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From: Daniel Fisher
To: smtp:"regreform@uspto.gov"
Date: 12/12/96 10:15am
Subject: Comments on Proposed Rule Changes Published September 23, 1996

Attn: Mr. Hiram H. Bernstein (703) 305-9285
U.S. Patent and Trademark Office

Sir:

Further to our telephone conference today, I am sending you my comments on the proposed rule changes. I would appreciate your consideration of these comments.

FM: Daniel E. Fisher
TO: Hiram. H. Bernstein
DATE: December 12, 1996
RE: Proposed Patent Office rule changes

MEMORANDUM

Proposed changes published September 23, 1996 to 37 C.F.R. 1.113(c) and 1.116(a) are ambiguous.

1. 37 C.F.R. 1.113(c) should be changed to read The first action in an application or continuation will not be made final.

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Rationale: Even though the comments published with the proposed rule changes indicates that a first action in a continuation will not be made final, this aspect is not in the rule.

falls under application

2. Following the first sentence in the proposed change to 37 C.F.R. 116(a) the following sentence should be inserted. (Any claim specifying allowable subject matter but objected to by reason of its dependency on a rejected base or intervening claim, may be rewritten into independent form as a matter of right.

etc

Rationale: First, as presently proposed Rule 1.116(a) is ambiguous. The proposed rule changes have been discussed at various forums (e.g., bar association meetings, etc.). Some patent practitioners at these forums opine that Rule 1.116(a) permits, as a matter of right, an objected to claim to be rewritten into independent form on the ground that the Patent Office standard paragraph used to object to such claims is a requirement of form that an applicant may comply with under the proposed change. Other practitioners maintain that proposed change to the rule permits the Patent Office to deny entry of such rewritten claims. No matter how the rule is ultimately used, it should not be ambiguous.

Second, current practice permitting such claims to be rewritten should be continued. With this practice an applicant will be able agree with the examiner on some claims (e.g., by canceling a base claim and rewriting dependent claims into independent form) while maintaining another claim for appeal when the applicant and examiner do not agree. Without this procedure, the applicant would be forced to file a continuation solely for the purpose of

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rewriting claims containing allowable subject matter into independent form,
and then file an appeal.