

COMMENTS OF ABA IP SECTION TO
CHANGES TO APPLICATION EXAMINATION
AND PROVISIONAL APPLICATION PRACTICE

1. RECOMMENDATION: The proposed change to Section 1.7 to extend the pendency of a provisional application to the next secular or business day following the twelve month date of a provisional application should be adopted.

COMMENT: This proposed change is fair and helpful to applicants; and it comports with 35 U.S.C. ' 119, the Paris Convention, as well as other treaties.

2. RECOMMENDATION: Proposed Section 1.53(c)(3), which provides for the conversion of a provisional application to a non-provisional application, should be amended to also provide that:

Where the provisional application does not contain a claim, and one was not filed with the request, the Office will notify the applicant and set a time for submitting a claim for examination.

COMMENT: The Office currently accords applicants an opportunity to complete filing requirements, other than the addition of new disclosure, where an application is deficient as to translation, fee, declaration, etc. In keeping with this policy, and to avoid unintentional abandonment of an application, an applicant should be advised of any claim deficiency and given the opportunity to rectify the matter.

3. RECOMMENDATION: Proposed new Section 1.53(c)(3) should contain a sentence which advises the reader that:

Conversion of an application under this paragraph results in a forfeiture of rights under 35 U.S.C. ' 119; and the term of any patent which issues from the application will be measured from the initial filing date of the provisional application.

COMMENT: Although the proposed sentence does not specify a requirement and is merely advisory, it should be included in the rule because of the seriousness of term reduction that results from conversion under this section.

4. RECOMMENDATION: Proposed revised Section 1.97(b) should include the following subparagraph (5):

(5) Within three months after the date of filing of a request for continued examination under Sec. 114.

COMMENT: An information disclosure statement filed within three months after the filing of a new or continuation application will be considered even though an official action may have issued in the

meantime. Since a continued examination request requires a fee corresponding to that of a new or a continuation application, the applicant should have the right to have newly submitted information considered up to three months after the filing of the request. The policy of the Office should be to accord applicants the maximum opportunity to bring possibly material information to the attention of the examiner.

5. RECOMMENDATION: Proposed new Section 1.114 should be amended to provide that;

Where an applicant timely files a request and fee set forth in Section 1.17(e), the Office will withdraw the finality of any Office action. If the request and fee are not accompanied by a submission, the Office will notify the applicant of the deficiency and set a period within which the deficiency must be rectified.

COMMENT: The fee provided by Section 1.17(e) is equal to the fee for filing a new application. In return for that fee, an applicant should be accorded the same benefits as if he were filing a new application. Further, under the twenty year term provisions, it is the applicant who bears the consequences of any delays in filing the necessary submission; and there is no harm to the public in according an applicant this benefit.

The PTO reduction in fees for continued examination (requiring only the basic filing fee, rather than the current recalculation for a CPA of a total filing fee based on the number of claims still pending) is favored.

6. RECOMMENDATION: Former subparagraph (b) of Section 1.116, which provides that amendments may be entered after a final rejection upon a showing of good and sufficient reason why they are necessary and were not earlier presented, should be retained in the revised Section 1.116.

COMMENT: Because of the high cost to an applicant of filing a request for continued examination, the applicant should at least have the opportunity to show why proposed amendments are necessary and were not earlier presented. The addition of an alternate procedure, namely a request for continued examination at the same fee as a continuation application, does not justify denying an applicant to make a showing under former subparagraph (b). This is particularly true when the amendments will correct errors or inconsistencies in the claims, or clarify the meanings of the claims. The PTO is urged to state in the Comments that the continued examination practice is not intended to change the standards under which it is determined that amendments after final are properly entered. Amendments of this type will not raise new issues nor will they require a further search or examination.

7. RECOMMENDATION: The proposed change to 1.78 to eliminate the requirement that a non-provisional be co-pending with a provisional application should be adopted.

COMMENT: This will permit applicants to claim priority rights from provisional applications which are abandoned prior to the expiration of the 12 month period.

8. RECOMMENDATION: Proposed new section 1.53(d) (1) should be amended to permit filing of a divisional (or to pursue claims covering a separate and distinct invention by continued examination.

COMMENT: Present rules allow for the filing of a divisional application as a CPA. Under the proposed rules (according to the comments at page 14867-68), it is not possible to file a divisional except as a rule 53(b) case. In the past, the ability to change claims in a previously filed application was extremely useful, both for applicants and Examiners. For example, in a situation where a restriction was made between the composition and method claims, most clients would elect the composition claims for prosecution. If suitable patent protection was not available for the composition claims due to prior art, then a CPA divisional could simply be filed to substitute the method claims for the composition claims. As this procedure is to be eliminated, the filing party will have to make a copy of the parent case, prepare a new IDS, file copies of the formal drawings, etc, whereas all this was taken care of in the previous application when a CPA was filed. A simple rule change should be made to allow continued examination submissions to include prosecution of claims normally covered in a divisional application, i.e., drawn to a separate and distinct invention.