

Sir: My comments on these proposed rules follows.

**COMMENTS ON THE PROPOSED RULES REVISIONS PUBLISHED AT 68 FR 14367, ENTITLED "CHANGES TO IMPLEMENT ELECTRONIC MAINTENANCE OF OFFICIAL PATENT APPLICATION RECORDS"**

The proposed rules relate to the USPTO's transition from paper to electronic patent application files.

37 CFR 1.3 - Business to be conducted with decorum and courtesy.

The proposed change to rule 1.3 (1) has nothing to do with the USPTO's transition to electronic application files and (2) appears to forego active participation of the Commissioner, now Director, in determining what constitutes a failure of decorum and courtesy. Prior rule 1.3 stated that a paper in violation of rule 1.3 "would be submitted to the Commissioner and will be returned by the Commissioner's direct order." That statement implied a review of the initial determination that the paper failed the courtesy requirement. In contrast, proposed 1.3 states that "[p]apers submitted in violation of this [the decorum and courtesy] requirement will be submitted to the Director and will not be entered." There is no reasonable basis for this proposed rule change. Therefore, it should not be implemented.

37 CFR 1.14 - Patent Applications Preserved in Confidence

This is an important rule since it defines inter alia the extent to which a third party can obtain access to patent applications records.

Proposed new section 1.14(b) states that "the Office may at its discretion provide access only to an electronic copy of the specification, drawings, and file contents of the application." The proposed rule does not indicated how the Office will " provide access only to an electronic copy." The proposed rule should be revised to clarify what "access only to an electronic copy" means to apprise practitioners of what they need to do to get that access.

Proposed new section 1.14(e) indicates that the Office may share unpublished applications with other IP offices, if the applicant consents. Presumably, the Office will implement a procedure that notifies the applicant of an intent to share the application with the other IP offices, and then requires the applicant takes some affirmative action after notice by the Office. That is the tack that the Office expressly takes in section 1.14(f)(2) regarding decisions the Director wants to publish for Board proceedings that are not otherwise public. The proposed rule should be amended in parallel with section 1.14(f)(2).

An ongoing defect with rule 1.14 is that it does not notify the public that the Office will provide either a copy of or access to a file for an abandoned unpublished application if the application number for that abandoned unpublished application is referenced in a document in the file of a publicly available application, such as in an IDS in the publicly available application. The Office should revise rule 1.14 to clarify that point.

Proposed new section 1.14(f) indicates that the Office may published certain decisions of the BPAI. The comments on the proposal states that Director has authority for publication of such decisions based upon the Director's authority specified in 35 USC 122(a) to make "information concerning" patent applications public in "special circumstances as may be determined by the Director." I agree. However, the comments list one special circumstance as an opinion concerning an application that claims the benefit of a published application, including a published foreign priority application. There is no logical relationship between foreign priority and a benefit to the public. Therefore, there is no logical reason for the Director to treat a claim to priority of a published foreign application as a "special circumstance." There is a public purpose served by publication of BPAI decisions, even if the BPAI does not think those decisions, as noted in the comments, "involve an interpretation of patent laws or regulations that would be precedential." 68 FR 14367 right hand column, first full paragraph. Accordingly, the Director should state that any decision of the BPAI concerning a patent application is a special circumstance warranting publication of the decision.

#### 37 CFR 1.52 - Language, paper, writing, margins, and compact disc specifications

Proposed rule 1.52 retains the requirement in 1.52(i) that lines must be 1 and ½ or double spaced. The basis for that requirement was so that clerks in the USPTO could hand write in certain amendments to the specification and claims. Since the USPTO is converting all papers copies to electronic files, no one will be able to hand write in certain amendments to the specification and claims. The requirement for line spacing greater than single line spacing wastes paper and causes more bulky filings. The USPTO should also be sensitive to the fact that most practitioners will not switch to electronic files, and therefore maintaining a requirement for line spacing greater than one causes unnecessary bulk in practitioners' files. For all of these reasons, proposed rule 1.52 should be revised to either require or encourage single line spacing.

#### 37 CFR 1.121 Manner of making amendments in applications

Proposed rule 1.121 generally requires amendment to the specification to be specified by an instruction to delete the specified section and replace it with a replacement section, and to include in the replacement section a strike through of text deleted and underlines of text added. In contrast to the current rule 1.121, applicant's are not required to (see e.g. proposed 37 CFR 1.121(b)(5) and CFR 1.121(c)(1) file both a clean copy and a marked up copy of amended text.

Proposed sections 1.121(b)(4) provides for reinstatement of previously deleted matter. Proposed section 1.121(b)(4) is unnecessary, since what can and can not be added via amendment is specified by statute and case law. Proposed section 1.121(b)(4) should not be implemented.

Proposed section 1.121(c) states that the "text of all pending claims (except for withdrawn claims) must be submitted in a single amendment document each time any claim is amended." However, withdrawn claims (1) may be amended and (2) may be reinstated by the examiner during prosecution. It would benefit both the examiner and the applicant to maintain a current set of all claims in the application. Maintaining the withdrawn claims in the claim set in the amendments enables the examiner to more readily determine if the withdrawn status remains proper throughout prosecution. Maintaining the withdrawn claims in the claim set in the amendments enables the applicant to more readily determine what claims, if any, to present in a division application, and to more readily amend the withdrawn claims to overcome issued noted by the examiner in the claims under examination that also relate to the withdrawn claims. Accordingly, the exception for withdrawn claims should not be included in the final rule.

Proposed 1.121(c) requires the claim set in an amendment to include parentheticals identifying their status. The Office should reconsider what status indicators to require because many of the status indicators are contradictory. For example, what status indicator may and must an applicant use for a claim that is both "Previously re-presented" and then "Currently amended"? I submit that the status indicators beginning "previously..."; "reinstated..."; and "represented ..." be deleted, so that claims status will be identified only by "original", "new", "currently amended", and "previously amended". The status "original" is legally significant pursuant to 35 USC 112 and 132. The status "new" is legally significant because that status identifies the claim as not part of the original disclosure. The status regarding "amended" is legally significant from the perspective of the doctrine of equivalents and helps the examiner determine relationship of amendments to prior rejections. The other status indicators appear to have no legal or practical utility, and therefore should not be required or encouraged.

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**Rick Neifeld, Ph.D. Patent Attorney**  
President, Neifeld IP Law, PC and StockPricePredictor.com, LLC  
2001 Jefferson Davis Highway, Suite 1001  
Arlington, VA 22202  
Tel: 703-415-0012  
Fax: 703-415-0013  
Email: [rneifeld@neifeld.com](mailto:rneifeld@neifeld.com)  
[www.Neifeld.com](http://www.Neifeld.com) and [www.PatentValuePredictor.com](http://www.PatentValuePredictor.com)