

January 5, 2004

VIA INTERNET: AB71.Comments@uspto.gov

Box Comments-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, V A 22313-1450

Re: Comments to Revision of Patent Term Extension
and Patent Term Adjustment Provisions Related to
Decisions by the Board of Patent Appeals and Interferences
Due: 5 January 2004
68 Federal Register 67818 (December 4,2003)

Dear Sir :

Please consider modifying the final version of proposed rules 701-02 to reflect the views in this letter. The point addressed in this letter has a citation to the page number and column number of the relevant text of the Federal Register.

The proposal to amend the rules to indicate that certain remands by the BP AI shall be considered "a decision in review reversing an adverse determination of patentability" for PT A and PTE purposes moves in the right direction. It is respectfully submitted, nevertheless, that a further step is appropriate.

Page 67819, Column 2

Specifically, the proposed rulemaking states: "If, however, the application is allowed as a result of further amendment, or after any other action by applicant (e.g., the filing of a paper containing argument, an affidavit or declaration, or an information disclosure statement), without being returned to the BP AI for further review, then such remand shall not be considered 'a decision in the review reversing an adverse determination of patentability' for patent term extension and patent term adjustment purposes." It is respectfully submitted that the examiner's rejection is effectively reversed if upon remand, the next Office action drops any issue raised on appeal. For example, assume the appeal brief addressed issues A, B, and C, and each issue was remanded to the examiner. If the next Office action drops issues A, B, and C, and raises new issue X, that action should be tantamount to a decision reversing the adverse patentability determination. A similar conclusion is possible if the next Office action were to have reversed, e.g., only issue A, and raised new issue x. In other words, to accumulate PT A or PTE it should be unnecessary to allow the

Commissioner for Patents

January 5, 2004

Page 2

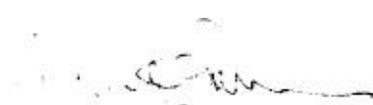
application without any intervening action by applicant, especially when the issues raised on appeal were effectively dropped by the examiner after a remand by the BPAI.

Furthermore, the rules should not diminish PTE or PT A because applicant files an information disclosure statement. Indeed, foreign prosecution typically takes longer than U.S. prosecution. For cases on appeal, it is not uncommon for a foreign patent office to issue an office action during the pendency of the appeal. In this scenario, it seems inappropriate for the PTO to penalize applicant in terms of PTE or PT A for complying with the duty to disclose. As a result, it would seem appropriate to allow provisions to exempt submissions with a Rule 97(e)(1) certification. As proposed, the Office's proposal would place an unfair result on U.S. attorneys who comply with the duty to disclosure.

A similar conclusion should be reached for applicants who are able to make a Rule 97(e)(2) certification. Indeed, there is no duty for people designated under Rule 56 to search the prior art. And if any of those people discover material information, applicant should not be considered to have delayed prosecution for complying with the duty of disclosure.

In view of these comments, please consider modifying the final version of these rules.

Respectfully submitted,



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