

applications, and place a significant burden on the Office's resources. An examiner's workload is increased by a supplemental reply received after the examiner has already conducted an updated prior art search and drafted the next Office action in response to the first reply. Beyond the additional time to read and consider the supplemental reply, the examiner may need to redraft the next Office action and frequently may need to conduct a further search. Pendency of the application is also increased when a first complete reply is filed to toll the period for reply and then a supplemental reply is filed beyond the statutory period set forth in the non-final Office action. Applicants are therefore strongly encouraged to file a reply to an Office action that represents a thorough consideration of all pending claims, the art of record, and the preceding Office action, and as well represents the full communication between applicants, any assignees and any legal representative mailing the reply. This would greatly reduce the need to file a supplemental reply. A single reply, absent supplements, would save examiners' time on rework. Cross-mailings between a new Office action and any supplemental reply would be significantly reduced. Applicant's patent term adjustment reductions (under § 1.704(c)(8)) would also be minimized, and the Office would save processing time and resources on patent term adjustment calculations. The changes to § 1.111(a)(2) would affect a very small percentage of applicants because only about 5.6% of all applications have one or more supplemental amendments. These supplemental amendments do, however, represent a significant burden on the Office from a small group of applicants. The burden would be effectively reduced by the instant proposed change.

After filing a reply to a non-final Office action, applicants would not be able in a supplemental reply, as a matter of right, to: (1) Further amend any claims; (2) add new claims; (3) reinstate previously canceled claims; (4) present evidence; or (5) submit arguments. The Office may enter any 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 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. Any supplemental reply filed after the expiration of the statutory period would not be entered even if the supplemental

reply meets one of the conditions since such reply would not be evaluated for entry. IDSs, or supplemental IDSs are not considered replies except when they are submitted pursuant to a requirement under § 1.105. IDSs filed with a non-compliant supplemental reply would be considered separately according to the requirements of §§ 1.97 and 1.98.

The proposed amendment to § 1.111(a)(2) would replace the procedures currently set forth in § 1.111(a)(2). The current disapproval procedures were meant to provide the Office with latitude to refuse entry of supplemental replies that unduly interfere with the preparation of an Office action. *See Changes to Implement the Patent Business Goals*, 65 FR 54604 (Sept. 8, 2000), 1238 *Off. Gaz. Pat. Office* 77 (Sept. 19, 2000). The disapproval procedures, however, did not address the pendency problems associated with first supplemental replies. The Office receives a significantly larger number of first supplemental replies than second (or subsequent) supplemental replies. Furthermore, the procedures for disapproving a second (or subsequent) supplemental reply are too time consuming for examiners and Office technical support staff. The proposed amendment to § 1.111(a)(2) would provide a single simplified procedure for handling all supplemental replies, which would reduce processing delays and save Office resources.

If a supplemental reply is denied entry, such reply would be assigned a paper number and placed in the application file, with no further action taken. To have any of the arguments or amendments contained in an unentered supplemental reply considered by the examiner, applicants may request the entry of the supplemental reply, or resubmit the contents of supplemental reply, in a proper reply to the next Office action, if the next Office action is a non-final action. If the next Office action is a final rejection or a notice of allowance, applicants may file a request for continued examination (RCE) in compliance with § 1.114 (*i.e.*, a request accompanied by a submission and a fee) and request the entry of the supplemental reply, or resubmit the contents of such reply, in the RCE submission, to have such reply considered by the examiner. If an RCE is filed after a final Office action, to have a previously filed supplemental reply considered, the RCE must be accompanied by a reply to the outstanding Office action. *See* § 1.114(c).

If an applicant cannot file a first reply to a non-final Office action that is to his

or her satisfaction (*e.g.*, an affidavit is being prepared under § 1.131), applicant may consider filing a continuing application, such as a continuation application under § 1.53(b) (as an RCE would not be permitted because the Office action is non-final, see § 1.114(b)).

A supplemental reply would be entered if it is filed within the period during which action by the Office is suspended under § 1.103(a) through (c). If a supplemental reply is filed during a suspension of action that was granted by the Office for a petition, with a showing of good and sufficient cause for suspension, the supplemental reply would be entered. For example, if test data is required to overcome a rejection under 35 U.S.C. 103(a) and the applicant needs more time to conduct an experiment and collect the test data, the applicant may file a first reply to the Office action (as the Office will not grant a suspension of action if there is an outstanding Office action awaiting a reply by the applicant) and a petition for suspension of action with a showing of good cause under § 1.103(a). If the suspension is granted by the Office, applicant may submit the test data in a supplemental reply during the suspension period. In addition, if an applicant is filing an RCE after a final rejection accompanied by a reply to the final Office action and needs more time to prepare a supplemental reply (*e.g.*, an affidavit), applicant may consider filing a request for suspension of action under § 1.103(c) with the RCE. The proposed § 1.111(a)(2)(ii) would permit the affidavit (which is supplemental to the reply to the final Office action) to be entered. A supplemental reply, however, would not be entered if it is filed during a suspension of action initiated by the Office under § 1.103(e).

The proposed amendment to § 1.111(a)(2) would not change the impact of the submission of a supplemental reply on patent term adjustment, in that the submission of any supplemental reply will cause a reduction of any accumulated patent term adjustment under § 1.704(c)(8).

Section 1.115: Section 1.115 is proposed to be amended by adding a new paragraph (b) to treat all preliminary amendments filed on or prior to (where a filing date being accorded application papers is later than the original receipt date of the application papers) the application filing date as being part of the original disclosure. Current paragraphs (b) and (c) of § 1.115 would be redesignated (c) and (d), respectively. If a preliminary amendment is determined to contain matter not otherwise included in the