

The Most Important Aspects of the New Patent Rules Supporting the USPTO's 21st Century Strategic Plan that come into Effective in November 2004, by Richard Neifeld, Ph.D., Patent Attorney

## **I. Introduction**

The USPTO has a long range plan, its 21st Century Strategic Plan intended to transform the USPTO into a responsive efficient organization. As part of that plan, the USPTO published a set of final rules changes to the rules of patent practice in 37 CFR. The following lists the three most generally applicable and important changes for U.S. patent practitioners. Much the material below is taken directly from a power point presentation published by the USPTO on these rules changes.

## **II. Most Generally Applicable and Significant Rules Changes**

### **1. The Ability to Type Sign Certain Papers, With What the USPTO Calls "S" Signatures**

S-signatures (§ 1.4(d)(2)):

Example for signing applicant:

/James Jones/  
James T. Jones

An S-Signature is any signature between forward slashes that is not a handwritten (§§ 1.4(d)(1) or (e)) or an EFS character coded signature (§ 1.4(d)(3)). It is inserted by electronic (e.g., a word processor) or mechanical means. S-Signatures may be used on documents that are either:

Mailed or hand (courier) delivered,  
Transmitted by facsimile, or  
Submitted via EFS directly as an EFS Tagged Image File Format (TIFF) attachment (e.g., scanned image), to the Office.

This provision enables practitioners to have an all electronic work flow, thereby enabling elimination of paper during the normal drafting and review activities.

### **2. The Following Rule Change for Preliminary Amendments Filed with New Applications**

Preliminary amendments that are present on the filing date of an application are treated as part of the original disclosure. Applicants are responsible for reviewing all preliminary amendments present on the filing date and providing a reference thereto in a § 1.63 oath or declaration for each such preliminary amendment containing subject matter not otherwise present in the application as filed. Preliminary amendments seeking cancellation of all the claims

without presenting any new or substitute claims will be disapproved.

Therefore, inventor's declarations should include a mechanism (such as a check box) to indicate that a preliminary amendment is being filed with the application, that the preliminary amendment is part of the application as filed, and that the inventor has reviewed the preliminary amendment.

### **3. Limitations to Amendments After Responding to an Office Action**

The following rule changes apply to filings after a response to a first office action.

Supplemental filings such as adding claims or evidence generally will not be entered unless they limit the examiner's work load. Specifically, after a complete reply has been filed, the Office may enter a supplemental reply that is filed before final rejection or allowance and in sufficient time to be entered into the application file, if the subsequent reply is clearly limited upon cursory review to: cancellation of claims; adoption of an examiner suggestion(s); placement of the application in condition for allowance; reply to an Office requirement made after the first reply was filed; correction of informalities (e.g., typographical errors); or simplification of issues for appeal.

This requirement forces practitioners to ensure that a response to a first office action is complete on all issues, and that the response presents all claims that the applicant might consider taking on appeal in response to a subsequent final action.

### **III. Conclusion**

The most important rule changes in the USPTO's Strategic Plan motivated rules being implemented in November 2004 allow typed signatures, define amendments filed with a new application to be part of the new application, and generally precluded filing of amendments that are not in response to an office action after the USPTO has mailed a first office action. Each of these changes requires significant changes in our practice.

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