

Acceptance of Certain Non-Compliant Amendments Under 37 CFR 1.121(c)

Effective immediately, the Office is waiving certain requirements set forth in 37 CFR 1.121(c) and may accept non-compliant amendments under 37 CFR 1.121(c) where the non-compliance is limited to: 1) the inclusion of text of a canceled claim, or a not entered claim, and 2) use of certain variations of status identifiers in a claim listing. The Office revised the amendment practice set forth in 37 CFR 1.121 in a final rule that became effective July 30, 2003. *See Changes to Implement Electronic Maintenance of Official Patent Application Records*, 68 *Fed. Reg.* 38611 (June 30, 2003), 1272 *Off. Gaz. Pat. Office* 197 (July 29, 2003). Although the revised amendment practice has been in effect for over 18 months, the Office is still receiving an unexpectedly high number of non-compliant amendments. Correction of the non-compliant items causes extra work for applicants, examiners and the Office's Technical Support Staff, delays prosecution and increases pendency of applications. Upon review, the Office has determined that some of the requirements of 37 CFR 1.121 are not essential and that waiver of certain provisions of 37 CFR 1.121 will still allow an examiner to clearly understand exactly what amendments have been made in an Image File Wrapper application. The Office will propose changes to 37 CFR 1.121 consistent with this notice in a rule making in due course.

37 CFR 1.121(c)(4)(i) provides that no claim text shall be presented for any claim in the claim listing with the status identifier "canceled" or "not entered." Claims that are indicated as "canceled" or "not entered" are not pending in the application and such text will be disregarded by the Office. Therefore, the Office hereby waives the provision of 37 CFR 1.121(c)(4)(i) that no claim text shall be presented for "canceled" or "not entered" claims. Accordingly, the Office will accept amendments that include the text of a canceled claim, or a not entered claim, if the amendment otherwise complies with 37 CFR 1.121, including use of the proper status identifier "canceled" or "not entered," respectively. Even though the Office will accept an amendment that includes the text of a canceled claim, or a not entered claim, applicants should comply with 37 CFR 1.121(c)(4)(i) by not providing the text of a canceled claim or a not entered claim.

37 CFR 1.121(c) provides that, in the complete claim listing of all claims ever presented, the status of every claim must be indicated after its claim number by using one of the following identifiers in parentheses: Original, Currently amended, Canceled, Withdrawn, Withdrawn-currently amended, Previously presented, New, and Not entered. Many applicants continue to use status identifiers that are not provided for in 37 CFR 1.121(c). The Office wants to reduce the burden on both the applicants and the Office and avoid delays in processing that result from holding an amendment non-compliant when the only non-compliance is the use of certain status identifiers that are not provided in 37 CFR 1.121(c) and which are determined to be clear and accurate by the Office. Therefore, the Office hereby waives the provision in 37 CFR 1.121(c) that the status of the claims must be indicated by one of the status identifiers listed in 37 CFR 1.121(c) to the extent permitted in this notice.

The Office will accept claim listings that include the alternative status identifiers set forth in the following table if the amendment otherwise complies with 37 CFR 1.121.

Table of status identifiers set forth in 37 CFR 1.121(c) and acceptable alternatives

Status Identifiers Set Forth in 37 CFR 1.121(c)	Acceptable Alternatives
1. Original	Original Claim; and Originally Filed Claim
2. Currently amended	Presently amended; and Currently amended claim
3. Canceled	Canceled without prejudice; Cancel; Cancelled; Canceled herein; Previously cancelled; Canceled claim; and Deleted
4. Withdrawn	Withdrawn from consideration; Withdrawn – new; Withdrawn claim; and Withdrawn-currently amended (see note below)
5. Previously presented	Previously amended; Previously added; Previously submitted; and Previously presented claim
6. New	Newly added; and New claim
7. Not entered	Not entered claim

Note: 37 CFR 1.121(c) sets forth that “Withdrawn–currently amended” is an acceptable variation of the status identifier “Withdrawn” for a withdrawn claim that is currently amended.

Additionally, the Office may also accept other variations of the status identifiers provided in 37 CFR 1.121(c) when the examiner determines that the status identifier used by applicant clearly and accurately designates the status of the claim.

Applicants should make every effort to comply with all of the requirements of 37 CFR 1.121, such as the use of the status identifiers provided in 37 CFR 1.121(c) in a complete claim listing, to reduce processing delays. The Office may continue to refuse to accept an amendment that does not otherwise comply with 37 CFR 1.121 or includes a status identifier which, in the opinion of the examiner, fails to clearly and accurately designate the status of a claim.

Inquiries concerning this memorandum may be directed to Elizabeth Dougherty or Eugenia Jones, Senior Legal Advisors in the Office of Patent Legal Administration, at (571) 272-7703 or **PatentPractice@uspto.gov**.

6/6/05
DATE

/s/
Joseph J. Rolla
Deputy Commissioner for
Patent Examination Policy