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Re: Patent Processing (Updating) 0651-0031, comment request., 77 Fed. Reg. 16813-17 (Mar. 22, 2012), <http://www.gpo.gov/fdsys/pkg/FR-2012-03-22/pdf/2012-6888.pdf>

Dear Ms. Fawcett and Mr. Fraser:

I am submitting these comments on all of the above-captioned notices of proposed rulemaking ("NPRM").

**I. 37 CFR § 1.52(e) and § 1.96 should be revised to only require what is needed rather than impede applicants with computer program-related inventions.**

Generally, 35 U.S.C. Sec. 112 provides for filing a patent application with a specification that shall contain a written description of the invention and of the manner and process of making and using it. 37 CFR § 1.52(e) and § 1.96 impose uniquely obstructive requirements for superfluous, trivial, or useless information, thereby impeding individuals with computer program-related inventions from pursuing patents as set forth below.

**A. Pointless Duplication**

37 CFR § 1.52(e)(3)(ii) requires, in relevant part, that "*the transmittal letter* must list for each compact disc the machine format (*e.g.*, IBM-PC, Macintosh), the operating system compatibility (*e.g.*, MS-DOS, MS-Windows, Macintosh, Unix), a list of files contained on the compact disc including their names, sizes in bytes, and dates of

creation, plus any other special information that is necessary to identify, maintain, and interpret (e.g., tables in landscape orientation should be identified as landscape orientation or be identified when inquired about) the information on the compact disc.”

37 CFR § 1.52(e)(5) requires that *the specification* shall contain “the names of the files contained on each of the compact discs, their date of creation and their sizes in bytes.”

Requiring that the same information be provided twice (in both the transmittal letter and in the specification) in the same filing is, of course, wholly duplicative and simply an unnecessary burden on applicants.

#### **B. Requiring Disabling of Enabling Disclosures Makes No Sense**

37 CFR 1.52(e) requires that all files on the discs be in ASCII. However, by removal of non-ASCII files, e.g., graphic files, acoustic files, etc., computer programs with non-ASCII files are disabled. Thus, in the absence of this Rule, one could have copied a disk at the PTO and executed the code at their location to see how disclosed invention operates; under the Rule, one can no longer see an operable embodiment. A Rule that requires disabling an otherwise enabling disclosure is ridiculous, contrary to Sec. 112, and completely unnecessary.

If the PTO is concerned about identifying what is on the disks or identifying ASCII files, such considerations do not necessitate removal of non-ASCII files. It is just needless work for an applicant and a disincentive to pursue a patent.

The Rule impedes applicants with computer program-related inventions with a uniquely obstructive requirement.

#### **C. Requiring Unnecessary Information**

It is understandable and justifiable that the PTO would require sufficient identifying information on a disk to allow association of the disk with a particular patent application and to ensure that what is on the disk is readable to the extent that the PTO can evaluate what has been filed. Sometimes, however, it is particularly important to see a program operate, as contrasted with reading remaining portions of the computer program that are written in ASCII.

In any case, there is no need to remove non-ASCII files, and to provide for all files, their names, sizes in bytes, and dates of creation; nor is it necessary to provide “tables in landscape orientation should be identified as landscape orientation or be identified when inquired about” - this is all needless for Sec. 112 or for carrying out any of the above-mentioned justifications.

It is similarly unnecessary to require disclosure of operating system compatibility (e.g., MS-DOS, MS-Windows, Macintosh, Unix). Many programs provide tool sets, e.g., for Windows, that will open files of essentially whatever is on a disk, so such Rule necessitating ASCII is Byzantinely unnecessary. Put simply, ASCII is not the only solution to being able to read what is filed.

However, requiring applicants to provide unnecessary and obtuse information in the specification is costly to the applicant. The applicant must pay the per page cost for lengthy patent applications, having an exorbitant length necessitated solely by PTO Rules for unnecessary information. See, e.g., published patent application Ser. No. 11/219,336, issuing on June 6, 2012 as U.S. Patent No. 8,195,495. Also there is the added patent attorney/agent cost for providing this unnecessary information, altogether impeding inventors from pursuing patents for computer program-related inventions.

Applicants that file disks with non-ASCII files face harsh consequences, as illustrated by a PTO communication dated 12/30/2010 in Ser. No. 61/460,389:

“If applicant wishes to have the information that was submitted on the CD, or as text files via EFS-Web, entered as part of the application, applicant is required to file within TWO MONTHS from the mailing of this notice: (1) a grantable petition under 37 C.F.R. 1.183 (showing an extraordinary situation where justice requires suspension of 37 C.F.R. 1.52(e) or EFS-Web requirements and 37 C.F.R. 1.52(a)(5); and (2) a substitute specification(excluding claims) and a statement that the substitute specification includes no new matter...

If the disks associated with the patent application are readable, there is no need to add uniquely obstructive requirements for superfluous, trivial, or useless information.

#### **D. Conflict with PCT Rules**

37 CFR 1.96 limits the number of lines of code in the specification, but there is no such requirement for a PCT patent application. The US rule should be harmonized with the PCT rules to allow however many lines as an applicant desires, as the extra page fee is sufficient in all cases. There is no need to limit the disclosure in the US or US national applications.

If the PTO is concerned about the readability of patent applications, it should not require that the specification contain “the names of the files contained on each of the compact discs, their date of creation and their sizes in bytes,” which is not particularly enlightening, while requiring removal of lines of code that one having ordinary skill in the art could easily read and understand.

If an application has more than 300 lines of code, 37 CFR 1.96 requires that it be filed on disks, and requirements made for information on the disk are not the same as requirements for the same disclosure when included in the specification, e.g., for all files, “their date of creation and their sizes in bytes.” Again, this added requirement to that which is permissible in the PCT should be harmonized out of the US rule. There should be no further limitation put on information that is located in the appendix rather than in the specification. Further, an application can comply with the PCT rules, reach the US national stage, and then be non-compliant with 37 CFR 1.96, so as to now require the

code be on disks. However, the added requirements for the files to have “their date of creation and their sizes in bytes” could well be new matter, or if the code was written but not put on disk previously, the dates of creation would be subsequent to the filing date of the patent application.

37 CFR § 1.52(e) and 1.96 provide uniquely obstructive requirements on patent applications for computer program-related inventions by requiring superfluous, trivial, or useless information.

## **II. Conclusion**

The requirements of Sec. 112 should not be compromised or undercut by 37 CFR § 1.52(e) and § 1.96, i.e., by requiring a disabling an enabling disclosure. Further, applicants for computer program-related inventions should not be made subject to impediment due to the subject matter of their inventions by Rules requiring superfluous, trivial, or useless information. Rules 37 CFR § 1.52(e) and § 1.96 should therefore be revised.

Respectfully submitted,



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