

The Procedure for Amending the Application under § 1.121

Presented by

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§ 1.121(b) - Amendment by Replacement Paragraph/Section

How to make amendments to the specification:

- Submit a clean (with no underlining or bracketing) amended paragraph/section with an instruction to substitute it for the pending paragraph/claim (**See FORMAT Slide**)
- Identify the pending paragraph/section to be replaced by any clear instruction (e.g., paragraph [0045], the paragraph beginning on page x, line y; the 3rd full paragraph on p.3, etc.)
- Also submit a marked-up version of the prior pending paragraph/section with all changes (relative to the prior paragraph) shown by any conventional comparison system

§ 1.121(b) - Amendment by Replacement Paragraph/Section

How to make amendments to the specification (cont.):

- The text of any added (new) or deleted paragraph does not have to be presented in any marked-up version (with underlining and bracketing); an indication that the paragraph has been added or deleted is sufficient, e.g., “The paragraph beginning at p. 2, line 6, has been deleted.”
- A substitute specification may be submitted for extensive amendments, but it must comply with § 1.125

§ 1.121(c) - Amendment by Replacement Claims

How to make amendments to the claims:

- Submit a clean (with no underlining and bracketing) amended claim with an instruction to substitute it for the pending claim with the same number; also submit a marked-up version of the prior pending claim with all changes shown by any conventional comparison system (**See FORMAT Slide**)
- Any new or canceled claim does not have to be in marked-up version; an indication that claim X is new or claim Y was canceled is sufficient
- Both the clean amended claim and the marked-up version should have the same expression: “amended,” “twice amended,” etc., in parentheses after claim number

§1.121(c)(3) - Amendment by Replacement Claims

How to make amendments to the claims (cont.):

- A clean set of all pending claims with the same numbers as the pending claims being re-presented can be submitted at any time (provided the requirements of §§ 1.116 and 1.312 are met)
- This submission will be construed as directing the cancellation of all previous versions of the re-presented claims
- The absence of an accompanying marked up version constitutes an assertion that the claim has not been changed relative to the immediate prior version

§ 1.121(c) - Amendment by Replacement Claims

How to make amendments to the claims (cont.):

- A claim may be canceled by an instruction (e.g., “cancel claim 3”)
- A canceled claim can be reinstated only by re-presentation of the complete text of the claim with a new claim number

FORMAT SLIDE

Recommended Format for Submitting Amendments with Replacement Paragraphs/Sections/Claims

- The following **FORMAT** is recommended for the amendment portion of the amendment paper:
 - First: A clean version of each replacement paragraph/section/claim along with clear instructions for entry
 - Second: Starting on a separate page, all appropriate remarks/arguments, 37 CFR 1.111 and MPEP 714
 - Third: starting on a separate page, a marked-up version entitled: **“Version with markings to show changes made”**

Amendment by Replacement Paragraphs/Claims

37 CFR 1.121(g)

Examiner's Amendment Practice

To encourage continued use of current examiner's amendment practice in order to expedite prosecution, and reduce applicant filings of formal amendments to incorporate agreed upon changes:

- At the time of allowance, examiners will not be required to provide either a clean version or a separate marked-up version of paragraph(s) or claim(s) amended by an examiner's amendment
- Amendment(s) to paragraph(s)/claim(s) in an examiner's amendment can be made by instruction to insert/delete specific word(s)

Amendment by Replacement Paragraphs/Claims

37 CFR 1.121(g)

Examiner's Amendment Practice (cont.)

- A clean version of a paragraph/claim, or a portion of a paragraph/claim, submitted by applicant in a fax or e-mail may be printed and incorporated into an examiner's amendment. A copy of the entire fax or e-mail should be printed and made of record as an attachment to the examiner's amendment.
- The examiner should mark the fax or e-mail attachment "requested" (in the same area as entry instructions are marked), then initial, so as to not cause a reduction of any patent term adjustment (37 CFR 1.704(c)(8)).
- As the attachment is made a part of the examiner's amendment, it does not get a separate PALM code. This precludes it from causing a reduction in any patent term adjustment.
- The electronic version of any e-mail submission will not be saved once printed version becomes part of the application record.

Amendment Practice

37 CFR 1.121

HOW TO TREAT NON-COMPLIANT AMENDMENTS:

- **For non-compliant preliminary or non-final amendment, LIE should send Notice of Non-Compliant Amendment Form to applicant**
- **For non-compliant after-final amendment, examiner should handle via advisory action; do not use Notice of Non-Compliant Amendment Form**
- **Examiner may not waive clean version requirement; examiner may approve entry without marked-up version if its absence does not impede continuation of examination**

§ 1.125 - Substitute Specification

- Substitute specification must be submitted in clean form and must be accompanied by marked up version showing changes
- Paragraphs should be numbered as per § 1.52(b)(6) to facilitate amendment practice (§ 1.121); not necessary to show numbers as changes in marked up version