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December 1, 2016

VIA EMAIL TO: seq_listing_xml@uspto.gov

TO: Susan C. Wolski,
Office of International Patent
Legal Administration, Office of the
Deputy Commissioner for International
Patent Cooperation

Re: Patent and Trademark Office [Docket No.:
PTO-P-2016-0039] Standard ST.26—Request for
Comments on the Recommended Standard for the
Presentation of Nucleotide and Amino Acid
Sequence Listings Using XML (eXtensible Markup
Language)

Dear Ms. Wolski:

Thank you for the opportunity to comment on the continuing international effort to revise the World Intellectual Property Organization (WIPO) standard for the presentation of nucleotide and/or amino acid sequences and the consequent changes to the United States rules of practice.

I have been a registered practitioner in private practice since 1994. I am involved in IP focused BAR organizations and I am founder of Neifeld IP Law, PC. However, these comments are my own.

The request for comments states:

In WIPO Standard ST.26, "free text" is limited to a few short terms indispensable for understanding a characteristic of a sequence, is preferably in the English language, and as part of the sequence data part of the sequence listing, must not exceed 1000 characters composed of printable characters from the Unicode Basic Latin code table."

COMMENT: There is no technological nor policy reason presented why, in ST.26, free text, is "limited to a few short terms ...[and] must not exceed 1000 characters." Barring such a reason,

no character limit should be imposed in St. 26 on free text.

The request for comments states:

In WIPO Standard ST.26, “free text” ... is preferably in the English language, It is expected that most inventors providing sequence information are capable of providing “free text” in the English language.

COMMENT: The phrase "preferably in the English language" is unenforceable and therefore meaningless surplusage. In WIPO Standard ST.26, either drop reference to English, or require the free text be in English.

The request for comments states:

Availability of an authoring tool in advance of the WIPO Standard ST.26 effective date is key to a successful transition from WIPO Standard ST.25. As envisioned, the authoring tool should be capable of intake of a sequence listing in WIPO Standard ST.25 format, and with additional input from applicant, create a sequence listing in WIPO Standard ST.26 format. *Unfortunately, direct conversion from one standard to the other is not possible*, due to numerous differences between the two standards,.... [Italics added.]

COMMENT: Inability to effect direct conversion will wreak havoc on transitional cases if they are required to comply with St.26 after being filed in compliance with St.25. If direct conversion is not possible, then PCT contracting states should agree to allow St.25 in any cases referencing, incorporating material previously incorporated by reference, claiming Paris priority or claiming a domestic national law benefit to earlier filings, as a condition to promulgating St.26.

Very truly yours,
Richard Neifeld,
Neifeld IP Law, PC

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