled to a filing date for a nonprovisional utility application.
Pages 21793 and 21804.

Given that applications may now be filed without any claims, and since the basic filing fee is premised on limits to the total number of claims and the number of independent claims, IBM believes that clarification is warranted to explain whether the basic filing fee will apply to an application filed without claims and when fees required for exceeding claims limits must be submitted.

Proposed Rule 1.57(a) – Filing a Nonprovisional “By Reference”

The proposed rule provides that a nonprovisional application may be filed “by reference” to a previously filed application in lieu of filing the specification and drawings. The applicant will be given a period of time within which to supply a claim and/or claims or a copy of the specification and drawings of the previously filed application. Pages 21795 and 21805.

The applicability to continuation-in-part (CIP) applications of filing “by reference” in proposed Rule 1.57(a) is unclear. The specification and drawings of the referenced application do not completely constitute the specification and drawings of a later filed application containing new matter. The proposed rules do not expressly address whether or how CIP filing practice is affected by proposed Rule 1.57(a). IBM believes clarification is warranted to avoid Applicant confusion and suggests a possible avenue for handling CIP filings that is consistent with the PLT and title II of the PLTIA. Namely, IBM suggests an additional sub-rule to Rule 1.57 providing that a CIP application can be filed “by reference” provided that the new matter (additional description and/or drawings) is included with the filing.

Conclusion

IBM believes that the changes and clarifications noted above are consistent with the statutory changes made pursuant to the PLT and title II of the PLTIA and will assist in their efficient implementation.

Respectfully submitted,

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