

From leithd@zgi.com Mon Nov 25 08:49:44 1996
Date: Fri, 22 Nov 1996 16:22:31 -0800
From: leithd@zgi.com
To: regreform@uspto.gov
Subject: Comments on Proposed Rulemaking (37 CFR)

Attached please find comments.
[Part 2, "attachment; filename="ogcomm.n22"" Attached file "ogcomm.n22" 18KB]
[Unable to print this part]

1.4(d)(1) Why has the recitation of "patent or trademark interference" been omitted?

1.101 If removed, why is the content not included in the MPEP (as for 1.104)? Or is there now no order for examination according to filing date?

1.105 If removed, why is the content not included in the MPEP (as for 1.104)?

1.116 Under current practice, applicants may submit amendments after final that concern the merits of the application or that place claims in better form for consideration on appeal (beyond canceling claims or complying with form requirements). These actions could be taken without (or prior to) incurring the expense of refiling the application. Under the new proposed rule, applicant must pay to refile the application and submit amendments that go beyond cancellation or compliance with form. In conjunction with this revision to 1.116, first action final practice would be eliminated (1.113(c)).

The practical outcome of this proposed revision is that, after the first Office Action and first opportunity to amend and/or argue their case, applicants must pay a filing fee each time they want to submit an amendment that goes beyond cancellation or compliance with form. The resultant increased financial burden on applicants, and particularly on solo inventors and small enterprises, is significant.

The elimination of first action final practice provides that submitted amendments must be considered by the examiner as a matter of right by the applicants. However, the examiners may lack motivation to reach agreement on some or all of the claims after amendment, when they and the Office realize that every sustained rejection will require applicants to pay another filing fee to present additional arguments and amendments.

The proposed revisions will particularly affect applicants prosecuting in Group 1800. In that Group, the Office's substantive consideration of amendments is generally deficient, and the number of amendments that are usually required to obtain allowance of claims are numerous. In addition, applicants whose cases are examined in Group 1800 are also subject to extensive restriction practice and to recently enacted limitations on the numbers of sequences that the Office will examine in any one case. Thus, the fees payable by Group 1800 applicants will expand exponentially if the proposed revisions to Sections 1.116 and 1.113 are implemented.

It is difficult to see how the proposed changes to Section 1.116 will reduce the regulatory burden on the American public (and perhaps the PTO). In fact, the proposed changes appear to be directed more towards generating increased fees payable by applicants.

The revisions relating to deletion of verified statements of facts; to correction of inventorship; to pending oaths or declarations, petitions and papers could/ should be applied retroactively.