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Subject: 1996 Changes to Patent Practice and Procedure

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Box Comments-Patents
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Sir:

I have reviewed the changes to the rules of patent practice and procedure published in the Official Gazette of October 22, 1996 at 1191 OG 105-148. Because some of the changes are far reaching and drastically affect the way practitioners, both patent agent and attorneys, and patent examiners will conduct patent prosecutions, I wish to comment upon them.

Rule 1.14: Patent applications preserved in confidence

The rule proposes to change that "applications are preserved in secrecy" to "applications are preserved in confidence." This may be seen to be a lower level of security, and will allow for applications to be discovered by third parties without the inventor's or assignee's approval. What steps will be taken to ensure that the "confidentiality" of applications is maintained? What happens if a Patent Office employee breaches this confidentiality? The original word "secrecy" seems to be a better word and is capable of fewer misinterpretations.

Rule 1.28: Effect on fees of failure to establish status, or change status, as a small entity

Does the proposed change to Rule 1.28 regarding small entity require that a small entity statement be filed with each of the continuing applications?

Rule 1.41: Applicant for patent

Proposed Rule 1.41 appears to make quite lenient the naming of inventors in new applications by providing a series of alpha-numeric characters. This would of necessity require a correction of inventorship. How can the original named applicant make the required oath or declaration under rule 1.48, if there is no such person or persons? Will some

time period be required to supply the real names of inventors, and if so, will this affect the filing date, as the application will not have been filed originally in the name of the actual inventor or inventors? Further, this change to the rules may create problems when patents are litigated. Those trying to invalidate patents may allege a fraud on the Patent Office (PTO) simply because no inventors were named on the application. The attorneys should know who the inventors are prior to filing the application. If necessary, inventors can be deleted by amendment once claims have been allowed. This change should not be adopted.

Rule 1.47: Filing when an inventor refuses to sign or cannot be reached

The proposed change to Rule 1.47 appears to provide that in subsection (b) an assignee can make the proper declarations with respect to non-signing inventors only "whenever all the inventors refuse to sign." This is a change from the present practice wherein the assignee can make the proper declarations when "an inventor" refused to sign. Under the proposed rule, can an officer or employee of the assignee make the required declarations if only one of the co-inventor's refuses to sign? In many cases, the signing co-inventor may not be able to make the proper declaration because he may not have personal knowledge of the facts. Rather, it will be one to whom the co-inventors report, or someone else in the assignee company, who will have the knowledge to make the declarations. The assignee should not be precluded from being able to make the required declarations when only one of the co-inventors refuses to sign.

Rule 1.52: Language, paper, writing, margins

The changes proposed to Rule 1.52 eliminate the requirement that translations be verified, and now only require a statement that the "translation is accurate." First, does the PTO see any difference between "accurate" translations and "verified" translations, and second, who will make the statement that the translation is accurate? Certainly, the attorney probably will not be able to make the statement.

Rule 1.53: Application number, filing date, and completion of application

The change to Rule 1.53(b)(1) proposes to eliminate the requirement that the name of the actual inventors be supplied to receive a filing date. See some of the comments above with respect to Rule 1.41. Will some time period be required to supply the names of the actual inventors? If no inventor is named in this time period, will the original filing date be lost?

Rule 1.53(b)(3) [at 1191 OG 129] creates a new "continued prosecution application." Does this replace the file-wrapper-continuation (FWC) application? Proposed rule 1.53(b)(3) appears to make the filing date of the application the date on which a request for such an application is made, yet accords it the serial number of its parent application. How does this affect the term of the application? What will be its effective filing date for determining its 20 year term?

Rule 1.69: Foreign language oaths and declarations

The proposed changes to rule 1.69 change the requirement that the translation of a foreign language oath or declaration be verified, and replace it with the requirement that the translation be accompanied by a statement that the translation is accurate. Who will make the statement. As noted with 1.52, the attorney generally will not be able to make the statement that the translation is accurate.

Rule 1.84: Standards for drawings

The change to allow photographs in design applications is a welcome change. This recognizes that photographs can show the claimed design better than can any draftsman.

Rule 1.111: Reply by applicant or patent owner

It is proposed to add the phrase "The reply [to an office action] must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over the applied references." What is the reason for adding this? I already do this in my practice. As this is a newly added phrase, does it add new requirements to a reply? If not, what was the reasoning in making this requirement, which I already believe to be a requirement?

Rule 1.113: Final rejection or action

Except for the addition that a first office action will not be made final, the proposed changes to rule 1.113 are respectfully asserted to be misguided. The proposed change limits what can be done after a final office action to appealing the rejected claims, canceling the rejected claims, or conforming to the examiner's requirements. As long as a second office action can be a final office action, this effectively means that an applicant will only have one chance to amend. This change fails to consider that the issues in an application do not mature until the second office action is issued, and that many allowances occur in response to amendments after final. Further, again, as long

as second office actions are final, what will an applicant be allowed to do when an examiner performs a second search and cites new references "because the first amendment necessitated the new search" as is often done? Under this radical change, the examiner will be able to cite new references on a second office action, make that office action final, and the applicant will be denied a chance to respond. It is hard to believe the Patent Office would want to create a situation where an applicant is denied the opportunity to respond. This change to the rules will lead to a dramatic increase in the number of appeals filed, loading down the board with appeals that would not have been necessary, but for this amendment to the rules.

Apparently, under current PTO practice, patent examiners are given "counts" for each first office action and each allowance or abandonment. The examiner gets no "counts" for any other office actions. The proposed changes, however, will only be equitable, if it is the third or fourth office action that can be made final. It would appear that for the proposed rule change to be equitable, the Examiners will have to be given "counts" for actions other than first office actions and abandonments or allowances, and that no final office action can be issued until the third, or even fourth office action.

Rule 1.116: Amendments after final action

The comments with respect to Rule 1.113 are applicable to the proposed changes to Rule 1.116. Proposed rule 1.116(b) appears to be only an attempt to increase the fees generated by the PTO by requiring new applications for continuing prosecution applications. This will greatly increase costs to the individual inventor and the small company in obtaining patents. Again, unless the rule as to when final actions can be entered, this change to Rule 1.116, and the corresponding proposed change in Rule 1.113, will drastically affect the patent practice and drastically increase to cost of obtaining patents.

Rule 1.121: Manner of making amendments

The proposed manner of amending the specification (1.121(a)(iii)) is not entirely clear. Is a complete new page of the specification with the changes shown therein to be required? If this is an attempt to push us toward the PCT practice of supplying new pages, the rule should so state in clear terms. Supplying a new page of text, with the additions underlined and the deletions in brackets, as appears to be proposed by the rules, does not make the printing of patents any easier than it is now.

I applaud the requirement of including all the pending claims in each amendment. This will make it easier for both

the applicant and the examiner during prosecution by providing one place to view all the claims. However, proposed rule 1.121(a)(2)(iv) which provides that failure to submit a pending claim in an amendment will be "construed as a direction to cancel that claim" is seen as a draconian measure for what would otherwise be a clerical error. Such a rule would only make sense if the papers provided by the applicant were to become the printed patent, as is the case in Canada. Again, if the PTO wants to move in this direction, such a change would be welcome, but the change to printing patents as provided by the applicants (again, as is done in Canada) should be done in a single change, and not incrementally, as appears to be the case here.

Rule 1.136: Filing of timely replies with petition and fee for extension of time and extensions of time for cause

The proposed changes to extension of time require that a reply "must be filed prior to the expiration of the period of extension to avoid abandonment of the application." Under current practice, if we are requesting a one month extension, for example, we can file the petition and reply on the one month date, and the reply will be timely if mailed under rule 1.8 or 1.10. Does this proposed rule change that? If it does, it is believed to be in conflict with rules 1.8 and 1.10.

Rule 1.193: Examiner's answer and substitute brief

The proposed substitute brief which may be file by the applicant is a novel concept. Allowing the Examiner to reopen prosecution in response to the substitute brief is seen as a way of advancing the prosecution of the application. However, this action would not be needed if the restrictions on amendments after final in Rule 1.113 and 1.116 were not so severe.

Rule 1.530(d): Amendments in reexamination proceedings

The comments from 1.121 are equally applicable here. The need for subsection (d)(5) relating to the form of replies is not understood. Should the Patent Office be regulating such minutia as line spacing, page margins, and page numbering?

In conclusion, some of the changes, especially the changes regarding amendments after final and the naming of inventors are fraught with unforeseen problems. These changes should be rethought or simply canceled. Other changes, for example, the supplying of all the pending claims in each amendment, in its broadest sense is believed to be good changes and I believe will enhance the prosecution of patent applications. The Patent Office could provide rules which would further help prosecution, and in

particular, the printing of patents. If true substitute pages were required for pages of specification and claims, when amendments are made to these pages, as is done the PCT, the applicant's copy could be printed as the patent, again, as is done in Canada and other countries. This practice would substantially reduce the need for certificates of correction.

Respectfully submitted

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