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April 25, 2003

BY E-MAIL

Honorable Commissioner of Patents
Washington, D.C. 20231

Re: Comments on Proposed Rule 37 C.F.R. §1.121

Dear Sir:

The following comments are submitted concerning the proposed revised rule 37 C.F.R. §1.121, as published in the Federal Register on March 25, 2003, with apologies for their tardiness.

1. Subparagraph (b)(1) addressed to deleting, replacing or adding a paragraph states in sub-subparagraph (ii) that "[a]ny . . . added paragraph(s) marked-up to show all of the changes relative to the previous versions of the paragraph(s). The changes must be shown by strike-through (for deleted matter) or underlining (for added matter)." This implies that a new paragraph or added paragraph should be underlined. However, the Patent Office sample format for the revised amendment, on page 2, does not show underlining the material of the added paragraph. It is recommended that sub-subparagraph (ii) only address replacement paragraphs.

2. In subparagraph (c), directed to claims, there is a category entitled "Re-presented-formerly dependent claim number ___." This category would appear to only result in confusion. For example, if claim 1 is independent and claim 5 a dependent claim that is indicated as allowable, when claim 1 is amended to incorporate the matter of claim 5 is it labeled "Re-presented-formerly dependent claim 5" or "Currently Amended"? Further, if there were 12 claims in the original application and it is decided to add claim 13, which combines claims 1 and 5, is that a "new" claim or is it a "Re-presented. . ." claim? We believe the first case is "Currently Amended" and the second case is "New". Thus, it would appear the only time "Re-presented. . ." would be used is when claim 5 is rewritten in independent form. In such a case, there is no need for the phrase "formerly dependent claim number 5" as the claim number does not change.

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3. In subparagraph (c)(2) it is stated the text of "withdrawn claims shall not be presented, but must be indicated only by claim number and status." However, if the claim is subject to an Election of Species Requirement and must be amended to correspond to the antecedent basis provided in a generic claim from which it depends that will be rejoined if the generic claim is allowed, how is it to be represented, as "Withdrawn" or "Currently Amended"? Likewise, what happens to claims that have been withdrawn by the Examiner as a result of a Restriction/Election Requirement, but which Applicants choose to amend and then argue for their rejoinder. Withdrawal of claims in a significant number of Applications is not final, although it may be stated as so in Office Actions. As noted above, species claims may be rejoined. Further, claims may be amended to become linking claims or to be placed in a form that requires rejoinder. As such they, should be properly presented in an Amendment in order to expedite prosecution and minimize unnecessary actions.

Respectfully submitted,

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