

Dear Sir or Madam,

The following comments represent only my personal views, and not necessarily those of the law firm with which I am employed or any client thereof.

These comments relate to the Notice of Proposed Rule Making published in the 22 April 2003 edition of the Official Gazette of the U.S. Patent and Trademark Office, relating to "Changes to Implement Electronic Maintenance of Official Patent Application Records."

I have comments relating to only two portions of the proposed rules.

#### Proposed Revisions to 37 CFR 1.97

The Office proposes to revise several portions of 37 CFR 1.97 to shift backward by a day the deadline for filing of an IDS in certain circumstances. Under the current rules, the IDS must be filed not later than the mailing date of certain Office actions. Under the proposed new rules, the IDS would have to be filed not later than THE DAY BEFORE the mailing date of the corresponding Office action.

The justification proposed by the Office for these changes is that applicants are able to use the PAIR system to determine when an Office action is mailed. If an applicant wishes to delay prosecution of the application, the applicant can file an IDS on the mailing date of the Office action. Regardless of whether this tactic is "unfair" (as the Office characterizes it in its comments in the Notice) or advisable, the proposed rule change may not prevent the practice.

Currently, the PAIR system is operated in such a way that notice is often posted on PAIR that an Office action has been prepared prior to its mailing. For example, please consider the PAIR entry for U.S. Patent No. 6,123,449. In that entry, the date of the Notice of Allowability was 8 May 2000 and the date of MAILING of the Notice of Allowance was 9 May 2000 (compare items 10 and 12). Similarly in the same PAIR entry, a Non-Final Rejection was entered on 10 February 2000, but not mailed until 11 February 2000 (compare items 5 and 6). Longer delays sometimes occur between entry of an Office action into PAIR and mailing of the same action (e.g., 20 days - compare items 9 and 10 in the PAIR entry for U.S. Patent No. 6,123,454). Thus, a vigilant applicant often knows at least a day ahead of time that an Office action will be mailed.

In my opinion, the rule proposed by the Office would not prevent the practice about which the Office complains, at least unless entry of notice of Office actions into the PAIR system were to be delayed until the corresponding mailing date. Even if that change were made, it is not clear that the rule change would inhibit late filing of an IDS, since applicants could estimate when an Office action is likely to issue (or prey on the good nature of examiners who will often attempt to estimate when an action will issue upon request by an applicant).

On balance, it seems to me that this rule change is much more likely to adversely affect applicants represented by members of the patent bar who are familiar with the current rule (and unfamiliar with the proposed new one) than any applicants who might attempt to game the system through late filing

of an IDS. For this reason, the changes proposed to 37 CFR 1.97 are not advisable, in my opinion.

Proposed Revisions to 37 CFR 1.121

The Office proposes to change 37 CFR 1.121 regarding the manner of making amendments to the specification and claims. Among those changes is a requirement that changes be indicated only by struck-through (i.e., deleted) and underlined (i.e., added) text. Previously, bracketing of deleted text and other methods of indicating revisions of claim and specification texts were permitted.

A difficulty that occasionally arose, particularly in patent applications in which chemical formulas appear in the specification or claims, was that Office personnel would delete portions of chemical formulas enclosed in brackets, even if brackets were not otherwise being used to indicate amended portions of the text. For that reason, some practitioners have avoided using brackets in patent applications. Brackets sometimes greatly clarify the meaning of chemical formulas, particularly relatively complicated ones.

I would like to know whether it is now 'safe' to use brackets in the text of the specification and claims of a patent application. Put another way, have examiners been instructed NOT to delete text appearing in brackets? With the switch to electronic processing of patent applications, it appears that it will be difficult for an examiner to alter text submitted by an applicant. However, I would appreciate if the Office would comment on this issue.

I appreciate the opportunity to comment on the Office's proposed rule changes. I believe that a longer comment period than the three days permitted for comments relating to the currently proposed rules might elicit a greater number of and more helpful comments from the patent community.

Very truly yours,

Gary

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