

COMMENT REGARDING NOTICE OF PROPOSED RULEMAKING

This comment relates to the notice of proposed rulemaking entitled "Changes to Implement Electronic Maintenance of Official Patent Application Records", which was published in the Federal Register on March 25, 2003 at 68 FR 14365-14379. This comment is directed to the proposed change to Rule 121 (37 C.F.R. §1.121), and more specifically to proposed Rule 121(c)(4).

In particular, the first sentence of proposed Rule 121(c)(4) would read "When one or more claims are amended or added in an amendment document, all of the claims shall be presented in a listing in ascending numerical order" (emphasis added). The purpose of this comment is to object to the requirement that the claims must be presented in ascending numerical order, for the following reasons.

For many years, the PTO has consistently expressed its preference that, to the extent possible, claims should be presented in logical order. For example, MPEP §608.01(n)(IV) states that, in a newly-filed application:

A claim which depends from a *dependent* claim should not be separated therefrom by any claim which does not also depend from said "dependent claim".

In other words, the PTO strongly prefers that applicants first arrange the claims of a new application in logical order, and then number the claims consecutively. As a result, claims in every newly-filed application should theoretically be in logical order. As a practical matter, those claims will also be in numerical order, by virtue of the fact that they are numbered after being placed in logical order, but it is clear that the PTO's primary concern is that the claims be in logical order. Where applicants fail to conform to this PTO preference that the claims be in logical order, MPEP §608.01(n)(IV) provides form paragraph 6.18 for examiners to use in advising applicants that:

A claim which depends from a dependent claim should not be separated [therefrom] by any claim which does not also depend from said dependent claim.

In a similar manner, current Rule 75(g) (i.e. 37 C.F.R. §1.75), which is not proposed to be changed, provides that:

. . . all dependent claims should be grouped together with the claim or claims to which they refer to the extent practicable.

In addition, MPEP §608.01(m) provides that:

All dependent claims should be grouped together with the claim or claims to which they refer to the extent practicable. Where separate species are claimed, the claims of like species should be grouped together where possible. Similarly, product and process claims should be separately grouped. Such arrangements are for the purpose of facilitating classification and examination.

This latter quote represents still another expressed preference that, to the extent practicable, the claims should be arranged in a logical order before they are numbered. As noted in this latter MPEP quote, an important reason why the PTO wants the claims arranged in logical order is to facilitate examination.

After an application has been filed, the claims are often amended during prosecution, and it is very common for the logical order of the claims to end up being significantly different from the numerical order. As noted above, a significant purpose behind the PTO's preference for logical order in newly-filed applications is to facilitate subsequent examination. Consequently, this PTO preference is perhaps even more relevant during prosecution than it is at filing. One of the big advantages of existing Rule 121 is that it permits an amendment document to present all of the pending claims in the logical order which is preferred by the PTO, rather than in numerical order. The following table shows an example drawn directly from an actual U.S. patent application. The left column shows how all of the pending claims were presented in logical order in an actual amendment document filed under existing Rule 121. The right column shows how the same claims would appear if they had to be arranged in "ascending numerical order" under proposed Rule 121.

<b>Logical Order</b> (Existing Rule 121)	<b>Numerical Order</b> (Proposed Rule 121)
41. Independent	41. Independent
62. Depends from 41	42. Depends from 54
54. Depends from 41	43. Depends from 54
55. Depends from 54	44. Depends from 54
42. Depends from 54	45. Depends from 54
43. Depends from 54	46. Depends from 54
44. Depends from 54	47. Depends from 54
45. Depends from 54	48. Depends from 54
46. Depends from 54	49. Independent
47. Depends from 54	50. Depends from 56
48. Depends from 54	51. Depends from 56
	52. Independent
49. Independent	53. Independent
63. Depends from 49	54. Depends from 41
56. Depends from 49	55. Depends from 54
57. Depends from 56	56. Depends from 49
50. Depends from 56	57. Depends from 56
51. Depends from 56	58. Depends from 52
	59. Depends from 58
52. Independent	60. Depends from 53
58. Depends from 52	61. Depends from 60
59. Depends from 58	62. Depends from 41
64. Depends from 52	63. Depends from 49
	64. Depends from 52
53. Independent	65. Depends from 53
60. Depends from 53	
61. Depends from 60	
65. Depends from 53	

As discussed above, an important purpose of the PTO preference for logical order is to facilitate examination. The left column achieves this objective

as fully and effectively as any newly-filed application. On the other hand, the right column represents an extremely illogical and confusing order that would make it much more difficult for examiners (and applicants) to figure out which claims are in which claim sets, and exactly what is being claimed in each claim set. If the full text of the claims were to be included (such that the claims were spread across 10 to 12 pages), it would be even more difficult to quickly make sense of these claims when they are presented in numerical (illogical) order. As a result, examiners will more frequently misunderstand what is being claimed, and will make more errors, thereby reducing the quality of examination provided. Further, it will take examiners more time to properly examine any given application, which will increase the PTO's average cost to examine each application. If an examiner telephones an applicant's attorney or agent several months after an amendment has been filed, it will be effectively impossible for the attorney/agent to glance at the claims in the amendment and quickly refresh his or her memory regarding which claims are in which claim sets, and what is being claimed in each claim set. As a result, the telephone conference will take longer and involve some confusion, and is less likely to result in resolution of whatever issue prompted the call. Over the past 20 years, the PTO has worked hard toward the goals of increasing efficiency and decreasing costs, while also improving the quality of examination provided to applicants. But the effect of proposed Rule 121(c)(4) would appear to be directly contrary to these objectives.

The only reason given in the proposed rule change for the requirement that the claims be in ascending numerical order is that "[t]his would prevent the grouping of claims by status (all new claims together, all amended claims together, etc.), and ensure a complete set of claims in numerical order, regardless of status". This appears to recognize that grouping claims by status does not facilitate their examination. On the other hand, putting claims in numerical order does not necessarily facilitate their examination either.

In conclusion, **the purpose of this comment is request that proposed Rule 121(c)(4) be modified so that, in the final rule, applicants will have the option of presenting the claims in an amendment document in the logical order that is strongly preferred by the PTO, which would be beneficial for applicants, examiners, and the PTO.** This comment is not suggesting that the final version of Rule 121(c)(4) should necessarily go farther and make it mandatory for all applicants to present claims in logical order. On the other hand, the PTO may wish to consider making it mandatory for all applicants to present claims in logical order, for example by adjusting Rule 121(c)(4) to use language similar to the language quoted above from MPEP §608.01(n)(IV). This would further the same long-standing PTO policies and objectives that are behind the PTO's strongly-expressed preference for the use of logical order in newly-filed applications in order to facilitate later examination, as set forth in MPEP §608.01(n)(IV), MPEP §608.01(m), Rule 75(g), etc.)

T. Murray Smith  
Reg. No. 30222  
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