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May 26, 2000

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Box Comments -- Patents
Commissioner for Patents
Washington, D.C. 20231

OFFICE OF PETITIONS
DEPUTY A/C PATENTS

**Re: Comments to Notice of Proposed Rulemaking Regarding Changes to
Implement Patent Term Adjustment Under Twenty-Year Patent Term**

Dear Commissioner:

In response to the notice of proposed rulemaking published in the Federal Register, Vol. 65, No. 63, the undersigned wish to make the following specific comments and request.

Proposed 37 CFR §1.704(c)(9) is, in part, onerous and unreasonable because it provides that not filing *formal drawings* at the time of filing a patent application constitutes a "failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application." Consequently, such a failure can affect patent term because any delays from such failures can be subtracted from any patent term adjustment due to PTO delays.

Proposed Rule 704(c)(9) is one of a number of specifically enumerated circumstances that are said to constitute an applicant's failure to engage in reasonable efforts to conclude processing or examination. As proposed, Rule 704(c)(9) in part states that such a failure exists when, at the time of application filing, an applicant does not file "drawings in compliance with section 1.84 (if applicable)." 37 CFR section 1.84 sets forth detailed drawing requirements. Therefore, it appears that proposed Rule 704(c)(9) requires that formal drawings be submitted at the time of filing application, or else patent term may be shortened.

The reality is that patent drawings are almost always formalized after filing the patent application. It is rare when an applicant has sufficient time, and there are no last-minute changes, such that the patent drawings can be formalized and sent together with the application at the time of filing. Typically, the patent application is written by a lawyer/agent in a law firm or corporate patent department who obtains the services of an outside draftsman to prepare the patent drawings. Changes to the drawings during drafting a finalizing the patent application are the rule rather than the exception, and are often made up to the last minute prior to filing application. Indeed, in many cases last minute changes are made by hand by the attorney because of the turnaround time associated with contacting the

draftsperson and having the change formalized. This same time constraint occurs even when the draftsperson is "in-house" because of the often rushed nature of filing patent applications. Even without last-minute changes, approval of the first draft of the drawings often occurs just before filing. In such a case, the lawyer would still have to communicate with the draftsperson to commission a formal set of drawings.

Moreover, informal drawings do not lengthen the examination process since such drawings are used for examination purposes. Also, when informal drawings are submitted after the application filing, they are approved/accepted after a routine review, again without lengthening the process. Thus, filing an application with informal drawings does not delay the processing or examination of the application. In fact, require informal drawings to be filed with the application, as in proposed rule 704(c)(9) could delay the application filing, to the substantial detriment of the applicant, without benefitting the process.

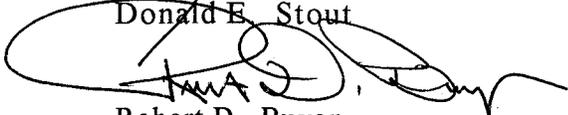
In addition, obtaining a formal set of drawings is more expensive than an initial, informal set. Requiring submission of the set of formal drawings at the time of filing of an application, when, as explained above, time is of the essence, can be a substantial disadvantage to small businesses and independent vendors. That is, the cost of a large set of drawings can run to the thousands of dollars, which may be difficult to raise on short notice. On the other hand, once the application is filed, independent inventors and other small entity applicants have a powerful asset to use for fund-raising. At that time, the cost of the drawings can be more easily borne.

We therefore ask that proposed Rule 704(c)(9) be amended to remove the requirement for formal drawings at the time of filing. We understand the need of the Patent Office to facilitate scanning and upcoming publication of properly formatted patent applications, but we believe that a reasonable time period after filing should be granted for submitting formal patent drawings. This will not affect the length of patent pendency, since there is typically a substantial delay between the date of filing and date of issuance of a first office action. We suggest a grace period of six (6) months after the time of filing to obtain and file formal drawings, after which patent term extension may be shortened.

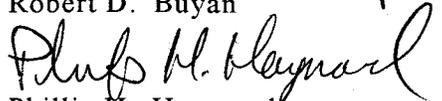
Sincerely,



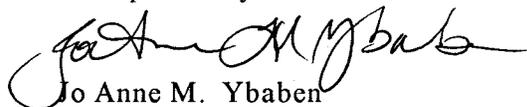
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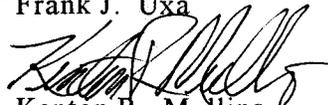
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