

changed. Further, the submission of a clean version in addition to a marked-up version is strongly discouraged. Dual versions (clean and marked-up) may get confused and the wrong version may get entered into the application file. In such an event, an incorrect message would be given, as providing any claim text in clean version will be taken to be an assertion by applicants that no changes have been made relative to the immediate prior version. The burden of ensuring accuracy between the most recent and the prior versions would be borne by applicants.

Amendments to a drawing figure will be made by submitting the actual changes in a replacement drawing sheet which is in compliance with § 1.84. If multiple drawing figures are on a single drawing sheet, the replacement drawing sheet should include the figures which have not been revised as well as the revised drawing figure(s). A detailed explanation of each of the changes made to a drawing figure must also be provided in a separate section of the amendment document. If the changes are not acceptable to or approved by the examiner, the applicant would be notified and given a requirement for corrective action in the next Office action. In the absence of an objection to the drawings, no further drawing submission by applicant will be required.

The proposed changes to amendment practice, if adopted in the final rule, will provide amendments ready for scanning and indexing into an electronic image format and incorporated into an electronic file wrapper that will be available and accessible to examiners on their individual PCs for further examination. Due to the large backfile of pending applications in the Office, the implementation of the scanning system and the creation of electronic file wrappers will be phased into the technology centers over a period of time. The proposed changes to the rule will require applicants to consolidate all of the claims of any currently pending application into a single amendment document each time any claim is amended, or a new claim is added. In the final rule, if it is adopted as proposed, all amendment documents will be required to include the full text of all pending claims (except for withdrawn claims) with their status in parentheses after the claim numbers, as well as an indication of the status of any claims which have been currently or previously canceled or withdrawn.

Section 1.121(b) is proposed to be amended to clarify that applicants must make amendments to the specification

by use of (1) replacement paragraph, or (2) replacement section. Provisions for submitting a substitute specification have been cross-referenced to § 1.125. Provisions for amending claims are provided for in other sections of this rule (paragraph (c)).

It is proposed that paragraphs (b)(1)(ii), (b)(2)(ii) and (b)(3)(ii) be changed to require that the amendment include a version of the amended paragraph, section or substitute specification (by reference to § 1.125) marked-up to show the changes by using "strike-through" as the method for showing deletions of subject matter in the specification. Similarly the Office proposes to require underlining to show additions of subject matter. Only strike-through and underlining should be used as the method to show changes.

It is further proposed to eliminate current paragraphs (b)(1)(iii), (b)(2)(iii) and (b)(3)(iii).

It is proposed to add new paragraph (b)(5) to indicate that precise instructions as to location of the changes must be provided for entry of amendments to the specification. Deletion of a paragraph or section may be made by instruction to cancel only; no actual text to be canceled should be submitted. Once an amended paragraph, section, or substitute specification is presented in an amendment document, there is no further need for the applicant to re-present the amended submission in a subsequently filed amendment document.

It is proposed to replace current paragraphs (c)(1) through (c)(3) with revised paragraphs (c) and (c)(1) through (c)(5). Paragraph (c) as revised would provide for a total rewriting of a claim each time the claim is amended, including markings to show the changes being made relative to the immediate prior version of the claim. This section would also require submitting a complete listing of all pending claims in the application, including the status of each and every claim in every amendment document that includes an amendment to the claims. This listing would replace all prior versions of the claims (except for any withdrawn claims), and listings of the claims in the application. The claim status required with each amendment document would be indicated in a parenthetical expression following the claim number. The status of all claims in the application, even those previously canceled or withdrawn, would be indicated with each amendment document.

In order to promote uniformity and consistency, only the following defined identifiers should be used to indicate

the status of the claims (in parentheses after the claim number):

- (Original): Claim filed with the application
- (Currently amended): Claim being amended in the current amendment document
- (Previously amended): Claim not being currently amended, but which was amended in a previous amendment document
- (Canceled): Claim deleted from the application
- (Withdrawn): Claim still in the application, but in a nonelected status
- (Previously added): Claim added in an earlier amendment document
- (New): Claim being added in the current amendment document
- (Reinstated—formerly claim # _): Claim deleted in an earlier amendment document, but represented with a new claim number in current amendment
- (Previously reinstated): Claim deleted in an earlier amendment and reinstated in an earlier amendment document
- (Re-presented "formerly dependent claim # _): Dependent claim re-presented in independent form in current amendment document
- (Previously re-presented): Dependent claim re-presented in independent form in an earlier amendment, but not currently amended

As a result of this proposed change, each amendment document would be self-contained, *i.e.*, it would include a complete set of claims for examination and would provide the status of all of the claims in one location in the file.

An example of how the claims, and the status of the claims, would be presented is as follows (use of the word "claim" before the claim number is optional):

- Claims 1–5 (canceled) (Note: consecutive canceled or withdrawn claims may be aggregated)
- Claim 6 (withdrawn)
- Claim 7 (previously amended): A bucket with a handle
- Claim 8 (currently amended): A bucket with a green blue handle
- Claim 9 (withdrawn)
- Claim 10 (original): A bucket with a wooden handle
- Claim 11: (new): A bucket with plastic sides and bottom

Paragraph (c)(1) would require the use of strike-through (for deletions) and underlining (for additions) to indicate how an amended claim differs from its immediate prior version. The proposed amendment to this section eliminates the previously accepted use of equivalent marking systems. No other