

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:

RIN 0651-AB71
[Docket No.: 2003-P-029]

For: **Notice of Proposed Rulemaking:
Revision of Patent Term Extension
and Patent Term Adjustment
Provisions Related to Decisions by
the Board of Patent Appeals and
Interferences**

**68 Fed. Reg. 67818
(December 4, 2003)**

***Comments In Reply To the Notice of Proposed Rulemaking Entitled
"Revision of Patent Term Extension and Patent Term Adjustment
Provisions Related to Decisions by the Board of Patent Appeals and
Interferences"***

Mail Stop Comments - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Notice of Proposed Rulemaking published December 4, 2003, at 68 Fed. Reg. 67818, the PTO Practice Committee at Sterne, Kessler, Goldstein & Fox P.L.L.C. submits the following comments.

Introduction

The United States Patent and Trademark Office (the Office) is proposing to amend the rules of practice in patent cases to indicate that certain remands by the Board of Patent Appeals and Interferences (BPAI) shall be considered decisions "in the review reversing an adverse determination of patentability" for patent term extension (PTE; 37 C.F.R. § 1.701) and patent term adjustment (PTA; 37 C.F.R. § 1.702) purposes. Specifically, if an application is remanded by a panel of the BPAI, and a notice of allowance under 37 C.F.R. § 1.311 is mailed without further review by the BPAI, without further amendment of the

application, and without other action by the applicant, the remand shall (if the proposed change is adopted) be considered a decision reversing an adverse determination of patentability for PTE and PTA purposes.

The Office states that "[s]uch a BPAI panel remand generally results in the examiner *sua sponte* deciding to withdraw the rejections and allow the application without any intervening action by the applicant." However, if the application is allowed as a result of a further amendment, or after any other action by the applicant, without being returned to the BPAI for further review, then such remand shall not be considered "a decision in the review reversing an adverse determination of patentability" for PTE and PTA purposes.

We fully support the Office's decision to consider a remand that results in an allowance to be considered a decision reversing an adverse determination of patentability for PTE and PTA purposes. However, to require that there be no further amendment or other action by the applicant does not seem to best serve the public interest. We ask for reconsideration of the requirement that the application must be allowed without further amendment, and without any other action by the applicant.

As discussed below, certain amendments or actions by applicant should be permitted, after remand from the BPAI, in an application that would otherwise be in condition for allowance, without detracting from any PTE or PTA that would be available under the proposed rules. The public would benefit from such a mechanism because such patents would issue with fewer errors. The benefit that would be obtained by providing the applicant with an opportunity to take certain miscellaneous actions prior to the mailing of a notice of allowance outweighs the pendency reduction benefit that results from applicant taking no action so as to not detract PTE or PTA.

Specific Comments

1. The proposed changes appear unduly narrow in view of the Office's interpretation of 37 C.F.R. § 1.701(a)(3). According to the current Notice of Proposed Rule Making, "the change being proposed in this notice addresses the situation in which an examiner responds to a remand by the BPAI panel by *sua sponte* withdrawing **all** the rejections and allowing the application...." (See Notice at page 67819, bottom of the first column). (Emphasis added). However, when rule 1.701 was originally finalized, the Office stated, "extension of patent term under § 1.701(a)(3) is applicable if all the rejections of **any one claim** are ultimately reversed." (See the Office's response to comment 137, 60 FR 20195, at 20219 (1995), 1174 OG 15, at 34). (Emphasis added).

The proposed revisions should allow for PTE/PTA, if, after remand, the examiner *sua sponte* withdraws all of the rejections and/or objections against any one claim. Subsequent actions or amendments by the applicant that do not address the merits of the allowed claims should not detract from the PTE/PTA time that was earned while the application was on appeal.

2. The proposed rule should be consistent with 37 C.F.R. § 1.704(d). IDS' that are certified under 37 C.F.R. § 1.704(d) are not considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under rule 704 paragraphs (c)(6), (c)(8), (c)(9) or (c)(10). The filing of a Rule 704(d) IDS after remand of the application from the BPAI should also not detract from PTE/PTA under this proposed amendments if the application is otherwise found to be allowable, after consideration of the art cited in the IDS.
3. Amendments made under 37 C.F.R. 1.312 will detract from PTA. Therefore, there needs to be a way to make administrative amendments that do not detract from PTE/PTA after remand of an application from the BPAI, but before allowance by the examiner. This is especially true for applications that have been on appeal because proposed new § 41.33(a) and (b) would prohibit an applicant from submitting amendments after the date a proceeding has been appealed, except for amendments canceling claims or rewriting dependent claims into independent form, and as permitted by §§ 43.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1). If these appeal rules are finalized, an applicant would not be able to submit administrative amendments during the time of appeal. As an application may be on appeal for years, it seems unduly harsh to prohibit an applicant from making even a minor change to the application if it is remanded and is otherwise ready for allowance.

Applicant should not otherwise lose PTE/PTA because administrative amendments that do not address the merits of a claim are made to the text of an application after remand but prior to the mailing of a notice of allowance. An example of such an amendment is an amendment that updates the address of a depository, for example, the address of the American Type Culture Collection (ATCC). The ATCC recently moved. Applications that have been on appeal at the BPAI for several years may still contain the old ATCC address. It is in the best interests of the public that patents that issue from those applications do so with the new address of the ATCC. However, such amendments are discouraged under the proposed rule because the amendment would detract from the PTE/PTA to which the application is otherwise entitled.

There are other types of administrative amendments that should be permitted actions under the new rules. Such amendments include changes to the title or abstract to correspond to the allowed claims, correction of a sequence ID number or the insertion of a sequence ID number after a sequence in the claim, correction of typographical errors, inconsistent case of pronouns, and inconsistencies between reference characters used in the specification and those used in the drawings.

4. Any Office or examiner requested submission or amendment should be permitted without a negative effect on the PTE/PTA, especially if such action is the resubmission of documents that have been lost or misplaced by the Office

(for example, the paper copy of a sequence listing). The applicant should not be penalized by loss of PTE/PTA because the Office has lost previously submitted papers and this loss is first brought to applicant's attention after remand from the BPAI in an application that is otherwise in condition for allowance.

5. Any examiner amendment should be permitted under the proposed rules, especially if such amendment does not reach the merits of the claims. Further, the examiner should have the option of requesting that the applicant prepare and submit a formal pleading that embodies the examiner-requested amendment. Such an examiner-requested amendment or submission should not detract from PTE/PTA under the proposed rule.
6. The new rule should also apply if the application would otherwise have been allowed, and the examiner withdraws the original objections and/or rejections, however, the examiner raises new questions or new rejections that were not before the BPAI.

For example, a new U.S. patent that the examiner may desire to cite in an office action may have issued during the time the applicant's application was at the BPAI. If the examiner withdraws all the original objections/rejections, and mails a new office action that raises new rejections against the claims, the original remand should still be considered a decision by the BPAI that reverses an adverse determination of patentability as that phrase is used in 35 U.S.C. § 154(b)(a)(C)(iii) since, except for the new art or new rejections, the application was otherwise allowable at the time the examiner withdrew the original rejections.

Conclusion

Consideration of the above comments is respectfully requested.

Respectfully submitted,
Sterne, Kessler, Goldstein & Fox P.L.L.C.

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