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Date: Nov. 21, 1996

TO: Jeffrey V. Nase
(ADDRESSEE) (PHONE)
Box Comments - Patents 703 308-6916
(LOCATION / COMPANY) (FAX)

FROM: George Meyer 512 505-8910
(SENDER) (EXTENSION)

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COMMENTS:
Comments to Notice of Proposed Rulemaking for 37 C.F.R.

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505 Barton Springs Road
Suite 500
Austin, TX 78704
November 19, 1996

Box-Comments
Assistant Commissioner for Patents
Attention: Jeffrey V. Nase
Washington, DC 20231

Re: Notice of Proposed Rulemaking to 37 C.F.R.

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Dear Assistant Commissioner:

I am a Patent Attorney with Motorola, Inc. The comments herein are mine, personally, and do not necessarily reflect Motorola's positions. Below are comments to and some proposals for changes to the Patent and Trademark Offices's (PTO's) proposed rules.

In Section 1.97(e), certifications should also include a certification for information from patent applications within the same priority chain. Essentially, this is "other United States counterpart applications" and is similar to "counterpart foreign applications" of Section 1.97(e)(1). Sections 1.97 and 1.98 were revised in 1992 to increase the likelihood that information would be timely submitted to the patent office to be considered early in prosecution. In 1995, the patent laws were changed, so that patent applications typically have a term that is 20 years from the effective filing date. Before 1995, there was less incentive to file divisional patent applications until the prior patent application was close to issuing. Since the patent laws were changed, divisional patent applications are more likely to be filed before a notice of allowance for the prior patent application or other divisional patent application. The situation in this instance is similar to the information cited in foreign counterpart applications.

The situation is similar to the information cited in foreign counterpart applications. The PTO should encourage compliance with the duty to disclose under Section 1.56. Therefore, the following is proposed as new Section 1.97(e)(3):

> That each item of information contained in the information disclosure statement was cited in a communication from the United States Patent and Trademark office in another nonprovisional United States patent application not more than three months prior to the filing of the information disclosure statement, where (i) such other nonprovisional patent application claims priority to the current nonprovisional patent application under 35 U.S.C. § 120, (ii) the current nonprovisional patent application claims priority to such other nonprovisional patent application under 35 U.S.C. § 120, or (iii) the current nonprovisional

> patent application and such other nonprovisional patent application claim priority to a common nonprovisional patent application under 35 U.S.C. § 120.

Section 1.97(e)(2) needs the period at the end replaced by "; and." No other changes to Section 1.97 are proposed.

As a side note, the undersigned attorney has had several applications where the examiners appear to be following the pre-1992 rules regarding pending patent applications cited in a later patent application. I have discussed the matter with Mr. Brian Hearn was the Supervisory Primary Examiner (SPE) for Group Art Unit (GAU) 1104. He stated that pending patent applications can be cited as "Other Information" on a Form PTO-1449. I usually do not have problems with GAU 1104 on this matter.

However, I still get examiners that refuse to consider co-pending patent applications that are listed on Form PTO-1449. These examiners state that the co-pending application can only be listed in application as a related application. First, Section 1.78 addresses priority and potential double patenting situations. If the inventive entities between the two are different, a non-statutory double patenting situation cannot arise. A reference to co-pending applications is not needed if priority or a double patenting situation cannot occur. Second, listing a pending patent application within another patent application does not necessarily mean that the examiner considered the co-pending application. The examiner may have only looked at the claims for potential double patenting issues and not examine the rest of the application. Form PTO-1449 provides a simple objective and conclusive way to show that an examiner has considered the reference, not just claims. Please have the SPE review the "new rules" from 1992 regarding Sections 1.97 and 1.98 with their examiners.

Sections 1.104 and 1.105 have been proposed to be removed. The rules should require the examiners to perform complete examinations and investigations of the prior art. The PTO should do what it can to avoid piece-meal prosecution. It is hypocritical of the PTO to have a section in the rules requiring the applicants to be fully responsive, yet, remove the section requiring the examiners to be complete. The rules have the effect of law unless they are contrary to statutes. Courts (district courts and the Federal Circuit) cannot ignore the rules. However, courts have discretion whether to ignore provisions of the M.P.E.P. because the M.P.E.P. is nothing more than a list of internal policies, similar to a corporation's internal policies. The requirement of that the examiners perform complete examinations and investigations of the prior art should be in both the rules and the M.P.E.P. Sections 1.104(a) and 1.105 should be retained and combined into one section.

Section 1.116 should allow, as a matter of right, merging of dependent claims into an independent claim if the examiner examined the claim. For example, an application has claims 1-4. Claim 1 is independent, claims 2 and 3 depend from claim 1, and claim 4 depends from claim 3. The examiner had to consider the following combinations of claims: 1 and 2; 1 and 3; and 1, 3, and 4. An amendment under Section

1.116 should allow merging claim 2 into claim 1, claim 3 into claim 1, or claims 3 and 4 into claim 1 because the examiner had to examine each of these. The examiner would have discretion not to enter an amendment merging claims 2 and 3 into claim 1 or merging claim 4 into claim 1 without the claim 3 limitations. After the first sentence, please insert the following.

> Any independent claim may be amended to include all limitations from a single dependent claim but must include all limitations of every intervening claim, if any. If an amendment to an independent claim forms a claim that the examiner has not specifically examined, such an amendment will not be entered as a matter of right but may be entered at the discretion of the examiner.

The proposed change to Section 116(b) should not be made or the previous section should be amended to insert "to the satisfaction of the Commissioner" after "sufficient reasons."

Although I understand the PTO's positions regarding the changes to Section 1.116, I believe that they are unwarranted. Situations can occur where there is good and sufficient reason that an amendment was not previously made. Very few examiners like appeals, and many examiners appear to do whatever is necessary to increase the likelihood of filing a continuation if this will avoid an appeal. The examiner gets two extra points if a continuation is filed and none if an appeal is made. Some practitioners and applicants abuse the process, however, the PTO's proposal penalizes all practitioners and applicants because of the actions of a few. Because of the point system at the PTO, abuse by many examiners can clearly be predicted with near certainty. My proposed change to Section 1.116(a) should be made, but Section 1.116(b) should not be changed.

The current Section 1.121(c) allows for corrections in spelling, punctuation, and typographical errors up to five words to be made without retyping the entire claim. I believe that this is reasonable and should be retained.

Under Sections 1.121(a)(1)(iv),1.121(a)(2)(iii), 1.121(b)(1)(iv), 1.121(b)(2)(i)(C), and 1.530(d)(1)(iv), and 1.530(d)(2)(i)(C), insertions are underlined and deletions are bracketed. I am proposing adding strikethru text to show deletions and italics to show insertions. Advances in printing methods (i.e., personal computers and laser printers) make strikethru text and italics possible without much difficulty. Deletions are much easier to see with strikethru text compared to brackets. Extraneous and missing brackets are very difficult to spot. With strikethru text, extraneous and missing brackets are eliminated. Publications illustrating changes to statutes are typically shown with strikethru text for deletions and underlining or italics for insertions. I am not proposing that brackets and underlying be eliminated, but to add strikethru text and italics as alternatives.

Section 1.121(a)(2)(ii) requires that the a separate complete set of claims be submitted. I agree that submitting a complete set of pending claims is appropriate in

some instances. For example, if a pending claim is amended or new claims are added, submitting a complete set of pending claims is not too much of a burden to the practitioner or applicant and should help the examiner. However, if the only change to claims is cancellation of claims, all of the pending claims should not need to be submitted.

Also, the requirement of a separate complete set of claims is not necessary. The practitioner or applicant should be given the option of presenting all the pending claims (including those showing amendments) within the claims amendment portion of the reply, submitting all the pending claims as an appendix to the reply similar to an appeal brief, or submitting all the pending claims on a separate paper. Some examiners have indicated a preference to have practitioners amend claims rather than submitting substitute claims. Requiring a separate complete set of claims will more likely result in practitioners submitting substitute claims rather than amending claims.

The proposed section also states that missing claims are presumed to be canceled. Claims should only be canceled by an express statement of cancellation, not an inadvertent omission. If all pending claims are to be submitted and one is omitted, the examiner should notify the applicant of the missing claim and give the applicant one month to submit a complete set of claims. The proposed "cancellation by omission" is too harsh and unnecessary.

Sections 1.137(a)(1) and 1.137(b)(1) have been changed to remove the portion referring to responses (replies) and only refers to continuations. Unless the application was finally rejected before the revival, an amendment should be accepted provided that the application is revived. If the application was finally rejected, the two appropriate replies could be limited to appeal or continuation, not a Section 1.116 amendment. Therefore, the language allowing for responses (replies) should be retained because the last action could be a non-final rejection.

Section 1.193 is proposed to include a provision that the applicant can reinstate the appeal. I believe that this is a very good addition but does not go far enough. It is not uncommon for examiners to reopen prosecution after appeal briefs have been filed. Reopening prosecution penalizes the applicant because any time extensions for the patent due to an appeal evaporate. Section 1.193(b)(2) should be changed to allow amendments, affidavits, and other evidence to address the new ground of rejection while also reinstating the appeal. The section should be further amended to include a provision that if the examiner reopens prosecution, a subsequent appeal notice fee (Section 1.17(e))and appeal brief fee (Section 1.17(f)) for the same application will be waived. Additionally, the time period for extension for the patent, if claims are eventually allowed, should start from the time of the first appeal and continue thereafter less any time due to unreasonable delays by the applicant. If the examiner did his or her duty completely, there should not be any need to reopen prosecution. Similar provisions should also apply to situations when the Board of Patent Appeals and Interferences of a new ground of rejection.

I request thoughtful and thorough consideration of my comments. I thank the Commissioner for having the opportunity to be heard on the proposed rule changes. Contact me if you have any questions or comments.

Very truly yours,

George R Meyer

George R. Meyer
Reg. No. 35,284