

final rejection, which may or may not have been entered by the Office prior to the submission of a (subsequent) supplemental amendment, a notice of appeal or an RCE request, the second or subsequent amendment should classify any claims presented for the first time in the second or subsequent amendment as "new." Any claims presented for a second or subsequent time (which were previously not entered) should be classified as "not entered." If an applicant presents new claims in an amendment whose entry status is unknown (at the time of filing of a second or subsequent amendment), and the same and/or additional claims are to be presented in a subsequently filed amendment, claim numbers following the last used numbers of the previously filed paper must be employed. See § 1.126. Even if the earlier amendment is not entered, the claim numbers presented in the subsequent amendment must begin after the last numbered claim of the previously submitted amendment. The Office will make modifications to correct the claim numbering prior to allowance once any unentered papers have been approved for entry.

*Comment 23:* Several comments addressed the status of "withdrawn" claims and the desirability of including the text of these claims in the complete claim listing (set), in order to facilitate the calculation of fees and relieve the burden of searching the entire file to locate and determine claim dependencies, etc. Another comment argued on behalf of presenting the claim text of these claims in order to be able to present amendments so as to have them rejoined with the claim(s) being examined.

*Response:* The Office has adopted the suggestion. Paragraph (c) has been revised to require the inclusion of the text of withdrawn claims in the claim listing (set). Paragraph (c) is amended to reflect this change. If withdrawn claims are being amended, they must still be classified with the status identifier "withdrawn," but may include markings to show changes.

*Comment 24:* One comment proposed that the Office modify the language of the rule to provide for presentation of some text that is to be deleted from the specification in order to assist in determining the exact location of text that is to be canceled.

*Response:* The suggestion made in this comment will be permitted in practice by the Office. There are a number of ways to identify the precise location of subject matter which is to be deleted from the specification, such as, use of paragraph numbers, page number

and line number identification: "paragraph at page 4 beginning with 'The apparatus \* \* \*,'". Paragraph (b)(1)(i) of this section provides that "Amendments to the specification may be made by submitting: (i) An instruction, which unambiguously identifies the location \* \* \*" If inclusion of a few words of text is needed to "unambiguously" or uniquely locate the paragraph to be deleted (e.g., due to the lack of line numbering), the use of the first and/or last few words of the paragraph is permitted.

*Comment 25:* One comment included the suggestion that the claim listing not be required to present claims in numerical order, but to permit groupings of claims in other than ascending numerical order. The commenter believes it is more important to an examiner to have the claims presented in groupings that represent a logical order, such as by subject matter relationship.

*Response:* The point raised by this comment has validity only in the original presentation of claims, where applicant can control the groupings of related claims as well as the claim numbering. In amendment practice, however, the re-presentation of claims in a different order, or the addition of new claims in an order other than numerical, would cause confusion in processing, make fee calculations difficult and possibly result in claims being overlooked. There are many other aspects of processing which a patent application undergoes, where strict numerical presentation of claims is essential.

*Comment 26:* A number of comments have been received which oppose the use of strike-through as the only marking system acceptable to indicate deleted subject matter in amendments of the specification and claims. Several of the comments raised the likelihood of confusion as the principal argument against the use of strike-through, where, for example, the numeral "4" is to be deleted, or a punctuation mark is to be changed. Others suggested possible confusion for deletion of formula elements. Another noted the inability of some word processing programs to make strike-through a permanent part of the final document.

*Response:* The Office has decided to modify the mandatory requirement of the use of strike-through to permit the use of double brackets (i.e., [[ ]]) where five or fewer characters are being deleted or where the use of strike-through cannot be easily perceived. Strike-through will still be the required method of indicating or marking text that is to be deleted by the amendment.

Double brackets could be used, for example, when changing "4 corners" to "three corners" in an amendment document, which would normally be perceived with difficulty if only strike-through were required. Double brackets may also be used when deleting five or fewer characters.

*Comment 27:* One comment suggested that the proposed rule (§ 1.121(b)(1)(ii)) provided for underlining with respect to a new paragraph being added to the specification, while the sample amendment (on the Office's Internet Web site) did not include underlining of an added paragraph. This apparent inconsistency could lead to confusion among applicants and practitioners.

*Response:* The addition of § 1.121(b)(1)(iii) to the final rule clarifies the use of markings for added paragraphs in the specification. This section provides that the full text of any added paragraph to the specification is to be presented without underlining.

*Comment 28:* Several comments opposed the requirement of § 1.121(d) that replacement sheets of drawings complying with § 1.84 be submitted in an amendment document. It was felt that applicants might incur an unnecessary expense if the drawings were not approved for entry.

*Response:* The suggestions that the Office not require replacement sheets of drawings which comply with § 1.84 have not been adopted. Since the majority of corrected drawings are accepted without requiring further modification, savings of time and resources would result in the majority of cases if additional processing is thereby eliminated. In order to provide an accompanying explanation of the changes being made, applicants must include explanatory comments in the remarks section of the amendment document. In addition, applicant may, under paragraph (d)(1), provide a marked-up drawing with annotations to show the changes made. The examiner may also require a marked-up drawing under paragraph (d)(2).

*Comment 29:* One comment questioned the current practice of retroactive non-entry of papers in violation of § 10.10(b). The comment also requested that papers violating § 10.10(b) be accepted into the record and serve to toll any time period running against the applicant until after the Office has notified applicant that a paper in the application was submitted in violation of § 10.10(b). The same comment requested that the Office only disapprove entry of papers violating § 10.10(b) that are submitted after the Office has provided a first notice in an