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AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

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November 6, 1996

The Honorable Bruce Lehman
Assistant Secretary of Commerce and
Commissioner of Patents and Trademarks
U.S. Patent and Trademark Office
P.O. Box 4
Washington, D.C. 20231

Dear Bruce:

On September 23, 1996, the Patent and Trademark Office published a Notice of Proposed Rule Making inviting comments on or before November 22, 1996 (61 Fed Reg 49819).

The AIPLA Committee on Relations with the PTO analyzed and considered the proposed rule changes both through extensive correspondence and at a meeting held in conjunction with the AIPLA Annual Meeting on October 25. Following this preparatory work, the AIPLA Board of Directors adopted a number of resolutions which address the issues contained in the Notice of Proposed Rule Making on which the PTO solicited comments.

We would very much appreciate the opportunity to work with the PTO to develop solutions acceptable to both the PTO and the user community regarding the proposed rule changes. We appreciate the opportunity to comment and look forward to working with you and your staff. The point of contact for AIPLA on these proposed rule changes and the resolutions adopted in connection with them is Charles Van Horn who can be reached at telephone 202-408-4000.

Thank you for your consideration.

Sincerely,

Roger S. Smith

Roger S. Smith
President, AIPLA

RSS/kmp

attachments

Retroactive Adoption of Certain Proposed Rules Changes (§§1.28(c)(2), 1.48, 1.324 and 1.137(b)).

Resolved, that the American Intellectual Property Law Association (AIPLA) favors, in principle, applying the proposed rules to:

1) already pending reissue oaths or declarations under proposed §1.175; and
2) already pending petitions and papers under proposed §§1.28(c)(2), 1.48, and 1.324 for previously filed petitions and papers;

in so far as the questions involving these matters are still being pursued by the applicant or considered by the PTO on the effective date of the final rule.

Resolved, that the AIPLA favors, in principle, applying proposed §1.137(b) to applications already abandoned and petitions already filed, if the one year time period for filing such petitions to revive is eliminated.

Resolved, that the AIPLA opposes, in principle, applying proposed §1.137(b) to applications already abandoned and petitions already filed, if the alternative proposed of providing a three month period for filing petitions under §1.137(a) and/or §1.137(b) is adopted and applied in a manner to adversely affect matters still being pursued by the applicant or considered by the PTO on the effective date of the final rule.

Modification of Continuing Application Practice Under §§1.53, 1.60 and 1.62.

Resolved, that the AIPLA favors, in principle, deleting existing rules §§1.60 and 1.62 and amending §1.53 to (1) permit continuation and divisional applications to be filed under §1.53(b)(1) in a manner similar to existing §1.53 filings or under §1.53(b)(3) in a manner similar to the filing of applications as file wrapper continuation applications (FWCs) under existing §1.62, and (2) require that all continuation-in-part applications must be filed under §1.53(b)(1).

Requirement to Identify Support for Amendments to Claims.

Resolved, that the AIPLA opposes, in principle, the proposed amendment to §1.121 which would require that amendments to claims in a reissue application or claims in a reexamination proceeding be accompanied by an explanation of the support in the disclosure of the application or patent for the amendment; and

(b)(2)(c)(iii)

Further resolved, that the AIPLA would also oppose, in principle, that a requirement to include an explanation of support in the disclosure of a patent application for any amendment to a claim be applicable to all patent applications.

Limitation of Amendments After Final.

Resolved, that the AIPLA opposes, in principle, the proposed amendments to §1.116 which would limit amendments after a final action to canceling claims or complying with any requirement of form expressly set forth in a previous office Action.

Resolved, that the AIPLA favors the proposed amendments to §1.113 prohibiting a first-action final in a continuing application.

Deletion of the 1 Year Limitation on Petitions to Revive Under §1.137(b).

Resolved, that the AIPLA, favors, in principle, amending §1.137(b) to eliminate the one year limitation on filing of petitions to revive under §1.137(b) based on unintentional abandonment of the application.

Resolved, that the AIPLA opposes, in principle, amending §1.137(a) and (b) to provide that one petition to revive be filed within 3 months of the first Office Notification that the application had become abandoned or that the patent had lapsed, in lieu of merely eliminating the one year limitation on filing petitions to revive under §1.137(b).

Resolved, that the AIPLA favors, in principle, making any change merely eliminating the one year requirement in §1.137(b) retroactive by applying the change to any application already abandoned or in which a petition was already filed on the effective date of the new rule, in so far as the applicant is still pursuing or the PTO is still considering the petition on the effective date of the final rule.

Elimination of Admission of Models and Exhibits Under §1.91 Unless Specifically Required by the PTO.

Resolved, that the AIPLA opposes, in principle, modifying §1.91 to preclude the admission of both exhibits and models whether three dimensional or two dimensional into the record unless specifically required by the PTO as necessary for any purpose in examination of a patent application.

Make All Application Procedures Similar in Reexamination and Reissue Proceedings.

Resolved, that the AIPLA favors, in principle, adoption of similar administrative policies, practices, and procedures for all reissue applications and reexamination proceedings.

Eliminate Rules Setting Instructions for the Operations of the PTO.

Resolved, that the AIPLA opposes, in principle, the deletion of the following Rules that represent instructions as to the operations of the Office contained in:

§1.101	order for examination
§1.104	nature of examination; examiner's action
§1.105	completeness of examiner's action
§1.108	abandoned application not cited
§1.122	entry and consideration of amendments
§1.184	reconsideration of cases decided by former Commissioners
§1.318	notification of national publication of a patent based on an international application
§1.325	other mistakes not corrected
§1.351	amendments to rules will be published
§1.352	publication of notice of proposed amendments

Prohibiting New Ground of Rejection in an Examiner's Answer and Permitting Filing of Substitute Appeal Brief as a Matter of Right rather than a Reply Brief on Appeal and an Appellate Reinstatement of Appeal.

Resolved, that the AIPLA favors, in principle, modifying appeal practice by (i) prohibiting the inclusion of a new ground of rejection in an Examiner's Answer but requiring the Examiner to reopen prosecution to enter a new ground of rejection, (ii) permitting appellants to file a substitute brief after receiving the Examiner's answer as a matter of right and (iii) permitting appellants to reinstate the appeal process if the Examiner reopens prosecution.

New Amendment Procedures.

Resolved, that the AIPLA favors, in principle, the proposed changes in the procedures for formatting and submitting amendments in non-reissue applications, reissue applications, and reexamination proceedings contained in proposed §1.121 if amended to delete that aspect of the proposed rule change that would consider the failure to include a claim in a separate sheet of pending claims as a direction to cancel the omitted claim.

Requirement in §1.4 that a Paper Submitted by any Party is a "Certification".

Resolved, that the AIPLA favors, in principle, (i) adding a requirement in §1.4 indicating that a party by submitting a paper to the PTO is certifying, based upon a reasonable inquiry, that the paper is not being presented for an improper purpose, such as to harass or delay or increase costs

1.4(d)(2)(i)(ii), (not (iii)) and (3)

and that the claims and contentions presented are warranted by law or by a nonfrivolous argument for the action sought, under threat of such sanctions as are deemed appropriate by the Commissioner, including termination of proceedings, (ii) adding a provision prohibiting any falsification, concealment or cover up in any matter within the jurisdiction of the PTO and, (iii) providing that an applicant may be required to indicate whether any assistance was received in preparing or prosecuting an application in return for compensation or consideration

Simplified Correction of Inventorship.

Resolved, that the AIPLA favors, in principle, the proposed amendments regarding procedures for the correction of inventorship in a patent application under §1.48, and in a patent under §1.324 under which, the presently required statements of facts supporting lack of deceptive intent are eliminated.

Reissue Oath or Declaration.

Resolved, that the AIPLA favors, in principle, the amendment in proposed §1.175 simplifying the oath and declaration requirement for reissue applications by removing the requirements for a showing of a lack of deceptive intent based on facts and circumstances including the showings related to how and when each of the errors arose.

Restriction Requirements in Reissue.

Resolved, that the AIPLA opposes, in principle, the proposed amendment to §1.176 that will permit the Patent and Trademark Office (PTO) to require restriction among claims in a reissue application except that no restriction would be required between the original claims of the patent and amended claims.

Resolved, that the AIPLA favors, in principle, the proposed amendments to §1.177 that would authorize the granting of multiple reissue patents, which may issue on different dates, only where the patent claims in each reissue case are directed to distinct and separate parts of the thing patented provided that a petition for the grant of multiple reissue patents has been approved prior to the issuance of any reissue patent.