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Sent: Wednesday, May 03, 2006 7:36 PM

To: AB93Comments

Subject: 3M IPC comments re: Changes to Practice for Continuing Applications

Attn: Robert W. Bahr

(See attached file: 3MIPC\_AB93\_comments.pdf)

Respectfully submitted,

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The Honorable Jon W. Dudas  
Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark Office

Attn: Robert W. Bahr  
Senior Patent Attorney, Office of the Deputy Commissioner for Patents

Re: Comments on Proposed Rules: "Changes to Practice for Continuing Applications,  
Requests for Continued Examination Practice, and Applications Containing  
Patentably Indistinct Claims"  
71 Fed. Reg. 48 (January 3, 2006)

Dear Under Secretary Dudas:

The United States Patent and Trademark Office (PTO) has proposed "Changes To Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims."<sup>1</sup> The motivation for the proposed rule changes includes reducing the backlog of unexamined applications and making the exchange between examiners and applicants more efficient. These objectives are clearly worthy of consideration and 3M Innovative Properties Company ("3M IPC") appreciates the PTO's ongoing efforts to address them.

3M IPC has prepared and prosecuted patent applications covering a wide range of technologies including medical devices, pharmaceuticals, information systems, software, adhesives, abrasives, cleaning products, semiconductors, and electronic materials,<sup>2</sup> and appreciates the different challenges encountered when prosecuting applications in these diverse technology areas. 3M IPC has supported the PTO's past efforts to increase quality, efficiency, and speed of examination. For example, 3M IPC supported fee increases to fund the hiring and training of new examiners. 3M IPC has also embraced opportunities to interact with the PTO and other interested applicants, assignees, and practitioners in addressing these areas of common concern, including the recent development and introduction of the Electronic Filing System. It is with this spirit of cooperation that 3M IPC has approached this opportunity to comment on the proposed changes to 37 C.F.R. §§ 1.78 and 1.114.

In general, 3M IPC believes that the process of patent prosecution, including the filing of continuing applications and requests for continued examination, could be improved if both the PTO and applicants had a better understanding of the issues facing each other throughout the current process, as well as during the subsequent enforcement of issued patents. While the present opportunity to comment on the proposed rule changes and the Town Hall meetings are steps in that direction, 3M IPC encourages the PTO to consider taking further steps including, e.g., round table discussions, focus groups, and pilot

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<sup>1</sup> 71 Fed. Reg. 48-61 (January 3, 2006).

<sup>2</sup> In 2005, 3M IPC filed 688 nonprovisional applications, including 236 continuing applications, on behalf of a large number of inventors. Utility applications were filed in each of the PTO's Technology Centers (i.e., 1600, 1700, 2100, 2600, 2800, 3600, and 3700).

programs before making significant changes in the rules governing patent prosecution.<sup>3</sup> Although the proposed rule changes may address issues faced by the PTO; from an applicant's perspective, some of the changes appear to be unnecessarily burdensome, to have limited potential for achieving the above-stated objectives, and to have unintended adverse consequences.

In view of these general comments, and the following specific comments, 3M IPC urges the PTO to consider the following steps:

- (1) continue to engage the patent community in an interactive and cooperative effort to identify and address common concerns regarding pendency, communication, and patent quality;
- (2) if changes to continuation and RCE procedures are implemented, use pilot programs to gather data on their effect; and
- (3) defer full implementation of significant rule changes pending assessment of the results achieved by steps (1) and (2).

In addition, as described in more detail in the following comments, 3M IPC

- (1) is opposed to the proposed limit on the number of continuing applications that may be filed as a matter of right, but would like to work with the PTO to identify alternative approaches to address the isolated cases of abuse of the current system;
- (2) is opposed to the proposed limit on the absolute number of RCEs that may be filed as a matter of right, and suggests the development of a standard to determine when the exchange between applicants and examiners is no longer mutually beneficial; and
- (3) is opposed to both the proposed additional disclosure requirements regarding co-pending applications beyond those already required by 37 C.F.R. § 1.56, and the proposed presumption of patentably indistinct claims based on the disclosures, rather than the claims, of co-filed applications.

### **Comments Regarding the PTO's Underlying Assumptions**

#### **1. The proposed rules will increase, rather than decrease, the examination backlog.**

According to the PTO, the current volume of continued examination filings (including requests for continued examination (i.e., RCEs)) is having a crippling effect on the Office's ability to examine new applications.<sup>4</sup> In order to address this problem, the PTO is proposing to severely restrict an applicant's ability to file second and subsequent continuing applications<sup>5</sup> and RCEs<sup>6</sup>. However, according to the PTO's 2005 statistics, less than six percent of the nonprovisional and RCE filings would have been affected by

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<sup>3</sup> Note that recent changes in the appeal process including, e.g., the pre-appeal brief and conference, as well as the introduction of the Electronic Filing System, were implemented using pilot programs.

<sup>4</sup> 71 Fed. Reg. at 49.

<sup>5</sup> *Id.* at 59 (Proposed Rules 78(d) (i) and (iv))

<sup>6</sup> *Id.* at 61 (Proposed Rule 114(f)).

the proposed rule changes.<sup>7</sup> Furthermore, based upon 3M IPC's experience prosecuting applications, it seems reasonable to assume that the burden on an examiner in responding to new arguments or amendments presented in an RCE or continuation application is often much less than that required to deal with a new, original application.

Generally, in the case of an RCE or continuing application, the examiner has recently considered the parent application and one would expect the examiner to be familiar with the specification, most of the relevant art, and all of the issues previously addressed.<sup>8</sup> Thus, even if the proposed rule changes effectively eliminated all second and subsequent continuing applications and RCEs, the reduced burden on the PTO would likely be significantly less than the six percent inferred from a simple comparison of the number of applications and RCEs filed.

In addition to the nominal expected impact the proposed rule changes might have on reducing the backlog, there appear to be several potential, unintended, adverse effects these rule changes will have on future filing practices and the backlog. For instance, the prospect of these rule changes being implemented will likely lead to a glut of patent filings before the rule changes become effective, similar to the activity that occurred in 1995 prior to the enactment of the 20 year patent term. In addition to taxing already overburdened PTO resources, these additional filings may keep from the public domain inventions that may not otherwise have been patented.

For example, patent practitioners, charged with protecting the intellectual property rights of their clients, will be motivated to search every pending application for all possible continuation applications and to file those continuing applications before the effective date of these proposed rules. Without having the benefit of the time allowed under the current procedure to assess which aspects of the claimed inventions are most important to the inventor or assignee, patents claiming aspects of even questionable value to the client may be filed to avoid a loss of rights under Proposed Rule 78(d)(1), particularly in light of the proposed retroactive effect of this rule change.<sup>9</sup>

Similarly, the PTO's Proposed Rule 78(d)(1)(ii), which requires practitioners to file all divisional applications during the pendency of the parent application,<sup>10</sup> will lead to an immediate increase in divisional applications claiming the benefit of currently pending applications. In addition, without the benefit of the time afforded under the current procedures to assess which aspects of the disclosure are worth patenting, a long-term

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<sup>7</sup> See *id.* at 57 (About 11,790 out of 317,000 nonprovisional applications were second or subsequent continuation or continuation in part applications. About 9,925 out of 52,750 requests for continued examination were second or subsequent requests. Therefore, less than six percent (i.e.,  $(11,790 + 9,925)/(317,000+52,750)$  or  $(21,715/369,750)$ ) filings were second or subsequent filings.)

<sup>8</sup> Because continuing applications are not always directed to the same examiner who handled the parent application, the assumption regarding familiarity with the case is not universally correct. However, the PTO could address this problem and reduce backlog by simply adjusting the mechanism by which applications are assigned so that related cases are assigned to a common examiner.

<sup>9</sup> *Id.* at 56.

<sup>10</sup> Proposed Rule 78(d)(1)(ii) provides that a divisional application may claim the benefit of only a single prior-filed application.

increase in the number of divisional applications will likely result as inventors and assignees seek to protect every potentially valuable invention disclosed in an application.

The proposed rule changes may also encourage practitioners to file longer, less focused applications, which will increase the burden on the examiners. For example, rather than face the burdens and risks associated with complying with Proposed Rule 1.78(f),<sup>11</sup> practitioners may prefer to include all related aspects of multiple inventions in a single application.

In addition to the effects these increased application filings will have on the PTO backlog, the RCE limits imposed by Proposed Rule 114(f) are likely to lead to an increase in the number of petitions challenging after-final practice including, for example, petitions under 37 C.F.R. § 1.127 challenging an examiner's refusal to admit an amendment. The proposed RCE limitations are also likely to cause an increase in the number of appeals, as practitioners are forced to choose between presenting new arguments through an RCE, thereby risking the loss of the right to file a continuing application,<sup>12</sup> or to present the arguments on appeal. This increase in the number of both petitions and appeals will contribute to an increase, rather than the desired decrease, in the current examination backlog.

## **2. The proposed rules will make the exchange between examiners and applicants less, rather than more, efficient**

Under current practice, a first office action and response may be required solely to arrive at claim language that clearly and accurately describes the scope of the invention in the minds of both the applicant and the examiner. Often, this process reflects the limitations of language in describing an invention; particularly inventions in leading edge technologies where advances in language have failed to keep pace with advances in the art. Unfortunately, following this mutually beneficial first step, applicants face the prospect of a final office action.<sup>13</sup> Given the limitations in the current after final practice,<sup>14</sup> applicants only meaningful opportunity for the examiner to consider arguments and amendments responding to the first true rejection of the envisioned invention requires the filing of an RCE. Faced with the consequences of filing an RCE

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<sup>11</sup> Proposed Rule 78(f)(2) requires applicants who file multiple applications to rebut a presumption of patentably indistinct claims where this presumption is based on (1) a common filing date; (2) at least one common inventor; (3) a common owner; and (4) "substantially overlapping disclosure," without any regard to the claims themselves. In contrast, if all of the claims were presented in a single application the burden would properly remain on the Patent Office to establish a restriction requirement based, not on the disclosure, but on the claims. (See 37 C.F.R. § 1.109.)

<sup>12</sup> Proposed Rule 78(d)(1)(i) precludes the filing of a continuation or continuation-in-part application where a request for continued examination under § 1.114 has been filed in the prior filed application. In addition, as currently worded, it is unclear whether Proposed Rule 78(1)(iv) would permit an applicant the opportunity to file a continuation or continuation-in-part application in such a situation.

<sup>13</sup> 37 C.F.R. § 1.113(a) "On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final ... ."

<sup>14</sup> See, e.g., 37 C.F.R. § 1.116. (In addition, there is a perception that the practice of issuing final actions to force an RCE is encouraged by the current "count" system.)

under the proposed rules, applicants may choose to file a petition<sup>15</sup> or appeal instead. In either case, the meaningful and mutually beneficial exchange between the applicant and the examiner will be cut short, and additional PTO resources will be required to rule on petitions or to process appeals.

### Comments on Specific Rule Changes

#### **1. 37 C.F.R. § 1.78**

##### Rule 78(a)(1)(3) Divisional Application

The current distinction between a divisional application and a continuation application accurately reflects the likely difference in resources required by the PTO in examining the application. Specifically, the resources required to examine an application directed to the independent and distinct invention of a divisional application will likely be greater than the resources required to examine the claims of a continuation application. Maintaining the current distinction between divisional and continuation applications will permit the PTO to tailor rule changes to each class of application in view of these likely differences in the resources required to examine them.

Therefore, 3M IPC proposes that the definition of a Divisional Application should be maintained as a “later application for an independent and distinct invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in the earlier or parent application,”<sup>16</sup> with no requirement that the newly claimed invention have been claimed in the earlier application.<sup>17</sup>

##### Rule 78(d)(1)(i) and (iii)

##### Single continuation for each nonprovisional or divisional application

As one justification for the rule changes limiting the number of continuation applications, the PTO asserts that such filings “divert patent examining resources from the examination of new technology and innovations, to the examination of applications that have already been examined...”<sup>18</sup> This justification appears to imply that the claims presented in a continuing application are less worthy of protection than the claims in a newly filed application. In 3M IPC’s experience, this is simply not the case.

Continuation applications arise for a variety of reasons. The PTO has identified one such situation where an applicant chooses to accept narrow claims in a first issued patent, and files a continuation application to pursue the broader claims.<sup>19</sup> In addition, such applications may be filed in order to obtain consideration of newly discovered art.

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<sup>15</sup> See 37 C.F.R. § 1.127 Petition from refusal to admit amendment.

<sup>16</sup> See MPEP § 201.06.

<sup>17</sup> In contrast, Proposed Rule 78(a)(3) limits the definition of a divisional application to an application that claims an invention that was disclosed and claimed in the prior-filed application, but was subject to a unity of invention or restriction requirement. (See, 71 Fed. Reg. at 58.)

<sup>18</sup> See 71 Fed. Reg. at 49.

<sup>19</sup> See, e.g., *id.* at 53.

As another example, consider an application filed with claims directed to the combination AB. During prosecution, the PTO and the applicant, working together, may discover prior art sufficient to establish a rejection of the claim to AB. In response, an applicant may originally pursue the addition of element C to render the claims patentable. After allowance, but prior to issuance of this application containing amended claim ABC, applicant may recognize that AC and ABD are also patentable. In such a case, it is unlikely that claims to AC or ABD could be added to the ABC case.

Under the current rules, an applicant would likely either file separate applications to AC and ABD, or a single application containing claims to both AC and ABD, with the expectation of a restriction requirement and the opportunity to file a later divisional application. In either case, an applicant would be entitled to claim priority to the original filing. Under the proposed rules, it appears that an applicant will be deprived of the opportunity to obtain patent protection for both the inventions AC and ABD, in addition to ABC, despite the fact the each of these inventions may be a valuable contribution to the field, and each was disclosed in the original application in full compliance with the requirements of 35 U.S.C.

Specifically, Proposed Rule 78(d)(1)(i) permits only a single continuation application as a matter of right, therefore applicants could not file separate continuations directed to AC and ABD. Proposed Rule 78(d)(1)(iii) would not permit a second continuation application, as it is unlikely that an applicant could show that claims to AC or ABD could not have been presented earlier. Finally, it does not appear that an applicant could file a single continuation to AC and ABD, and file a divisional application after receiving a restriction requirement, as Proposed Rule 78(d)(ii) only permits an applicant who files a divisional application to claim the benefit of a single prior-filed application.<sup>20</sup>

As a final example, many applications, particularly those in the pharmaceutical, biological, and chemical arts, may include a claim to a broad genus of compounds. As applicants gain additional information about their inventions, they often identify specific species of greater practical value. Such applicants may file continuation applications claiming these narrower species in order to maximize their protection and streamline potential enforcement. Under the current system, these continuation applications neither extend the patent term nor impact the public notice function. In addition, as the broader genus claims have already been allowed, the examination of applications directed to the narrower species claims should pose a minimal burden on patent examining resources.

In each of the situations described above the filing of multiple continuation applications serves a valuable need for applicants and contributes to the overall ability of the patent system to promote the progress of useful arts.<sup>21</sup> Although isolated examples of abuse of the current continuation practice are well known,<sup>22</sup> 3M IPC believes the proposed rule changes, which effectively limit an applicant to a single continuation application, are

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<sup>20</sup> See *id.* at 59, Proposed Rule 78(d).

<sup>21</sup> See U.S. Const. art. I, § 8, cl. 8.

<sup>22</sup> See, e.g., 71 Fed. Reg. at 49.

unnecessarily burdensome and adversely affect an applicant's *bona fide* attempt to obtain full protection for his or her inventions. Therefore, 3M IPC opposes the proposed restrictions on the filing of continuing applications.

### Additional Comments

3M IPC proposes that applicants be entitled to one or more continuation applications from a prior-filed nonprovisional application, international application, or divisional application regardless of the prior filing of a request for continued examination under § 1.114. RCEs are a useful tool in developing an effective exchange between applicants and examiners. The PTO has recognized that such exchanges may lead to well-designed claims that give the public notice of precisely what the applicant regards as his or her invention.<sup>23</sup> As discussed above, the preclusive effect of filing an RCE, as effectuated by Proposed Rule 78(d)(1)(i) and (iii), would impede these exchanges and the benefits they provide.

If the PTO maintains the proposed definition of a divisional application, 3M IPC proposes that applicants be entitled to file continuation applications directed at independent and distinct inventions without regard to any other prior-filed continuation application. Generally, an applicant is entitled to a patent on any invention disclosed to the extent required by 35 U.S.C. § 112 that is new, useful, and unobvious.<sup>24</sup> There is no requirement in 35 U.S.C. that the applicant recognize that a particular aspect of his or her disclosure is patentable at the time the application is filed, nor is there any requirement that an applicant claim all aspects of the disclosure in the original filing. Therefore, an attempt to deny an applicant a patent solely because that applicant failed to recognize or claim an invention at the time of filing may be beyond the authority of the PTO as an administrative agency.<sup>25</sup>

### Rule 78(d)(1)(ii)

In the case of a divisional application, applicants should not be restricted to claiming the benefit of only a single prior-filed application. Rather, applicants should be able to claim priority through a chain of divisional applications, allowing applicants the opportunity to tailor their filing strategy and control their costs as they gather information about the relative importance of individual aspects of their inventions.

### Rule 78(d)(1)(iv)

#### *Request for Clarification*

Clarification of Proposed Rule 78(d)(1)(iv) is requested. Specifically, the PTO is asked to clarify whether this portion of the rule would permit the filing of a continuation

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<sup>23</sup> 71 Fed. Reg. 48.

<sup>24</sup> 35 U.S.C. §§ 101-103

<sup>25</sup> 35 U.S.C. § 2(b)(2) (“The [United States Patent and Trademark] Office ... may establish regulations, not inconsistent with the law ...”)



application claiming the benefit of a prior-filed nonprovisional application when a request for continued examination under § 1.114 has been filed in the prior-filed nonprovisional application.

When considering this request for clarification, please consider the following additional comments. First, as discussed above, it is urged that the filing of an RCE should not impact an applicant's ability to file a continuation application. Second, it is urged that continuation applications under Proposed Rule 78(d)(1)(iv) should be available to applicants who file an RCE in the prior-filed nonprovisional application.

#### *Additional Comments*

The standard for filing a continuing application under Proposed Rule 78(d)(1)(iv) is overly burdensome.<sup>26</sup> If rule changes are implemented, 3M IPC suggests that the filing of a second or subsequent continuation application or continuation-in-part application after an RCE be permitted upon a showing of good and sufficient reasons why the arguments, amendments, or evidence were not presented during the prosecution of the prior-filed application. 3M IPC further suggests that this showing be included as part of the filing of the continuing application rather than requiring the filing a separate petition to the Director.<sup>27</sup> The fee for filing a second or subsequent application could be adjusted to reflect the added burden on the examiner to evaluate the proffered reasons.

If the PTO maintains the current standard of Proposed Rule 78(d)(1)(iv), clarification of the rule to indicate precisely what situations would be covered by a "could not have been submitted" standard is requested. For example, in some instances an examiner will fail to meet every part of the PTO's initial burden. In such a case, would an applicant be forced to assume or guess what may have been intended and respond accordingly? If instead an applicant points out the deficiencies in the Office Action, but does not present amendments, arguments, or evidence that might have been made based on the assumptions or guesses, are these deemed to be arguments that could have been made? Also, for example, how will the standard apply where any issue fee payment is due, and despite repeated requests, the examiner fails to take the appropriate action, such as acknowledging and returning a PTO-1449 form? Currently, an applicant is forced to choose between paying the issue fee and assuming the examiner will take the appropriate action prior to issuance, or taking the more prudent approach of filing an RCE or continuation to ensure that the proper actions are completed. Under the proposed rules, the latter option is effectively foreclosed.

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<sup>26</sup> "The [continuing] non provisional application must have filed therein a petition ... and a showing to the satisfaction of the Director that the amendment, argument, or evidence could not have been submitted during the prosecution of the prior filed application." (Proposed Rule 78(d)(1)(iv), emphasis added.)

<sup>27</sup> See § 1.116(b)(3) providing the standard for when an amendment touching the merits of an application may be admitted after a final rejection.

### Rule 78(e)

3M IPC suggests that a petition to accept an unintentionally delayed claim for the benefit of a prior-filed application should be granted regardless of whether there has been a request for continued examination under § 1.114. In the alternative, such a petition to accept an unintentionally delayed claim for the benefit of a prior-filed application should be granted upon a delayed showing of good and sufficient reasons why the arguments, amendments, or evidence offered in the prior-filed RCE were not presented during the prosecution of the prior-filed application. Under the currently proposed rules, an applicant who timely filed a request for the benefit of a prior-filed application may be allowed to file an RCE, provided the request is filed with appropriate petition, fee, and the required showing.<sup>28</sup> The change to Proposed Rule 78(e) suggested by 3M IPC would allow an applicant to obtain an RCE in a application claiming the benefit of prior-filed application regardless of the order in which those steps occurred.

### Rule 78(f)(1)

In a typical research environment, a particular inventor may work alone or with various combinations of other inventors on wholly unrelated inventions. Applications claiming such unrelated inventions are often prepared and prosecuted by different practitioners and perhaps through different firms. Under the current rules, applicants are required to inform the PTO of such other pending applications, regardless of their filing date and inventorship, if they are material to the patentability of the claims at issue.<sup>29</sup> In contrast, Proposed Rule 78(f)(1) would require tracking all applications based solely upon the proximity of their filing dates and a common inventor. The PTO has failed to suggest any benefit that would be achieved by such a requirement sufficient to justify the significant burden imposed on applicants and their representatives.

### Rule 78(f)(2)

The purported benefit of Rule 78(f)(2) is to aid the PTO in identifying potential double patenting rejections. However, such a rejection is properly focused solely on the claims,<sup>30</sup> while the standard for triggering the demands of Rule 78(f)(2) is based on the disclosures. There are many instances where two applications may contain significantly similar disclosures yet have substantially unrelated claims, e.g., where the applications address two different problems in a common field, where two independent and distinct articles share one or more common elements, and where two independent and distinct processes are capable of producing a common product. Therefore, the burdens imposed by Proposed Rule 78(f)(2) appear to exceed any purported benefit sought to be achieved, and should not be implemented.

If the Proposed Rule 78(f)(2) is implemented, the phrase “substantially overlapping disclosure” should be clarified. For example, if two applications are directed to

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<sup>28</sup> See 71 Fed. Reg. 61, Proposed Rule 114(f).

<sup>29</sup> 37 C.F.R. § 1.56 and MPEP § 2001.06(b).

<sup>30</sup> 37 C.F.R. § 1.109.

patentably distinct inventions and both incorporate an unrelated patent by reference, do the applications have “substantially overlapping disclosures”?

## **2. 37 C.F.R. § 1.114(f) Request for continued examination**

Applicants should be entitled to file at least one request for continued examination as of right in any application, including a continuation application. As discussed above, the RCE system facilitates the exchange between an applicants and an examiner, and benefits both the applicant and the public. These benefits are no less valuable in a continuation or continuation-in-part application than they were in the parent application.

The standard for filing a second or subsequent RCE Proposed Rule 114(f) is overly burdensome.<sup>31</sup> If rule changes are implemented, 3M IPC suggests that the filing of a second or subsequent RCE should be permitted upon a showing of good and sufficient reasons why the arguments, amendments, or evidence were not presented earlier. 3M further suggests that, rather than filing a separate petition to the Director, this showing should be required as part of the filing of the RCE, and evaluated by the examiner.<sup>32</sup>

As one possible alternative to the proposed changes, an examiner could be permitted to refuse entry of an RCE if the first office action in response to the proffered RCE would be a proper final rejection.<sup>33</sup> In addition, 3M IPC would support an effort to define the situations in which such a first office action final would be allowed so as to provide an effective tool to cut-off RCEs when communication between the applicant and examiner are no longer reasonably productive. Such a procedure would address the PTO’s concerns about the diminishing returns of repeated RCEs, while protecting the benefits of an ongoing discussion when both the examiner and applicant believe such an exchange is valuable.

In the alternative, if the PTO maintains the current standard of Proposed Rule 114(f), the rule should be clarified to indicate what situations would be covered by a “could not have been submitted” standard, as discussed above.

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<sup>31</sup> “The request for continued examination [must include] a petition ... and a showing to the satisfaction of the Director that the amendment, argument, or evidence could not have been submitted during the close of prosecution in the application.” (Proposed Rule 114(f), emphasis added.)

<sup>32</sup> See § 1.116(b)(3) providing the standard for when an amendment touching the merits of an application may be admitted after a final rejection.

<sup>33</sup> See MPEP § 706.07(b).

### Summary

3M IPC is committed to continuing to work with the PTO to address common concerns regarding the quality, efficiency and speed of the patent prosecution process. 3M IPC also has a goal of optimizing the intellectual property rights of its clients and believes that advances in quality, efficiency and speed can be achieved without significantly impacting 3M IPC's ability to achieve that goal. This belief is reflected in the comments above.

3M IPC appreciates the PTO's ongoing efforts to improve the patent prosecution process, including the efforts expended in preparing and presenting the current proposed rule changes. However, as discussed above, 3M IPC believes further refinements are necessary to achieve the results desired by the PTO without unnecessarily burdening applicants. 3M IPC thanks the PTO for considering its views, and would welcome additional opportunities to address the issues impacted by the proposed rule changes.

Sincerely,

A handwritten signature in black ink, reading "Thomas M. Spielbauer". The signature is written in a cursive style with a long horizontal flourish at the end.

Thomas M. Spielbauer, Reg. No. 58,492  
Nancy Lambert, Reg. No. 44,856  
on behalf of 3M Innovative Properties Company