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To: regreform <regreform@uspto.gov>  
Subject: Comments on Proposed Rulemaking at 60 FR 49820

The undersigned, a partner in the intellectual property law firm of Fish & Neave, of New York City, submits the following comments on the Notice of Proposed Rulemaking published at 60 FR 49820, proposing "miscellaneous amendments" to the Patent Rules of Practice.

The undersigned cannot understand the reason for the change of what is now called a "response" to a "reply." This proposed change, which generated a multitude of proposed amendments because of the sheer number of rules affected, serves no apparent purpose other than to confuse practitioners. The term "response" has been used for decades, and probably since the founding of the Republic. Moreover, the term "reply" already has a well-defined, and different, meaning in interference practice, giving rise to a potential for confusion that does not exist at present; on the other hand, there is nothing else in the Rules called a "response."

The undersigned encourages the Patent and Trademark Office to further proofread the proposed amendments. The undersigned recalls that there is at least one place in the rules where the word "case" was not proposed to be changed to "application," even though it would be appropriate to do so.

The undersigned believes that the proposed amendments to 37 C.F.R. §§ 1.28(c)(2), 1.48, 1.175 and 1.324 should be retroactive, as well as any other rules that lessen the requirements for factual showings. The consequences later in litigation for falsifying such showings should be sufficient to prevent abuse of relaxed rules.

With regard to specific rules:

The proposed insertion in 37 C.F.R. § 1.4(d)(1)(ii), "or of a copy of a copy" should probably be -- or a copy of a copy --.

The changes in 37 C.F.R. §§ 1.41(a) and 1.53(d), and the addition of 37 C.F.R. § 1.48(f), allowing "correction" of inventorship in an

unexecuted application merely by listing the correct inventors in the executed declaration filed to complete the application, are most welcome. The undersigned has always felt that the need to resort to Rule 48 in such cases was an unnecessary burden so long as no deceptive intent was involved. After all, applications that are filed without execution are usually those filed in a hurry -- e.g., to beat a statutory bar date -- where there may not be time to fully investigate inventorship before filing.

Further clarification is required in 37 C.F.R. § 1.53(b)(1)(i). First, something is wrong with the placement of the parentheses in the following line:

(§ 1.51(a)(1)(ii)) and paragraph (d) of this section

The undersigned believes it should read as follows:

(§ 1.51(a)(1)(ii) and paragraph (d) of this section)

Second, on the merits, the rule requires that in a continuation application, a copy of the executed declaration filed to complete the most immediate prior national application should be filed. In the second (and subsequent) continuation in a chain of continuations, the declaration filed in the immediate prior application would itself be a copy of the declaration in a still prior application. It should be clarified that a copy of that copy is sufficient (if it is), or that a newly signed declaration is required in a second or subsequent continuation. The undersigned understands that the former is the case, in view of 37 C.F.R. § 1.4(d)(1)(ii), but the issue should be clarified.

Although not part of the rule itself, the requirement for the statement of copendency for a Continued Prosecution Application under proposed 37 C.F.R. § 1.53(b)(3) should be clarified in the case of a chain of such applications. It was not perfectly clear to the undersigned whether a single recitation that the application was a continuation of the common application number is sufficient, or whether the common application number must be referred to multiple times, corresponding to the number of earlier applications in the chain. Again the

undersigned believes that the former was intended, but finds that the commentary is not perfectly clear.

In 37 C.F.R. §§ 1.52(a,d) and 1.69(b), who should make the statement that the translation is accurate? Should it be the translator or is it sufficient if it is the practitioner? How much first-hand knowledge does the practitioner need to know that the translation is accurate?

With regard to the addition of 37 C.F.R. § 1.113(c) and the accompanying tightening of 37 C.F.R. § 1.116(b), the undersigned does not believe that this "quid pro quo" is a good deal for applicants. On the contrary, the undersigned believes that the Office already issues final actions too freely, and that applicants should therefore have more, not less, latitude in making amendments after a second rejection. In particular, "applicant's amendment necessitated the new ground of rejection" as a justification for finality is probably one of the most unfair aspects of U.S. patent practice, because it is always available when an applicant makes a convincing showing of patentability but an Examiner does not want to allow an application. To the undersigned's knowledge, the United States already has the closest thing in the world to a one-response system, and the proposal would move us even closer to such a system. The number of first-action final rejections does not come close to the number of final rejections issued in second and subsequent actions even where applicants have made good faith efforts to advance prosecution, so that the adoption of 37 C.F.R. § 1.113(c) would not be sufficient "compensation" for a stricter 37 C.F.R. § 1.116(b). The argument that waiting to find out whether or not a response (reply?) will be entered before filing a continuation delays the ultimate issuance of a patent is not compelling. Pre-examination processing time for File Wrapper Continuation applications under the current Rules is no shorter than that for new applications; presumably the same will be true for Continued Prosecution Applications. The delay that will result from routinely having to wait for a new Filing Receipt to be issued, and all other pre-examination processing to be carried out, prior to being able to file a second response (reply?) in any application will undoubtedly be greater, in the aggregate, than it is now; now, at

least for some applications, a second response results in allowance and avoids the need for a continuation.

The undersigned urges the Office to rethink the requirement of proposed 37 C.F.R. § 1.121(a)(2)(ii) for a complete copy of all claims to be submitted with each amendment in which any claim is amended. In applications with many claims, this requirement will be particularly burdensome in terms of unnecessary "bulking up" of the physical file folder both in applicant's file and in the Office's file. If the aim is to have a complete set of claims for printing purposes, the Rules can be amended to require that such a set of claims be submitted after allowance. Moreover, if the requirement is adopted as proposed, the undersigned strongly urges that 37 C.F.R. § 1.121(a)(2)(iv) NOT be adopted; such a rule could result in loss of an applicant's rights based on a typographical or clerical error. A claim should not be cancelled absent an affirmative instruction by applicant to do so, and proposed 37 C.F.R. § 1.121(a)(i)(A) should be amended to so state.

With respect to claim amendments in reissue applications, the undersigned does not understand why any distinction should be made from original applications with regard to the requirement for submission of a full claim set with each amendment (proposed 37 C.F.R. § 1.121(b)(2)(iv)). Indeed, such a requirement would make more sense in a reissue application, where the reissue patent is printed with the amendments visible, and with the amended claims mixed in among the unamended claims, than it does in an original application (unless the suggestion, not formally proposed in this rulemaking, to utilize a reissue certificate instead of a printing a new reissue patent, is adopted).

With regard to the proposed amendment of 37 C.F.R. § 1.172 to require assignees to establish ownership, this amendment appears unnecessary insofar as the consent of assignee is an action by assignee, and 37 C.F.R. § 3.73(b) already requires assignee to establish ownership in order to take action in an application.

The foregoing comments represent the views of

the undersigned and not necessarily those of  
Fish & Neave.

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