MEMO

To	USPTO patentEFW.comments@uspto.gov
From	Lee C. Wright (LWRIGHT@sughrue.com) 2100 Pennsylvania Ave NW, Washington, DC 20037
Subject	Comments on the Changes To Implement Electronic Maintenance of Official Patent Application Records
Date	April 23, 2003

Dear Sirs:

In *Changes to Implement Electronic Maintenance of Official Patent Application Records*, 68 Fed. Reg. 57, 14365 - 14372 (March 25, 2003), the USPTO proposes to amend 37 C.F.R. §§1.121 and 1.97. The following comments are submitted in response to the proposed rule changes and in response to the "Pre-OG Notice" document *Amendments in a Revised Format Now Permitted*, set forth on the USPTO website.

I. 37 C.F.R. §1.97

A. The filing of an IDS does not trigger any extra response by the examiner. The examiner may merely chose to consider the IDS with the next office action. Except for notices of allowance (which an applicant would probably not want to delay), the "short term needs" and the "delay" are not apparent.

The filing of a supplemental response may cause delay, but not the filing of an IDS.

Having different rules for different mail date situations does not promote the alleged goals of the USPTO to simplify the patent process.

B. Applicants are already discouraged from such a practice. If a response has been filed, an applicant will lose patent term by filing an IDS. See 37 C.F.R. §1.704(c)(8). Discouragement on top of 37 C.F.R. §1.704(c)(8) is not necessary.

C. If a response has been filed, as a courtesy to examiner, I will often contact the Examiner to indicate that an IDS is forthcoming. It is just as likely that an examiner will take advantage of that information to speed up the mailing of an office action as it is for an applicant to monitor the pair system to "unfairly delay prosecution".

II. 37 C.F.R. §1.121

37 C.F.R. §1.121 (proposed) states: "The listing will serve to replace all prior versions of the text of the claims (except for withdrawn claims) in the application." What will serve to replace the prior versions of the withdrawn claims if the withdrawn claims are amended?

37 C.F.R. §1.121 (proposed) states: "The text of all pending claims (except for withdrawn claims) must be submitted in a single amendment document each time any claim is amended." How are the withdrawn claims to be amended?

37 C.F.R. §1.121 (proposed) includes status "identifiers". How is the status of a withdrawn claim that is amended to be indicated?

The proposed identifiers all relate to how the claims are being presented in the amendment, except for one, the identifier "withdrawn." "Withdrawn" is not an indicator of how the claim is being treated in the present or past amendments. Rather, it is an indication of the status of the claim, like allowed, rejected, and objected to. It does not belong with the other "identifiers." If "withdrawn" is to be used, should "allowed" likewise be used?

Not allowing <u>both</u> the presentation and the amendment of withdrawn claims fails to meet the goal of enabling a complete listing of all the claims to be conveniently located and easily accessed on a computer screen for review.

Further, MPEP §821.04 identifies certain circumstances where withdrawn claims "will" be rejoined. The availability of rejoinder encourages applicants to amend withdrawn process claims in a

manner similar to the amendments to the elected product claims. 37 C.F.R. §1.121 (proposed) excludes the text of withdrawn claims from being even included in an amendment.

Rejoinder is not a topic embraced or understood by many examiners. 37 C.F.R. §1.121 (proposed) will further discourage examiners from considering rejoinder. Rather, examiners will not even look at the withdrawn claims and will merely cancel them, thus actually delaying compact and efficient prosecution.