

Sir or Madame:

We offer the following comments to the "Changes to Implement Electronic Maintenance of Official Patent Application Records" announced in the Federal Register, 68 (March 25, 2003), pp. 14365-14379.

1. Under the Discussion of Specific Rules for Section 1.59 (FR 68 at p. 14368), the following statement appears: "Where the image is generated from a physical source document, the originating document may be disposed of once the electronic image accuracy is verified." We recommend that the Office not destroy original physical documents under its proposed new procedures. Faint, wrinkled, or dog-eared originals, or originals that are improperly positioned on the imaging device, will lead to images that, upon close scrutiny, are incomplete or inconclusive and that will require reference to the original document to supply the missing information. If the imaging device converts to a pure black-and-white or a gray scale image, any color information present on the original will also be lost. Although the quoted sentence refers to a verification process, it is submitted that the adequacy of such process should be assessed only after a substantial evaluation period. At least during such an evaluation period, we respectfully submit that original physical source documents should not be destroyed.

In connection with the proposed revisions to Section 1.121 (Manner of making amendments in applications), we offer the following additional comments:

2. Currently, Rule 121 recites in several places:

"... changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system." The proposed revised Rule 121 replaces this well-known formula with:

"... changes must be shown by strike-through (for deleted matter) or underlining (for added matter)."

We recommend that the Office not adopt the proposed mandatory strike-through/underlining system for indicating changes. If the Office is committed to a mandatory system, we recommend that the established and well-known bracket/underlining system be specified. For the deletion of textual matter, the familiar square brackets "[]" are easily identified and unmistakably show exactly what text is to be deleted, whether an entire subparagraph, phrase, word, letter, or punctuation mark. The same cannot be said for the strike-through technique. Typically, the strike-through is a single thin horizontal line that overlaps to some degree with a given character. In the font used in this e-mail message, for example, the strike-through overlaps substantially completely with at least the characters "e", "=", and "4". This characteristic of strike-through can be a source of genuine confusion. For example, an attempt to modify a hypothetical claim 5 so that it depends from claim "3" rather than from claim "4" would appear as:

5. (Currently amended) The article of claim (~~4~~)3, wherein ... which of course would likely be misconstrued as a change to "43" with no deletion of any character. The bracket system would not be susceptible to such misinterpretation. Even where the strike-through does not overlap with a given character, the combination of the strike-through and the original character can be easily overlooked as a different character, such as the ~~strikethrough~~ of a comma (~~strikethrough~~ ,) appearing as a semicolon (;). Again, such an oversight would not occur with the bracket

approach. Another problem associated with strike-through is the possibility of a false positive, as for example might be caused by a scratch or blur on the glass plate of a photocopier machine or a fiber or dust particle in a facsimile machine.

Therefore, because of the potential criticality of each and every word, letter, and other character, and the importance of a clear and unambiguous prosecution history, we respectfully urge the Office not to adopt the mandatory strike-through/underlining system. If the Office is committed to a mandatory system, we request that the bracket/underlining system be specified. We would also support a continuation of the existing marking provisions, permitting bracket/underlining or any equivalent marking system.

3. If strike-through alone is retained in Rule 121 as the mandatory form of deletion, we request clarification regarding its meaning. Is strike-through limited to a single thin horizontal line approximately midway between the top and bottom of the characters of text? Or does the term also encompass: (a) two parallel horizontal lines (double strike-through); (b) a wavy/sinusoidal line; (c) one or more "x" or "X" overstruck over the matter to be deleted; (d) any of the foregoing drawn by hand? Similarly, if underlining will be the mandatory marking for added matter, does that also encompass double underlining?

4. Clarification is requested in connection with the parenthetical expressions appearing in subpart (c) of the revised Rule 121. In that subpart, although the mandatory "must" is used to say that the status of each of the claims must be indicated, the sentence immediately following uses the permissive language "should": the status "should be indicated by use of one of" the eleven listed identifiers (emphasis added). The permissive language would appear to permit identifiers other than the eleven listed -- clarification is requested. The quoted sentence refers to "one" of the identifiers, but again the permissive language would appear to permit the use of more than one of the listed identifiers if applicable. If the rule is clarified to require that exactly one of the eleven listed expressions must be used, then guidance is requested regarding how practitioners should identify a claim for which multiple identifiers are applicable, e.g., "Previously added" and "Currently amended", or "Previously amended" and "Canceled".

Respectfully submitted,

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