Jeff's (3)
10/31/96

Voting Tally
October 23, 1996

65 Responses of 200 Committee Members

VOTING SHEET
Committee on Relations with the PTO
Please return by Facsimile or otherwise
by Friday, October 18, 1996 to

Rene D. Tegtmeyer
Fish Richardson PC
600 13th Street, NW Suite 500N
Washington, D.C. 20005
Facsimile No. 202/783-2331

Resolution 1: **Retroactive Adoption of Certain Proposed Rules Changes (§§1.28(c)(2), 1.48, 1.324 and 1.137(b)).**

| | | | | | | |
|---|---|---|---|---|---|---|
| 45 | Favor | 12 | Oppose | 7 | Abstain | OK |

Resolution 2: **Modification of Continuation Application - Practice under §§1.53, 1.60 and 1.62**

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|---|---|---|---|---|---|---|
| 45 | Favor | 7 | Oppose | 2 | Abstain | OK |

Resolution 3: **Requirements for Identifying Support for Amendments to Claims**

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|---|---|---|---|---|---|---|
| (A) (reissue and reexamination) | 27 Favor | 35 | Oppose | 3 | Abstain | OK |
| (B) (all applications) | 12 Favor | 51 | Oppose | 1 | Abstain | |

Resolution 4: **Limitation of Amendments After Final**

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|---|---|---|---|---|---|---|
| 3 | Favor | 62 | Oppose | | Abstain | Work |

Resolution 5: **Deletion of the One Year Limitation on Petitions to Revive under §1.137(b)**

(A) 37 Favor 20 Oppose 5 Abstain OK
(eliminate 1 year)

(B) 18 Favor 39 Oppose 6 Abstain
(set 3 month limit)
[Note: Votes should not be the same for (A) and (B)]

(C) 36 Favor 19 Oppose 6 Abstain OK
(make (A) retroactive)

Resolution 6: **Elimination of Admission of Models and Exhibits unless required** §1.91 ?

(A) 12 Favor 50 Oppose 2 Abstain
(all exhibits eliminated)

(B) 21 Favor 36 Oppose 4 Abstain Disagree Consent
(only three dimensional exhibits eliminated)

Resolution 7: **Make all Application Procedures like Reexam and Reissue Procedures.** ?

26 Favor 34 Oppose 3 Abstain

Resolution 8: **Eliminate Rules Setting Instructions for the Operations of the PTO.**

8 Favor 54 Oppose 2 Abstain explain better

Resolution 9: **Prohibiting New Ground of Rejection in Examiner's Answer; Permitting Substitute Brief in Reply as a Matter of Right; and Appellant Reinstatement of Appeal.** §1.193

57 Favor 5 Oppose 2 Abstain OK

Resolution 10: **New Amendment Procedures (Technical Requirements)**

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|---|---|---|---|---|---|
| 20 | Favor | 40 | Oppose | 5 | Abstain |

Resolution 11: **Requirement in §1.4 that Submission of a Paper to PTO by a Party is a "Certification".**

| | | | | | |
|---|---|---|---|---|---|
| 24 | Favor | 34 | Oppose | 6 | Abstain |

Resolution 12: **Simplified Correction of Inventors**

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|---|---|---|---|---|---|
| 59 | Favor | 5 | Oppose | | Abstain |

Resolution 13: **Amendment to §1.175 to Simplify the Reissue Oath and Declaration Requirements.**

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|---|---|---|---|---|---|
| 61 | Favor | 3 | Oppose | 1 | Abstain |

Resolution 14: **Restriction Requirements in Reissue.**

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|---|---|---|---|---|---|
| (A) (PTO Restriction) | 24 Favor | 37 | Oppose | 3 | Abstain |
| (B) (Multiple Reissues) | 30 Favor | 29 | Oppose | 3 | Abstain |

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## COMMENTS ACCOMPANYING VOTING SHEETS

Reinventing government leaves me cold! I have not read all 48 pages of proposed changes. If I am wrong in interpreting any resolution call me and I'll change my vote. -- Herb Roberts (14)

Resolution 3: PTO Rule is too vague; a practitioner should always provide an explanation where support may be found for an amendment to a claiming any application. Resolution 4: strongly oppose; not a quid pro quo; forces applicant to refile and pay additional filing fee plus incurs time delays; Resolution 9: unclear -- by Ronald A. Daignault (12)

Resolution 9: Examiner should be able to add new ground of rejection. Applicant can request revision. Res. 14 rule must state what restriction or ____ reissues are possible only if one is patentable over the other. -- by Jordan B. Bierman (8)

Resolution 3 - The rule proposed by the PTO is too vague and subject to misapplication and abuse by Examiner -- by Timothy W. Hagan (17)

This vote on proposals and explanation of the resolutions is the best in many years -- by Robert Steven Linne (18)

Resolutions 12 and 13 are important. by Roland Plottel (23)

With regard to Resolution 4, I would rather favor liberalizing amendments after final. The need for filing a continuation adds to expense, delay and additional examination effort -- by Ed Sokolski (24)

I can't vote once on a multi-part resolution when I favor some parts and oppose others. Also many of the explanations are hard to follow. You would do better just to recite the existing and proposed rules point by point. -- by George Wheeler (28)

Res. #7: Reexam and reissue procedures should remain "special" and not be harmonized with procedures for all applications. -- by S. Nolan (31)

Does Resolution 9 do away with all reply briefs - e.g., Examiner makes "new point of argument" -- is a reply brief still okay? -- by Elliot Goldberg (32)

Title of Resolution 7 is confusing; we are just harmonizing reexam and reissue, not all applications? -- by Richard S. Meyer (37)

Resolutions 6 and 8 particularly bother me. Adoption of Resolution 6 would make it more difficult to provide demonstration evidence at interviews. Adoption of Resolution 8 would make it more difficult to hold the PTO's feet to the fee. -- by Eric W. Gutting (39)

Evaluated without review of proposed rulemaking. -- by James K. Poole (41)

I'm confused about #7. The resolution refers to all applications. The proposal seems to be for Reexam and reissue applications. I favor consistency in reexam/reissue; the procedures can be different for other applications. -- by Richard Phillips (42)

Resolution #7 should have part a) re making all application procedures like reissue/reexam, and part b) harmonizing

reissue/reexam. In such a question I would vote against part a) but in favor of part b). -- Jim Haight (44)

Re Resolution 5: would favor (a) only when there are no more applications pending that can issue with 17 year term. Re Resolution 7: I oppose this change only as to the reissue certificate otherwise I favor it. -- by Vincent T. Pace (46)

Res. 2 seems to have a small error. PTO will use filing date of the new application (and Serial Number of old application). This vote sheet is ambiguous - when I say "favor", am I favoring the PTOs action or am I favoring the resolution? If the latter, do I favor a resolution when the resolution itself contains "favor/oppose" in parentheses? -- by James A. Finder (51)

Resolution 4 - very important to oppose this. Many first actions are truly mysterious and we need more than one opportunity to amend -- by Kate Murasyi (58)

Re Res. 2 - I oppose with regard to CIPs only!
Re Res. 4 - I favor no first action finals! -- by Henry M. Zykorie (62)

In the comments to Resolution #4, a person can presently appeal after a first office action in a continuing case as long as there is a claim that has been twice rejected. Unless this provision is also being changed, the comment is not entirely correct. -- by Alvin J. Riddles (25)

Narrative observations received from Gordon Stewart, Noel Smith, Paul Morgan and Alvin Riddles are attached.