

Applicants are reminded that any identification of a basis for requesting special status and a statement of compliance with the technology specific requirement for special status must be based upon a good faith belief that the invention in fact qualifies for special status. See §§ 1.56 and 10.18.

*Section 1.103:* Section 1.103(a) 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 1.105:* Section 1.105(a) is proposed to be amended to redesignate paragraph (a)(3) as paragraph (a)(4) and add new paragraphs (a)(1)(viii) and (a)(3). Sections 1.105(a)(1)(viii) and (a)(3) contain additional examples of information requirements and set forth exemplary formats to portray the use of § 1.105 to seek stipulations, for example, as to the knowledge of those of ordinary skill in the art, and to require responses to interrogatories, for example, as to applicant's understanding of the knowledge of persons of ordinary skill in the relevant art.

This proposal sets forth a practice for soliciting applicant's knowledge, such as stipulations to clarify the record by removing uncontroverted assertions from further consideration, or for soliciting the applicant's response to specific questions based on the applicant's knowledge to resolve outstanding issues. The requirement for information provisions of § 1.105(a)(1) contain several examples, not by any means exhaustive, of the types of information that may be required from applicants under § 1.105. The Office is proposing to add the following examples to § 1.105(a)(1): Technical information known to applicant concerning the interpretation of the related art, the disclosure, the claimed subject matter, other information pertinent to patentability, or the accuracy of the examiner's stated interpretation of such items. The format of such a requirement would differ markedly from the format of the existing examples, which generally require specific documents. New paragraph (a)(3) provides examples of formats for requirements for information: (1) a requirement for documents; (2) interrogatories in the form of specific questions seeking applicant's knowledge; or (3) stipulations in the form of statements with which the applicant may agree or disagree. The existing provisions of paragraph (a)(3) would be included in paragraph (a)(4), which would also recognize that information in the form of opinion might not be held, and permit a reply to a requirement for opinion to be

considered complete where it is stated that an opinion is not held.

35 U.S.C. 101, 102, 103 and 112 require that claimed subject matter be among those eligible for patentability, provide utility that is substantial, credible and specific, be supported by a written disclosure that teaches how to make and use the invention and be definite in characterization, and be novel and non-obvious to a person of ordinary skill in the art. Evidentiary issues surrounding these patentability conditions frequently arise that require applicant reply for resolution.

In particular, the knowledge and skill of a person of ordinary skill in the art is highly pertinent to the resultant utility, to the degree of disclosure required, and to the degree to which prior art reads on claimed subject matter in view of inherent aspects and standard practices and knowledge in the art. However, evidence of what the indicia would be for that knowledge and skill may be highly burdensome to collect, and may be particularly wasteful of examiner resources for certain elementary issues, such as in common matters of scientific and engineering practice.

The Office is considering the use of stipulations and interrogatories relating to elements of the prior art, recognitions of problems to be solved, and rationales for combinations.

Applicant and the examiner may agree on the knowledge exhibited by persons of ordinary skill in the art, and this may be documented by formal stipulation. Alternatively, the examiner may articulate specific questions for applicant response in the form of an interrogatory designed to elicit the aspects of the knowledge of persons of ordinary skill in the art pertinent to analyzing patentability arising from the art of record.

Additional instances where stipulations and interrogatories may be used to elicit information reasonably necessary to examination include eliciting: (1) Applicant's interpretation of the distinctions among claims; (2) applicant's interpretation of the common technical features shared among all claims, or admission that certain groups of claims do not share any common technical features; (3) applicant's intention for the scope of structural and procedural support found in the disclosure for means or step plus function claims; (4) applicant's interpretation for precisely which portions of the disclosure provide the written description and enablement support for each claim element; (5) applicant's interpretation for the intended breadth of claim terms,

particularly where those terms are not used per se in the specification; (6) applicant's interpretation of which portions of each claim correspond to the admitted prior art in the specification; (7) applicant's interpretation of the specific utility provided by the claimed subject matter; and (8) applicant's identification of new subject matter in a continuation-in-part.

All requirements for information under § 1.105 must be reasonably necessary to treating a matter in an application. As such, requirements for information must be specific in the articulation of what is required and must exhibit a reasonable likelihood of being readily fulfilled by the applicant. The Office's policy of compact prosecution requires that both examiners and applicants provide the information necessary to raise and resolve the issues related to patentability expeditiously. Where information highly pertinent to patentability determination may be required in a form that is readily responded to, such as with solicitations of stipulations or interrogatories directly related to the issues on the record, such a requirement is consistent with the policies of compact prosecution and reasonable necessity for making requirements.

*Section 1.111:* Section 1.111(a)(2) is proposed to be amended to provide that a supplemental reply to a non-final Office action will not be entered as a matter of right, with the exception that a supplemental reply will be entered if it is filed within the period when action by the Office is suspended under § 1.103(a) through (c) (suspensions requested by the applicant). The proposed amendment to § 1.111(a)(2) would also provide that the Office may enter a supplemental reply that is filed before the expiration of the statutory period (*i.e.*, within six months from the mailing date of the non-final Office action) if the supplemental reply is clearly limited to: (1) Cancellation of a claim(s); (2) adoption of an examiner suggestion(s); or (3) placement of the application in condition for allowance. The proposed amendment to § 1.111(a)(2) would replace the current procedures for disapproving a second or subsequent supplemental reply set forth in § 1.111(a)(2).

The proposed amendment to § 1.111(a)(2) would encourage applicants to utilize the Office's resources more efficiently, by filing a complete first reply to a non-final Office action, thus assisting the Office in reducing pendency. Supplemental replies cause significant material delays in the examination and processing of