



Revised Amendment Practice 37 CFR 1.121 - Final Rule Effective Date: July 30, 2003

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*New paragraphs should
not be underlined*

Amendment Practice – IFW Final Rule *Background*

- The image file wrapper (IFW) prototype began in three Art Units and it included a revised amendment format.
 - See *USPTO ANNOUNCES PROTOTYPE OF IMAGE PROCESSING*, 1265 Off. Gaz. Pat. Office 87 (Dec. 17, 2002).
- The revised amendment format was readily accepted by prototype participants and examiners.
- The **voluntary revised amendment format** was made available to all applications except reissue applications and reexamination proceedings in February 2003.
 - See *Amendments in a Revised Format Now Permitted*, 1267 Off. Gaz. Pat. Office 106 (Feb. 25, 2003).

Amendment Practice – IFW Final Rule *Background*

- Flyer describing the voluntary revised amendment format was mailed with every Office action.
- Sample Revised Amendment Format has been posted on website at:
 - <http://www.uspto.gov/web/patents/ifw/>.
- Technical support staff were trained, and examiners were notified, about the voluntary revised amendment format (completed in May 2003).

Amendment Practice – IFW Final Rule *Rule Making*

- Notice of Proposed Rule Making (NPR)
 - *See Changes to Implement Electronic Maintenance of Official Patent Application Records, 68 FR 14365 (Mar. 25, 2003), 1269 Off. Gaz. Pat. Office 166 (Apr. 22, 2003).*
 - Proposed changes to 37 CFR 1.121 and other corresponding changes.
 - Many comments received; in many instances, suggestions were adopted.
 - The comments are posted at <http://www.uspto.gov/web/offices/pac/dapp/opla/col>

Amendment Practice – IFW Final Rule

Rule Making

- Revised Amendment Practice - Final Rule
 - See *Changes to Implement Electronic Maintenance of Official Patent Application Records*, 68 Fed. Reg. 38611 (June 30, 2003), xxxx Off. Gaz. Pat. Office xxx (July xx, 2003)(final rule).
 - Revised amendment practice set forth in the final rule replaces the voluntary revised amendment format.
 - **Strict compliance is mandatory** - all amendments filed on or after July 30, 2003 must comply with the revised 37 CFR 1.121, except amendments to the specification and claims filed in reissue applications and reexamination proceedings.
 - A sample amendment document is posted on the USPTO's website at <http://www.uspto.gov/web/patents/ifw/>.

- **Amendment Practice – IFW Final Rule**
- Major Changes from Notice of Proposed Rule Making:
 - Only seven status identifiers are permissible instead of eleven. See slides 10 – 12.
 - The text of withdrawn claims must be included in the listing of the claims.
 - Comments on the NPR suggested supplying text of withdrawn claims for rejoinder purposes.
 - Applicants may need to amend withdrawn claims to include limitations added to elected claims to permit rejoinder.
 - Drawing changes may be shown by annotated drawings.
 - Permissible markings only include underlining, strikethrough, and double brackets [[]].
 - Note: changes from NPR are highlighted in bold on the next few slides.

Amendment Practice – IFW Final Rule

- Highlights:
 - Each section of an amendment paper must start on a separate sheet.
 - For example: each of the following sections must start on a separate sheet: Introductory comments, Amendments to the Specification, Amendments to the Claims, Amendments to Drawings, and Remarks.
 - Submit only one version of the replacement paragraph or section, or currently amended claims, with markings (*i.e.*, strikethrough, **double brackets** [[]], or underlining), to show the changes relative to immediate prior version.
 - The requirement to provide a clean version has been eliminated, except when applicant submits a substitute specification.

Amendment Practice – IFW Final Rule

Amendments to Claims

- When there is any amendment to a claim, a claim listing of all claims ever presented in the case must be supplied in ascending numerical order.
- A simple example of a claim listing is as follows:

Claims 1-5 (canceled)

Claim 6 (previously presented) A bucket with a handle.

Claim 7 (withdrawn) A handle comprising an elongated wire.

Claim 8 (withdrawn) The handle of claim 7 further comprising a plastic grip.

Claim 9 (currently amended) A bucket with a green blue handle.

Claim 10 (original) The bucket of claim 9 wherein the handle is made of wood.

Claim 11 (canceled)

Claim 12 (not entered)

Claim 13 (new) A bucket with plastic sides and bottom.

Amendment Practice – IFW Final Rule

Amendments to Claims

- What is a claim listing?
 - A claim listing must include:
 - The claim number of every claim ever presented in the application, whether entered or not;
 - A status identifier, in parentheses, following each claim number;
 - The text of all pending claims (including **withdrawn** claims); and
 - Markings to show the changes made only in the current amendment.
 - The claims in the listing (in the current amendment) will replace all prior versions, and listings, of claims in the application.

Amendment Practice – IFW Final Rule

Amendments to Claims

- The seven (7) permissible status identifiers and their definitions, are:
 - (Original): Claim filed with original specification (not added by preliminary amendment and not previously amended).
 - (Currently amended): Claim being amended in the current amendment. Currently amended claims must include markings (strikethrough, double brackets, or underlining) to indicate changes.
 - (Canceled): Claim canceled or deleted in current amendment or previously. Do not present the text of a canceled claim. Consecutive canceled claims may be grouped together (*e.g.*, claims 1-5 (canceled)).

Amendment Practice – IFW Final Rule *Amendments to Claims*

- Seven (7) permissible status identifiers (cont.):
 - (Withdrawn): Non-elected claim. **The text of a withdrawn claim must be presented. Withdrawn claims that are being currently amended must be presented with markings (strikethrough, double brackets, or underlining) to indicate changes.**
 - (Previously presented): This is a generic identifier to cover any claim that was previously added or amended in an earlier amendment paper. **The proposed identifiers “previously amended” or “previously added” were not adopted, and must not be used.**

Amendment Practice – IFW Final Rule

Amendments to Claims

- Seven (7) permissible status identifiers (cont.):
 - (New): Claim being added in the current amendment paper. The text of the claim must be presented in clean form without underlining.
 - (Not entered): **Claim presented in a previous unentered amendment.** Do not present the text of a not entered claim. Consecutive not entered claims may be grouped together (*e.g.*, Claims 20-25 (not entered)). If in doubt as to whether a prior amendment was entered, the claim should be presumed to be “not entered”.
- The following status identifiers in NPR have been eliminated: previously amended, previously added, reinstated-formerly claim #_, previously reinstated, re-presented-formerly dependent claim #_, previously re-presented.

Amendment Practice – IFW Final Rule

Amendments to Claims

- The listing of claims must comply with the following:
 - A status identifier for each claim is required. Multiple status identifiers must not be used for any single claim.
 - The text of all claims being currently amended must be presented with markings to show changes relative to immediate prior version.
 - Only claims of the status “currently amended” and **“withdrawn” (if the withdrawn claims are being currently amended) may include markings.**
 - All other pending claims (including **withdrawn claims** that are not being currently amended) must be presented in clean text (without markings).

Amendment Practice – IFW Final Rule *Amendments to Claims*

- Listing (cont.):
 - Any claim presented in clean text (no markings) constitutes an assertion that it has not been changed relative to the immediate prior version, except omitting markings (*i.e.*, underlining, strikethrough, and double brackets) and deleted text. For example,
 - If the immediate prior version of the claim was:

“Claim 1 (currently amended) A bucket with a blue handle.”
 - The listing of claims in the current amendment must have:

“Claim 1 (previously presented) A bucket with a handle.”

Amendment Practice – IFW Final Rule

Amendments to Claims

- Listing (cont.):
 - Canceled claims and **not entered** claims may only have a “canceled” or “not entered” status identifier after the claim number. The text must not be supplied.
 - New or added claims must have “new” as a status identifier
 - Do not underline the text of the new claims.
 - Grouping of Claims – consecutive canceled claims or **not entered** claims may be aggregated into one line.
Examples: Claims 1-5 (canceled), or
 Claims 20-25 (not entered)

Amendment Practice – IFW Final Rule

- Markings to Show Changes:
 - Replacement paragraphs or sections, replacement abstracts, currently amended claims, and substitute specifications: must include markings to show all changes relative to the immediate prior version.
 - Added text must be shown by **underlining**.
 - Deleted text must be shown by **strikethrough** (e.g., strikethrough), with 2 exceptions:
 - For deletion of five or fewer consecutive characters, **double brackets** **[[]]** may be used (e.g., **[[eroor]]**); and
 - If strikethrough cannot be easily perceived, deleted text must be shown by **double brackets** **[[]]** around the deleted text characters.
 - For example: changing “4 corners” to “three corners” should be indicated by “three**[[4]]** corners”.

Amendment Practice – IFW Final Rule

- Markings to Show Changes (cont')
 - For changes of punctuation marks or difficult to perceive characters, applicants may delete text before and after with strikethrough, and then insert such text along with the change by underlining. For example:
 - If the hyphen in “strike-through” is to be deleted, it may be shown as “strike-throughstrikethrough”

Amendment Practice – IFW Final Rule

Amendments to Specification

- The location of the paragraph or section to be deleted or replaced, or where a new paragraph or section is to be added, must be unambiguously identified.
 - The location can be identified by using a few words at the beginning and/or the end of the paragraph or section.
- Do not underline the text of a new paragraph or section
- Deletion of a paragraph or section must only include an instruction to delete, and the location of the paragraph or section.
- Replacement paragraph or section must be a marked-up version showing the changes.
- A clean version of any replacement paragraph or section must not be submitted in addition to a marked up version, except when applicant submits a substitute specification.

Amendment Practice – IFW Final Rule

Amendments to Abstract

- An amendment to an abstract is treated like an amendment to the specification.
 - If the changes are minor in nature, submit a replacement abstract with markings to show all changes relative to the immediate prior version.
 - If the abstract is being substantially rewritten, submit a new abstract in clean text (no markings) accompanied by an instruction for the cancellation of the previous abstract.
 - Any new, or replacement, abstract must be submitted on a separate sheet (37 CFR 1.72).

Amendment Practice – IFW Final Rule *Substitute Specification*

- Substitute Specification under 37 CFR 1.125 requires:
 - A statement that the substitute specification includes no new matter.
 - A specification with markings to show all the changes relative to the immediate prior version.
 - A **clean version** (without markings) of the substitute specification.
 - **The requirements of a marked-up version and a clean version have been retained.**

Amendment Practice – IFW Final Rule *Amendments to Drawings*

- Amendment to drawings must include:
 - **Replacement drawing sheet** showing amended figures which include the desired changes, without markings, on a separate sheet in compliance with § 1.84; and
 - **Explanation of the changes** in the remarks, or preferably, in the drawing amendments section, of the amendment paper.
 - **Optional unless required by examiner:**
 - **Annotated drawing sheet** – a marked-up copy of the amended figure(s) with annotations showing the change(s) may be submitted, or required by the examiner.

Amendment Practice – IFW Final Rule *Amendments to Drawings*

- Amendments to Drawings (cont.):
 - Replacement drawing sheet(s) must be identified in top margin as “**Replacement Sheet**”.
 - Annotated drawing sheet(s) must be identified in top margin as “**Annotated Sheet Showing Change(s)**”.
 - This will avoid confusion between a replacement sheet and an annotated sheet.
 - Annotated drawing sheet(s) will not be entered as part of the official drawing(s) for the application.
 - The replacement drawing sheet(s) and annotated drawing sheet(s), if any, should follow the last page of the amendment paper, as attachment(s).

Amendment Practice – IFW Final Rule *Amendments to Drawings*

- Amendments to Drawings (cont.):
 - Proposed drawing correction process is eliminated.
 - Replacement drawing sheet with changes is accepted by examiner, unless otherwise notified by examiner. No further drawing submission is required.
 - If not acceptable, applicants will be notified of any objections or additional requirements.

Amendment Practice – IFW Final Rule *Amendments to Drawings*

- Amendments to Drawings (cont.)
 - Any replacement drawing sheet including amended figures must include all of the figures appearing on the immediate prior version of the sheet.
 - The replacement drawing figure must not be labeled as “amended.”
 - 37 CFR 1.173 now provides for amending drawings in reissue applications in a similar manner.

Amendment Practice – IFW Final Rule *Amendments to Drawings*

- Deletion of a figure requires the following:
 - An instruction to delete the figure;
 - A replacement sheet which does not include the canceled figure, unless no other figure is on the same sheet as the canceled figure;
 - Amendment to the specification to make corresponding changes to the description of the drawings (*e.g.*, deletion of the description of the canceled figure); and
 - If other figures need to be renumbered, those figures also need to be amended with revised figure numbers via replacement drawing sheets.

Amendment Practice – IFW Final Rule *After Final Amendments*

- Any amendment after final (§1.116), or amendment filed with a request for continued examination (RCE) under §1.114, must include markings showing the changes relative to the last entered amendment
 - Do not include markings to show changes relative to any unentered amendment.
 - Applicant should not assume that an after final amendment is entered because after final amendments are not entered as a matter of right (§1.116).

Amendment Practice – IFW Final Rule *After Final Amendments*

- If applicant has not received an advisory action, applicant should check via PAIR, or call the examiner, to determine whether the after final amendment has been entered before filing another after final amendment or an amendment with an RCE.
- If the advisory action has indicated that an after final amendment will be entered upon the filing of an appeal, applicant should assume that the after final amendment is not entered.
 - Any subsequent amendment must include markings showing the changes relative to the last entered amendment, and not the amendment which the advisory action indicated will be entered upon the filing of an appeal.

Amendment Practice – IFW Final Rule *After Final Amendments*

- If applicant wishes to file an RCE after filing more than one after final amendment that has not been entered, applicant is encouraged to file an amendment with the RCE that includes:
 - Instructions not to enter the unentered after final amendments; and
 - All of the desired changes, including changes presented in the unentered after final amendments.
 - The markings must show changes relative to the last entered amendment.
 - A claim listing which includes any unentered claims presented using the status identifier “not entered” (*e.g.*, claims 20-25 (not entered)). Any new claims must be numbered consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not).

Amendment Practice – IFW Final Rule *Treatment of Non-compliant Amendments*

- Applicants will be notified of any amendment paper that is not accepted because the changes do not comply with revised §1.121.
 - For **preliminary amendments and replies to non-final Office actions or notices**,
 - A Notice of Non-Compliant Amendment identifying the problem section(s) will be mailed; and
 - A period for reply shall be given; but
 - PTA reductions may be incurred. See §1.704(c)(7)
 - For **after-final amendments** (see also slides 26-28),
 - Non-compliance will be indicated in an advisory action; and
 - The time period for reply continues to run from the mailing date of the final Office action.
 - See MPEP 714.03 (8th Ed. 1st Rev., Feb. 2003).

Amendment Practice – IFW Final Rule

Treatment of Non-compliant Amendments

- The Notice of Non-Compliant Amendment will identify:
 - Each section of the amendment that is not in compliance with 37 CFR 1.121;
 - Items that are required for compliance; and
 - The reasons why the section of the amendment fails to comply with 37 CFR 1.121.
- In reply to the Notice, applicants must submit the **corrected section of the amendment** that was non-compliant.
 - Re-submission of the entire amendment is not required.
 - The entire section, however, with corrections, must be resubmitted.
- The Office will only enter the sections of the amendment that are in compliance with 37 CFR 1.121.

Amendment Practice – IFW Final Rule *Treatment of Non-compliant Amendments*

- Non-compliant claim amendment example:
 - If an amendment includes:
 - (1) amendments to the specification, and
 - (2) amendments to the claims, including adding new claims 21 – 25,
 - But the amendments to the claims were non-compliant,
 - Because the claim listing did not include a status identifier for each claim,
 - A Notice of Non-Compliant Amendment will be mailed.

Amendment Practice – IFW Final Rule

Replying to Notices of Non-Compliant Amendments

- Non-compliant claim amendment example continued:
 - In reply to the Notice, applicant must submit a **corrected claim listing** that includes a status identifier for each claim.
 - The new claims 21-25 must be presented with the status identifier of “new” and the text of the claims not underlined.
 - Note: the new claims 21-25 must not be presented with the status identifier of “not entered” and must not be renumbered as claims 26-30.
 - A non-compliant amendment is different than an unentered after final amendment situation.
 - In the after final situation, the claim numbers of any unentered new claims may not be re-used.

Amendment Practice – IFW Final Rule

Replying to Notices of Non-Compliant Amendments

- Non-compliant claim amendment example continued
 - The Office would enter:
 - The amendments to the specification from the original amendment paper, and
 - The amendments to the claims that include the corrected claim listing from the paper filed in reply to the Notice.

Amendment Practice – IFW Final Rule

Amendments filed in International Applications

- The revised amendment practice under 37 CFR 1.121 does not apply to amendments filed in the international stage of an international application.
 - Such amendments must be in compliance with the Patent Cooperation Treaty (PCT) amendment procedure (*i.e.*, PCT Articles 19 and 34(2)(b)).
 - Thus, status identifiers are not to be used during the international stage.
- Amendments filed in the national stage (pursuant to 35 U.S.C. 371) of an international application must comply with the revised amendment practice under 37 CFR 1.121.
 - The status identifier “original” must only be used for claims that were presented on or before the international filing date and have not been modified or canceled.

Amendment Practice – IFW Final Rule ***Information Contacts***

Any questions regarding the submission of amendments pursuant to the revised practice should be directed to Office of Patent Legal Administration (OPLA):

Call (703) 305-1616,

e-mail to Patent.Practice@USPTO.gov, or

Contact one of the following Legal Advisors:

Elizabeth Dougherty (elizabeth.dougherty@uspto.gov)

Eugenia Jones (eugenia.jones@uspto.gov)

Joe Narcavage (joseph.narcavage@uspto.gov)

Further Information Contacts

- Image File Wrapper - <http://www.uspto.gov/web/patents/ifw/>
- Recent Patent-Related Notices (published in O.G., F.R., etc.)-
<http://www.uspto.gov/web/offices/pac/dapp/ogsheet.html>
- Questions of a General Nature - Inventors Assistance Center- 800-PTO(786)-9199
- Electronic Business Center – Customer Numbers, PAIR, EFS -
<http://www.uspto.gov/ebc/> or (703) 305-3028
- The American Inventors Protection Act of 1999 in general-
<http://www.uspto.gov/web/offices/dcom/olia/aipa/index.htm>

Thank you

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