

**Subject: Comments on Changes to Implement Electronic Maintenance of Official Patent Application Records**

The undersigned presents the following comments on the March 25, 2003 notice of proposed rulemaking entitled "Changes to Implement Electronic Processing of Official Patent Application Records" (68 FR 14365).

The undersigned is most concerned with the proposed changes in 37 CFR 1.121 (Rule 121) regarding the format of amendments. Under the proposal, a complete set of all claims, even those not amended, must be included in any amendment. Although each claim in the set must be identified by a status identifier, the proposed format would allow claims that are intended to be retained to be cancelled too easily by mistake. The undersigned believes that no status change for any claim, and especially no claim cancellation, should be effected unless there is an explicit statement in the remarks portion of the amendment confirming the status change. To avoid an unnecessary burden on the Patent and Trademark Office (PTO) to find the explicit statement, the undersigned proposes that Rule 121 be amended to require that at the beginning of the Remarks section, an applicant be required to identify all claims whose status is being changed by the current amendment, and to state how the status is being changed. Thus, the explicit statement will always be in the same place and can easily be verified by the PTO. Indeed, in applications with large numbers of claims, it would be beneficial to the PTO to have such a summary of status changes -- to save PTO personnel the effort of combing through a large number of claims to find those whose status is changing when the status of only a small number of claims is changing. If the status summary differs from the status identifiers, the amendment can be deemed informal, and a time limit can be set for the applicant to correct that informality in the amendment.

In addition, the undersigned is concerned with the size of the paper file that will result from reproducing all claims in every amendment, particularly in applications with large numbers of claims, but even where the number of claims is not large. The PTO has not said what it plans to do with the paper amendments after they have been scanned, but if they are to be retained, the paper file could become unmanageably bulky. And practitioners' files, which are likely to remain in paper form for some time, also could become unmanageably bulky.

Finally, the undersigned is concerned with the proposed change in 37 CFR 1.97(c) (Rule 97(c)) regarding the timing of Information Disclosure Statements (IDSs) near the mailing of a paper closing prosecution. In an extension of the excessive suspicion shown by the PTO over the last several years concerning applicant motives -- and particularly practitioner motives -- the PTO is proposing to require that IDSs be submitted one day before prosecution is closed on the merits, rather than by the day prosecution is closed as is currently required. The stated reason for this rule change is that the status of applications is available via the PAIR system, and applicants will retain IDSs until they see that prosecution has been closed, so that the IDSs can be mailed that same day, with the idea that that somehow confers an advantage on applicants.

The undersigned believes that this proposed change unfairly burdens honest applicants to take care a very small number, if any, of dishonest applicants who try to "game the system." Indeed, it is the undersigned's experience that submitting any paper that crosses in the mail with a paper closing prosecution works to applicants' disadvantage by slowing down PTO processing, particularly if prosecution is closed by a Notice of Allowance

or a Notice of Allowability, rather than to applicants' advantage. Therefore, there is no incentive for applicants to act as the PTO suggests they would.

In addition, the proposed change overstates the effectiveness of the PAIR system. While the undersigned has found PAIR to be a wonderful tool, and would never want to go back to the time before PAIR, PAIR simply does not reflect changes in status as quickly as the proposed rule change suggests. The undersigned's experience is that a status change usually does not appear for at least one day, and sometimes several days after it occurs. It is rare that a change is reflected on the same day that it occurs.

For these reasons, the undersigned believes that the proposed change in Rule 97(c) is unnecessary.

The undersigned is a partner in the intellectual property law firm of Fish & Neave. However, these comments are those of the undersigned alone, and do not necessarily reflect the views of Fish & Neave.

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