

applications (which are otherwise open to the public under § 1.14(a)(iv)) as acceptable documents for incorporation by reference since the text of abandoned applications is not published after abandonment on the Internet at this time. The Office is considering how to make previously unpublished material to which the public is currently permitted access pursuant to § 1.14(a)(iv) (e.g., unpublished incorporated by reference applications) available on the Internet. The Office may reconsider this position when its electronic file wrapper permits access to the text of unpublished abandoned applications on the Internet.

Section 1.57(c)(1) through (c)(3) defines essential material as those items required by 35 U.S.C. 112, ¶¶ 1, 2, and 6.

Section 1.57(d) defines the scope of incorporation by reference practice for nonessential subject matter. As discussed with respect to § 1.57(c), the Director has considerable discretion in determining what may or may not be incorporated by reference in a patent application. Through the Office's incorporation by reference policy, the Office ensures that reasonably complete disclosures are published as U.S. patents and U.S. application publications.

Section 1.57(e) is added so that it is clear that a copy of the incorporated by reference material may be required to be submitted to the Office even if the material is properly incorporated by reference. The examiner may require a copy of the incorporated material simply to review it and understand what is being incorporated or to put the description of the material in its proper context. Another instance where a copy of the reference may be required is where the material is being inserted by amendment into the body of the application to replace the incorporation by reference statement.

Section 1.57(f) addresses corrections of incorporation by reference. Section 1.57(f) provides that improper incorporation by reference statements may be corrected with a timely filed amendment. Nothing in § 1.57(f) authorizes the insertion of new matter into an application. The Office is concerned that improper incorporation by reference statements and late corrections thereof require the expenditure of unnecessary examination resources and slow the prosecution process. By treating improper incorporation by reference statements as not incorporating any material (until the incorporation by reference is corrected), the Office and applicants will avoid expending unnecessary resources and

delays in prosecution occasioned by the many references to extraneous material that are often found in patent applications. Applicants know whether they want material incorporated by reference, and must timely correct any incorporation by reference errors.

*Section 1.58:* Section 1.58(a) is proposed to be amended to provide that a table not be included in both the drawings and in the body of the specification of an application. Section 1.58(b) is also proposed to be amended to clarify that correct visual alignment of rows and columns of chemical and mathematical formulae and tables is retained when the electronic file is rendered by opening and displaying the electronic file at the Office using a text viewer program. Section 1.58(c) is additionally proposed to be amended to recommend that the font size of text be at least 0.166 inches or 0.422 cm. and to eliminate a reference to elite type font.

Section 1.58(a) is proposed to be amended because applicants have been making voluminous applications even larger by including the same table as both a drawing figure and as text in the body of an application. Filing duplicate tables requires additional review by the Office to determine if the drawing table and the text table are duplicates and to identify differences if any differences exist. Moreover, the number of pages is effectively increased, causing increased scanning, storage and reproduction costs. In addition, the burden on the public to copy and review a published application or patent is also increased. *See* § 1.83 for a similar proposed change involving tables and sequence listings.

Section 1.58(b) is proposed to be amended adding "visually" so that it is clear that the data in the electronic file are appropriately formatted so that the alignment of rows and columns is maintained in the table when the file is opened to view at the Office. The Office has found that some filers have only been providing markers to identify rows and columns in table data. When the table is viewed at the Office the markers do not cause the rows and columns of data to be visually aligned. Unless each entry in a table is surrounded with an appropriate number of spaces the visual spatial alignment of the table is not maintained: *i.e.*, the rows and cells are mis-aligned. A way to provide the proper alignment is to insert space characters in each cell so that the overall number of characters in each cell is the same, and to maintain a constant font width for all characters.

Many programs that are used to generate tables allow the user to provide additional spaces manually when typing

data. Many of these programs also provide an automated way to pad the cells with space characters, and create an ASCII file with spatially aligned data. This feature is generally invoked by a command that is often called printing to a "formatted text" format or "prn" file. The program formats the table as it would appear on paper padding the cells with spaces to provide proper alignment of the cell entries.

A review of different versions of the same software product and of different software products showed no consistency in the menu language used for the formatting command noted above. With the constant change in software versions, the Office is not able to provide a list of all the menu variations. However, a person knowledgeable with the software used to create tabular data should be able to find the commands to invoke this feature in the software.

Section 1.58(c) is proposed to be amended for the same reason that § 1.52(b)(2)(ii) is proposed to be amended. Section 1.58(c) currently requires that the text be in a lettering style that is at least 0.08 inches high, which is the minimum font size set forth in Patent Cooperation Treaty (PCT) Rule 11.9. Text having a font size only 0.08 inches high is difficult to capture with optical character recognition technology and may not be reproducible as required by § 1.52(a)(1)(v) (and PCT Rule 11.2(a)). A font size of 12 (12/72 inch or 0.166 inch (0.422 cm.) high) is significantly more reproducible than a font size of 6 (6/72 inch or 0.08 inch (0.211 cm.) high). Accordingly, § 1.58(c) is proposed to be amended to indicate a preference for a larger font size. In addition, the reference to elite type is proposed to be deleted as it was inconsistent with the size given. Elite type is a typewriter type that runs 12 characters to the inch. Instead of referencing elite type, the rule is proposed to reference a font size of 6 which should be more meaningful to most patent applicants (most word processing software programs have an option to choose a font and a font size).

*Section 1.59:* Section 1.59 is proposed to be amended to refer to the petition fee set forth in § 1.17(g) for consistency with the change to § 1.17. *See* discussion of § 1.17.

*Section 1.69:* Section 1.69(b) is proposed to be amended by deleting the words "or approved" as unnecessary, and possibly leading to confusion and the mistaken assumption that the Office has a procedure for the approval of applicant generated forms, where no such procedure exists. *See Changes to Implement the Patent Business Goals,*