The USPTO Should Promulgate 37 CFR 1.101 To Prevent Inconsistent Treatment Of The Form Of Continuing Applications

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I. The USPTO'S Inconsistent Treatment of the Form of Continuing Applications Is a Problem

Not infrequently, patent applicants file continuing applications that include the same inventive disclosure of an earlier filed application. Most often (with the exception being continuation-in-part applications), these applications contain the same inventive disclosure as the earlier filed application. And most often, the documents forming the continuing application, that is the abstract, written disclosure, claims, drawings, and any of the various types of appendices, are identical copies of the same documents forming the earlier filed application.

In some of those continuing applications, the USPTO impose formal requirements that were not imposed in the earlier filed application. This leads to several problems.

First, the existence of formal requirements that were not imposed in the earlier filed application result in additional costs to the applicants in addressing such requirements. Because those requirements were not imposed in examination of the earlier filed application they are clearly unnecessary to examination. And those costs are not inconsequential. See "2021 Report of the Economic Survey," AIPLA (2021), page I-107 ("Formalities, including preparing and filing formal declarations, assignments, and powers of attorney, responding to pre-examination notices, and preparing papers to make corrections" and "Preparing and filing formal drawings").

Second, the existence of formal requirements imposed by the USPTO that were not imposed in the earlier filed application result in loss of a practitioner's good will with their client applicant and the USPTO's good will with the public generally. This is because applicant relies upon the practitioner to comply with formal requirements. Therefore, imposition of unexpected formal requirements (which the practitioner must report to the client), can raise the impression that the practitioner is not competent.

Knowing that, practitioners are burdened with forewarning their clients that the USPTO is mercurial and may impose requirements that cannot be reasonably expected, in order to avoid that mis-impression that the practitioner is not competent. And practitioner's regularly post comments, at least in email list services, complaining about the USPTO's arbitrariness. For example, a comment on the PCT Oppedahl List service on 7/5/2022 reads:

> Yes this is the irritating situation. The drawings are good enough for the 18-month pub of the 371 case. The drawings are good enough for the Examiner in the 371 case to figure out what is patentable and what is not. The drawings are good enough for the Examiner in the 371 case to be enabling. The drawings in the 371 case are good enough for the Issue Branch. They appear in the issued patent from the 371 case. Then we file a continuation or divisional, and the drawings are good enough to get through the Application Branch. And the drawings are good enough for the 18-month pub of the continuation or divisional. And the drawings are good enough for the Examiner to do his or her job of figuring out whether the invention is patentable or not. And the drawings are apparently enabling and do not raise any best mode issue in the eyes of the

> Examiner, given that now comes the time to pay an Issue Fee in this continuation or divisional case. But guess what? All of a sudden, the drawings are not good enough to satisfy the Issue Branch in the continuation or divisional case. Just as you described.

Moreover, the inconsistency of action is arbitrary and therefore violates the law preventing arbitrary agency action. See 5 USC 706(2)(A) ([A court shall] ... hold unlawful and set aside agency action, findings, and conclusions found to be— (A) arbitrary....”). However, filing a civil action to address such a problem would be ineffective. First, filing such a civil action is far more expensive than spending the time and costs associated with complying with the arbitrary requirement. Second, filing such a civil action would not in any case stay the deadline running to comply with the arbitrary requirement, Third, any decision on such a civil action could not reasonably be expected prior to the deadline running to comply with the arbitrary requirement and therefore would affect the adverse consequences of failing to comply with the arbitrary requirements. And those adverse consequences include in some situations abandonment of the application and irretrievable loss of all patent rights.

The quote herein above from the PCT Oppedahl List service was directed to inconsistent treatment of drawing in a continuation of a US national stage of a PCT application. However, as I note above, the broader issue is that the USPTO imposes requirements in continuing applications that are inconsistent with requirements imposed during examination of the application to which the continuing application claims benefit.

And, from personal experience, this kind of inconsistent treatment by the USPTO of continuing applications has been endemic for decades.

II. The USPTO Should Promulgate a Rule to Solve that Problem

Because the problem is endemic, because the APA remedy is ineffective, and to improve the good will of both practitioners and the USPTO, the USPTO should promulgate a rule forbidding the USPTO’s examining corps from imposing requirements as to the form of a specification, including the abstract, claims, drawings, Appendices, Sequence Listings, and Large Tables, that are inconsistent with requirements imposed in their benefit application.

III. A Proposed Rule to Solve that Problem

The most natural location for such a rule would be in 37 CFR Chapter I, Subchapter A, Subpart B, "National Processing Provisions," in the sub subsection "Examination of Applications." This sub subsection cites its authority as 35 USC 131 and 35 USC 132. 35 USC 131 reads "The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor." So this sub subsection of 37 CFR dealing with "Examination of Applications" is right place to limit the scope of examination.

The "Examination of Applications" sub subsection of 37 CFR spans 37 CFR 1.101 to 37 CFR 1.110. And it just so happens that 37 CFR 1.101 is "[Reserved]". So an appropriate rule could be placed in 37 CFR 1.101.

The following text would be an appropriate rule.

37 CFR 1.101 - The Office shall impose no requirement as to the form of a specification, including the abstract, claims, drawings, Appendices, Sequence Listings, and Large Tables in an application filed pursuant to 35 USC 111(a) that claims benefit under 35 USC 120 to a national application that has received a first examination pursuant to 35 USC 131 that is inconsistent with the first examination in that national application.

IV. Why Proposed Rule Is Appropriate

The following analysis shows that the proposed rule's language has appropriate scope.

35 USC 120 extends the scope of a benefit claim to " an application previously filed in the United States, or as provided by section 363 or 385". That is, to prior filed applications filed in the United States, PCT applications, and Hague applications. This scope is appropriate because it includes all types of patent applications filed in the United States.

37 CFR 1.9(a)(1) defines a "national application" for all of 37 CFR chapter I, to mean "either a U.S. application for patent which was filed in the Office under 35 U.S.C. 111, an international application filed under the Patent Cooperation Treaty in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid, or an international design application filed under the Hague Agreement in which the Office has received a copy of the international registration pursuant to Hague Agreement Article 10." Therefore, "national application" is the appropriate defined term for proposed rule 37 CFR 1.101.

Finally, because provisional applications do not receive an examination pursuant to 35 USC 131, even though benefit may claimed to them, provisional applications cannot trigger the imposition of proposed rule 37 CFR 1.101.

V. Summary

In summary, there is a problem with the USPTO's examination of continuing applications imposing formal requirements that are inconsistent with examination of their parent application, that inconsistency has real world costs, affects the good will of practitioners and the USPTO, and is illegal. The solution to the problem should be a promulgated rule because no lesser change would be effective, and I propose above a suitable rule.

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