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January 10, 1997

FAX TO (703) 308-6916

Hiram H. Bernstein
Assistant Commissioner for Patents
Washington, D.C. 20231

Re: Proposed Amendment of Rule 53

Dear Mr. Bernstein:

Thank you for taking a few moments yesterday to discuss the combination of Rules 53, 60 and 62. I have general comments about the rearrangement of the rules, and several specific comments regarding what may be typographical errors.

I generally agree with the idea of rearranging the rules so that all the permitted procedures for filing original and continuing applications are next to each other. However, I think the proposed amendment makes Rule 53 so long that it obscures the most important purpose of the rule, which is to specify the essential requirements for a filing date, a date which can be critical to the protection of valuable inventions. Note the substantial amount of text separating the requirements for filing dates in provisional applications, nonprovisional applications, and continued prosecution applications, and even more text thereafter.

I think that Rule 53 should be limited to the rules on application number and filing date. My suggestion would be to move paragraphs (b)(1)(i) and (ii) and paragraphs (c) and (d) of Rule 53 to rule 54, and perhaps retitile that rule as "Completion of application." Note that rule 54 already refers to Rule 53 with regard to completion of an application, so incorporating those provisions into rule 54 would be appropriate.

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Paragraphs (b)(1)(i) and (ii) of Rule 53 could perhaps be given the subheading *Oath Requirements for Continuing Applications*. Similarly, paragraphs (c) and (d) of Rule 53 would fit in the revised Rule 54 as *Procedures in Cases of Incomplete Applications or Missing Parts*. All of these paragraphs relate more to completion of the application than to the filing date.

Alternatively, the oath requirements for continuing applications could be placed in any of Rules 60, 61 or 62, where they would be adjacent to Rule 63, the main rule on oaths and declarations, or they could even be added to Rule 63. Note that Rule 63 already states a requirement relating to the oath in a CIP application.

If it is decided to keep all the above provisions in rule 53, it would help make it comprehensible to have italicized subheadings, as in Rules 84 and 96. For example:

<u>Paragraph/ Subparagraph</u>	<u>Subheading</u>
(b)(1)	<i>Filing date of nonprovisional application.</i>
(b)(1)(i)	<i>Continuing applications not requiring new oath.</i>
(b)(1)(ii)	<i>Continuing applications requiring new oath.</i>
(b)(2)	<i>Filing date of provisional application.</i>
(b)(3)	<i>Continued prosecution applications.</i>
(c)	<i>Incomplete applications, filing date refused.</i>
(d)	<i>Missing parts, filing date granted.</i>

Rule 53(b)(1)(i) appears to have a typographical error in the first few lines of the second sentence, perhaps a missing comma or parenthesis. Regarding the "statement that the copy is a true copy," several lines down in that same subparagraph, it is not clear which copy is the antecedent for "the copy." A simple fix would be to include the numbers (1) and (2) to separate the two conditions as was done in the discussion of that proposed rule.

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It is not clear how the "true copy" statement is useful. In cases where such a statement could be honestly made, i.e., where the oath had already been executed, it would seem that the executed oath and an unexecuted copy thereof would be equally available to the applicant or his attorney.

It is not clear how paragraph (b)(1)(iii) of Rule 53 is consistent with subparagraph (b)(1)(i)(A), which suggests that the inventorship does not include the names deleted pursuant to that subparagraph. Perhaps the interrelationship of the two subparagraphs could be made more clear.

Best of luck in assimilating all the comments and making appropriate amendments to the rules.

Respectfully submitted,



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