

Michael O'Connell
San Francisco, CA

Nov. 12, 2003

Mail Stop Comments -- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Commissioner for Patents:

This letter responds to proposed changes to 37 CFR Parts 1 and 5 identified in Fed.Reg. 68(177), Sep. 12, 2003. For the most part, the proposed changes appear to be appropriate. Sections that needed comments are identified below along with the comments to them.

General comment: The process employed by the PTO to amend rules and propose new rules does not distinguish between minor procedural changes and changes which could substantially impact Examination or practice before the PTO. The proposed changes of Fed.Reg. 68(177) amount to amending sixty rules and adding two new rules. Many of the proposed changes will have little impact on Examination or practice before the PTO. It makes sense to propose these changes in one massive set of proposed rule changes. Others, such as the proposed changes to 37 CFR 1.105, have a high likelihood of significant impact upon both Examination and practice before the PTO. These latter changes should be separately proposed and given more consideration than the former so that the patenting process is not negatively impacted by not fully considering major changes before they are implemented.

Section 1.52(b)(2)(ii), first comment: There is much confusion between correlating font size in points to size of capital letters in inches. When a font is referred to in points, the points measure the height from the top of the ascenders to the bottom of the descenders. Often this can be measured by printing "fg" and measuring the height in inches from the top of the "f" to the bottom of the "g." Typically, capital letters have a height which is three fourths of the font's point height. Thus, a capital A in Times New Roman in 12 point font has a height of about 0.125 in. not 0.166 in.

Section 1.57(c), first comment: By eliminating the ability to incorporate commonly owned unpublished applications by reference, the usefulness of incorporation by reference practice will be severely curtailed. Incorporation by reference allows an applicant to incorporate information found in closely related applications without unduly increasing the length of the application. Often, this is useful for avoiding a later claim of inadequate written description, lack of enablement, or not fulfilling the best mode requirement. An application having such material is likely to be filed concurrently or closely in time to the application incorporating it by reference. Since publication takes

place 18 months after filing and issue takes longer, there will be few opportunities to shorten application length by incorporation by reference practice.

Section 1.57(c), second comment: Current patent office rules provide public access to unpublished patent applications incorporated by reference, 37 CFR 1.14. While this is not Internet access, it is not a significant burden since numerous commercial enterprises are available for obtaining copies of documents from the PTO. From a legal stand point, an interested party's expense in obtaining a copy of the unpublished patent application is minor in comparison to the cost of the legal analysis of the published application (or of the issued patent) that incorporates the unpublished application by reference.

Section 1.57(c), third comment: By law, an applicant is allowed to redact a patent application publication to that which is being published elsewhere in the world, 35 USC 122(b)(2)(B)(v). Patent laws vary throughout the world. Sometimes this results in a foreign inventor needing to add material that is essential only under U.S. law. This produces an anomalous result: A foreign inventor that adds such material to their U.S. application is not required to publish it in the U.S.; but a U.S. inventor incorporating by reference material that is only essential under U.S. law is required to do so by way of a published application or an issued patent.

Section 1.57(c), fourth comment: While there is a possibility that a file containing an unpublished patent application will not be available at the patent office (e.g., the patent is about to be issued and the file is at the printer), there is both a near term and a long term solution. The near term solution is to provide the inventor's or assignee's contact information upon determination that a file is unavailable so that an interested party can request a copy of the unpublished application. The long term solution will happen as a matter of course as the PTO transitions to electronic files since the electronic files will never be unavailable.

Section 1.57(c), fifth comment: Subparagraph (2) references 35 USC 112, ¶ 2, which is confusing because the referenced paragraph of the law presents the requirements for the claims. Subparagraph (2) seems to say that claims can be incorporated by reference.

Section 1.57(c), sixth comment: Subparagraph (3) references 35 USC 112, ¶ 6, which opens a multitude of questions. Means plus function elements of claims present numerous problems, not the least of which is that the Fed. Cir. requires a "clear link" between the element and language in the specification. It seems unwise to further confuse an already confusing area of the law by making a specific rule allowing language supporting a means plus function element to be incorporated by reference.

Section 1.57(c), seventh comment: Rather than restate the law of 35 USC 112 in subparagraphs (1), (2), and (3), the PTO should consider using the existing language in MPEP § 608.01(p): "Essential material is defined as that which is necessary to (1) describe the claimed invention, (2) provide an enabling disclosure of the claimed invention, or (3) describe the best mode (35 USC 112)."

Section 1.58(c), first comment: See comment relative to Section 1.52(b)(2)(ii) above.

Section 1.105, first comment: The public comments that were provided relative to section 1.105 and published on Sept. 8, 2000, continue to be relevant and pertinent to this controversial rule and the newly proposed version. Fed.Reg. 65(175), 54633-35. Copy attached.

Section 1.105, second comment: This section has an effective date of three years ago and, as such, there has been too little time since its enactment to determine whether the additional information identified in proposed section 1.105(a)(1)(viii) and the litigation discovery tools identified in proposed section 1.105(a)(3) are needed.

Section 1.105, third comment: The first example given for justifying the proposed changes to section 1.105 is a hypothetical need for the Examiner to query the applicant regarding the knowledge of those of ordinary skill in the art. Requesting a stipulation from the applicant regarding the knowledge of those of ordinary skill in the art changes an objective standard to a subjective standard. Currently, Examiners work intimately with the prior art relevant to the applications that they examine. It is the prior art that determines the knowledge of one of ordinary skill in the art. As such, Examiners are in a position to initially determine the knowledge of one of ordinary skill in the art. If appropriate, the Applicant may rebut this initial determination.

Section 1.105, fourth comment: The second example given for the proposed changes to section 1.105 is to remove uncontroverted assertions from the record via stipulations. If an Examiner's assertion is not controverted, the record stands for the Examiner's assertion under the doctrine of file wrapper estoppel. There is no need for such a stipulation.

Section 1.105, fifth comment: Proposed section 1.105(a)(1)(viii) is not needed because the Examiner can make an assertion regarding any of these items and the Applicant must respond or let the Examiner's assertion stand.

Section 1.105, sixth comment: Proposed section 1.105(a)(3) provides litigation discovery tools to the Examiner, namely requests for documents, interrogatories, and stipulations. An inappropriately worded request from an Examiner for documents could leave an applicant no choice but to send a library of books to the PTO, at great expense to the applicant and which will never be looked at by the Examiner. Interrogatories and stipulations are used in litigation to limit issues to be brought before the courts. They are completely inappropriate to an ex parte action where an applicant must either accept an Examiner's final word on a subject or appeal.

It is unfortunate but many patent practitioners are unable to keep up with proposed changes to patent laws and rules. Often, vocal critics of the U.S. patent system are not registered practitioners and take anecdotal instances and transform them into crises. The

Nov. 12, 2003
Commissioner for Patents
Page 4

FTC Chairman's recent report on the balance between patent law and competition is a prime example since it completely fails to mention that patents are an engine of competition. Without the U.S. patent system, there would be few technology driven startups. Without technology driven startups, large technology companies will consolidate to the point that there is little competition. It may seem ironic that as the current trend is to assail patent laws another current trend is to strengthen copyright laws. The irony disappears when one realizes that weaker patent laws and stronger copyright laws both benefit large entities. Note that the FTC Chairman's report also includes mistakes of law and fact. Consequently, it has done a great disservice to patent law policy by being issued as a final report when it is at best a preliminary draft.

The comments given here are not provided merely to be critical. But rather are provided in an attempt to address rule changes which create problems for the public and the PTO.

Best regards,

/s/ Michael O'Connell
Michael O'Connell
Reg. No. 42, 950

Attachment

information is supplied, e.g., application number, any error in the information would significantly delay identification of the application being cited.

Comment 48: One comment suggested that the change to § 1.98(d) adds a great deal of complexity for very little benefit, particularly as the examiners should be considering the prosecution history, which is independent of whether the IDS in the prior application complied with § 1.97. Additionally, there is no justification to apply § 1.98(d)(2) retroactively.

Response: The comment has been adopted. The proposed required compliance with § 1.97 for the IDS in the prior application has not been carried forward in the final rule. It is also the intent of the Office, as stated in the preamble to the instant final rule, not to apply § 1.98(d)(2) retroactively.

Section 1.102: Section 1.102(d) is amended to refer to “the fee set forth in § 1.17(h)” for consistency with the changes to §§ 1.17(h) and 1.17(i). See discussion of changes to §§ 1.17(h) and 1.17(i).

Section 1.103: The proposal to amend § 1.103 was not proceeded with in this final rule, but has been included in the final rule to implement request for continued examination practice (the final rule resulting from *Changes to Application Examination and Provisional Application Practice*, Interim Rule, 65 FR 14865 (March 20, 2000), 1233 *Off. Gaz. Pat. Office* 47 (April 11, 2000)). The comments on the proposed amendment to § 1.103 have been treated in that final rule.

Section 1.104: Section 1.104(a)(2) (second sentence) is amended to add the phrase “in an Office action” to provide basis for the phrase “Office action” in §§ 1.111(a), (b), and 1.115(a).

Section 1.104(e) has been revised by deleting the last sentence thereof. The last sentence previously stated:

Failure to file such a statement does not give rise to any implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the examiner.

This statement of the rule is inconsistent with recent decisions by the United States Supreme Court (Supreme Court) and the United States Court of Appeals for the Federal Circuit (Federal Circuit), which highlight the crucial role a prosecution history plays in determining the validity and scope of a patent. See e.g., *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 41 USPQ2d 1865 (1997); *Markman v. Westview Instruments*, 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995), *aff'd* 517 U.S. 320, 38 USPQ2d 1461 (1996);

Vitronics Corp. v. Conceptronic Inc., 90 F.3d 1576, 39 USPQ2d 1573 (Fed. Cir. 1996). The examiner’s statement of reasons for allowance is an important source of prosecution file history. See for example *Zenith Labs., Inc. v. Bristol-Myers Squibb Co.*, 19 F.3d 1418, 30 USPQ2d 1285 (Fed. Cir. 1996), which references MPEP 1302.14 to this effect (Footnote 7 of the case).

In view of the recent case law dealing with prosecution history, the failure of an applicant to comment on damaging reasons for allowance would give rise to a presumption of acquiescence to those reasons, and the negative inferences that flow therefrom. Accordingly, the statement in the rule that failure to file comments on reasons for allowance does not give rise to any implication that an applicant (or patent owner) agrees with or acquiesces in the reasoning of the examiner is obsolete and out of step with recent case law. The deletion of this statement from the rule should require applicant to set forth his or her position in the file if he or she disagrees with the examiner’s reasons for allowance, or be subject to inferences or presumptions to be determined on a case-by-case basis by a court reviewing the patent, the Office examining the patent in a reissue or reexamination proceeding, the Board of Patent Appeals and Interferences reviewing the patent in an interference proceeding, etc.

That the examiner does not respond to a statement by the applicant commenting on reasons for allowance does not mean that the examiner agrees with or acquiesces in the reasoning of such statement. While the Office may review and comment upon such a submission, the Office has no obligation to do so.

This revision of § 1.104(e) does not provide any new policy, but rather tracks the state of the case law established in the decisions of the Supreme Court and the Federal Circuit.

Section 1.105: Section 1.105 is a new section containing §§ 1.105(a) through (c), relating to requirements by the Office that certain information be supplied.

Section 1.105(a)(1) provides examiners or other Office employees explicit authority to require submission, from individuals identified under § 1.56(c) or any assignee, of such information as may be reasonably necessary for the Office to properly examine or treat a matter being addressed in an application filed under 35 U.S.C. 111 or 371, in a patent, or in a reexamination proceeding. The examples given that contain specific references in §§ 1.105(a)(1)(i), (iii), and

(vii) to inventors, and in § 1.105(a)(2) to assignees who have exercised their right to prosecute under § 3.71 are not intended to limit the scope of general applicability for all individuals identified in § 1.56(c). Abandoned applications also fall within the scope of the rule to provide for handling of petition matters. New § 1.105 is simply an explicit recitation of inherent authority that exists pursuant to 35 U.S.C. 131 and 132, and continues the practice of providing explicit authority to Office employees as was done with the Board of Patent Appeals and Interferences under § 1.196(d) and with trademark examiners under § 2.61.

The explicit authority of the examiner under § 1.105 to require such information as may be reasonably necessary to properly examine an application or treat a matter therein will be effective for any Office action written on or after the date that is sixty days after the date of publication in the **Federal Register**.

The inherent authority of the Office to require applicants to reply to requirements for information under 35 U.S.C. 131 and 132 was made explicit in § 1.105(a)(1) to encourage its use by Office employees so that the Office can perform the best quality examination possible. The authority is not intended to be used by examiners without a reasonable basis, but to address legitimate concerns that may arise during the examination of an application or consideration of some matter.

Sections 1.105(a)(1)(i) through (a)(1)(vii) identify examples of the types of information that may be required to be submitted. Section 1.105(a)(1)(i) relates to the existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention. Section 1.105(a)(1)(ii) relates to whether a search was made, and if so, what was searched. Section 1.105(a)(1)(iii) relates to a copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention. Section 1.105(a)(1)(iv) relates to a copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application. Section 1.105(a)(1)(v) relates to a copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result. Section 1.105(a)(1)(vi) relates to identification of improvements. Section 1.105(a)(1)(vii)

relates to uses of the claimed invention known to any of the inventors at the time the application is filed notwithstanding the date of the use. Knowing a particular use/application of an invention may be helpful in determining a field of search for the invention.

Other examples where the Office may require the submission of information are:

- (1) A reply to a matter raised in a protest under § 1.291;
- (2) An explanation of technical material in a publication, such as one of the inventor's publications;
- (3) The identification of changes made in a reformatted continuing application filed under § 1.53(b);
- (4) A mark-up for a continuation-in-part application showing the new matter where there is an intervening reference;
- (5) Comments on a new decision by the Federal Circuit that appears on point;
- (6) The publication date of an undated document mentioned by applicant which may qualify as printed publication prior art (35 U.S.C. 102(a) or (b)); or
- (7) Information of record which raises a question of whether applicant derived the invention from another under 35 U.S.C. 102(f).

The Office intends to provide training for its employees on the appropriate use of § 1.105. Any abuse in implementation of the authority, such as a requirement for information that is not in fact reasonably necessary to properly examine the application, may be addressed by way of petition under § 1.181.

Section 1.105 does not change current Office practice in regard to questions of fraud under § 1.56, and inquiries from examiners relating thereto are not authorized. See *MPEP 2010*.

Section 1.105(a)(2) provides that where an assignee has asserted its right to prosecute an application pursuant to § 3.71(a), matters such as §§ 1.105(a)(1)(i), (iii), and (vii) that especially relate to the inventors may also be applied to the assignee. It is also contemplated that these paragraphs may be applied to other individuals identified by § 1.56(c).

Section 1.105(a)(3) provides a safety net by specifically recognizing that where the information required to be submitted is unknown and/or is not readily available, a complete reply to the requirement for information would be a statement to that effect. There would be no requirement for a showing that in fact the information was unknown or not readily available such as by way of disclosing what was done

to attempt to satisfy the requirement for information. Nonetheless, it should be understood that a good faith attempt must be made to obtain the information and a reasonable inquiry made once the information is requested even though the Office will not look behind the answer that the information required to be submitted is unknown and/or is not readily available. An Office employee should not continue to question the scope of a specific answer merely because it is not as complete as the Office employee desires. (See Example below.)

Example: In a first action on the merits of an application with an effective filing date of May 1, 1999, the examiner notes the submission of a protest under § 1.291 relating to a public sale of the subject matter of the invention and requests a date of publication for a business circular authored by the assignee of the invention, which circular was submitted with the protest. It is expected that the attempt to reply to the requirement for information would involve contacting the assignee who would then make a good faith attempt to determine the publication date of the circular. The reply to the requirement states that the publication date of the circular is "around May 1, 1998." As "around May 1, 1998" covers dates both prior and subsequent to May 1, 1998, a *prima facie* case under 35 U.S.C. 102(b) would not exist. The examiner cannot require that the reply be more specific or hold the reply to be incomplete based on such information. The examiner can, however, in the next Office action seek confirmation that this is the most specific date that was obtained or can be obtained based on a reasonable inquiry being made if that is not already clear from the reply to the initial requirement for information.

Section 1.105(b) provides that the requirement for information may be included in an Office action, which includes a restriction requirement if appropriate, or can be sent as a separate letter independent of an Office action on the merits, such as when the information required is critical to an issue or issues that need to be addressed in a subsequent Office action. Each Technology Center can determine how best to implement the section. For example, a Technology Center having certain technologies where pertinent prior art is highly likely to be found in a commercial data base may choose to implement § 1.105(a)(1)(i) routinely for those technologies, sending out requirements for information either when such applications are first forwarded to the Technology Center, or at the time they are assigned to an examiner.

Section 1.105(c) provides that a reply to a requirement for information or failure to reply is governed by §§ 1.135

and 1.136. Note the Example provided in the discussion of § 1.105(a)(2).

Comment 49: Several comments either oppose or strongly oppose the rule. Three comments argue that the Office is without statutory basis to support the rule and in fact violates 35 U.S.C. 103(a) (patentability shall not be negated by the manner in which the invention was made), while two others argue that there is no need for the rule in view of the Office's inherent authority. All the comments opposing the rule argue that the rule imposes an unreasonable burden on the applicants. One comment argues that the rule imposes an unreasonable burden on the examiners to prepare the request. Objections to the rule include:

- (1) It will slow the examination process where applicant is required to reply;
- (2) It sets a standard of "reasonably necessary" that is new and different from the materiality standard in § 1.56;
- (3) The information may be protected by attorney-client privilege;
- (4) The information may be voluminous;
- (5) It may be difficult to make a good faith search when large corporate teams or foreign entities are involved;
- (6) New issues are created in subsequent litigation as to whether a good faith search was made and whether the duty of candor was complied with, particularly if the reply was that the information is unknown or not available; and
- (7) It may be used to shift the burden of examination from the examiner to the applicant.

There was also a concern that the Office did not address any mechanism to assure a uniform policy among the 3,000 examiners.

Response: The comments objecting to the new rule are not adopted. The Office will, however, actively work toward ensuring that examiners apply the rule uniformly and fairly, and the Office will provide a petition remedy to achieve those purposes. As to the specific burdens that the rule is said to create, it must be kept in mind that the rule is aimed at resolving an issue that is reasonably necessary for the examiner to resolve for the proper examination of the application. The requirement for information under § 1.105 thus cannot be avoided in our system of examination (as opposed to registration) and would have been made under the Office's inherent authority. Accordingly, the authority set forth in the rule is not contrary to statute. The rule is propounded not to create a new cause celebre among the bar but to encourage examiners to do the best examination

possible. Implementation of the rule is no different than what other parts of the examination process create when rejections and objections are made to which applicants must reply. Each of the claimed ill effects of § 1.105 can be equally charged against the normal examination process where a requirement under § 1.105 is not an issue.

As to fears that examiners will use such authority as a fishing expedition or a tool of harassment causing applicants extensive expenses to either attempt to comply or challenge the need for the information, as noted above, the Office will in its implementation of the rule work hard to minimize such problems. The Office recognizes that with a large examining staff there are bound to be a small number of cases that need corrective action, and the Office will be sensitive to that. The Office, however, cannot hold itself hostage to fears that a few of these situations will arise and force examination to the lowest common denominator by not permitting examiners to resolve issues that are reasonably necessary to be resolved for a quality examination.

Comment 50: One comment suggested that any Requirement for Information first be reviewed by an SPE or Director in the Technology Center before being sent.

Response: As the Office moves to implement § 1.105 the comment will be evaluated to study its feasibility.

Section 1.111: The heading of § 1.111 is amended to clarify that it applies to a reply by the applicant or patent owner to a non-final Office action.

Section 1.111 is amended to divide former § 1.111(a) into §§ 1.111(a)(1) and (a)(2). Section 1.111(a)(1) is amended to: (1) Provide a reference to § 1.104 concerning the first examination of an application; and (2) move the reference of §§ 1.135 and 1.136 (for time for reply to avoid abandonment) from § 1.111(c) to § 1.111(a).

Section 1.111(a)(2) is amended to provide that a second (or subsequent) supplemental reply will be entered unless disapproved by the Commissioner, and that disapproval may occur if the second (or subsequent) supplemental reply unduly interferes with an Office action being prepared in response to the previous reply. Factors that will be considered in disapproving a second (or subsequent) supplemental reply include: The state of preparation of the Office action responsive to the previous reply as of the date of receipt by the Office (§ 1.6) of the second (or subsequent) supplemental reply (§ 1.111(a)(2)(i)); and the nature of any changes to the specification or claims

that would result from entry of the second (or subsequent) supplemental reply (§ 1.111(a)(2)(ii)).

Disapproval of a second or subsequent reply applies to replies filed on or after two months from the date of publication in the **Federal Register**.

Disapproval of a second (or subsequent) supplemental reply will be delegated to the appropriate Technology Center Group Director under MPEP 1002.02(c). As most supplemental replies cause only a minor inconvenience to the Office, the Office is not inclined to adopt a change that would preclude the ability to file a second (or subsequent) supplemental reply when such is warranted. There are, however, some applicants who routinely file supplemental (or preliminary, see § 1.115) replies that place a significant burden on the Office by: (1) Canceling the pending claims and adding many new claims; (2) adding numerous new claims; or (3) being filed approximately two months from the date the original reply was filed (*i.e.*, when the examiner is likely to be preparing an Office action responsive to the original reply). These applicants also tend to be those having many applications simultaneously on file in the Office. These actions are calculated to interfere with the timely examination of an application and can be particularly detrimental to the Office.

The provision that the entry of a second (or subsequent) supplemental reply may be disapproved by the Commissioner (or his or her delegate) gives the Office the latitude to permit entry of those second (or subsequent) supplemental replies that do not unduly interfere with the preparation of an Office action, but also gives the Office the latitude to refuse entry of those second (or subsequent) replies that do unduly interfere with the preparation of an Office action. Factors that will be taken into consideration when deciding whether to disapprove entry of such a second (or subsequent) supplemental reply include: (1) The state of preparation of an Office action responsive to the initial or previous reply as of the date of receipt (§ 1.6, which does not include § 1.8 certificate of mailing dates) of the second (or subsequent) supplemental reply by the Office; and (2) the nature of the change to the specification or claims that would result from entry of the second (or subsequent) supplemental reply. That is, if the examiner has devoted a significant amount of time to preparing an Office action before such a second (or subsequent) supplemental amendment is received, and the nature of the change to the specification or claims that would

result from entry of the second (or subsequent) supplemental reply would require significant additional time (see examples below), it is appropriate for the Office to disapprove entry of the second (or subsequent) supplemental reply.

Example 1: If the second (or subsequent) supplemental reply amends the pending claims, adds numerous new claims, or amends the specification to change the scope of the claims, which the reply requires the examiner to devote significant additional time to prepare the Office action, the entry of such supplemental reply may be appropriately disapproved when the examiner has devoted a significant amount of time to preparing an Office action before such reply is received.

Example 2: If the second (or subsequent) supplemental reply amends the specification so that a new matter issue is raised, the entry of such reply may be appropriately disapproved when the examiner has devoted a significant amount of time to preparing an Office action before such reply is received.

Both conditions in § 1.111(a)(2) must be met, although it is not intended that the amount of time required to address the changes amount to the same period of time already spent by the examiner in preparing the initial response. Where a second (or subsequent) supplemental amendment merely cancels claims (as opposed to canceling claims and adding claims, or simply adding claims)(see below for additional examples), it is not appropriate to disapprove entry of such a second (or subsequent) supplemental amendment even if the examiner has devoted a significant amount of time to preparing an Office action before such a second (or subsequent) supplemental amendment is filed.

Example 3: If the second (or subsequent) supplemental reply amends the pending claims to alleviate rejections under 35 U.S.C. 112, ¶ 2, it would not be appropriate to disapprove the entry of such reply under § 1.111(a)(2).

Example 4: If the second (or subsequent) supplemental reply includes only changes that were previously suggested by the examiner, it may not be appropriate to disapprove the entry of such reply under § 1.111(a)(2).

Obviously, if a supplemental reply is received in the Office (§ 1.6) after the mail date of the Office action responsive to the original (or supplemental) reply, and it is not responsive to that Office action, the Office will continue the current practice of not mailing a new Office action responsive to that supplemental reply, but simply advising the applicant that the supplemental reply is nonresponsive to such Office action and that a responsive reply (under § 1.111 or § 1.113 as the situation may be) must be timely filed to avoid