

method of markings or comparison (other than strike-through and underlining) would be permitted. Only claims of the status "currently amended" would include markings showing changes made.

Paragraph (c)(2) would require that the current amendment document include not only the marked-up version of claims being currently amended, but also the submission of a clean version of pending claims not being amended in the current amendment document. The presentation of clean text (not underlined) in any claim would constitute an assertion that no changes have been made from the immediate prior version of the same claim. This would relieve the Office of the burden of cross-reading various versions of the same claim to ensure accuracy of rewritten claims. The text of canceled or withdrawn claims should not be presented in each amendment document; these claims should be indicated as being in the status of "(canceled)" or "(withdrawn)".

Paragraph (c)(3) would provide for the cancellation of any claim by mere instructions to cancel. If no instructions to cancel a specific claim were submitted in an amendment paper, listing the claim as canceled in the claim status would constitute an instruction to cancel the claim; no other instruction would be necessary. Any added claims (in the current amendment document) should be merely identified in the status parenthetical expression as "(new)" and should not be underlined.

As proposed in paragraph (c)(4), the claims should be presented in ascending numerical order. This would prevent the grouping of claims by status (all new claims together, all amended claims together, etc.), and ensure a complete set of claims in numerical order, regardless of status. Consecutive claims of the same status, however, could be aggregated (e.g., "Claims 1-5 (previously canceled)"). Further, it is proposed to revise paragraph (c)(4) to require that any sheet of an amendment paper including part of the text of a claim shall not include material directed to any other part of the amendment or any remarks concerning the claims. This requirement will facilitate indexing of the application papers.

Paragraph (c)(5) would require that a claim canceled in its entirety could only be reinstated if presented as a new claim with a new claim number.

Paragraph (d) would require that any drawing changes be submitted in compliance with § 1.84 on replacement sheets in an attachment to an

amendment document. An accompanying detailed explanation of all of the changes would be provided on a separate sheet in the drawing amendments or remarks section of the amendment document. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant would be notified and informed of any required corrective action in the next Office action. No further drawing submission of the amended drawing figure(s) by applicant would be required, unless applicant is so notified.

As proposed in paragraph (d)(1), the applicant would be permitted to provide a marked-up copy of any figure being amended with the amendment document. This mark-up would be used by the Office to determine the changes being made in the drawings.

As proposed in paragraph (d)(2), examiners would be permitted to require a marked-up copy of a figure that has been or is required to be revised. The examiner may make the requirement in an Office action requiring a drawing correction, or after a drawing amendment has been made.

A change is proposed to the last line of paragraph (g) in order to bring it into conformity with earlier changes, "(c)(1)" is changed to "(c) and (c)(1) through (c)(5)".

It is proposed that paragraph (h) be added to require that each section of an amendment (e.g., amendments to the claims, amendments to the specification, replacement drawings, remarks) begin on a separate sheet of the amendment paper.

Paragraphs (h), (i), and (j) have been renamed as (i), (j), and (k), respectively.

**Section 1.125:** Paragraph (b) is proposed to be revised to add a cross-reference to § 1.312 to remind applicants that for submissions of substitute specifications filed after the notice of allowance has been mailed and up to the time of payment of the issue

fee, entry of the substitute specification is not a matter of right.

Paragraphs (c) of § 1.125 is proposed to be revised to require the presentation by applicant of both a marked-up version of the specification (using strike-through to indicate deleted subject matter and underlining to indicate added subject matter) and a clean version without markings.

**Section 1.823:** Section 1.823 is proposed to be amended by revising paragraph (a)(1) to require that any sheet including a part of a sequence listing not include material other than part of a sequence listing. This change is to facilitate indexing of the specification.

### Rule Making Considerations

**Administrative Procedure Act:** This notice proposes changes to the rules of practice that facilitate electronic image record management of patent application files to support the beginning-to-end electronic processing of patent applications. The changes proposed in this notice are limited to the format for and the manner of making amendments to patent applications, the handling of patent applications and other papers within the Office, the manner of filing information disclosure statements, and the procedures for electronic exchange of priority documents with other intellectual property offices. Therefore, these changes involve rules of agency practice and procedure under 5 U.S.C. 553(b)(A). *See Bachow Communications Inc. v. FCC*, 237 F.3d 683, 690 (D.C. Cir. 2001). Therefore, prior notice and opportunity for public comment are not required pursuant to 5 U.S.C. 553(b) or (c) (or any other law). Nevertheless, the Office is providing this opportunity for public comment on the changes proposed in this notice because the Office desires the benefit of public comment on these proposed changes.

**Regulatory Flexibility Act:** As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 (or any other law), an initial regulatory flexibility analysis under the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*) is not required. *See* 5 U.S.C. 603.

**Executive Order 13132:** This rule making does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

**Executive Order 12866:** This rule making has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

**Paperwork Reduction Act:** This proposed rule involves information collection requirements which are