

AIPLA

AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

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November 12, 2003

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Notice of Proposed Rulemaking
Changes to Support Implementation of the United States
Patent and Trademark Office 21st Century Strategic Plan
68 Fed. Reg. 53816 (September 12, 2003)

Dear Mr. Commissioner:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to offer comments on the rule and practice changes proposed by the United States Patent and Trademark Office (PTO) in the subject notice.

AIPLA is a national bar association whose more than 15,000 members are primarily lawyers in private and corporate practice, in government service, and in the academic community. The AIPLA represents a wide and diverse spectrum of individuals, companies and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

AIPLA supports the 21st Century Strategic Plan as we have previously stated in letters to you and Secretary Evans. We also support the PTO's efforts and goals to improve the patent examination process and to use information technology to simplify and improve patent application processing. Many of the proposed changes described in the Notice will contribute to achieving these goals, however, some raise significant concerns because of the burdens that are likely to be created and/or because they appear unnecessarily restrictive.

Please consider the following comments and suggestions on the proposed rule and practice changes described in the notice:

37 C.F.R. § 1.4: Nature of correspondence and signature requirements

The proposed rule change provides for filing correspondence with electronic signatures on electronically created correspondence documents that are filed by facsimile transmission, hand-carried, or mailed to the Office for entry in a patent application, patent file, or reexamination proceeding. While we understand that the proposed rule change does not permit the filing of Official correspondence by electronic mail (e.g., email) messages over the Internet to the PTO, we generally support the initiative of the PTO to provide for an electronic signature option. AIPLA favors flexible provisions for electronic signatures. However, the detailed requirements proposed by the PTO, in addition to the proposal to treat failure to follow the formality and content requirements of an electronic signature as an unsigned document, raises very serious concerns. Those that understand the stringent requirements and penalties will likely avoid using an electronic signature option, whereas those who are not as familiar with those requirements and penalties may use the option to the detriment of their clients and themselves.

We believe that the detailed requirements proposed for § 1.4(d)(1)(iv) are too stringent and will lead to inadvertent errors that will cause problems for the PTO and applicants alike. The distinctions between an “actual name” and a “complete name,” as specified in the proposed rule, will lead to inadvertent violations that could cause the paper to be treated as unsigned. This result may not be detected until after a patent is issued and raise questions of abandonment, validity, and enforceability of the patent. These potential adverse consequences will deter use of electronic signatures and permit those who wish to attack a patent to exalt requirements of form over substance.

We agree that the PTO needs standards to support the assumption that a document has been signed, but we would suggest that the requirements be more flexible so that the Office could assume that a document was signed without the potential adverse consequences of an unsigned document. As noted in § 1.4(h), the PTO has authority to require ratification or confirmation of a signature where questions arise as to the authenticity of the signature. For example, it is now possible to electronically append a signature (that looks like a handwritten signature) that could be an electronic-signature option. One benefit of such an option is that it may help to deter fraud, because a simulated handwritten signature is hard to copy in a string of typed characters. In addition, this option is less likely to create inadvertent violations caused by typographical errors in one or more of the typed characters.

The proposed requirement that the signer “personally insert” his or her electronic signature by use of numbers and/or letters, also appears to be unnecessarily inflexible.

The proposed rule would have greater benefit for practitioners, who have documents prepared by others (e.g., secretaries, administrative assistants, associates), if the rule provided that an electronic signature is appropriate when the document was reviewed by the person whose electronic signature is included, it being understood that the individual has authorized the filing of the paper in accordance with the certification and understandings of 37 C.F.R. § 10.18.

Finally, the Office has requested comments on the alternative of requiring labeling the order of names in a signature in place of the proposed rule requiring capitalization of the entire family name. While we have not determined any basis for a preference among those alternatives, we would prefer that, whatever standard the Office adopts be set forth in the regulation as a preference, rather than a requirement. We believe this more flexible approach would result in general compliance with the preference of the PTO, would not result in significant adverse consequences for the practitioner and applicant, and would preserve the opportunity for the PTO to request clarification or confirmation in appropriate circumstances.

37 C.F.R. § 1.6: Receipt of correspondence

AIPLA supports the increased flexibility reflected in this proposed section that provides that black and white drawings in patent applications may be transmitted to the Office by facsimile. The commentary for this change, however, suggests that photographs or drawings with detail should not be transmitted by facsimile. While there should not be much dispute about the identity of a photograph, the question of whether a drawing has too much detail to be transmitted by facsimile is a matter on which reasonable people may differ. Will applicants be notified when a facsimile transmission of a drawing is unacceptable? Are there any adverse term adjustment consequences of transmitting a drawing with too much detail to the PTO?

37 C.F.R. § 1.8: Certificate of mailing or transmission

The PTO proposes permitting notification to the Office of a previous mailing, or transmitting, of correspondence, when "a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence." The discussion associated with this rule proposal suggests that a reasonable amount of time would be one month from the time the correspondence was mailed. While AIPLA welcomes this expedited procedure to resolve substantially delayed mail problems, the proposed rule may not go far enough. Unfortunately, papers are and have been misplaced in the PTO with increasing frequency. This unfortunate occurrence is not limited to papers that are transmitted or mailed to the PTO under the provisions of § 1.8.

Where papers are mailed to the PTO, there may be no evidence whether the papers were received, or of the date on which the original papers were received. What date will be assigned to the duplicate papers for the purpose of the second sentence of

§ 1.8(a)? [The actual date of receipt will be used for all other purposes.] If the original papers are subsequently associated with the file after the duplicate papers are filed, will this alter the time for taking subsequent action where, for example, the paper filed was a notice of appeal (the date for filing the appeal brief runs from the date of receipt in the PTO of the Notice of Appeal)? How will the PTO and applicant know when subsequent action (e.g., appeal brief) is required if both papers are ultimately associated with the application file? Will there be any patent term adjustment consequences for sending in a duplicate copy of papers already mailed or transmitted to the PTO where the PTO either fails to locate the original papers, or does locate the original papers?

Although the proposed regulation applies to papers that are mailed or transmitted to the PTO in accordance with § 1.8(a), but not received in the Office after a reasonable amount of time has elapsed, how is applicant to know whether the papers were received and misplaced or never received? If the purpose is to provide an expedited procedure to resolve substantial delays, then the procedure should also be applicable to those papers that are received in the PTO and then misplaced, particularly since applicants have no way of knowing (other than a postcard receipt if it is properly handled by the PTO and postal service) whether or not a paper has been received until it is associated with the appropriate PTO file and entered into PALM/PAIR. We understand that this new proposed procedure does not alter the ability of applicants who have hand-carried papers to the PTO and have a dated postcard receipt to file a duplicate copy of the correspondence with a copy of the postcard receipt to obtain action on that paper.

37 C.F.R. § 1.17: Patent application processing fees

The Office proposes different fee categories for various types of petitions depending on the amount of work normally associated with the processing of the petitions. These categories were determined as the result of an activity-based-accounting cost analysis of the PTO's cost of treating the various petitions. However, it is not clear whether this cost analysis considered one of the principal reasons for having a single cost for all petitions, which was to simplify the process for both applicants and the PTO. By setting different categories, the Office invites mistakes and errors by both applicants and the PTO that will lead to additional work and create uncertainty among those not familiar with the various categories of petitions. Finally, a petition fee of \$400.00 seems excessive for the average petition in most of this category since this represents more than half of a filing fee for an application at the large entity amount, and more than the filing fee for an application in a small entity amount.

37 C.F.R. § 1.19: Document supply fees

The PTO discussion of the change in this section indicates that it is proposed to clarify that copies of documents may be provided in whole, or in part, in electronic image form at the Office's option. There is nothing in the proposed rule that would suggest this principle other than the absence of any indication in §§ 1.19(b)(1) and (b)(4) about the manner in which copies would be provided. The other paragraphs of § 1.19 specifically reference copies on paper or copies on a compact disc that would appear to be contrary to the Office option as indicated in the discussion. The discussion further points out that the Office is considering charging a single fee for copies made from the IFW (image file wrapper) to recover an average cost and limiting the additional fee (for additional pages beyond 400) to paper copy non-IFW documents rather than the actual cost depending on size, if public comment is favorable. Unfortunately, we are not able to provide any guidance as this question is not clear. First, there is no discussion of the basis for assessing the costs for obtaining copies of IFW files. If these costs were to include the costs of locating the application file and converting the file to an IFW, it would appear that the first requester would pay a disproportionate share for obtaining a copy of the IFW document. Second, it is our understanding that the Office is moving quickly to convert all pending applications to an IFW file that will become available on the PTO website once each application becomes publicly available. We assume that there will be no fees for accessing an IFW file from the PTO website. The discussion further indicates that providing copies from an image system is cheaper so that excess page fees can be eliminated in most cases. However, the PTO has not provided any estimate of the single fee it would contemplate adopting as the average cost and how that would compare with the costs of obtaining a copy of an application from the IFW of less than 400 pages. In general, the concept of a single fee for copies of applications provided from the IFW appears to be the appropriate direction, but without a numerical analysis we cannot endorse such a suggestion at this time.

37 C.F.R. § 1.52: Language, paper, writing, margins, compact disc

In this and other related sections, the PTO proposes requiring a statement that a translation is accurate be signed by the individual who made the translation. We think this requirement is unnecessarily limiting and impractical in some circumstances. In many cases, a requirement that a statement that the translation is accurate be signed by an individual who made the translation may be appropriate and readily obtained. In other circumstances, such a statement cannot be obtained when, for example, a machine translation is provided, a form is used in accordance with § 1.69 relating to foreign language oaths and declarations of inventors, or where a translation is provided in a court or other proceeding that does not identify who made the translation. It seems both unrealistic and unnecessary for an applicant who submits a foreign language oath or declaration to have the signature of the person who provided that translation, if known. Any person who submits a translation of a foreign language document to the

PTO would submit it with the belief that the translation is accurate in accordance with the undertaking of § 10.18. Since we are not aware of any problems with inaccurate translations, the current requirements appear to us to be adequate for the purpose of translations that may be submitted to comply with the requirements of §§ 1.52, 1.55, 1.57, 1.69 and 1.78.

Finally, in § 1.52(e), the Office should consider eliminating the page length limitations of § 1.52(e)(1)(iii) since the PTO should encourage the submission of tables in electronic form. Tables seldom scan accurately so that the submission of tables on a compact disc would promote the use of electronic submissions and help to avoid the alignment problems that the PTO has experienced.

37 C.F.R. § 1.55: Claim for foreign priority

The PTO proposes to amend this section to include a requirement that the first-filed application in a chain of applications (as well as all intermediate applications) must contain a claim for priority in compliance with § 1.55 to a prior foreign application for a subsequent application to claim the benefit of the prior foreign application through the first-filed application (and all intermediate applications). This proposed requirement would appear to place applicants in a position of claiming the benefit of an application where it is known that such benefit is not available simply to preserve a potential valid claim for benefit in a subsequent application. Consider, for example, the foreign application directed to an invention "ab." A subsequent U.S. application discloses the invention "ab," but also describes and claims an improvement "abc." To the extent that the claims are limited to the combination "abc," the benefit of the foreign application would not be available since that invention is not described in that foreign application. However, in order to preserve the possibility that applicant may decide to claim the invention "ab" in a subsequent continuing application, applicant would be required to claim the benefit of the foreign application in the first U.S. application. This problem may also arise where the PTO requires restriction among inventions and some, but not all, are supported in the foreign priority application. This seems both unnecessary and improper where it is known that no benefit is available.

It is not clear from the discussion of this proposal by the PTO whether this proposal would require amendment of each earlier application to provide a claim for benefit of a foreign application where those applications are filed before the effective date of this proposed rule change, particularly where the most recent application is filed after the proposed change is to take effect. In addition, it is not clear whether an appropriate claim for benefit to a foreign application as proposed could be added after the patent was granted by way of § 1.182 petition, certificate of correction, and/or reissue. A clarification by the PTO is requested if this proposal is adopted.

37 C.F.R. § 1.57: Incorporation by reference

New § 1.57 proposes to establish an inherent incorporation by reference practice (§ 1.57(a)) that applies when an application contains, on the filing date, a claim for priority or benefit of an earlier-filed patent application. We understand that this would apply whether or not the claim conformed to the provisions of §§ 1.55 or 1.78, but would not apply to an application but is designated as a related application for which benefit is not claimed or any other document referenced in the application as filed. For example, we understand that a claim for benefit to an earlier U.S. application contained in a transmittal letter filed with an application would be sufficient to invoke the provisions of proposed § 1.57(a). AIPLA generally supports this provision as an additional safeguard for applicants who file applications that inadvertently omit pages of specification or sheets of drawings that were contained in an earlier-filed application for which a claim for benefit is contained in the application.

Proposed § 1.57(a) is unnecessarily restrictive in several respects. First, paragraph (a) should be available to an applicant whether or not portions of the earlier application were inadvertently omitted. This proposed policy and practice should be available whether any material is omitted, inadvertently or otherwise. Secondly, proposed § 1.57(a) is stated to be available only when the omitted portion of the specification or drawings is “completely contained” in the prior-filed application. In a discussion of this proposed section, “completely contained” is defined as material that is “expressly (as opposed to implicitly) disclosed in the prior application.” This restriction is both unwise and unnecessary. An applicant should be able to rely on any material that is explicitly, implicitly, or inherently described in the prior-filed application. In addition, there is no good reason to create a different standard between the inherent incorporation by reference practice of paragraph (a) and the explicit incorporation by reference practice of paragraph (b).

The provisions of § 1.57(a)(1) regarding the requirement to file an amendment to include the omitted portion of the specification or drawings of the prior-filed application no later than the close of prosecution as defined by § 1.114 is confusing. A request for continued examination under § 1.114 has the effect of removing the finality of any previous Office Action and would appear to permit the filing of this type of amendment after an RCE is filed. Is the deadline specified in this section the close of prosecution before an RCE is filed or does it include the close of prosecution after the last RCE in an application has been filed? AIPLA supports adoption of this rule as it would apply to any prior-filed application, so that it should be applicable to any continuing application - continuation, divisional, and continuation-in-part applications.

Finally, since a prior filed application would inherently be incorporated by reference when the provisions of § 1.57(a) are satisfied, it would appear to be possible to convert an inherent incorporation by reference situation under paragraph (a) into an explicit incorporation by reference situation under paragraph (b) by amending the application (after filing and before abandonment or allowance) to include an explicit incorporation by reference statement. This amendment would avoid the need to file an amendment to incorporate the omitted material before close of prosecution and provide an additional safeguard for applicants to amend the application after the deadline of § 1.57(a)(1).

Proposed § 1.57(b) requires that information incorporated by reference be identified by using language "incorporated by reference" and must identify the referenced information in the manner set forth in §§ 1.98(b)(1)-(b)(5). Proposed § 1.57(f) states that a purported incorporation by reference that does not comply with all requirements is not effective to incorporate such material by reference unless corrected by the applicant in a timely manner. In general, AIPLA believes these requirements are too restrictive and the consequences of a failed incorporation by reference are too severe. Consider, for example, a statement in a patent application that - Applicants incorporate by reference U.S. Patent Nos. 5,123,456 and 5,234,567 as teaching dyes useful in this invention. This clear and explicit statement would not be treated as a proper incorporation by reference because (1) the language "incorporation by reference" was not used, and (2) the U.S. patents were not identified by inventor, patent number and issue date as required in § 1.98(b)(1). Is this clear and unambiguous statement likely to be corrected before the patent issues? Should applicants lose the benefit of the subject matter incorporated by reference under these circumstances? AIPLA believes the answers are "no" and respectfully submits that any policy or practice that requires this conclusion is unnecessarily restrictive.

AIPLA believes greater flexibility is necessary to preserve the clear intent of this statement and avoid unnecessary work for both the PTO and applicants. The Office should provide guidance on language which it considers acceptable, but accept any language where applicant manifests an intent to incorporate the content of a document by reference, recognizing that the mere identification of a document or description of its content does not incorporate the content of that document by reference. Further, the identification of the document incorporated by reference should be clear, but should not have to follow a prescribed formula to invoke the incorporation by reference principle.

37 C.F.R. § 1.76: Application data sheet

The proposed change to § 1.76(c)(2) would require that a supplemental application data sheet (ADS) include all section headings and all appropriate data for each section heading in addition to identifying information that is being changed (added, deleted, or modified). The discussion with respect to this proposal indicates that a

supplemental ADS containing only new or changed information is likely to confuse the record and create unnecessary work for the Office. However, since the existing rule requires only that the supplemental ADS identify the information that is being changed and need not contain all the previously submitted information that has not changed, the clear impact on applicants is to create additional work and raise the risk that a supplemental application data sheet would not be in compliance with the new requirements. What circumstances warrant this dramatic shift in practice and policy? This proposed change appears both unnecessary and unwise.

Neither the current rule nor the proposed rule explains the manner in which an indication should be made of the information that has changed. The discussion of this proposed rule indicates that a supplemental ADS must be submitted with any changes or additions underlined (for deletions without replacement data, use strike-through or brackets). It is not clear whether these instructions are a preferred format or a requirement that is not specified in the regulations. The PTO should clarify the instructions and make them consistent with other regulations for indicating changes (e.g., § 1.121).

37 C.F.R. § 1.78: Claiming benefit

Section 1.78(c) would be amended to clarify that the prior art exception under 35 U.S.C. § 103(c) does not apply to double patenting rejections. AIPLA questions the wisdom of adding such a sentence about double patenting rejections to the regulations, when the issue is not otherwise addressed in the regulations except for § 1.321(c). If double patenting is to be addressed in the regulations, it should be done comprehensively in a separate regulation, and not buried in a regulation entitled "Claiming Benefit of Earlier Filing Date and Cross-reference to Other Applications." In addition, there are many other important principles of making sound rejections based on lack of utility, anticipation, or prima facie obviousness that are appropriately not addressed in the regulations, that make it both unwise and inappropriate to address this important, yet relatively minor, principle of double patenting in the regulations.

37 C.F.R. § 1.83: Content of drawing

The Office should clarify whether this proposed change would prohibit figures containing certain sequences from the sequence listing, or if it is simply intended to prohibit an entire copy of the sequence listing from also being provided as a figure. For example, would a figure containing a DNA sequence and a sequence of a polypeptide encoded thereby be permitted, even though both sequences would be in the specification (in the sequence listing)? Likewise, would an alignment of several proteins be permitted in the figure, despite all of the separate protein sequences being contained in the sequence listing?

37 C.F.R. § 1.91: Models or exhibits

Section 1.91 would be amended to include paragraph (c) which provides that a model or exhibit must be accompanied by photographs that show multiple views of the material features of the model or exhibit and substantially conform to the requirements of § 1.84. Material features, according to the discussion, are considered to be those features which represent that portion(s) of the model or exhibit forming the basis for which the model or exhibit has been submitted. AIPLA suggests that some term other than “material” be used to describe the features that need to be represented. The word “material” is used in § 1.56 to describe information to be submitted to the PTO. The use of the same term in other contexts will cause confusion and create unnecessary uncertainty in PTO regulations.

While a photograph may serve to illustrate the important features of a model or exhibit, an additional narrative statement may be necessary to describe the content of a video or DVD submitted in an application file. Those applicants who elect to submit such a model or exhibit should have the burden of adequately summarizing for the record the relevant content of the model or exhibit. This burden should be similar to that imposed on applicants who conduct an interview on substantive matters with an examiner in the PTO (§ 1.133(b)).

37 C.F.R. § 1.98: Content of information disclosure statement

AIPLA encourages the PTO to expand the applicability of the provisions of proposed § 1.98(e) that eliminate the requirement to supply a copy of a U.S. patent or U.S. patent application publication cited in an IDS in certain circumstances. Eliminating the requirement now for all pending applications and reexamination proceedings will immediately relieve applicants and the PTO of a significant burden of handling paper copies of these documents when submitted in an Information Disclosure Statement.

37 C.F.R. § 1.105: Requirements for information

AIPLA is very concerned about the proposed expansion of the information gathering tools of the PTO to include the proposed technical information known to applicants. The proposed suggestion that examiners use requirements for documents, interrogatories, and stipulations in the form of statements with which an applicant may agree or disagree is viewed by many as an attempt to shift the fundamental aspects of search and examination away from the examiner to applicants themselves. There is concern that many examiners will resort to this practice as a substitute for conducting their own search and examination responsibilities.

Unfortunately, the proposal of the PTO confuses technical information that may be known to an applicant with an applicant’s interpretation of claims, common technical features, support for a claim limitation, utility, and prior art. Interpretation by its very

nature requires a judgment on behalf of an individual, and while that judgment may be a conclusion reached by a particular individual, it is not necessarily instructive as to the knowledge or skill of the hypothetical person of ordinary skill in the art. Applicants, the inventors named in a patent application, are typically neither legally trained nor aware of the legal requirements or concepts for determining various issues of patentability. Accordingly, most applicants would not be qualified to respond to the typical questions outlined in the discussion of this proposal.

If the PTO were to adopt the proposed practice, it is not clear whether all inventors must be consulted on the questions proposed or how an assignee is to consult with an inventor who is no longer employed by that assignee. An additional problem posed by the substantial delays experienced in examination these days is that most inventors have moved well beyond the invention described in an application when that application is taken up for examination. It is unlikely that any inventor would have technical knowledge about the specifics of a patent application that was prepared three or four years before a question is posed by the PTO, without spending substantial time reviewing the application.

An applicant may be capable of producing a response to a PTO question or stipulation, but only after the expenditure of considerable time and resources to formulate an appropriate response. Even this response, however, would simply contain the views of a particular individual which cannot be equated with the knowledge or views of a hypothetical person of ordinary skill in the art. When an expert testifies in court as to the level of skill in the art, typically many hours of preparation are consumed in studying information, at least some of which is typically not in the patent record, that may be relevant to the issue. If the proposed practice is adopted by the PTO, it should be made clear what an inventor is expected to do in order to formulate a response to that inquiry.

AIPLA is concerned that questions and stipulations made pursuant to the proposed practice will not be well formulated and will create procedural sideshows for both applicants and the PTO that will detract, rather than add, to the quality and efficiency of search and examination. Most examiners lack the legal training in formulating interrogatories or stipulations, and most examiners are unaware of the consequences that could grow from the exchange of questions and replies to those questions by applicants. If the PTO decides to adopt the proposed practice, AIPLA suggests that any requirement pursuant to § 1.105(a)(1)(viii) be expressly approved by a trained attorney with litigation experience.

Finally, it is not clear from the proposed practice what options an applicant would have when faced with a requirement for information pursuant to the proposed practice. In lieu of responding to the requirement, could applicants request clarification of the requirement or object to the requirement as being unnecessary to further the

examination process in the application? Unfortunately, the proposed practice offers significant opportunities to create substantial new burdens on applicants that will be costly, largely wasteful, and unlikely to lead to information relevant to a determination of patentability.

37 C.F.R. § 1.111: Reply by applicant

The amendments proposed to this section would prohibit the entry of a supplemental reply as a matter of right unless it was filed within six months from the mailing date of a non-final Office Action and was clearly limited to: (A) cancellation of a claim(s); (B) adoption of an examiner's suggestion(s); or (C) placement of an application in condition for allowance. While it is recognized that the orderly examination of patent applications requires some limit on consideration of supplemental replies, the proposed practice offers a bright-line test that is unduly restrictive, will be unfair to applicants in many situations, and will even prolong the examination process and increase the burden on the PTO in many instances.

A supplemental reply that is filed and associated with the application file before an examiner begins consideration of the original reply to a non-final Office Action should always be considered, and particularly if it is clearly limited to the three instances specified in paragraph (a)(2)(i). The current practice that permits the PTO to ignore (not enter) a supplemental reply when a substantial amount of work has already been conducted by the examiner would appear sufficient to safeguard the interests of the PTO in maintaining the efficiency of the examination process. There may be other justifiable reasons for filing a supplemental reply other than the specific reasons identified in paragraph (a)(2)(i), such as an amendment to take into consideration the teachings of new prior art or to reduce the issues for an appeal following an interview by the examiner. In addition, an applicant has an obligation under § 1.133(b) to file a complete written statement of the reasons presented at an interview as warranting favorable action and it is desirable to file such a statement before the next Office Action by the PTO to avoid potential adverse consequences to patent term adjustment where such a paper is filed after the notice of allowance is mailed.

In the discussion of this proposed change, the PTO suggests that if the next Office Action is a final rejection or a notice of allowance, applicants could file a request for continued examination and request entry of the supplemental reply. However, it would appear that applicants could request entry of the supplemental reply in response to a final Office Action without filing a RCE, although it is recognized that there would be no entry of such an amendment as a matter of right without filing the RCE.

Failure to enter the supplemental amendment may prolong the examination process since that amendment may not be entered in response to a final Office Action.

In this situation, applicants would be required to file a continuing application or an RCE in order to obtain entry of the supplemental amendment that had been filed even before the issuance of the final Office Action. This additional expenditure of time and resources by both the applicant and the PTO may be unnecessary under current practice but would be almost inevitable under the practice proposed by the PTO. AIPLA does not support the proposed modification but favors the current practice under § 1.111(a)(2) that permits the disapproval of a second or subsequent supplemental reply that unduly interferes with an Office Action being prepared in response to the previous reply.

37 C.F.R. § 1.115: Preliminary amendments

The proposed changes to this section indicate that the PTO will assume that the content of a preliminary amendment filed with the application will be considered a part of the application as filed unless the examiner determines that new matter would be introduced by that amendment. When applicant is notified that new matter is allegedly present in the preliminary amendment, it is our understanding that applicant would have an option to (1) provide a new oath or declaration that specifically made reference to the preliminary amendment, or (2) could cancel the subject matter in the preliminary amendment that was considered to constitute new matter, or (3) request reconsideration and/or file a Rule 1.181 petition to challenge the holding of new matter. It is suggested that the second sentence of proposed § 1.115(b) should be amended to read "if such a preliminary amendment submitted on or prior to the filing date of an application is determined . . . " for purposes of clarity.

37 C.F.R. § 1.175: Reissue oath or declaration

The proposal to add new paragraph (e) requiring a new oath or declaration for continuing reissue applications must identify an error not corrected in an earlier reissue application is considered to be unnecessary and inappropriate in most circumstances. Consider, for example, a reissue application containing two additional claims that both broaden the claims of the original patent by omitting a particular limitation. These two claims are not of the same scope and the examiner is willing to allow the narrower of the broader claims. Under these circumstances, it would appear that applicant could permit a first reissue application with the original patent claims and a single broadened claim to issue in a first reissue patent and file a continuing reissue application with the broadest of the new claims added by reissue that corrected the same error by eliminating the same limitation contained in the patent claims.

It is unclear why the same reissue declaration that identified the same error in both claims added by reissue would not be acceptable in the continuing reissue application. It is standard continuing application practice to accept claims of a scope that an examiner is willing to allow in a first application and file a continuing application

to continue the prosecution of typically broader claims to the same invention. Accordingly, while there may be some situations where the same oath or declaration in an original reissue application would not be appropriate in a continuing application, there does not appear to be any basis or need to express a prohibition of that practice as in proposed paragraph (e).

37 C.F.R. § 1.213: Nonpublication requests

Proposed paragraph (a)(4)(ii) states that in order for an applicant to sign a nonpublication request, it must be applicant's intent at the time the nonpublication request is filed that the application will not be the subject of an application filed directly in another country or filed under a multilateral international agreement that requires publication at 18 months. According to the discussion associated with this proposal, it is not sufficient if there is simply an absence of any intent or plan concerning the filing of any counterpart application that would be subject to 18 month publication. It is respectfully submitted that such a narrow interpretation of the requirement of 35 U.S.C. § 122(b)(2)(B)(i) is not required by the letter or spirit of the statute, nor is it desirable from a practical standpoint. In stating this view, we wish to be very clear that we believe that protecting national security is the only reason that a pending application should not be published at 18 months. We look forward to the PTO's legislative proposal announced in the 21st Century Plan to achieve this goal. Until the law is changed, however, we believe the proposal to amend § 1.213(a) is unwise.

A nonpublication request must be filed at the time of filing a U.S. application. The statute does not require publication of a U.S. application where no application is filed directly in a foreign country or filed under an international agreement that requires publication at 18 months, regardless of the intent of applicant at the time of filing the U.S. application or the filing of a nonpublication request. The intent of applicant at the time of signing the nonpublication request should be irrelevant so long as there is compliance with the statutory requirements mandating publication under the prescribed circumstances.

The proposed interpretation by the PTO puts an applicant and the PTO in a completely unnecessary and untenable position where no decision not to file abroad has been made at the time of filing the U.S. application. An applicant who, after filing an application without a nonpublication request (because he or she was uncertain about whether a later foreign filing would occur), later decides not to file abroad would have to abandon the original application and re-file it with a nonpublication request. This would add senseless costs and unnecessary application filing burdens on the PTO and applicant. In addition, the proposed interpretation creates yet another opportunity for those who seek to attack a patent on trivial matters that exalt form over substance. Still further, these burdens are more likely to fall on U.S. applicants who claim small entity status and are unlikely to have made a decision to file abroad at the time of filing the

U.S. application because of limited resources. The PTO should ignore the intent, or lack of intent, of an applicant to file abroad at the time of filing a U.S. application and focus on the activity that requires publication in the United States.

37 C.F.R. § 1.324: Correction of inventorship in patent

This section would be amended to clarify that the inventorship of a patent may be changed only by way of request from all of the inventors together with assignees of the entire interest, or on order of a court. The PTO is requested to clarify whether this would include situations where one or more inventors is unavailable as covered in §§ 1.42 and 1.43.

37 C.F.R. § 1.705: Patent term adjustment determination

AIPLA supports the proposed change in this regulation to explicitly address an event that would affect patent term adjustment which occurs after the mailing of the notice of allowance. In the discussion of this proposed change and in conformance with earlier PTO notices, the PTO lists events that may occur after the mailing of a notice of allowance which could result in a reduction in patent term adjustment. Some of these events, such as a request for refund or a status letter, or even some late priority claims, are caused by errors committed by the PTO or delays incurred in PTO processing. It is respectfully submitted that papers filed to correct a PTO error should not result in reduction of any patent term adjustment. Applicants should be able to request reconsideration of any determination made by the PTO based on the fact that the filing of particular paper after a notice of allowance is mailed was occasioned by an error or delay made by the PTO or the postal service.

We appreciate the opportunity to provide comments on these proposed rules and would be pleased to assist in any way we can.

Sincerely,

A handwritten signature in black ink, appearing to read "Michael K. Kirk". The signature is fluid and cursive, with the first letters of the first and last names being capitalized and prominent.

Michael K. Kirk
Executive Director
AIPLA