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Box Comments
Assistant Commissioner for Patents
Washington, D. C. 20231**FAX RECEIVED****NOV 21 1996****PETITIONS OFFICE**

Attention: Jeffrey V. Nase

Sir:

This letter contains my comments relating to the 1996 Changes to Patent Practice and Procedure published at 1191 O.G. 105.

I was registered January 15, 1937 and in the almost 60 years since then I have filed over 2000 applications, handled about 40 interferences, been lead attorney in about 200 patent suits, been lead attorney in about 30 patent trials and argued about 20 appeals in the U. S. Courts of Appeal. I had a case in the U. S. Supreme Court as to the constitutionality of one of the patent laws. I am still active and have, this year, handled 13 patent applications, three trademark cases and a number of patent licensing matters.

1.121 MANNER OF MAKING AMENDMENTS

I disapprove of the changes in this rule as they will inherently complicate the practice and increase the expense of prosecuting and examining patent applications, increase the expense of storage space, and cause problems when errors are made.

The cost of patent applications is passed along to the client, and reduces the money available for research. Every rule change should be carefully considered with this in mind. In Europe, costs are high, research is lagging and the economies are not as good as ours. Europe's problems are the result of high costs and high taxes. Small cost increases add to other small increases and soon costs rise appreciably.

If an attorney submits a new specification and a rewrite of all claims, is the examiner going to read all of it? If so then PTO costs will increase. Increases in the time spent by examiners will exceed savings in clerical costs.

The bigger the file, the greater the storage space. I keep files until the patent expires and my storage space is overflowing. To add even 5% to each file would require 5% more space. In my case this 5% increase would last 20 years. For the PTO, the increase would last forever.

Attorneys will expect their clerks to provide the revised copies required by the new rule. Suppose an error is made. When the error changes a claim the attorney might face a fraud charge if the patent is the basis of an infringement suit. Years ago a defendant-infringer charged fraud because there was an error in quoting a claim in the remarks. If attorneys feel that they must personally reread and double check all of the submissions then the attorney costs will far exceed any benefits.

I can see that this rule would avoid the need for PTO clerks that enter amendments. However, in many, if not most, cases it is easier to enter short amendments as is now done, than to submit a rewrite of a long application. Perhaps this requirement could be limited to cases where the amendments are numerous.

1.116 AMENDMENTS AFTER FINAL

I believe that this proposed change is unwise. This is especially true in view of the new law wherein patents expire 20 years from the filing date. It is now highly desirable to get patents out as soon as possible. If an application can be allowed by an amendment after final, why delay the case?

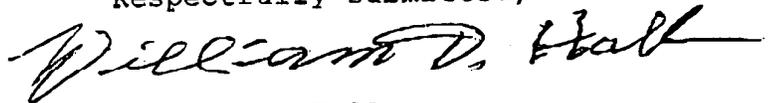
1.175 REISSUE OATH

The PTO should be tough on applicants who claim to have made errors in getting a patent. It is only logical that they should thoroughly explain how the errors occurred. It is hard to get a court to review this issue and the PTO should not avoid its responsibility of making sure that an error really occurred.

1.53 CONTINUED APPLICATIONS

The provision simplifying the present FWC procedure is especially good and is by far the best and most important of all of the new proposals. Further, there should be instructions to examiners to take up these applications for examination promptly, and not wait as though they were new applications. They should be examined no later than other forms of amended applications.

Respectfully submitted,



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