IN THE UNITED STATES PATENT AND TRADEMARK OFFICE	
In re:	
RIN 0651-AB64 [Docket No.: 2003-P-020] For: **Notice of Proposed Rulemaking: Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan** **68 Fed. Reg. 53816 (September 12, 2003)**	

Comments In Reply To the Notice of Proposed Rulemaking Entitled "Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan"

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

Sir:

In reply to the Notice of Proposed Rulemaking published September 12, 2003, at 68 Fed. Reg. 53816, the PTO Practice Committee at Sterne, Kessler, Goldstein & Fox P.L.L.C. submits the following comments.

I. Proposed 37 C.F.R. § 1.4(d)(1)(iv)(A)

The proposed rule defines who can insert an electronic signature into an electronically created document. The proposed rule requires that the signer "personally insert" his or her electronic signature. The proposed rule states that the person signing the correspondence must personally insert the electronic signature. The comments state that the "personally insert" requirement is met by the signer "directly typing" his or her electronic signature on a keyboard. The comments also state that the requirement is not met when a first person types the electronic signature of a second person, upon receiving only a general instruction from the second person to insert the second person's signature.

The rule should be more flexible and allow some mechanism for a second party to process and send an electronic filing for a first person, as long as such authorization is clear and specific for this filing. Even now, the practitioner is not required to personally

drop a filing into a mail box, or to personally deliver it to the United States Patent and Trademark Office (USPTO). An assistant generally copies and packages the filing and makes the actual "submission." Since we are in Washington, we have a docketing assistant hand-carry filings directly to the USPTO.

Also, the USPTO does not require an original signature on many of the pleadings. The USPTO will accept a faxed transmission of many pleadings. The faxed copy of a pleading does not contain an original signature. Rather, the copy with the original signature remains with the practitioner's files. A similar system should be allowed for electronic filings. The standard for electronic filing should not be higher.

Safeguards can be put in place at the practitioner's end that establish that the authorization of a person to electronically file a document is more than a "general instruction" - and to ensure that it is a specific instruction with regard to this version of this filing. An example is the following. An assistant prepares the electronic filing and prints out each page for the practitioner's review. After review of the printouts of all of the pages, and after reviewing any necessary corrections, the practitioner indicates his or her approval by physically marking the boxes with the two certifications and by physically signing his or her name on the printout of the page and in the block in which the electronic signature is to be placed. These papers are then returned to the electronic filing assistant. That assistant then electronically checks the two certifications and types in the electronic signature, reprints that page for the file, and submits the filing. The page containing the original certifications and signature also stays with the practitioner's file.

Such a signed authorization on the printout of the paper copy of the filing is more than a "general instruction" to insert a signature. It is a specific authorization with regard to a specific version of the electronic pleadings. This is just one example of how a specific authorization can be obtained and retained for the file.

It is up to the practitioner to ensure that unauthorized filings are not submitted on the non-electronic side. It should be up to the practitioner to establish procedures to ensure that unauthorized electronic filings are not submitted too. If a practitioner repeatedly abused the electronic filing system, the Office of Enrollment and Discipline has measures to address the situation. Also, a requirement that the practitioner personally sign all filings would not stop a third party who stole the practitioner's password and improperly filed under the practitioner's name.

II. Proposed 37 C.F.R. § 1.6(d)(4)

The proposed rule contains text that had previously been removed from rule 6(d)(4) as of September 12, 2003, as a result of the Final Rule entitled "Reorganization of

Correspondence and Other General Provisions," published at 68 Fed. Reg. 48268 (August 13, 2003). Therefore, the following text should be deleted from proposed rule 6(d)(4): "Drawings submitted under §§ 2.51, 2.52, or 2.72 and." Proposed rule 6(d)(4) should simple read, "Color drawings submitted under §§ 1.81, 1.83 through 1.85, 1.152, 1.165, 1.173, or 1.437;".

III. Proposed 37 C.F.R. § 1.76(c)(2)

The comments to the proposed rule states that a Supplemental Application Data Sheet *must* be submitted with any changes or additions underlined. For deletions without replacement data, the comments state that strike-through or brackets must be used. However, the rule itself does not require underlining, strike-through or brackets. The proposed rule simply states that the information that is being changed be identified.

If this rule is to be changed, then the standard of the proposed rule - that the information be "identified," should be adopted, rather than the standard mentioned in the comments. The software for generating Application Data Sheets (ePAVE) generally does not permit underlining or strike-through and some fields may not permit entry of brackets. Such text editing must occur after the fact. Clarification of the comment section is requested as to whether it is "recommended" that underlining, strike-through and brackets be used if possible, and, if not, whether any clear form of identification of the information that is being changed will be acceptable.

IV. Proposed 37 C.F.R. § 1.83(a)

The proposed rule states that sequence listing that are in the specification are not permitted to also be included in the drawings. The comments state that applicants should not be "obliged" to include sequence listings in the drawings due to the current requirement of § 1.83(a) that "all claimed features must be shown in the drawings." This statement is confusing.

We are opposed to this rule as it is proposed. A sequence listing representation cannot easily substitute for a figure when the figure is more than a simple recitation of bases or amino acids. The information that can be obtained by looking at a figure of a sequence may not be the same as can be obtained looking at a sequence listing. For example, a figure may show an alignment of multiple sequences. Such alignments may only clearly seen when all the sequences are physically represented next to each other on the same page. An alignment cannot be shown in a sequence listing, and it can be very difficult to fully describe in the specification.

Also, it is not clear whether figures that contain a sequence that has a SEQ ID No. but now is part of a larger, undefined sequence would be allowed. For example, the specification may describe a small nucleotide primer of 15 bases. There may also be a graphical representation of the sequence of the primer after extension. In such a graphical

representation, on the figure, the primer's sequence of 15 bases is printed in position next to a "line" that represents an undefined longer sequence that is now attached to the original 15 bases. Would such figures be allowed?

As a further example of how figures can contain more information than can be easily shown in a sequence listing, a figure that has a sequence may have additional text elements that further characterize the sequence. The examiner can glance at the figure and quickly gleam information much more rapidly than such information can be obtained by looking at a sequence listing and having to refer back to individual annotations that appear at the beginning of each sequence. Examples of such elements include notations that reveal restriction sites (for DNA) and proteolytic sites (for protein), or arrows with alternate nucleotide (DNA) or alternate amino acids (protein) above a few positions. The impact of such changes is more easily seen in a figure than in a sequence listing.

Figures of genomic DNA sequences often contain textual identification of certain DNA motifs, for example, promoter sites, termination sequences, enhancer sequences, intron/exon boundaries - all of which are more easily seen in a figure than can be represented in the header information of a sequence listing.

Lastly, there may not be time to prepare a sequence listing before the application must be filed. If the Applicant could not put the sequence in a figure, the proposed rule would only force Applicants to insert long sequences into the detailed description of the specification, rather than as a figure, to ensure that a filing date for such sequences was obtained.

Alternatively, Applicants would be forced to file the sequence in the figure, and then cancel it later when the sequence listing was filed. The specification would also have to be amended to remove all references to that figure, and all other figures renumbered, if necessary, along with appropriate amendments throughout the specification to change the figure numbers throughout the text. Additionally, references to the deleted figures would have to be replaced with references to SEQ ID Numbers. This would create much unnecessary work for both the USPTO and the applicants.

V. Proposed 37 C.F.R. § 1.111(a)(2)

The proposed rule states that supplemental replies to non-final office actions are to be limited to certain listed items: cancellation of claims, adoption of an examiner's suggestion or placement of the application in condition for allowance. The comments state that if a reply cannot be filed that is to applicant's satisfaction because an affidavit is being prepared under § 1.131, then the applicant may consider filing a continuation application. We are opposed to the proposed rule.

The USPTO has rules that are in place now that allow the USPTO to deny consideration of a late-filed supplemental pleading. 37 C.F.R. 1.111(2) clearly sets forth when supplemental replies may be disapproved. No further limitation to this rule is needed.

Filing a continuation application would seem to tax USPTO resources more than filing a supplemental reply. Also, the proposed rule does not allow for the situation where the affidavit or declaration has been prepared and approved, but signatures cannot be obtained by the statutory bar date.

If this rule is adopted, we propose it be modified to include at least one additional category in which supplemental replies be permitted. We proposed that, in addition to the proposed categories, that supplemental replies be permitted if they perfect informalities. An example of such an informality would be the submission of an executed terminal disclaimer, where the reply had mentioned that the applicants would be filing the same. Another example would be the submission of a signed declaration under 35 U.S.C. §§ 1.131 or 1.132, where the unsigned (or partially signed) declaration had been submitted with the original reply. In such an example, the examiner has the benefit of the data presented in the declaration at the time of the filing of the reply, and the USPTO has not had to wait for the information.

VI. Proposed 37 C.F.R. § 1.115

The USPTO has requested comments regarding whether the benefits of the proposed change in Office policy (elimination of the current petition practice and treatment of preliminary amendments filed on or prior to the filing date of an application as part of the original disclosure) outweighs the attendant hardship (re-execution of the oath or declaration).

We believe that elimination of the filing of a petition in this regard would outweigh the hardship of re-executing the oath or declaration. The proposed rule provides a consistent way of treating preliminary amendments and it should be adopted.

VII. Summary

Consideration of the above comments is respectfully requested.

Respectfully submitted,

Sterne, Kessler, Goldstein & Fox P.L.L.C.

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