

November 5, 2003

Ms. Joni Chang  
Legal Advisor, Office of  
Patent Legal Administration  
United States Patent and Trademark Office  
Washington, D.C. 22313-1450

Re: Reply to Notice of Proposed Rulemaking  
Changes To Support Implementation of the  
USPTO 21st Century Strategic Plan  
68 Federal Register 53813 (September 12, 2003)

Dear Ms. Chang,

I appreciate the opportunity to offer comments on the rule and practice changes proposed by the USPTO in the subject notice.

I am a retired SPE and former Director of the Independent Inventor Programs and am currently a patent consultant teaching and designing training curriculum at the Patent Academy.

My comments and suggestions on specific proposals are as follows:

Section 1.111:

I am concerned with the entire proposed Rule change, the language of the Rule, and the rationale for its support and presentment.

First, the proposed Rule states that the Office may enter a supplemental reply if it is "...clearly limited to: A) Cancellation of a claim(s); (B) Adoption of an examiner's suggestion(s): or (C) Placement of the application in condition for allowance."

My concern is the ambiguity of these exceptions. Will the supplemental reply be entered if it merely cancels one of thirty pending claims? Will the supplemental reply be entered if it adopts one suggestion but argues that any other suggestion is not being adopted for a given reason? Also, is an examiner's "suggestion" the same as "the examiner recommends..." or a response to an "objection" to a claim?

Second, the main rationale for the proposed Rule change is to reduce pendency by saving the examiner's time on rework, etc. I don't understand how this concern comports with the fact that a supplemental reply filed before the examiner has picked up the application to respond to the previously filed amendment does not impact on the examiner at all. The current Rule 111 recognizes this situation and accurately handles the involved concerns. Furthermore, with the current amendment practice under Rule 121 and with the advent of electronic filing of all papers (IFW and eDAN) the amount of effort to enter the supplemental reply is de minimus. Furthermore, some of the supplemental replies that would be prohibited (further amendment of the claims, submitting evidence or arguments) actually enhance and facilitate the prosecution as opposed the adversely affecting the pendency of the application.

Third, the proposed Rule change does not address the situation of a supplemental reply pursuant to an interview with the examiner. An interview may produce a clarification of the issues and a supplemental reply focusing on these issues assists the examiner in his/her deliberations on the application. Both Rule 1.133(b) and MPEP Section 713.04 dictate that the applicant has the duty to address the substance of the interview.

Fourth, the proposed Rule changes appear to be inconsistent with 37 CFR 1.115 (a) (1) Preliminary Amendments.

Fifth, the proposed Rule change can be better handled with the current Rule 111 coupled with modifying the changes in calculating term adjustment under 37 CFR 1.703 Reduction of Period of Adjustment. If applicants insist on filing a supplemental reply when the examiner is preparing an action in response to the previous reply, they may be dissuaded from doing so by the following change: modify 37 CFR 1.703(a) (2) to state "... after the date that is four months after the date a reply or supplemental reply under Section 1.111 was filed whichever occurs last.

Sixth, A preferred Rule change would have been:

" [2] Supplemental replies. [I] A supplemental reply will not be entered as a matter of right except as provided in paragraph [a][2][ii] of this section or at the initiation of the Office (e.g., after an interview) or pursuant to section 1.133(b) or prior to the preparation of an Office action. The Office may enter a supplemental reply.... (continue with the proposed Rule change language).

Seventh, instead of the proposed Rule change, I would recommend changing the current Rule 1.111(a) (2) by making it applicable to any supplemental reply as opposed to the current "second (or subsequent) supplemental reply".

I appreciate the opportunity to provide comments.

Sincerely,  
Richard J. Apley  
Richard J. Apley