

[[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strike-through, followed by including and underlining the extra text with the desired change. This section eliminates the previously accepted use of equivalent marking systems. No other methods of markings or comparison (other than underlining, strike-through or double brackets) are permitted. Only claims of the status "currently amended," or "withdrawn" if also being amended, shall include markings showing changes made. Examples of typical amendments in the revised format will be available on the Office's Internet Web site (<http://www.uspto.gov>).

Paragraph (c)(3) requires that the current amendment document also include the submission of a clean version, *i.e.*, without any markings in the presentation of text, of all pending and withdrawn claims not being amended, but being included as part of the claim listing in the current amendment document. The presentation of a clean version in any "original," "previously presented," or "withdrawn" claim constitutes an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims of the (current) status of withdrawn or previously presented. This relieves the Office of the burden of cross-reading various versions of the same claim to ensure accuracy of rewritten claims. Any claims added by amendment must be indicated with the status of "new," presented in clean version, and shall not be underlined.

Paragraphs (c)(4)(i) and (ii) set forth when claim text must not be presented and that cancellation of any claim is effected by mere instructions to cancel. Alternatively, identifying the status of a claim in the complete listing of all claims as "canceled" will constitute an instruction to cancel the claim. The text of "canceled" and "not entered" claims must not be presented; and these claims must be indicated as being in the status of "canceled" or "not entered," respectively.

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

Paragraph (d) requires that any drawing changes be submitted in compliance with § 1.84 on replacement sheets as an attachment to an amendment document. An accompanying detailed explanation of all of the changes should be provided on a separate sheet in the drawing

amendments or remarks section of the amendment document. A marked-up copy of one or more of the figures being amended, with annotations, may also be included to provide further explanation of the changes made. The marked-up version must be labeled as "Annotated marked-up Drawings." 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 and appropriate changes made to the brief description of the several views of the drawings for consistency. 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 (as per § 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will 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.

In order to bring § 1.121(g) into conformity with earlier changes, "(c)(1)" is changed to "(c) and (c)(1) through (c)(5)."

A new § 1.121(h) has been inserted 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.

Previous §§ 1.121(h), (i), and (j) have been redesignated as §§ 1.121(i), (j), and (k), respectively.

#### Section 1.125

Paragraph (b) has been 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.

Paragraph (c) of § 1.125 has been revised to require the presentation by applicant of both a marked-up version of the specification (using strike-through or in some circumstances double brackets to indicate deleted subject matter and underlining to indicate added subject matter) and a clean

version without markings. Deleted subject matter must be shown by striking through the deleted text or, in some cases, placing double brackets at the beginning and the end of the deleted text. Double brackets must be used if the deleted text would not be easily perceived using strike-through, such as, the deletion of a punctuation mark or a number. Double brackets may also be used to indicate the deletion of five or fewer consecutive characters. Examples of typical amendments in the revised format will be available on the Office's Internet Web site (<http://www.uspto.gov>).

#### Section 1.173

Current § 1.173(b)(3) is being replaced by §§ 1.173(b)(3), (3)(i) and (3)(ii) as a conforming amendment, in order to provide consistency between utility and reissue drawing practice.

#### Section 1.823

Section 1.823 has been amended by revising § 1.823(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.

#### Response to Comments

The Office published a notice proposing changes to the rules of practice to implement electronic maintenance of official patent application records. *See Changes to Implement Electronic Maintenance of Official Patent Application Records*, 68 FR 14365 (Mar. 24, 2003), 1269 *Off. Gaz. Pat. Office* 166 (Apr. 22, 2003) (proposed rule). The Office received twenty written comments (from Intellectual Property Organizations, Law Firms, and Patent Practitioners) in response to this notice. Comments generally in support of a change are not discussed. The comments and the Office's responses to those comments follow:

*Comment 1:* A number of comments questioned if the Office, after making the proposed change in § 1.3, would continue its practice of providing notice to an applicant, patent owner or third party requester when a paper submitted by that party constituted a failure of proper decorum and courtesy.

*Response:* The Office will continue to provide written notice that a paper submitted by a party to the Office constitutes a failure of proper decorum and courtesy. Following the mailing of the written notice, the paper will no longer be retained in the public electronic image file wrapper. The paper version will eventually be destroyed