

*Comment 13:* One comment requested that § 1.52(i) be liberalized to permit single line spacing because the Office would no longer need to hand-enter amendments within the electronic files and because the current requirement creates bulky files for applicants.

*Response:* This request cannot be adopted. First, during the transition to an image file wrapper environment, the Office must continue its current paper-based system for a considerable number of applications. Second, even after the transition is complete, the greater than single line spacing is useful for image processing (e.g., using optical character recognition technology). This is particularly true for text including superscript or subscript font. Further, the change would be inconsistent with PCT Rule 11.9(c) and would therefore be undesirable.

*Comment 14:* One comment suggested that the preamble of § 1.59 be reconsidered. It was suggested that the Office should not, particularly during an evaluation period, destroy original (pre-scanning) paper copies of document to safeguard the usability of its records.

*Response:* The Office plans to store the original paper copies for a period of time while the Office evaluates the effectiveness of its quality control and quality assurance procedures. The original paper copies will eventually be destroyed under a NARA-approved schedule.

*Comment 15:* Several comments questioned if the Office, after making the proposed change in § 1.59, would continue its practice of providing notice to an applicant, patent owner or third party requester when a paper was expunged.

*Response:* The Office will continue to provide written notice when granting a petition for expungement. Following the mailing of the written notice, the expunged paper will no longer be retained in the public electronic image file wrapper. The Office has also amended § 1.59 to provide that notice of non-entry will be provided.

*Comment 16:* One comment requested clarification concerning whether an application's title is considered an "other part" in proposed §§ 1.71 and 1.72 or whether the title should continue to be provided on the first page of the specification.

*Response:* The title of the invention, if presented as part of the specification as a heading on the front page of the specification, is considered to be part of the specification. See § 1.77(b)(1). Therefore, the title may continue to be provided on the first page of the specification.

*Comment 17:* One comment suggested that the Office change its internal practices to require applicant's consent to making most substantive changes to abstracts by revising MPEP § 608.01(b).

*Response:* MPEP § 608.01(b) provides that changes to the abstract at allowance are to be made by examiner's amendment. Procedures for preparing examiner's amendment are set forth in MPEP § 1302.04. Substantive changes to the abstract must be made by formal examiner's amendment with approval from the applicant. Therefore, the current practice and procedures are consistent with the comment.

*Comment 18:* One comment suggested that the Office reconsider its proposal to eliminate the last sentence of current § 1.72 and revised the sentence to read: "In proceedings within the Office, the Abstract shall not be used for interpreting the scope of the claims," so that examiners would not be tempted to rely on the Abstract to displace the "broadest reasonable interpretation" of a claim.

*Response:* The comment is not adopted. The Federal Circuit has indicated that the abstract is a potentially helpful source of intrinsic evidence in determining the scope of the claims. See *Hill-Rom Co.* 209 F.3d at 1341 n.\*, 54 USPQ2d at 1440 n.1 (Fed. Cir. 2000).

*Comment 19:* Several comments indicated that it would be unfair for the Office to reduce, by one day, the time period in § 1.97(c) for submission of an information disclosure statement (IDS).

*Response:* The Office proposed this change to realign when applicants would be entitled to consideration of IDSs in light of the real time access to changes in status information by accessing the Office's computer records via the PAIR. Several comments indicated that this change would unfairly burden honest applicants in order to punish a small number of dishonest ones. In light of the comments, the Office has not gone forward with this proposal. The Office is actively considering a change in PAIR to delay the inclusion of changes in status information in PAIR until the next business day after changes in status as an alternative remedy that would not be overly inclusive.

*Comment 20:* One comment suggested that the Office permit submission of e-IDS statements listing foreign patent documents and non-patent literature.

*Response:* The Office has been investigating how to expand the use of e-IDS to non-U.S. patent documents to allow applicant to submit a broader variety of listings of references and to allow examiners to easily retrieve the

cited references. Unfortunately, the Office resources do not permit expansion at this time.

*Comment 21:* One comment questioned if the Office, after determining that a paper submitted under § 1.99 could not be entered, would notify the party submitting the paper that it was not entered.

*Response:* The Office will continue its practice of not corresponding with third parties following publication of an application under 35 U.S.C. 122(b), since the Office's procedures must not permit third party protests after publication without the express written consent of the applicant. See 35 U.S.C. 122(c).

*Comment 22:* A number of comments suggested that the Office reduce the number of status identifiers required as part of § 1.121(c). Several comments stated that the eleven identifiers described for use by the Office were unnecessarily complex, and having to use such a large number could lead to confusion and errors. Most of the focus in the comments was on the identifiers "(Reinstated—formerly claim #)," "(Previously reinstated)," "(Re-presented —formerly dependent claim #)" and "(Previously re-presented)." Several comments suggested the use of no more than five identifiers, since it was felt a number of the proposed identifiers might be overlapping or redundant.

*Response:* The comments, for the most part, have been adopted by the Office. Paragraph (c) is amended in the final rule to require the use of only the following identifiers: (Original), (New), (Currently amended), (Withdrawn), (Canceled), (Not entered) and (Previously presented), the last of which is inclusive of previously added and previously amended claims.

The use of appropriate identifiers in the image file wrapper environment is designed to inform any user (examiner, technical support staff, applicant, practitioner, etc.) of the current status of each and every claim in the application. Labeling a claim as "new" or "currently amended" serves the desired purpose by providing a focus on what is being added to the claims in the application via the current amendment, relative to the immediate prior version. Additional explanations relating to status identifiers or classification of claims into a particular status can be provided at any time in the "Remarks" section of the amendment document.

Claims presented for the first time in an amendment after final rejection should be classified with the status identifier "new." If an applicant presents claims in an amendment after