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HAVERSTOCK, GARRETT & ROBERTS

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From:	Herbert B. Roberts	Date:	Nov. 19, 1996
To:	Jeffrey V. Nase	Time:	
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Assistant Commissioner for Patents
U.S. Patent and Trademark Office
Washington, D.C. 20231

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Attention: Jeffrey V. Nase

Re: PTO Proposal Making Miscellaneous
Amendments To Patent Rules Of Practice
60FR49820-Department Of Commerce
37 CFR Parts 1, 3, 5 and 7
(Docket No. 960606163-6163-01)
RINO651-AA80
1996 Changes To Patent Practice and Procedure

Dear Mr. Nase:

The following comments are made on behalf of the attorneys in this firm. First, we are concerned that many patent practitioners will be unable to carefully study and analyze 48 pages of proposed changes in a period of two months from the first publication. Further, we are concerned that such wholesale changes will provide inadequate consideration for many proposals which make significant changes. Although most practitioners and PTO staff members agree that changes are desirable, the system is really working quite well. My personal concern is that some of the proposed changes might be more harmful than beneficial! Our following comments relate to certain proposals which we consider to be most important, but our comments are not intended to be all-inclusive and our failure to mention a particular change does not necessarily represent an endorsement of the changes that are not addressed. The following comments are keyed to the present numbering system as used in the proposed changes.

First, with regard to proposed changes in §§ 1.113 and 1.116, we are opposed to making it more difficult to work with Examiners in securing allowable claims after a final rejection. By limiting the options of the Applicant to appealing claims, canceling claims, or complying with any requirement of form, the effect appears to be to force more continuations in order to secure allowable claims or place claims in better form for appeal. This clearly is not in the best interest of Inventors, Assignees or the Patent System. Thus, the proposed changes would likely result in increased prosecution costs and less favorable patent protection. An ability to work with Examiners after a final rejection is a critical aspect of prosecuting patent applications and we believe that the proposed changes are not likely to reduce current case load or expedite

prosecution. Additionally, in general, we believe that the most important goal of the U.S.P.T.O. should be to issue good patents and that the U.S.P.T.O should not sacrifice this goal in order to expedite patent prosecution. not a tradeoff

With regard to the proposed changes to § 1.4 regarding verifications, although amending § 1.4 to specify that the proposed certifications set forth therein are automatically made upon presenting any paper to the U.S.P.T.O. might simplify matters in certain instances where, for some reason, verification is lacking when required, it seems that a desirable effect of requiring verifications would be lost. That desirable effect is that before presenting a paper to the U.S.P.T.O., a person carefully considers and confirms the information set forth in such paper. One would hope that when a person is required to sign a paper that includes a verification, the presence of the verification would tend to cause that person to carefully consider what is being presented. If the requirement for verification is removed, a person, particularly a non-attorney, would be less likely to carefully consider what is being presented. This could lead to problems relating to upholding the patent which issues from any such application. Persons should have actual knowledge that they are making a verification, particularly if they are subjecting themselves to the penalties of 18 U.S.C. § 1001. Such actual knowledge is fostered by requiring papers to expressly include the verification as required under current practice. We therefore oppose the changes.

With regard to the proposed changes in §§ 1.41 and 1.48, the proposed changes regarding identification of the inventors at the time of filing, in conjunction with the proposed changes regarding correction of inventorship, seem to promote sloppy filing procedures. Although the changes might reduce the need for certain petitions for correction of inventorship, it should be possible in almost all cases for practitioners to correctly identify the inventors at the time of filing. If an inventorship error is made, correction should be required as soon as possible. Removing the diligence requirement of § 1.48 therefore makes little sense as it would seem to promote delay in correcting such errors in inventorship. Inventorship questions should remain important to the validity of patents.

With regard to the proposed changes in Appellate practice, we urge slow and careful consideration relating to such changes and we consider the proposed changes to be substantial.

Last, we believe that the proposed changes in the Rules of Practice are important enough to schedule a public hearing and we believe that changes should be handled on a more piece-meal schedule to give the Patent Bar time to consider the changes more carefully.

Sincerely yours,

HAVERSTOCK, GARRETT & ROBERTS

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