



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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The reply filed on May 9, 2000, is not fully responsive to the prior Office action issued on July 7, 1998, because of the following omission(s) or matter(s): the deficient May 9, 2000, reply failed to sufficiently supplement the deficient April 30, 1999, reply which failed to comply with the Administrative Requirement. See 37 CFR § 1.111.

The applicants object strenuously to the Office's requirement that they review their hundred of applications, containing over ten thousand claims, and eliminate conflicting claims or else certify that there are no conflicting claims. The applicants argue that the USPTO requirement is "contrary to law" and constitutes substantive rulemaking absent notice and comment.

In fact, under 37 C.F.R. § 1.63 and § 1.56, the applicants are required to 1) review and understand the contents of each specification, including all claims and amendments, and 2) eliminate conflicting claims or notify the Office of conflicting claims. Upon review by the Office of a sampling of the specifications and the thousands of claims, it is a fact that some of the claims are conflicting. Assuming the oaths made under 37 C.F.R. § 1.63, are sound, then the applicants must not be familiar with their own applications.

These regulations do not shift the burden of examination onto the applicants, as the applicants have contended. The Office may examine each application regardless of the content of the applicants' certifications. However, the applicants must present claims properly. In re Ochiai, et

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al., 71 F.3d 1565, 1572 (Fed. Cir. 1995), citing In re Dillon, 919 F.2d 2d 688, 695 (Fed. Cir. 1990). The PTO regulations simply require that the applicants certify that they have reviewed and understand *all* of their own specifications, including claims and amendments, and that they either 1) cancel or withdraw unpatentable claims, or else 2) disclose to the Office all information material to the patentability of each claim. In short, the regulations require good faith filings by the applicants. The reiteration of these regulatory principles by the primary examiner, in the form of the Administrative Requirement, is not controversial. The Office merely asked for something the applicants have been and are required to do anyway, before being entitled to USPTO examination of their applications. Under the Administrative Requirement mailed in the Office action issued on July 7, 1998, the applicants are given reasonable choices:

- (1) file terminal disclaimers in each of the [related] applications terminally disclaiming each of the other . . . applications, or;
- (2) provide an affidavit attesting to the fact that all claims in the [related] applications have been reviewed by [the applicants] and that no conflicting claims exists between the applications. [The applicants] should provide all relevant factual information including the specific steps taken to insure that no conflicting claims exist between the applications, or;
- (3) resolve all conflicts between claims in the [identified] applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the [related] applications. (Note: the five examples [in the Administrative Requirement Appendix] are merely illustrative of the overall problem. Only correcting the five identified conflicts would not satisfy the requirement.)

It is not solely the burden of the Office, as the applicants imply, to review each of the over ten

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thousand of the applicants' claims and determine, for each claim, whether the applicants are violating their regulatory duties of knowledge of claims and disclosure or elimination of conflicting material. Rather, the applicants have an initial and continuing burden to comply with 37 C.F.R. § 1.56 and 1.63, regardless of whether the Office discovers that the applicants are in violation of the regulations under 37 C.F.R. § 1.78(b). Given documented evidence, through discovery of various conflicting claims, the applicants should review their compliance with 37 C.F.R. § 1.56 and 1.63 (as well as § 1.75, requiring that claims "differ substantially" and are not "unduly multiplied"). An Office requirement including a request for additional assurances is not only reasonable in view of the applicants own knowledge of over ten thousand claims, but advisable in the protection of the "public interest." 37 C.F.R. § 1.56(a).

As the applicants assert, a substantive rule is one that "affects individual rights and obligations." Animal Legal Defense Fund, et al. v. Quigg, et al., 932 F.2d 920, 927 (Fed. Cir. 1991). The applicants identify no statutory "right" that the Administrative Requirement abrogates. The applicants cannot credibly argue they have a "right" to file conflicting claims, or to be unaware of the contents of their own specifications, amendments, or claims. The applicants have no "right" to fail to remove conflicting claims from co-pending applications, and certainly, the applicants have no "right" to fail to notify the Office of conflicting claims. The applicants also have no "right" to shop among the USPTO examiners for conflicting interpretations of the applicants' claims, as implied by the petition under 37 C.F.R. § 1.181, filed on March 7, 2000, in

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co-pending application no. 08/470,571, which demands an exercise of the supervisory authority of the Commissioner. See the co-pending application no. 08/470,571, Petition at page 32 lines 10-12.

To the contrary, the applicants have an initial and continuing obligation to understand the contents of their own claims, and either eliminate conflicts or notify the Office of the conflicts. In fact, the additional option of terminal disclaimer, given the applicants in the Administrative Requirement, allows the applicants an option the USPTO is not required to offer. The USPTO could simply have required the applicants to review their over ten thousand of claims and either eliminate conflicts or certify that no conflicts exist.

The Commissioner has the right to conduct “orderly proceedings within his office so long as he does not violate the statute.” Ethicon, Inc., v. Quigg, 849 F.2d 1422, 1428 (Fed. Cir. 1988). As The applicants have alleged no statutory rights that the Requirement abrogates, the Commissioner is well within his discretion to impose this procedural Administrative Requirement.

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