

The New PTO Patent Rules Published 6/30/2003

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- Richard A. Neifeld, Ph.D. Patent Attorney
- Neifeld IP Law, PC - www.Neifeld.com
- Rneifeld@Neifeld.com

OUTLINE

- I. Introduction - Basis for the Rule Changes
- II. Rule by Rule Review of Rules Changed 6/30/2003 (Primarily rules 1.14 (access); 1.52 (applications); and 1.121 (amendments))
- Amendment Practice Tips
- Exemplary USPTO amendment with my comments

Introduction

- One of the USPTO's business goals is to implement an all electronic office. That requires scanning of all paper documents to "image paper." This business goal drives the USPTO's desire to regularize and revise amendment format.

Introduction

- Pursuant to the AIPA, the USPTO is required to publish applications, often prior to when they are examined, but before an examiner reviews the priority claim information for accuracy. Early publication drives the PTO's desire to scan, capture, and electronically check priority claim information.

Introduction

- 68 FR 38611 – 38630 specify amendment format rule changes and related rule changes.
- Changes effective on 7/30/2003
- USPTO indicates rules will be strictly enforced.
- Summary of each rule change follows

Rule by Rule Review - 1.3

- 1.3 – Decorum and Courtesy
- Complaints against USPTO employees must be made in a paper separate from “other correspondence.”
- What this means is a complaint must not be filed in a paper for entry in a patent or trademark application.

Rule by Rule Review – 1.3

- 1.3 – Decorum and Courtesy
- Problem – 1.3 defines no standard when a paper is a “complaint” as opposed to a bona fide response.
- Example; Examiner gives a declaration of fact in support of claim rejections. E.g., knowledge of a web site and web site’s date of existence. Applicant’s response attacks examiner’s credibility, citing contradictory statements by examiner in related applications. Is the attack on credibility, which is clearly admissible under FRE 607-609, admissible. Note due process issue.

Rule by Rule Review - 1.14

- 1.14 – Patent Applications Preserved in Confidence
- Pursuant to 35 USC 122, the USPTO keeps patent applications confidential, subject to many exceptions. Rule 1.4 defines these exceptions.
- Biggest exception – publication
- Specific exceptions, by rule subsection, noted below.

Rule by Rule Review - 1.14

- 1.14 – Patent Applications Preserved in Confidence
- 1.14(a) – U.S. Application information
- 1.14(b) – Electronic access to information
- 1.14(c) – Power to inspect a pending or abandoned application
- 1.14(e) – Decisions by the Director or BPAI
- 1.14(f) – 1.47 notice to inventors that do not sign.
- 1.14(g) - PCT application information
- 1.14(h) – Special circumstances or Act of Congress

Rule by Rule Review

- 1.14(a)(1) – When the USPTO will make applications and file contents available
- 1.14(a)(2) - When the USPTO will make status information available

Rule by Rule Review - 1.14

- 1.14(a)(1)(i)-(iii) – Patented application, Abandoned published application, or Pending published application (as redacted)
- The USPTO will provide the file for a patented application, abandoned published application, or pending published application (as redacted) upon request and payment of 1.19(b) fee (\$200 plus \$40 per 100 pages after the first 200)

Rule by Rule Review - 1.14

- 1.14(a)(1)(iv)– Unpublished abandoned application (including a provisional application)
- The USPTO will provide the file contents for an unpublished abandoned application if the application is specifically identified in the specification or priority to the application is claimed in a published US or PCT patent document and the 1.19(b) fee paid.

Rule by Rule Review - 1.14

- NOTE:
- 1.14(a)(1)(iv) changes prior practice of making file for an unpublished abandoned application available if the abandoned file's application number was cited in *any* paper in a publicly available U.S. patent document file.

Rule by Rule Review - 1.14

- 1.14(a)(1)(v) Unpublished pending application
- The USPTO will provide a copy of the file contents of an unpublished pending application if benefit to the application is claimed in a U.S. or PCT published patent document upon request and payment of the 1.19(b) fee.

Rule by Rule Review - 1.14

- 1.14(a)(1)(vi) Unpublished pending application
- The USPTO will provide a copy of the *application as originally filed* of an unpublished pending application if the application is identified in a U.S. or PCT published patent document upon request and payment of the 1.19(b) fee.

Rule by Rule Review - 1.14

- 1.14(a)(1)(vii) – Files or file contents otherwise not available to the public
- The USPTO will provide a copy of the *application as originally filed* of an unpublished pending application if the application is identified in a U.S. or PCT published patent document upon request and payment of the 1.19(b) fee.

Rule by Rule Review - 1.14

- 1.14(a)(2) - Status information
- The USPTO will make status information available to a member of the public apparently for all applications.

Rule by Rule Review - 1.14

- 1.14(a)(2)(i)-(iv) - Status information
- Status information includes: pending, issued, abandoned, published, series code and serial number, serial number and any one of U.S. filing date, PCT filing date, and national stage entry date, priority claims to the application in another application, the priority claim type in the other application, and status information of the other application.

Rule by Rule Review - 1.14

- 1.14(b) - The USPTO may at its discretion provide only electronic access

Rule by Rule Review - 1.14

- 1.14(c) – USPTO may at its discretion provide access to an application to anyone having a power to inspect signed by:
 - an applicant
 - an attorney of record
 - attorney that signed the application filing papers if no inventor declaration was filed
 - a 3.71 authorized official of the assignee (e.g., official that filed a statement with a 3.73(b) certification)

Rule by Rule Review - 1.14

- 1.14(e) – USPTO may at its discretion publish decisions of the Director or the Board.
- Director must believe the decision has precedential value
- Applicant or party will be given notice and an opportunity to object on trade secret or confidential information grounds.
- Note: Court review available, so party/applicant could effectively prevent disclosure

Rule by Rule Review - 1.14

- 1.14(g) – PCT applications
- 1.14(g)(1) - The USPTO will provide copies of files of a PCT application if the application is published, designates the U.S, and the requestor pays the 1.19(b) fee, under the following conditions.

Rule by Rule Review - 1.14

- 1.14(g)(1) – PCT applications
- Home Copy: The USPTO was the receiving office
- Search Copy: The USPTO was the ISA and issued the ISR
- Exam Copy: The USPTO was the IPEA, the IPER (soon to be IPRP) has issued, and the U.S. was elected.

Rule by Rule Review - 1.14

- 1.14(g)(2) – English language translations
- The USPTO will provide a copy of the English language translation of a publication of a PCT application upon proof of publication and that the U.S. was designated, and payment of the 1.19(b)(4) fee. (\$25.00)
- NOTE: *There is no requirement that the U.S. national stage or U.S. bypass application be published. This is superior to obtaining a machine translation, and at virtually no cost.*

Rule by Rule Review - 1.14

- 1.14(g)(3)-(5) – Miscellaneous
- The USPTO will not provide access or copies of a PCT application prior to publication
- The USPTO will not provide access or copies of a Exam Copy until after the IPER (IPRP) is established.
- (Note 1.14(g)(5) refers to (h)(3) which should be a reference to “(g)(3)” – PTO rule error)

Rule by Rule Review - 1.52

- 1.52 – Language, paper, writings, margins, compact disc specifications
- 1.52(a)(1) – 8 and ½ by 11 inch or A4
- Paper sheets of a single document must all be the same size (to facilitate scanning; separate papers filed concurrently can be different sizes)
- Papers must not be permanently bound together. (Staples generally OK.)
- 1.52(a)(2) - Papers should NOT be hole punched!

Rule by Rule Review - 1.52

- 1.52(a)(3) – Exceptions to requirements
- Office provided forms
- reissue application specification
- 1.52(a)(6) – e-filed documents must comply with EFS requirements as to form and transmission.
- 1.52(a)(5/7) - Non-complying filings will be subject to a time limit requirement to comply *to avoid abandonment/termination*

Rule by Rule Review - 1.52

- 1.52(b) – Applications, Reexaminations, and *Amendments*
- 1.52(b)(1) – Application, amendment, and translations (except foreign language inventor declarations):
 - 1.52(b)(1)(i) - Must comply with 1.52(a) formal requirements
 - 1.52(b)(1)(ii) Must be in English or accompanied by an English translation, and a certification as to the accuracy of the translation

Rule by Rule Review - 1.52

- 1.52(b)(2) – Text requirements for 35 USC 111(a) application specification and 111(a) and reissue application amendments
- 1.52(b)(2)(i) – 1 and ½ line spacing
- 1.52(b)(2)(ii) – Type font at least .21 cm high
- 1.52(b)(2)(iii) – Only single column of text

Rule by Rule Review - 1.52

- 1.52(b)(3-4) – Claims and abstract must each start on separate pages
- 1.52(b)(5) –
- Pages must be numbered consecutively starting with “1”
- Page numbering must be located centrally above or below, preferably below, text

Rule by Rule Review - 1.52

- 1.52(b)(6) – Paragraphs of specification, except in a reissue or reexamination, *may* be numbered at the time of filing in the format **[0001]** as the first text in each paragraph.
- 1.52(b)(7) – Non-compliance with 1.52(b)(1)-(5) results in a time limit requirement to comply to avoid *abandonment/termination*.

Rule by Rule Review - 1.59

1.59 – Expunged of information or copy of papers in application file

The USPTO will no longer return to the applicant a paper expunged from the applicant's patent application file

Rule by Rule Review - 1.71/272

- 1.71(f) – Detailed description and specification of invention – The specification must commence on a separate sheet of paper from all other parts of the application.
- 1.72 – Title and abstract – The abstract must commence on a separate sheet of paper from all other parts of the application, follow the claims section, and be limited to 150 words

Rule by Rule Review – 1.75/98

- 1.75 Claims – The claims must commence on a separate sheet of paper from all other parts of the application.
- 1.98(e) – IDSs filed via EFS do not need to include copies of U.S. patent documents (limited to 50 USPs and 50 PGPs per IDS)
- 1.99 – Third party submissions – The USPTO will not enter non-compliant submissions. 1.99 is amended to clarify that no comment on any submitted information is permitted.

Rule by Rule Review – 1.121

- 1.121 – Manner of making amendments in applications
- 1.121(a) – Amendments in non-reissue applications are made by filing a paper complying with 1.52's formal requirements and specifying amendments for the USPTO to make.
- 1.121(b-k) – Various rules for amendments by application type and application section.

Rule by Rule Review – 1.121

- Note that 1.121 applicable to ALL amendments, including preliminary amendments.
- consequence: *Prelims can no longer be included in new application transmittal letters.*

Rule by Rule Review – 1.121

- 1.121(b) – Amendments to the specification
- The specification can be amended as follows:
 - Add, replace, or delete a paragraph
 - Replace a “section”
 - Substitute a specification

Rule by Rule Review – 1.121

- 1.121(b)(i) – *Replacement Paragraphs*
- Instruction unambiguously identifying the location of a replacement paragraph
- Text of replacement paragraph
 - * Underline text to add
 - * Strike-through or double bracket 5 or fewer characters of text to delete
 - * Use subparagraph numbering, e.g. 75.1 between 75 and 76, for added paragraphs in paragraph numbered specifications

Rule by Rule Review – 1.121

- 1.121(b)(i) - *Deleted Paragraphs*
- Instruction unambiguously identifying the location of a paragraph to delete
- The instruction may include a few words from beginning and end of paragraph, if needed to identify
- Do NOT include text of deleted paragraph; do not include deleted paragraph with strike-through or with brackets

Rule by Rule Review – 1.121

- 1.121(b)(2) – *Replacement Sections*
- Refer to section heading, unambiguously identify the location of the section
- Instruct to delete and replace
- Provide a replacement section showing changes relative to previous version (underline new text; strike-through or optionally double bracket less than 5 characters to be deleted)

Rule by Rule Review – 1.121

- 1.121(b)(3) – *Substitute Specification*
- An instruction to replace the specification
- A substitute specification complying with 1.125(b-c)
- 1.125(b-c) requires:
 - Statement that no new matter is added
 - Marked up version showing all changes using strike-through/underline procedure
 - *Numbering of the paragraphs of the specification*, other than the claims, using Arabic numerals

Rule by Rule Review – 1.121

- 1.121(c) – Claims
- i - Rewrite entire claim, except when claims is being canceled
- ii - Include a complete list of all claims ever presented and text of all pending claims, including withdrawn claims
- iii - *Complete list of claims replaces prior listing of claims in the USPTO's official file*

Rule by Rule Review – 1.121

- 1.121(c) – Claims
- iv - Each claim number *must* be followed in parenthesis by one of *only the following 7* status indicators: Original, Currently amended, Canceled, Withdrawn, Previously presented, New, Not entered
- v – Present claims in ascending numerical order
- vi - Optionally aggregate consecutively numbered claims with “canceled” or “Not entered” status

Rule by Rule Review – 1.121

- 1.121(c) – Claims
- iiv – “withdrawn” claims may be amended, and listed with status “withdrawn-currently amended”
- *1.121(c)(4)(i) - Do not present text of claims with status “canceled” and “Not entered”*
- *1.121(c)(4)(i) – Claim canceled either by sentence instruction to cancel, or by parenthetical status indicator “canceled”*
- **NOTE** – *Carefully check accuracy of claim status indicators*

Rule by Rule Review – 1.121

- 1.121(d) – Amendments to Drawings
- Replacement sheet must comply with 1.84
- 1.84 specifies:
 - Identifying indicia, if any, in top margin
 - Consecutively numbered sheets
 - A4 or 8 and ½ by 11 inch
 - Generally, 1 inch margins
 - Characters at least 1/8 inch high

Rule by Rule Review – 1.121

- 1.121(d) – Amendments to Drawings
- Replacement sheet must be labeled in the “Replacement Sheet”
- Replacement sheet must include all figures on the sheet it replaces, not just figure or figures being amended
- Amendments to drawings must be explained in detail in remarks
- 1.121(d)(1-2) Marked up copy of drawing showing changes optional, unless required by the examiner

Rule by Rule Review – 1.121

- 1.121(g) – Examiner Amendments
- Examiner’s can make amendments in any manner internally acceptable to the USPTO
- 1.121(h) – Amendment sections
- Each section of an amendment document must begin on a separate sheet
- 1.121(i-j) – Amendments in reissue applications and reexamination proceedings must comply with 1.172 and 1.530 respectively, not 1.121.
- 1.121(k) – Amendments in provisional applications must comply with 1.121.

Rule by Rule Review – 1.125

- 1.125(c) – Substitute Specification
- A substitute specification will be entered if submitted prior to payment of the issue fee, includes a statement that no new matter is added, and include the marked up version using the strikethrough/underline procedure

Amendment Practice Tips

- Notes on marked up version generation
- Word or WordPerfect tool will generate
- Practice point – delete and replace entire words or preferable sentences so that marked up version generator does not contain underline and strikethrough in immediately adjacent text

Amendment Practice Tips

- Practice point – Extremely important to control e-documents to ensure reliability of filed version
- Practice point – If relying upon PGP or USP text from the web, use Notepad to strip out formatting in order to generate a clean text compare
- Do not include a separate letter to the Draftsman when filing a drawing amendment

Amendment Practice Tips

- PCT 371 filing amendments pick up with international processing leaves off
- PCT treaty limits formal requirements
- 1.121 does NOT apply to amendments made in the international stage (Art. 19 or 34 amendments)
- Note, however, similarity of new USPTO amendment rules and PCT format

Amendment Practice Tips

- USPTO posted an exemplary amendment to guide practitioners
- Note bold handwritten comments on images of pages of that amendment that appear in the following slides

The PTO's Exemplary Amendment with My Comments USPTO Sample Am.

SAMPLE FORMAT FOR REVISED AMENDMENT PRACTICE (Rev. 6/03)

| | | | | |
|--------------|---|-------------------|------------------|------|
| Appl. No. | : | XX/YYY,YYY | Confirmation No. | WXYZ |
| Applicant | : | James Q. Inventor | | |
| Filed | : | April 19, 2003 | | |
| TC/A.U. | : | 1744 | | |
| Examiner | : | John Doe | | |
| | | | | |
| Docket No. | : | 12345/JAS/R758 | | |
| Customer No. | : | 88888 | | |

↖ Heading
Summary
of Amendment
↙

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

AMENDMENT

Sir:
In response to the Office action of October 16, 2003, please amend the above-identified application as follows:

- Amendments to the Specification** begin on page 2 of this paper.
- Amendments to the Claims** are reflected in the listing of claims which begins on page 3 of this paper.
- Amendments to the Drawings** begin on page 4 of this paper and include both an attached replacement sheet and an annotated sheet showing changes.
- Remarks/Arguments** begin on page 5 of this paper.
- An **Appendix** including amended drawing figures is attached following page 5 of this paper.

↙ Page
number
centered

Appl. No. XX/YYYY,YYY
Amdt. dated Jan. 15, 2004
Reply to Office action of Oct. 16, 2003

Seperate Page
↓

Amendments to the Specification:

Please replace paragraph [0021] with the following amended paragraph:

[0021] In the construction of the bucket of this invention, various materials have been selected [[and]] which offer a number of diverse properties [[,]] and allow for varied functions of the article. For caustic solutions, the bucket can be made of a durable polymer plastic material. Where an aesthetic appeal is desired, the bucket can be any [[of]] one of many attractive colors. The following ~~listing~~ list of properties serves to define possible uses for the buckets.

Please replace paragraph [0045] with the following amended paragraph:

[0045] Figure 1 displays a bucket of the invention. As can be seen from the drawing, ~~the a~~ handle is attached to the upper lip of the structure and connected at points diametrically opposite each other on the circumference.

Please add the following new paragraph after paragraph [0075]:

[0075.1] An optional feature of the articles of the invention is the addition of a tetrafluoroethylene coating to the bucket to provide protection from any contents which might be caustic. The coating can be provided to the surface during the manufacturing process or can be added in a later step.

Please delete the paragraph beginning at page 2, line 4, which starts with "Under normal circumstances"

Appl. No. XX/YYYY,YYY
Amdt. dated Jan. 15, 2004
Reply to Office action of Oct. 16, 2003

Examples of
claim status
Parentheticals

Amendments to the Claims:

This listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims:

Claims 1-5 (canceled)

Claim 6 (previously presented): A bucket with a handle.

Claim 7 (withdrawn): A handle comprising an elongated wire.

Claim 8 (withdrawn): The handle of claim 7 further comprising a plastic grip.

Claim 9 (currently amended): A bucket with a ~~green~~ blue handle.

Claim 10 (original): The bucket of claim 9 wherein the handle is made of wood.

Claim 11 (canceled)

Claim 12 (not entered)

Claim 13 (new): A bucket with plastic sides and bottom.

Appl. No. XX/YYYY,YYY
Amdt. dated Jan. 15, 2004
Reply to Office action of Oct. 16, 2003

Amendments to the Drawings:

The attached sheet of drawings includes changes to Fig. 2. This sheet, which includes Fig. 1-2, replaces the original sheet including Fig. 1-2. In Figure 2, previously omitted element 13 has been added.

Description
of Drawing Am

Should list which
sheet is replaced

Attachment: Replacement Sheet
Annotated Sheet Showing Changes

(Should state that changes
are shown in some form,
e.g., by hand writing in
red ink)

The PTO's Exemplary Amendment with My Comments

Appl. No. XX/YYY,YYY
Amdt. dated Jan. 15, 2004
Reply to Office action of Oct. 16, 2003

Status
remarks

REMARKS/ARGUMENTS

In the specification, the paragraphs [0021] and [0045] have been amended to correct minor editorial problems. The new paragraph [0075.1] added after paragraph [0075] discusses in general terms the features taken from Example 4.

In amended Figure 2, the previously omitted element numeral 13 has been added.

Claims 6-10 and 12-13 remain in this application. Claims 1-5 and 11 have been canceled. Claims 7 and 8 have been withdrawn.

The examiner has acknowledged that claims 6 and 9-10 are directed to allowable subject matter. Claim 7-8 have been withdrawn as the result of an earlier restriction requirement. Claim 13 adds an additional feature from Example 2 in the specification.

In view of the examiner's earlier restriction requirement, applicant retains the right to present claims 7-8 in a divisional application

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Reasoning and substance follow

Respectfully submitted,
SMITH, JONES & BROWN

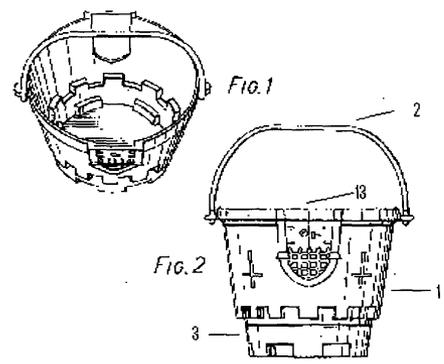
By _____
Martin J. Gallagher
Reg. No. 99,999
Tel.: (101) 555-2345

Affiliation

Attachments

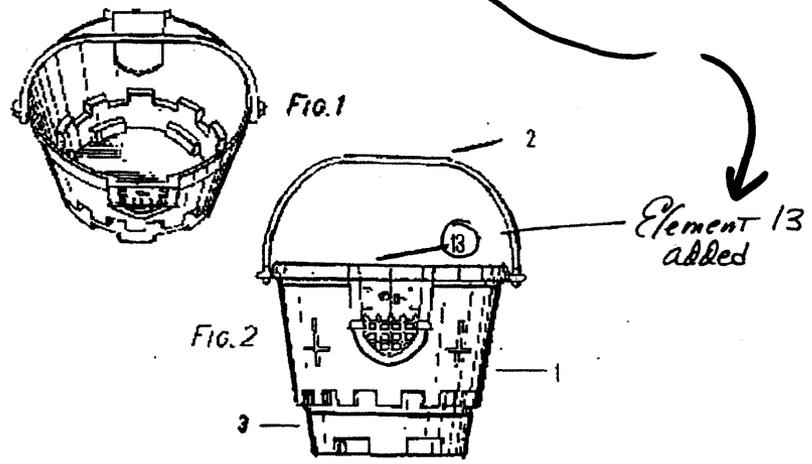
Attachments should be expressly identified

Appl.No. XX/YYYY,YYY
Amdt. Dated Jan. 15, 2004
Reply to Office action of Oct. 16, 2003
Replacement Sheet



Appl.No. XX/YYYY,YYY
Amdt. Dated Jan. 15, 2004
Reply to Office action of Oct. 16, 2003
Annotated Sheet Showing Changes

Markup



The New PTO Patent Rules Published 6/30/2003

THANK YOU
THE END

- Richard A. Neifeld, Ph.D. Patent Attorney
- Neifeld IP Law, PC - www.Neifeld.com
- Rneifeld@Neifeld.com