DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Parts 1, 3, 5, and 7

[Docket No. 960606163–6163–01]

RIN 0651–AA80

1996 Changes to Patent Practice and Procedure

AGENCY: Patent and Trademark Office, Commerce.

ACTION: Notice of proposed rulemaking.

SUMMARY: The Patent and Trademark Office (Office) is proposing to amend the rules of practice in patent cases to simplify the requirements of the rules, rearrange portions of the rules for better context, and eliminate unnecessary rules or portions thereof as part of a government-wide effort to reduce the regulatory burden on the American public. The procedure for filing of continuation and divisional applications would be simplified. Another type of simplification being proposed that would affect several rules is the acceptance of a statement that errors were made without deceptive intent, unaccompanied by any further showing of facts and circumstances. The naming of inventors would no longer be required on filing of the application in order to obtain a filing date, which would eliminate the need for certain petitions to correct inventorship.

DATES: Written comments must be received on or before November 22, 1996, to ensure consideration.

Comments will be available for public inspection after receipt and will be available on the Internet (address: regreform@.uspto.gov). Commentators should note that since their comments will be made publicly available, information that is not desired to be made public, such as the address and phone number of the commentator, should not be included in the comments. A public hearing will not be conducted.

ADDRESSES: Comments should be sent by mail message over the Internet addressed to regreform@.uspto.gov.

Comments may also be submitted by mail addressed to: Box Comments—Patents, Assistant Commissioner for Patents, Washington, DC 20231, Attention: Jeffrey V. Nase or by FAX to (703) 308–6916. Although comments may be submitted by mail or FAX, the Office prefers to receive comments via the Internet. Where comments are submitted by mail, the Office would appreciate the comments to be electronically filed on a DOS formatted 3¼ inch disk along with a paper copy of the comments.

The comments will be available for public inspection in Suite 520, of One Crystal Park, 2011 Crystal Drive, Arlington, Virginia.

FOR FURTHER INFORMATION CONTACT: Hiram H. Bernstein, by telephone at (703) 305–9285 or by mail addressed to: Box Comments—Patents, Assistant Commissioner for Patents, Washington, DC 20231 marked to the attention of Mr. Bernstein or by FAX to (703) 308–6916.

SUPPLEMENTARY INFORMATION: This proposed rule change seeks to implement President Clinton's program of reducing the regulatory burden on the American public, which program is supported by the Office as published in the *Official Gazette* on June 6, 1995. 1175 *Off. Gaz. Pat. Office* 19, 20 and 22. The proposed changes are directed towards: (1) Simplification of procedures for filing continuation and divisional applications, establishing lack of deceptive intent in reissues, petition practice, and in the filing of papers correcting improperly requested small entity status; (2) elimination of unnecessary requirements, such as certain types of petitions to correct inventorship under § 1.48; (3) removal of rules and portions thereof that merely represent instructions as to the internal affairs of the Office more appropriate for inclusion in the Manual of Patent Examining Procedure (MPEP); (4) rearrangement of portions of rules to improve their context; and (5) clarification of rules to aid in understanding of the requirements that they set forth.

The Office is particularly interested in comments as to whether the proposed rules if adopted should be applied to already pending reissue oaths or declarations under the new proposed standards of § 1.175 as it is to be amended under the final rule and already pending petitions and papers under §§ 1.28(c)(2), 1.48 and 1.324 as they are to be amended under the final rule for such papers submitted prior to the effective date of any final rule change, *i.e.*, should the advantages proposed by these suggested rule changes that are incorporated into the final rule be applied retroactively to papers submitted prior to the effective date of the final rule.

Discussion of Specific Rules

If Title 37 of the Code of Federal Regulations, Parts 1, 3, 5 and 7 are amended as proposed:

Section 1.4(d) paragraphs (1) and (2) would be amended to place the current subject matter of both paragraphs into paragraphs (d)(1) (i) and (ii) with a clarifying reference in paragraph (d)(1)(ii) to the submission of a copy of a copy.

Paragraph (d)(2) of § 1.4 would be amended so that the certifications set forth in the rule would be automatically made upon presenting any paper to the Office by the party presenting the paper and in an added paragraph (d)(3)(ii) identifying by the statute, 18 U.S.C. 1001 that sets forth the required standards of conduct. Sanctions would be set forth in a § 1.4(d)(3)(i) for violation of the certifications in § 1.4(d)(2) and for violations of the standards of conduct in § 1.4(d)(3)(ii).

The proposed amendments to § 1.4(d) would support proposed amendments to §§ 1.6, 1.8, 1.10, 1.27, 1.28, 1.48, 1.52, 1,55, 1.69, 1.102, 1.125, 1.137, 1.377, 1.378, 1.804, 1.805, (1.821 and 1.825 will be reviewed at a later date in connection with other matters), 3.26, and 5.4 that would delete the requirement for verification (MPEP 602) of statements of facts by applicants and other parties who are not registered to practice before the Office. The absence of a required verification has been a source of delay in the prosecution of applications, particularly where such absence is the only defect noted. The proposed change to § 1.4(d) would automatically incorporate required averments thereby eliminating the necessity for a separate verification for each statement of facts that is to be presented, except for those instances where the verification requirement is retained. Similarly, the proposed amendments to § 1.4(d) would support a proposed amendment to §§ 1.97 (§§ 1.637 and 1.673 will be reviewed at a later date in connection with other matters) that would change the requirements for certifications to requirements for statements. The oath or declaration under §§ 1.63 and affidavits under §§ 1.131 and 1.132 would not be affected. The requirement in § 5.25(a)(3) for a verified statement would be maintained, as the required explanation must include a showing of facts (evidence), not mere allegations, which will be weighed by the official deciding the petition for retroactive license. The statements in §§ 1.494(e) and 1.495(f) that verification of translations of documents filed in a language other than English may be required would be maintained, as such requirements are made rarely and only when deemed necessary (when persons persist in translations which appear on their face to be inaccurate, for example). The requirements for certification of service on parties in §§ 1.248, 1.510, 1.637 and 10.142 would be maintained.

Section 1.4 would also have a new paragraph (g) related to an applicant who has not made of record a registered attorney or agent being required to state whether assistance was received in the preparation or prosecution of a patent application. This is proposed to be transferred from § 1.33(b) for consistent contextual purposes.

Section 1.6 paragraph (e)(2) would be amended to remove the requirement that the statement be verified in accordance with the proposed change to § 1.4(d)(2).

Section 1.8 paragraph (b)(3) would be amended to remove the requirement that the statement be verified in accordance with the proposed change to § 1.4(d)(2).

Section 1.10 would be amended to remove the requirement for a statement that is verified. See comments to § 1.4(d). It is also proposed to clarify the section by substitution of ''averring to the fact'' with ''stating.''

Section 1.14 would have the title and paragraphs (a) and (e) amended to replace the term ''secrecy'' by ''confidence'' to conform to the usage in 35 U.S.C. 122. Paragraph (a) of § 1.14 would have a reference to serial number changed to application number. Section 1.14 would also be amended to have paragraph (f) added to recognize the proposed change to § 1.47 (a) and (b) that are also exceptions to maintaining pending applications in confidence by providing public notice of the prospective issuance of a pending application to nonsigning inventors.

Section 1.17 (and § 1.136(a)) would add a recitation to an extension of time fee payment for a reply filed within a fifth month after a nonstatutory or shortened statutory period for reply was set. Section 1.17(a) is specifically proposed to be subdivided into paragraphs (a)(1) through (a)(5), with paragraphs (a)(1) through (a)(4) setting forth the amounts for one-month through four-month extension fees proposed in Revision of Patent Fees for Fiscal Year 1997, 1186 *Off. Gaz. Pat. Office* 14 (May 7, 1996); 61 FR 19224 (May 1, 1996). Paragraph (a)(5) would provide the small and other than small entity amounts for the newly proposed fifth-month extension fee. Sections 1.17 (b), (c) and (d) are proposed to be removed as unnecessary in view of proposed § 1.17 (a)(1) through (a)(5).

Fee levels, as proposed by the Revision of Patent Fees for Fiscal Year 1997, were used in establishing the fifth-month extension of time fees for large and small entities for paragraph (a)(5) of § 1.17. A shortened statutory period for reply of one month may be set, thereby allowing a fifth month for reply within the six-month statutory period for response. Section 1.17(a) is being amended to recognize the availability of a fifth-month extension of time when a one-month or a thirty-day shortened statutory period is set (*e.g.*, in a written requirement for restriction). The addition of a fifth-month would then also become available for replies with nonstatutory periods of time set, such as for replies to Notices to File Missing Parts of Applications.

Section 1.17(i), as proposed, would: add a petition fee under § 1.59 for expungement and return of papers, delete the references to petitions under §§ 1.60 and 1.62 to accord a filing date in view of the proposed deletion of §§ 1.60 and 1.62, and to change ''divisional reissues'' to ''multiple reissue applications.'' Moreover, § 1.17, as well as §§ 1.103, 1.112, 1.113, 1.133, 1.134, 1.135, 1.136, 1.142, 1.144, 1.146, 1.191, 1.192, 1.291, 1.294, 1.484, 1.485, 1.488, 1.494, 1.495, 1.530, 1.550, 1.560, (1.605, 1.617, 1.640, and 1.652 will be reviewed at a later date in connection with other matters), 1.770, 1.785, (1.821 will be reviewed at a later date in connection with other matters), and 5.3, would replace the phrases ''response'' and ''respond'' with ''reply'' for consistency with § 1.111.

Section 1.21(n), as proposed, would delete the reference to an improper application under §§ 1.60 or 1.62 in view of the proposed deletion of §§ 1.60 and 1.62.

Section 1.26(a) is proposed to be amended to better track the statutory language of 35 U.S.C. 42(d) by deleting ''[m]oney'' and ''actual,'' adding ''fee'' and adding back language relating to refunds of fees paid that were not ''required'' that was inadvertently dropped in the July 1, 1993, publication of title 37 CFR, and from subsequent publications.

Section 1.27 (a) through (d) would be amended to remove the requirement that a statement filed thereunder be ''verified.'' See comments relating to § 1.4(d). Section 1.27(b) is proposed to be amended for clarification with the movement of a clause relating to ''any verified statement'' within a sentence.

Section 1.28(a) would be amended to remove the requirement for a statement that is ''verified.'' See comments relating to § 1.4(d).

Section 1.28(a) would also be amended to provide that a new small entity statement would not be required for reissue or continued prosecution (§ 1.53(b)(3)) applications where small entity status is still proper and reliance is had on a reference to a small entity statement filed in a prior application or patent or a copy thereof is supplied.

Section 1.28(a) would be further amended to state that the payment of a small entity basic statutory filing fee in a nonprovisional continuing application, which claims benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) of a prior application or in a continuing prosecution application, or in a reissue application, wherein the prior application or the patent has small entity status, will substitute for the reference in the continuing or reissue application to the small entity statement in the prior application or in the patent, thereby establishing small entity status in such nonprovisional application.

Section 1.28(a) is also amended to require a new determination of continued entitlement to small entity status for continued prosecution applications filed under § 1.53(b)(3) and to clarify that the refiling of applications as continuations, divisions and continuation-in-part applications and the filing of reissue applications also require a new determination of continued entitlement to small entity status prior to reliance on small entity status in a prior application or patent.

Section 1.28(c) would have the requirement removed for a statement of facts explaining how an error in payment of small entity fees occurred in good faith and how and when the error was discovered. A fee deficiency payment based on the difference between fees originally paid as a small entity and the current large entity amount at the time of full payment of the fee deficiency will be deemed to constitute a belief by the party submitting the deficiency payment that small entity status was established in good faith and that the original payment of small entity fees was made in good faith. Any paper submitted under § 1.28(c) will be placed in the appropriate file without review after the processing of any check or the charging of any fee deficiency payment specifically authorized.

Section 1.33 would no longer provide that the required residence and post office address of the applicant can appear elsewhere than in the oath or declaration under § 1.63. Section 1.63(a)(3) would be amended to require that the post office address as well as the residence be identified therein and not elsewhere. Permitting the residence to be elsewhere in the application other than the oath or declaration, as in current § 1.33(a), is inconsistent with current § 1.63(c) that states the residence must appear in the oath or declaration. The requirement for placement of the post office address is proposed to be made equivalent to the requirement for the residence to

eliminate confusion between the two, which often are the same destination and are usually provided in the oath or declaration. The reference in § 1.33(a) to the assignee providing a correspondence address has been moved within § 1.33(a) for clarification. Other clarifying language including a reference to § 1.34(b), use of the terms ''provided,'' ''furnished'' rather than ''notified,'' and ''application'' rather than ''case,'' while ''of which the Office'' would be deleted.

Section 1.33(b) would be removed and the subject matter transferred to new § 1.4(g).

Section 1.41(a) (and § 1.53) would no longer require that a patent be applied for in the name of the actual inventors for an application for patent to receive a filing date. The requirement for use of full names would be moved to § 1.63(a) for better context. The requirement for naming of the inventor or inventors would be replaced with only a request that such names or an identifying name be submitted on filing of the application. The use of very short identifiers should be avoided to prevent confusion. Without supplying at least an identifying name that is specific the Office may have no ability or only a delayed ability to match any papers submitted after filing of the application and before issuance of an identifying Application number with the application file. Any identifier used that is not an inventor's name must be specific, alphanumeric characters of reasonable length, and must be presented in such a manner that it is clear to application processing personnel what the identifier is and where it is to be found. It is strongly suggested that applications filed without an executed oath or declaration under § 1.63 or 1.175 continue to use an inventor's name for identification purposes. Failure to apprise the Office of the application identifier being used will result in applicants having to resubmit papers that could not be matched with the application and proof of the earlier receipt of such papers where submission was time dependent.

Paragraph (a) of § 1.41 would also be amended to recite that the actual inventor or inventors of an application are set forth in an executed § 1.63 oath or declaration to correspond to the proposed change in § 1.53(b)(1)(iii). Hence, the recitation of the inventorship in an application submitted under § 1.53(d) without an executed oath or declaration for purposes of identification may be changed merely by the later submission of an oath or declaration executed by a different inventive entity without recourse to a petition under § 1.48.

Section 1.47 would be amended to provide for publication in the Official Gazette of a notice of filing for all applications submitted under this section rather than only when notice to the nonsigning inventor(s) is returned to the Office undelivered or when the address of the nonsigning inventor(s) is unknown. The information to be published includes: The Application number, filing date, invention title and inventors identifying the missing inventor.

Section 1.47 would also be amended for clarification purposes. A reference to an ''omitted inventor'' in § 1.47(a) would be replaced with ''nonsigning inventor.'' Statements in §§ 1.47 (a) and (b) that a patent will be granted upon a satisfactory showing to the Commissioner would be deleted as unnecessary. Section 1.47(b) is proposed to be amended to clarify that it applies only where *none* of the inventors are willing or can be found to sign the Declaration by substitution of ''an inventor'' by ''all the inventors.'' The use of ''must state'' in regard to the last known address would be deleted as redundant in view of the explicit requirement for such address in the rule. The sentence in § 1.47(b) referring to the filing of the assignment, written agreement to assign or other evidence of proprietary interest would be deleted as redundant in view of the requirement appearing earlier in § 1.47(b) calling for ''proof of pertinent facts.''

Section 1.48 for inventorship corrections in an application (§ 1.324, for inventorship corrections in a patent, and § 1.175, for reissue declarations) would no longer require factual showings to establish a lack of deceptive intent. All that will be needed is a statement to that effect.

Section 1.48 would be amended in its title to clarify that the section is related to patent applications as opposed to patents.

Section 1.48(a) would not require correction of the inventorship if the inventorship or other identification under § 1.41 was set forth in error on filing of the application. Section 1.48(a) is proposed to be amended to apply only to correction of inventor or inventors from that named in an originally filed executed oath or declaration and not to the naming of inventors or others for identification purposes as is currently proposed under § 1.41. The statement to be submitted would be required only from the person named in error as an inventor or from the person who through error was not named as an inventor rather than from all the original named inventors so as to comply with 35 U.S.C. 116. The present requirement that any amendment of the inventorship under § 1.48(a) be ''diligently'' made would be removed. The applicability of a rejection under 35 U.S.C. 102(f)/(g) against an application with the wrong inventorship set forth therein and any patent that would issue thereon is deemed to provide sufficient motivation for prompt correction of the inventorship without the need for a separate requirement for diligence.

A clarifying reference to § 1.634 would be added in § 1.48(a) for instances when inventorship correction is necessary during an interference and has been moved from § 1.48(a)(4) for improved contextual purposes.

The § 1.48(a)(1) statement would require a statement only as to the lack of deceptive intent rather than a statement of facts to establish how the inventorship error was discovered and how it occurred, since the latter is proposed to be deleted. Additionally, the persons from whom a statement is required now includes any person not named in error as an inventor but limits statements from the original named inventors to only those persons named in error as inventors rather than all persons originally named as inventors including those correctly named. The paragraph would be amended to remove the requirement that the statement be verified in accordance with the proposed change to § 1.4(d)(2).

Section 1.48(a)(2) would be amended for clarification purposes to indicate the availability of §§ 1.42, 1.43 or 1.47 in meeting the requirement for an executed oath or declaration under § 1.63 from each actual inventor. Section 1.47 would only be applicable to the person to be added as an inventor (inventors named in an application transmittal letter can be deleted without petition). For those persons already having submitted an executed oath or declaration under § 1.63, a petition under § 1.183, requesting waiver of reexecution of an oath or declaration, may be an appropriate remedy. The requirement for an oath or declaration is maintained in § 1.48(a) notwithstanding its replacement in § 1.324 for issued patents by a statement of agreement or lack of disagreement with the requested change in view of the need to satisfy the duty of disclosure requirement in a pending application that is set forth in a § 1.63 oath or declaration.

Section 1.48(a)(4) would be amended to include a citation to § 3.73(b) to clarify the requirements for submitting a written consent of assignee, which is subject to the requirement under § 3.73(b), and to delete the reference to an application involved in an interference, which is being moved to

§ 1.48(a). Section 1.48(a)(4) would also be amended to clarify that the assignee required to submit its written consent is only the existing assignee of the original named inventors at the time the petition is filed and not any party that would become an assignee based on the grant of the inventorship correction.

Section 1.48(b) would also be amended to remove the requirement that a petition thereunder be diligently filed. The applicability of a rejection under 35 U.S.C. 102(f)/(g) against an application with the wrong inventorship set forth therein and any patent that would issue thereon is deemed to provide sufficient motivation for prompt correction of the inventorship without the need for a separate requirement for diligence.

Section 1.48(b) would have a clarifying reference to § 1.634 added for instances when inventorship correction is necessary during an interference.

Section 1.48(c) would be amended so that a petition thereunder no longer need meet the current requirements of § 1.48(a), which are also proposed to be changed. A statement from each inventor being added that the inventorship amendment is necessitated by amendment of the claims and that the error occurred without deceptive intent would be required under § 1.48(c)(1) rather than the previous requirement of a statement from each original named inventor. The previous requirements under § 1.48(a) for an oath or declaration, the written consent of an assignee and the written consent of any assignee are retained, but are now separately set forth in §§ 1.48(c)(2) through (c)(4). The particular circumstances of a petition under this paragraph, adding an inventor due to an amendment of the claims that incorporates material attributable to the inventor to be added, is seen to be indicative of a lack of deceptive intent in the original naming of inventors. Accordingly, all that must be averred to is that an amendment of the claims has necessitated correction of the inventorship and that the inventorship error existing in view of the claim amendment occurred without deceptive intent. The current requirement for diligence in filing the petition based on an amendment to the claims would not be retained as applicants have the right, prior to final rejection or allowance, to determine when particular subject matter is to be claimed. Applicants should note that any petition under § 1.48 submitted after allowance is subject to the requirements of § 1.312, and a petition submitted after final rejection is not entered as a matter of right. The statement of facts must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office.

Section 1.48(c)(2) would clarify the availability of §§ 1.42, 1.43 and 1.47 in meeting the requirement for an executed oath or declaration under § 1.63. Section 1.47 would only be applicable to the person to be added as an inventor. For those persons already having an executed oath or declaration under § 1.63 a petition under § 1.183, requesting waiver of reexecution of an oath or declaration, may be an appropriate remedy.

Section 1.48(c)(4) would clarify that the assignee required to submit its written consent is only the existing assignee of the original named inventors at the time the petition is filed and not any party that would become an assignee based on the grant of the inventorship correction. A citation to § 3.73(b) would be presented.

Section 1.48(d) would be amended by addition of ''their part'' to replace ''the part of the actual inventor or inventors'' and of ''omitted'' to replace ''actual'' to require statements from the inventors to be added rather than from all the actual inventors so as to comply with 35 U.S.C 116. Section 1.48(d)(1) would also be clarified to identify the error to be addressed is the inventorship error. It is not expected that the party filing a provisional application will normally need to correct an error in inventorship under this paragraph by adding an inventor therein except when necessary under § 1.78 to establish an overlap of inventorship with a continuing application. Automatic correction of the inventorship is not possible as is the case for nonprovisional applications when an executed oath or declaration under § 1.63 with the correct inventorship is later filed; since an oath or declaration is not to be submitted in provisional applications, § 1.51(a)(2).

Section 1.48(d)(1) would be amended to remove the requirement that the statement be verified in accordance with the proposed change to § 1.4(d)(2).

Section 1.48(e)(1) would be amended to replace a requirement in provisional applications that the required statement be one ''of facts'' directed towards ''establishing that the error'' being corrected ''occurred without deceptive intention,'' thereby requiring only a statement that the inventorship error occurred without deceptive intent. Paragraph (e)(1) would also be amended to remove the requirement that the statement be verified in accordance with the proposed change to § 1.4(d)(2). It is not expected that the party filing a provisional application would need to file a petition under this paragraph since the application will go abandoned by operation of law, § 1.53(e)(2), and the need to delete an inventor will not affect the overlap of inventorship needed to claim priority under § 1.78(a)(3) for any continuing application.

Section 1.48(e)(3) would be amended to clarify that the assignee required to submit its written consent is only the prior existing assignee before correction of the inventorship is granted and not any party that would become an assignee based on the grant of the inventorship correction and a reference to § 3.73(b) would be added.

Section 1.48(f) would be added to provide that the later filing of an executed oath or declaration would act to correct the inventorship without a specific petition for such correction and would be used to issue a filing receipt and process the application notwithstanding any inventorship or other identification name earlier presented.

Section 1.48(g) would be added to specifically recognize that the Office may require such other information as may be deemed appropriate under the particular circumstances surrounding a correction of the inventorship.

Section 1.51(c) covering the use of an authorization to charge a deposit account is proposed to be removed as unnecessary in view of § 1.25(b).

Section 1.52 paragraphs (a) and (d) would be amended to remove the requirement that the translation be verified in accordance with the proposed change to § 1.4(d)(2). Paragraphs (a) and (d) of this section would also be amended to clarify the need for a statement that the translation being offered is an accurate translation, as is also proposed in § 1.69 paragraph (b).

Section 1.53(b)(1), as proposed, would remove: (1) The phrase ''in the name of the actual inventor or inventors as required by § 1.41,'' and (2) the sentence ''[i]f all the names of the actual inventor or inventors are not supplied when the specification and any required drawing are filed, the application will not be given a filing date earlier than the date upon which the names are supplied unless a petition with the fee set forth in § 1.17(i) is filed which sets forth the reasons the delay in supplying the names should be excused.'' These proposed changes are consistent with the proposed change to § 1.41. Section 1.53(b)(1) (and § 1.41(a)) would no longer require that a patent be applied for in the name of the actual inventors for an application for patent to receive a filing date.

Section 1.53(b)(1), as proposed, would change (1) ''[a] continuation or

divisional application (filed under the conditions specified in 35 U.S.C. 120, 121 or 365(c) and § 1.78(a)) may be filed under this section, § 1.60 or § 1.62'' and (2) ''[a] continuation-in-part application may also be filed under this section or § 1.62'' to (1) [a] continuation or divisional application (filed under the conditions specified in 35 U.S.C. 120, 121 or 365(c) and § 1.78(a)) may be filed under this paragraph or paragraph (b)(3) of this section'' and (2) ''[a] continuation-in-part application must be filed under this paragraph, respectively. Upon the deletion of §§ 1.60 and 1.62, any continuation-in-part applications must be filed under § 1.53(b)(1), but a continuation or divisional application may be filed under §§ 1.53(b)(1) or (b)(3).

Section 1.53(b)(1), as proposed, would also add a new paragraph (b)(1)(i) expressly providing that any continuation or divisional application may be filed by all or by less than all of the inventors named in a prior application, and that a newly executed oath or declaration is not required pursuant to §§ 1.51(a)(1)(ii) and 1.53(d) in a continuation or divisional application filed by all or by less than all of the inventors named in a prior application, provided that one of the following is submitted: (1) A copy of the executed oath or declaration filed to complete (§ 1.51(a)(1)) the most immediate prior national application for which priority is claimed under 35 U.S.C. 120, 121 or 365(c), or (2) a copy of an unexecuted oath or declaration, and a statement that the copy is a true copy of the oath or declaration that was subsequently executed and filed to complete (§ 1.51(a)(1)) the most immediate prior national application for which priority is claimed under 35 U.S.C. 120, 121 or 365(c). The phrase ''most immediate prior national application'' is proposed rather than ''prior application'' to accommodate those situations in which the prior application was filed under current §§ 1.60 or 1.62, or where the prior application was itself a continuation or divisional application and filed with a copy of the executed oath or declaration from a prior application pursuant to § 1.53(b)(1)(i). As is currently the situation under §§ 1.60 and 1.62, the applicant's duty of candor and good faith including compliance with the duty of disclosure requirements of § 1.56 is continuous and applies to the continuation, divisional or continued prosecution (§ 1.53(b)(3)) application, notwithstanding the lack of a newly executed oath or declaration. Therefore, applicants should be informed of the intent to file a continuation, divisional or continued prosecution application with a copy of the proposed claimed supplied. New § 1.53(b)(1)(i), as proposed, would also reference § 1.53(d) for the filing of a continuation or divisional application without the concomitant submission of a newly executed oath or declaration or a copy of the oath or declaration for the most immediate prior national application for which priority is claimed under 35 U.S.C. 120, 121 or 365(c).

Section 1.53(b)(1), as proposed, would also add a new paragraph (b)(1)(i)(A) providing that the copy of the executed or unexecuted oath or declaration for the most immediate prior national application for which priority is claimed under 35 U.S.C. 120, 121 or 365(c) must be accompanied by a statement from applicant, counsel for applicant or other authorized party requesting the deletion of the names of the person or persons who are not inventors in the continuation or divisional application. Where the continuation or divisional application and copy of the oath or declaration from the prior application is filed without a statement from an authorized party requesting deletion of the names of any person or persons named in the prior application, the continuation or divisional application will be treated as naming as inventors the person or persons named in the prior application, taking into account any petition for correction of inventorship pursuant to § 1.48 in the prior application that has been granted prior to the filing of the continuation or divisional application. For situations where an inventor or inventors are to be added in a continuation or divisional application see paragraph (ii) under this section.

The statement requesting the deletion of the names of the person or persons who are not inventors in the continuation or divisional application must be signed by person(s) authorized pursuant to § 1.33(a) to sign an amendment in the continuation or divisional application. That is, such a statement must be signed by: (1) All of the inventors in the continuation or divisional application (*see* MPEP 714.01(a)), (2) the assignee of record of the entire interest in the continuation or divisional application in compliance with § 3.73(b) (*see* MPEP 324), (3) an attorney or agent of record, or (4) a registered attorney or agent acting in a representative capacity pursuant to § 1.34(a).

Section 1.53(b)(1)(i), as proposed, would add a new paragraph (B) providing that where the power of attorney or correspondence address was changed during the prosecution of the prior application, the change in power of attorney or correspondence address must be identified in the continuation or divisional application.

Section 1.53(b)(1), as proposed, would add a new paragraph (ii) providing that a newly executed oath or declaration must be filed in a continuation or divisional application naming an inventor not named in the prior application. For situations where an inventor or inventors are to be added in a continuation or divisional application the Office will not require a petition pursuant to § 1.48, but will require only the newly executed oath or declaration naming the correct inventorship in the continuation or divisional application under § 1.53. For deletion of inventors in a continuation or divisional application see § 1.53(b)(1)(i) and (b)(3). New § 1.53(b)(1)(ii), as proposed, would also provide that a newly executed oath or declaration must be filed in a continuation-in-part application, which application may name all, more, or less than all of the inventors named in the prior application.

Section 1.53(b)(1)(iii), as proposed, would clarify that the inventorship is not set forth in an application until an executed oath or declaration is submitted therein in accordance with the proposed change to § 1.41(a). Where the inventorship was voluntarily set forth on filing an application without an executed oath or declaration pursuant to § 1.53(d) for purposes of identification, the actual inventorship of the application will be controlled by the later submission of an executed oath or declaration which may change what was originally identified as the inventorship without recourse to a petition under § 1.48 in accordance with the proposed change to § 1.41(a).

Section 1.53(b)(2), as proposed, would remove the phrase ''in the name of the actual inventor or inventors as required by § 1.41'' and the sentence ''[i]f all the names of the actual inventor or inventors are not supplied when the specification and any required drawing are filed, the provisional application will not be given a filing date earlier than the date upon which the names are supplied unless a petition with the fee set forth in § 1.17(q) is filed which sets forth the reasons the delay in supplying the names should be excused.'' Section 1.53(b)(2) (and § 1.41(a)) would no longer require that a patent be applied for in the name of the actual inventors for an application for patent to receive a filing date.

Section 1.53(b)(2)(ii), as proposed, would change the phrase ''treated as'' to ''converted to'' for clarity.

Section 1.53(b)(3) is proposed to be added to provide for the filing of a continued prosecution application.

Section 532 of the Uruguay Round Agreement Act (Pub. L. 103–465, section 532, 108 Stat. 4809 (1994)) amended 35 U.S.C. 154 to provide that the term of patent protection begins on the date of patent grant and ends on the date 20 years from the filing date of the application. As any delay in the prosecution of the application will reduce the term of patent protection, reducing unnecessary delays in the prosecution of applications is a mutual interest of patent applicants and the Office.

An applicant in a nonprovisional application filed on or after June 8, 1995, must file a continuing application to obtain further examination subsequent to a final rejection or other final action. The current continuing practice under §§ 1.60 and 1.62 of processing an application filed thereunder with a new application number and filing date delays the examination of such continuing applications. Therefore, the Office proposes to eliminate this delay by: (1) Not assigning a new application number to an application filed under § 1.53(b)(3), and (2) not processing the application filed under § 1.53(b)(3) with a filing date of the request for an application under § 1.53(b)(3). Rather, a continued prosecution application would retain the application number and the filing date of the prior application to which it relates for identification purposes thereby allowing examination to proceed without the delays that would be caused by the current need to assign to applications filed under §§ 1.60 and 1.62 a new application number and filing date as of the date the Rule 60 or 62 application was requested (submitted).

Section 1.53(b)(3), as proposed, would specifically provide that: (1) In a complete nonprovisional application (§ 1.51(a)(1)) filed on or after June 8, 1995, a continuation or divisional application that discloses and claims only subject matter disclosed in that prior complete application and names as inventors the same or less than all the inventors named in that prior complete application may be filed under this paragraph, and (2) the filing date of the continued prosecution application, such as for continuity purposes under 35 U.S.C. 120 and § 1.78, is the date on which a request for an application under this paragraph, including identification of the prior application number is filed.

The specific reference to the prior application required by 35 U.S.C. 120 and § 1.78(a)(2) will be satisfied by a sentence that the continued prosecution application is a continuation or divisional, as appropriate, of prior application number ##/###,###, filed ##/##/##, now abandoned, notwithstanding that the so identified application number and filing date are also the application number and filing date assigned to the continued prosecution application under this paragraph. Where the continued prosecution application derives from a chain of § 1.53(b)(3) applications assigned a common application number and filing date, a sentence that the application is a continuation or divisional, as appropriate, of the common application number and filing date will constitute a specific reference (35 U.S.C. 120 and § 1.78(a)(2)) to each application assigned that application number and filing date. Since § 1.53(b)(3) is proposed to be limited to continuations and divisionals, the actual filing date of the request for an application under § 1.53(b)(3) will be relevant only to the copendency requirement of 35 U.S.C. 120 and § 1.78 and patent term *vis-a-vis* Pub. L. 103–465. Nevertheless, § 1.53(b)(3) is proposed to be limited to a continuation or divisional of a complete application filed on or after June 8, 1995, so as to avoid any dispute as to whether the application is subject to 20-year patent term as set forth in Pub. L. 103–465. That is, any continuation or divisional of an application filed prior to June 8, 1995, as well as any continuation-in-part, must be filed under § 1.53(b)(1).

Section 1.53(b)(3)(i)(A), as proposed, would provide that an application under § 1.53(b)(3) (a continued prosecution application) will use the specification, drawings and oath or declaration from the prior complete application and will be assigned its application number for identification purposes.

Section 1.53(b)(3)(i)(B), as proposed, would provide that the filing of a request for a continued prosecution application is a request to expressly abandon the prior application as of the filing date granted the application under § 1.53(b)(3).

Section 1.53(b)(3)(i)(C), as proposed, would provide that a continued prosecution application must be filed before the payment of the issue fee, abandonment of, or termination of proceedings on the prior application with the filing date of a request for a continued prosecution application being the date on which a request for a continued prosecution application including identification of the application number of the prior complete application is filed.

Section 1.53(b)(3)(ii) (A) and (B), as proposed, would provide that filing fee for a continued prosecution application is the statutory basic filing fee as set forth in § 1.16 and any additional fee due based on the number of claims remaining in the application after entry of any amendment accompanying the request for an application under this section and entry of any amendments under § 1.116 unentered in the prior application which applicant has requested to be entered in the new application.

In instances in which a continued prosecution application is submitted without the basic statutory filing fee or any additional claims fee due, the Office will continue to mail a ''Notice of Missing Parts'' under § 1.53(d)(1) and give the applicant a period of time within which to file the fee and to pay the surcharge under § 1.16(e) to prevent abandonment of the application (*see* § 1.53(d)(1)). Thus, the filing of a continued prosecution application without the basic statutory filing fee or any additional claims fee due will result in a delay in the initial processing of the application. An applicant, however, may eliminate or limit this delay by either filing the request for a continued prosecution application with the appropriate filing fee or not delaying the submission of the appropriate filing fee until the mailing of or expiration of the period for response to the ''Notice of Missing Parts.''

Section 1.53(b)(3)(iii), as proposed, would provide that if a continued prosecution application is filed by less than all the inventors named in the prior application, a statement must accompany the application when filed requesting deletion of the names of the person or persons who are not inventors of the invention being claimed in the continued prosecution application. Where an application is filed under § 1.53(b)(3) without a statement requesting deletion of the names of any person or persons named in the prior application, the application will be treated as naming as inventors the person or persons named in the prior application, taking into account any grant of a petition correcting inventorship in the prior application pursuant to § 1.48. To correct the inventorship in the continued prosecution application, the Office will not require a petition pursuant to § 1.48 as the application is to be filed without a newly executed oath or declaration, but will require only a newly executed oath or declaration naming the correct inventorship in the continued

prosecution application, which is similar to the requirements for correction of the inventorship in applications filed under § 1.53(b)(1) without a newly executed oath or declaration.

Section 1.53(b)(3)(iv), as proposed, would require that any new change be made in the form of an amendment to the prior application, and would provide that any new specification filed with the request for an application under § 1.53(b)(3) would not be considered part of the original application papers, but would be treated as a substitute specification in accordance with § 1.125. In the event that legislation mandating the 18-month publication of patent applications (*e.g.*, H.R. 1733) is enacted, it will be necessary to amend proposed § 1.53(b)(3)(iii) to require a substitute specification in compliance with § 1.125 and drawings including only those changes to the prior application during the prosecution of the prior application.

Section 1.53(b)(3)(v), as proposed, would provide that the filing of a continued prosecution application will be construed to include a waiver of confidence by the applicant under 35 U.S.C. 122 to the extent that any member of the public who is entitled under the provisions of § 1.14 to access to, or information concerning either the prior application or any application filed under the provisions of § 1.53(b)(3) may be given similar access to, or similar information concerning, the other application(s) in the file wrapper.

Section 1.53(b)(3)(vi) (A) through (D), as proposed, would provide that the applicant is urged to furnish in the request for an application under § 1.53(b)(3) the following information relating to the prior application to the best of his or her ability: (A) Title as originally filed and as last amended, (B) name of applicant as originally filed and as last amended, (C) current correspondence address of applicant, and (D) identification of prior foreign application and any priority claim under 35 U.S.C. 119.

Section 1.53(b)(3)(vii), as proposed, would provide that envelopes containing only requests and fees for filing an application under § 1.53(b)(3) should be marked ''Box CPA.''

Section 1.53(c), as proposed, would replace its current language with three paragraphs treating: (1) Applications found to be improper or incomplete, (2) any requests for review of a notification that an application has been found to be improper or incomplete, and (3) termination of proceedings in an application for failure to timely correct a filing error or seek review of a notification that an application has been found to be improper or incomplete.

Section 1.53(c)(1), as proposed, would specifically provide that ''[i]f any application filed under paragraph (b) of this section is found to be incomplete or improper, applicant will be so notified and given a time period within which to correct the filing error.''

Section 1.53(c)(2), as proposed, would specifically provide that ''[a]ny request for review of a notification pursuant to paragraph (c)(1) of this section, or a notification that the original application papers lack a portion of the specification or drawing(s), must be by way of a petition pursuant to this paragraph,'' ''[a]ny petition under this paragraph must be accompanied by the fee set forth in § 1.17(i) in an application filed under paragraphs (b)(1) or (b)(3) of this section, and the fee set forth in § 1.17(q) in an application filed under paragraph (b)(2) of this section,'' and ''[i]n the absence of a timely (§ 1.181(f)) petition pursuant to this paragraph, the filing date of an application in which the applicant was notified of a filing error pursuant to paragraph (c)(1) of this section will be the date the filing error is corrected.''

Section 1.53(c)(3), as proposed, would specifically provide that ''[i]f an applicant is notified of a filing error pursuant to paragraph (c)(1) of this section, but fails to correct the filing error within the given time period or otherwise timely (§ 1.181(f)) take action pursuant to paragraph (c)(2) of this section, proceedings in the application will be considered terminated'' and ''[w]here proceedings in an application are terminated pursuant to this paragraph, the application may be returned or otherwise disposed of, and any filing fees, less the handling fee set forth in § 1.21(n), will be refunded.'' Section 1.53(c)(3), as proposed would not provide that proceedings in the application will be considered terminated for failure to timely respond to a notification that the original application papers lack a portion of the specification or drawing(s). Thus, the failure to timely seek review of a notification that the original application papers lack a portion of the specification or drawing(s) will not result in termination of proceedings in (or abandonment of) the application, but will simply result in such portion of the specification or drawing(s) not being considered part of the original disclosure of the application.

Section 1.53(d)(1), as proposed, would change ''paragraph (b)(1) of this section'' to ''paragraphs (b)(1) or (b)(3) of this section,'' such that § 1.53(d)(1) would be applicable to applications filed under §§ 1.53 (b)(1) and (b)(3), where § 1.53(d)(2) would be applicable to applications filed under § 1.53(b)(2) (*i.e.*, provisional applications). While § 1.53(d)(1) addresses both the filing fee and the oath or declaration, the oath or declaration of an application under § 1.53(b)(3) will be the oath or declaration of the prior complete (§ 1.51(a)(1)) application. As such, an oath or declaration will not be required under § 1.53(d)(1) for a proper application under § 1.53(b)(3).

Section 1.53(d)(1), as proposed, would be further amended to add the phrases ''including a continuation, divisional, or continuation-in-part application'' and ''pursuant to §§ 1.63 or 1.175, which may be a copy of the executed oath or declaration filed to complete (§ 1.51(a)(1)) the most immediate prior national application for which priority is claimed under 35 U.S.C. 120, 121 or 365(c), or a copy of an unexecuted oath or declaration, and a statement that the copy is a true copy of the oath or declaration that was subsequently executed and filed to complete (§ 1.51(a)(1)) the most immediate prior national application for which priority is claimed under 35 U.S.C. 120, 121 or 365(c), in a continuation or divisional application'' for clarity and consistency with § 1.53(b)(1). A reference to submission of a copy of a Notice to File Missing Parts would be removed.

Section 1.54(b), as proposed, would add the phrase ''unless the application is an application filed under § 1.53(b)(3).'' To minimize application processing delays in applications filed under § 1.53(b)(3), as proposed, such applications will not be processed by the Office of Initial Patent Examination as new applications.

Section 1.55 paragraph (a) would be amended to remove the requirement that the statement be verified in accordance with the proposed change to § 1.4(d)(2).

Section 1.59 would be amended: By revising the title to indicate that expungement of information from an application file would come under this section, by revising the existing paragraph and designating it as paragraph (a)(1), and by adding paragraphs (a)(2), (b) and (c). Paragraph (a)(1) would retain the general prohibition on the return of information submitted in an application which has a filing date. The portion of the paragraph relating to the Office furnishing copies of application papers has been shifted to new paragraph (c). Paragraph (a)(2) would make explicit that information, forming part of the original disclosure, i.e., written

specification, drawings, claims and any preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175, will not be expunged from the application file.

Paragraph (b) of § 1.59 would provide an exception to the general prohibition of paragraph (a) on the expungement and return of information and would allow for such when it is established to the satisfaction of the Commissioner that the requested expungement and return is appropriate.

Paragraph (b) of § 1.59 is intended to cover the current practice set forth in MPEP 724.05 where the submitted information has initially been identified as trade secret, proprietary, and/or subject to a protective order and where applicant may file a petition for its expungement and return that will be granted upon a determination by the examiner that the information is not material to patentability. Any such petition should be submitted in response to an Office action closing prosecution so that the examiner can make a determination of materiality based on a closed record. Any petition submitted earlier than close of prosecution may be returned unacted upon. In the event pending legislation for pre-grant publication of applications, which provides public access to the application file, is enacted, then the timing of petition submissions under this section will be reconsidered. A result of the proposed amendment to this section would be to have a petition to expunge decided under the instant rule by the examiner who determines the materiality of the information to be expunged rather than by the Office of Petitions under § 1.182, which prior to rendering a decision on the petition consults with the examiner on materiality of the information at issue.

Paragraph (b) of § 1.59 is also intended to cover information that was unintentionally submitted in an application, provided that: (i) The Office can effect such return prior to the issuance of any patent on the application in issue, (ii) that it is stated that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, (iii) the information has not otherwise been made public, (iv) there is a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted, and (v) it is established to the satisfaction of the Commissioner that the information to be returned is not material information under § 1.56. Requests to return information that have not been clearly identified as information that may be later subject to such request by marking and placement in a separate sealed envelope or container shall be treated on a case-by-case basis. It should be noted that the Office intends to start electronic scanning of all papers filed in an application, and the practicality of expungement from the electronic file created by a scanning procedure is not as yet determinable. Applicants should also note that unidentified information that is a trade secret, proprietary, or subject to a protective order that is submitted in an Information Disclosure Statement may inadvertently be placed in an Office prior art search file by the examiner due to the lack of such identification and may not be retrievable.

Paragraph (b) of § 1.59 is also intended to cover the situation where an unintended heading has been placed on papers so that they are present in an incorrect application file. In such situation, a petition should request return of the papers rather than transfer of the papers to the correct application file. The grant of such a petition will be governed by the factors enumerated above in regard to the unintentional submission of information. Where the Office can determine the correct application file that the papers were actually intended for, based on identifying information in the heading of the papers, e.g., Application number, filing date, title of invention and inventor(s) name(s), the Office will transfer the papers to the correct application file for which they were intended without need of a petition.

Added paragraph (c) of § 1.59 retains the practice that copies of application papers will be furnished by the Office upon request and payment of the cost for supplying such copies.

Section 1.60 is proposed to be removed and reserved.

In the notice of proposed rulemaking entitled ''Changes to Implement 20-Year Patent Term and Provisional Application'' (20-Year Term Notice of Proposed Rulemaking) published in the Federal Register at 59 FR 63951 (December 12, 1994), and in the Patent and Trademark *Office Official Gazette* at 1170 *Off. Gaz. Pat. Office* 377 (January 3, 1995), § 1.60 was proposed to be removed due to the rule change to § 1.4(d), which permits the filing of a copy of an oath or declaration. The proposed removal of § 1.60 in the 20-Year Term Notice of Proposed Rulemaking, however, was withdrawn in the final rule to permit further study.

A continuation or divisional application may be filed under 35 U.S.C. 111(a) using the procedures set forth in § 1.53, by providing a copy of the prior application, including a copy of the oath or declaration in such prior application, as filed. The patent statutes and rules of practice do not require that an oath or declaration include a recent date of execution, and the Examining Corps has been directed not to object to an oath or declaration as lacking either a recent date of execution or any date of execution. This change in examining practice will appear in the next revision of the MPEP. As discussed *supra*, the applicant's duty of candor and good faith including compliance with the duty of disclosure requirements of § 1.56 is continuous and applies to the continuing application.

Sections 1.60(b)(4) and 1.62(a) currently permit the filing of a continuation or divisional application by all or by less than all of the inventors named in a prior application without a newly executed oath or declaration. To continue this practice, § 1.53 is proposed to be amended to provide that any continuation or divisional application may be filed by all or by less than all of the inventors named in a prior application, but where a newly executed oath or declaration is not submitted for a continuation or divisional application filed by less than all the inventors named in the prior application, the copy of the oath or declaration for the most immediate prior national application for which priority is claimed under 35 U.S.C. 120, 121 or 365(c) must be accompanied by a statement requesting the deletion of the names of the person or persons who are not inventors in the continuation or divisional application. A newly executed oath or declaration will continue to be required in a continuation or divisional application naming an inventor not named in the prior application, or a continuation-in-part application.

Section 1.60 is now unnecessary due to: (1) The rule change to § 1.4(d), (2) the proposed addition of § 1.53(b)(1)(i) to expressly permit the filing of either a newly executed oath or declaration, or a copy of the executed oath or declaration filed to complete pursuant to § 1.51(a)(1) the most immediate prior national application for which priority is claimed under 35 U.S.C. 120, 121 or 365(c), in a continuation or divisional application, (3) the proposed addition of § 1.53(b)(1)(i) to permit the filing of a continuation or divisional application by all or by less than all the inventors

named in a prior application, using a copy of the executed oath or declaration filed to complete the prior application, and (4) the proposed addition of § 1.53(b)(3) to permit the filing of a continued prosecution application.

A new application containing a copy of an oath or declaration under § 1.63 referring to an attached specification is indistinguishable from a continuation or divisional application containing a copy of an oath or declaration from a prior application submitted pursuant to § 1.53(b)(1)(i), as proposed. Unless an application is submitted with a statement that the application is a continuation or divisional application (§ 1.78(a)(2)), the Office will process such a new application without requiring a new oath or declaration. Applicants are advised to clearly designate any continuation or divisional application as such to avoid the issuance of a filing receipt that does not indicate that the application is a continuation or division.

Section 1.62 is proposed to be removed and reserved.

In the proposed rulemaking entitled ''Changes to Implement 18-Month Publication of Patent Applications'' (18-Month Publication Notice of Proposed Rulemaking) published in the Federal Register at 60 FR 42352 (August 15, 1995), and in the Patent and Trademark Office *Official Gazette* at 1177 *Off. Gaz. Pat. Office* 61 (August 15, 1995), § 1.62(e) was proposed to be amended to require a substitute specification in compliance with § 1.125 and drawings where the application filed under § 1.62 is a continuation-in-part application. The 18-Month Publication Notice of Proposed Rulemaking proposed to digital image and/or optical character recognition (OCR) scan application material into an electronic data base, which data base would be used to publish the application (*e.g.*, for producing copies of the technical contents of the application-as-filed). The 18-Month Publication Notice of Proposed Rulemaking indicated that as applications filed prior to the implementation of 18-month publication will not have been image- or OCR-scanned into the electronic data base, the technical contents of an application filed under § 1.62 in which the prior application was itself filed prior to the implementation of 18-month publication will not be contained in the electronic data base.

The solution proposed in the 18-Month Publication Notice of Proposed Rulemaking was for the Office to obtain the microfiche copy of the prior application for applications under § 1.62 which do not add additional disclosure (*i.e.*, continuation or divisional applications) and image or OCR scan it into the electronic data base, and to amend § 1.62 to provide that, where the application adds additional disclosure (*i.e.*, is a continuation-in-part application), a substitute specification in compliance with § 1.125 and drawings will be required.

The proposal in the 18-Month Publication Notice of Proposed Rulemaking to obtain the microfiche copy of prior continuation or divisional applications is now considered unfeasible. A number of applications filed under § 1.62 derive from a chain of applications filed under § 1.62. The information pertaining to such an application's chain of prior applications contained within the Patent Application Location and Monitoring (PALM) system is not sufficiently comprehensive to readily and reliably indicate the prior application that contains a specification and drawings, and is not sufficiently reliable to avoid the occasional inclusion of an unrelated application in the chain of prior applications. This could result in the inadvertent publication of the specification and drawings of the wrong application.

In addition, the microfiche copy of the prior application may be a microfiche of sheets of specification and/or drawings on 8½ by 14-inch paper, which paper size is not technically useable by the equipment which will be employed for pre-grant publication of patent applications. Attempts to reduce such sheets of specification and/or drawings to a paper size processible by pre-grant publication equipment results in electronic files which contain illegible text and figures. Moreover, the microfilming process under pre-grant publication differs from the previous microfilming process, and as such, the microfiche copy of such a prior application is sufficiently dissimilar from the microfiche copy of an application under pre-grant publication that it causes accurate technical date capture difficulties.

In the event that legislation mandating the 18-month publication of patent application is enacted, it will be necessary to require a substitute specification in compliance with § 1.125 and drawings including any changes to the prior application during the prosecution of the prior application or pursuant to § 1.62(e) to continue § 1.62 practice.

Section 1.62 is now unnecessary due to: (1) The rule change to § 1.4(d), (2) the proposed change to § 1.53(b)(1) to expressly permit the filing of either a newly executed oath or declaration, or a copy of the executed oath or declaration filed to complete pursuant to § 1.51(a)(1) the most immediate prior national application for which priority is claimed under 35 U.S.C. 120, 121 or 365(c), in a continuation or divisional application, (3) the proposed change to § 1.53(b)(1) to permit the filing of a continuation or divisional application by all or by less than all the inventors named in a prior application, using a copy of the executed oath or declaration filed to complete the prior application, and (4) the proposed addition of § 1.53(b)(3) to permit the filing of a continued prosecution application.

The Office currently receives a number of petitions requesting that an application filed under §§ 1.60 and 1.62 be accepted even though at the time of filing of the application, the application did not comply with all the requirements of §§ 1.60 or 1.62 due to inadvertent error on the part of the applicant. The examination of these improper applications under §§ 1.60 and 1.62 is delayed until a petition to accept the application is filed and granted. The large majority of the applications filed under § 1.60, however, complied at the time of filing with the requirements of § 1.53(b)(1), and the copy of the oath or declaration from the prior application is now acceptable as the oath or declaration for the application, regardless of whether the application is an application under § 1.53 or § 1.60. The removal of § 1.60 and simplification of § 1.62 will reduce the number of these types of petitions and will simplify the procedures for filing an application for both the Office and patent practitioners.

It is anticipated that, subsequent to the removal of §§ 1.60 and 1.62, applications purporting to be applications filed under §§ 1.60 or 1.62 will be filed until the deletion of §§ 1.60 and 1.62 become well known among patent practitioners. Applications purporting to be an application filed under § 1.60 will simply be treated as a new application filed under § 1.53 (*i.e.*, the reference to § 1.60 will simply be ignored).

Applications purporting to be an application filed under § 1.62 will be treated as continued prosecution applications under § 1.53(b)(3), and those applications that do not meet the requirements of § 1.53(b)(3) (*e.g.*, continuation-in-part applications or continuations or divisional of applications filed before June 8, 1995) will be treated as improper continued prosecution applications under § 1.53(b)(3). Such improper applications under § 1.53(b)(3) may be corrected by

way of petition under § 1.53(b)(c) (and $130 fee pursuant to § 1.17(i)).

Such a § 1.53(c) petition in a continuation or divisional application will be granted on the condition that the applicant file: (1) The $130 petition fee, and (2) a true copy of the complete application designated as the prior application in the purported § 1.62 application papers as filed, or, if the prior application was an application filed under § 1.62, a true copy of its most immediate parent application which contained a specification and drawings as filed. Such a § 1.53(c) petition in a continuation-in-part application will be granted on condition that the applicant file: (1) The $130 petition fee, and (2) a true copy of the complete application designated as the prior application in the purported § 1.62 application papers as filed, or, if the prior application was an application filed under § 1.62, a true copy of its most immediate parent application which contained a specification and drawings as filed, and any amendments submitted during the prosecution of the prior application.

Section 1.63(a)(3) is proposed to be amended by requiring the post office address to appear in the oath or declaration and having the requirement from § 1.41(a) for the full names of the inventors placed therein.

Section 1.69, paragraph (b), would be amended to remove the requirement that the translation be verified in accordance with the proposed change to § 1.4(d)(2). Paragraph (b) of this section is also being amended to clarify the need for a statement that the translation being offered is an accurate translation, as is proposed for § 1.52, paragraph (a) and (d).

Section 1.78(a)(1)(ii), as proposed, would remove the references to §§ 1.60 and 62 in view of the proposed deletion of §§ 1.60 and 62.

Section 1.84, paragraph (b), is proposed to be amended by removing references to the filing of black and white photographs in design applications as unnecessary in view of the reference in § 1.152 to § 1.84(b).

Section 1.91 is proposed to be amended for clarification purposes by additionally reciting ''Exhibits'' as well as models. The section is proposed to be amended to state that a model, working model or other physical exhibit may be required by the Office if deemed necessary for any purpose in examination of the application. This language is moved from § 1.92.

Section 1.92 is proposed to be removed and reserved and the language, as stated above, transferred to § 1.91 for improved contextual purposes.

Section 1.97 (c) through (e) are proposed to be amended by replacement of ''certification'' by ''statement,'' see comments relating to § 1.4(d), and by clarifying the current use of ''statement'' by the terms ''information disclosure.'' Section 1.97(e)(2) is further amended to replace ''or'' by ''and'' to require that: No item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and that no item of information contained in the information disclosure statement to the knowledge of the person signing the statement, after making reasonable inquiry, was known to any individual designated in § 1.56(c) more than three months prior to the filing of the information disclosure statement. The use of ''and'' rather than ''or'' is in keeping with the intent of the rule as expressed in the MPEP 609, page 600–91, that the conjunction be conjunctive rather than disjunctive. The mere absence of an item of information from a foreign patent office communication was clearly not intended to represent an opportunity to delay the submission of the item when known more than three months prior to the filing of an information disclosure statement to an individual having a duty of disclosure under § 1.56.

Section 1.101 is proposed to be removed and reserved as relating to internal Office instructions.

Section 1.102, paragraph (a), would be amended to remove the requirement that the showing be verified in accordance with the proposed change to § 1.4(d)(2).

Section 1.103, paragraph (a), would be amended by replacement of ''response'' with ''reply'' in accordance with the proposed change to § 1.111.

Section 1.104 is proposed to be removed and reserved as relating to internal Office instructions (the material of paragraph (c) would be present in the MPEP).

Section 1.105 is proposed to be removed and reserved as relating to internal Office instructions.

Section 1.108 is proposed to be removed and reserved as relating to internal Office instructions.

Section 1.111(b) is proposed to be amended to explicitly recognize that a reply must be reduced to a writing which must point out the specific distinctions believed to render the claims, including any newly presented claims, patentable. It is noted that an examiner's amendment reducing a telephone interview to writing would comply with § 1.2.

In § 1.112 it is proposed to remove as being unnecessary the statement that ''any amendments after a second Office action must ordinarily be restricted to the rejection, objections or requirements made in the office action'' to reflect actual practice wherein an unrestricted right of entry exists prior to a final rejection and that an application or patent under reexamination be considered repeatedly unless a final action is rendered. It is proposed to amend the section for clarification purposes by addition of a reference to reconsideration ''before final action.''

Section 1.113(a), as proposed, would add ''by the examiner'' after ''examination or consideration,'' change ''objections to form'' to ''objections as to form'' for clarity, and would replace ''response'' with ''reply'' in accordance with the proposed change to § 1.111.

Section 1.113(b), as proposed, would change ''clearly stating the reasons therefor'' to ''clearly stating the reasons in support thereof'' for clarity.

A new § 1.113(c) would be added to provide that the first action in an application will not be made final. See comments to §§ 1.116 and 1.191.

Section 1.115 is proposed to be replaced by new § 1.115 that would contain material to be deleted from §§ 1.117 through 1.119, 1.123 and 1.124. No change in substance is contemplated with the material of deleted sections being rearranged and edited for clarity and contextual purposes in the new section. The reference to ''application'' is intended to include reissue applications.

Section 1.116(a), as proposed, would limit amendments after a final rejection or other final action (§ 1.113) to those amendments cancelling claims or complying with any requirement of form set forth in a previous Office action, and would replace the phrase ''any proceedings relative thereto'' with ''any related proceedings'' for clarity.

Section 1.116(b), as proposed, would provide that any amendment not in compliance with § 1.116(a) must be submitted with a request for an application under § 1.53(b)(3) to ensure consideration of the amendment.

Under § 1.116, as proposed, amendments after final rejection or other final action would be limited to cancelling claims or complying with any requirement of form expressly set forth in a previous Office action. Currently, amendments after final which concern the merits of an application may, upon a showing of good and sufficient reasons why they are necessary and were not earlier presented, be entered and amendments after final which present rejected claims

in better form for consideration on appeal may be entered. This procedure causes delays in the ultimate issuance of the application as a patent, since applicants will await a ruling on whether such amendment will be entered prior to deciding whether to obtain the entry of such amendment through the filing of a continuing application. In addition, the expedited handling of numerous amendments after final, and the expedited consideration of whether there is an adequate showing of good and sufficient reasons why an amendment after final concerning the merits of an application is necessary and not earlier presented, or whether an amendment after final presents rejected claims in better form for consideration on appeal, places a significant burden on Office resources.

Section 1.113(c), as proposed, would eliminate first action final practice, and, as such, would eliminate the necessity to submit an amendment after final simply to avoid a first action final in a continuing application. In view of this safeguard, and the delay and burden of the current practice for the treatment of amendments after final, § 1.116 is proposed to be amended to limit those amendments that may be presented as a matter of right after a final rejection or other final action. Put simply, the proposed elimination of first action final practice by the Office is the *quid pro quo* for the proposed strict limitation of after final practice. Persons submitting comments objecting to this proposed limitation of after final practice should frame such comments in the context that the proposed elimination of first action final practice by the Office is coupled to the proposed limitation of after final practice.

Section 1.116, as proposed, would not affect the authority of an examiner to enter in an application under final an amendment that places the application in condition for allowance, but does not strictly meet the requirements of § 1.116(a). That is, in instances in which the applicant and examiner agree on an amendment that would place the application in condition for allowance, the examiner would retain the authority to enter the amendment, notwithstanding the requirements of § 1.116(a). Where, however, the applicant and the examiner do not agree on whether an amendment would place an application in condition for allowance, and the amendment does not meet the requirements of § 1.116(a), the applicant could not require the examiner to consider the amendment as a matter of right.

Section 1.117 is proposed to be removed and reserved as the subject matter was transferred to proposed § 1.115.

Section 1.118 is proposed to be removed and reserved and its subject matter transferred to proposed § 1.115.

Section 1.119 is proposed to be removed and reserved and its subject matter transferred to proposed § 1.115.

Section 1.121 paragraphs (a) through (f) are proposed to be replaced with paragraphs (a) through (c), which separately treat amendments in non-reissue applications (paragraph (a)), amendments in reissue applications (paragraph (b)) and amendments in reexamination proceedings (paragraph (c)). Paragraphs (a) and (b) each separately treat amendment of the specification (paragraphs (a)(1) and (b)(1)) and of the claims (paragraphs (a)(2) and (b)(2)). In comparing amendment practice to the specificat′ion for non-reissue and reissue applications: When making an amendment to the specification of a non-reissue application a copy of all previous amendments would not be required, whereas for reissue applications a copy of all previous amendments to the patent specification would be required. In comparing amendment practice to the claims for non-reissue and reissue applications: When making an amendment to the claims of a non-reissue application or when new claims are added, a copy of all pending claims, including original claims that have never been amended, would be required, whereas for reissue applications a copy of only claims that are being amended or added would be required.

Paragraph (a) of § 1.121 would relate to amendments in non-reissue applications and retains a reference to § 1.52. Paragraph (a)(1) would relate to the manner of making amendments in the specification other than in the claims. Paragraph (a)(1)(i) would require the precise point to be indicated where an amendment is made. Paragraph (a)(1)(ii) would allow amendments that are deletions only to be done by a direction to cancel rather than presenting the sentence(s), paragraph(s) and/or page(s) with brackets. This should be compared to cancellation of material from the patent specification in a reissue application (paragraph (b)((1)((ii)) or in a reexamination proceedings (§ 1.530(d)(1)(ii)—by way of a copy of the rewritten material). Paragraph (a)(1)(iii) would require all other amendments, such as additions or deletions mixed with additions, to be made by submission of a copy of the rewritten sentence(s), paragraph(s) and/or page(s) to permit the examiner to more readily recognize the changes that are being made. Current practice does not require the marking of an amendment to the specification in non-reissue applications. A change in one sentence, paragraph or page that results in only format changes to other pages not being amended are not to be submitted. Paragraph (a)(1)(iv) would identify the type of markings required by paragraph (a)(1)(iii), single underlining for added material and single brackets for material deleted. The marking would also be required to be applied in reference to the material as previously rewritten and not as originally presented if that differed from the previous presentation.

Paragraph (a)(2) of § 1.121 would relate to the manner of making amendments in the claims of a non-reissue application. Paragraph (a)(2)(i)(A) would permit cancellation of a claim by a direction to do so or by simply omitting a copy of the claim when a complete copy of all pending claims are presented pursuant to paragraph (a)(2)(ii) of this section. Paragraph (a)(2)(i)(B) would permit amendment of a previously submitted claim, other than mere cancellation by submission of a copy of the claim completely rewritten with markings pursuant to paragraph (a)(2)(iii) of this section rather than continuing to permit requests that the Office hand-enter changes of five or less words, § 1.121(c)(2). Such rewriting would be construed as a direction that the rewritten claim be a replacement for the previously submitted claim. Paragraph (a)(2)(i)(C) sets forth that a new claim may only be added by the submission of a clean copy of the new claim.

Paragraph (a)(2)(ii) of § 1.121 would require that when a previously submitted claim is amended, or when a new claim is added, applicant must submit a separate copy of all pending claims to include all newly rewritten claims, all newly added claims, all previously rewritten claims that are still pending and any unamended claims that are still pending. This would enable the examiner to more quickly identify the claims that must be reviewed for the next Office action and would enable the printer to have a current version of the allowed claims for printing should the application be allowed. Compare with amendment of claims in reissue applications wherein only a copy of an amended patent claim or added claim is required, paragraph (b)(2)(i)(A) of this section, but not of previous claims (patent and added claims) that are not currently being amended. Current practice does not require a complete copy of all pending claims but only those claims being amended or added.

Paragraph (a)(2)(iii) of § 1.121 would identify the type of marking required by paragraph (a)(2)(i)(B), single underlining for added material and single brackets for material deleted.

Paragraph (a)(2)(iv) of § 1.121 would provide that the failure to submit a copy of any previously submitted claim would be construed as a direction to cancel that claim.

Paragraph (a)(3) of § 1.121 would clarify that amendments to the original application drawings for non-reissue applications are not permitted and are to be made by way of a substitute sheet for each original drawing sheet that is to be amended.

Paragraph (a)(4) of § 1.121 would require that any amendment presented in a substitute specification must be presented under the provision of this section either prior to or concurrent with the submission of the substitute specification.

Paragraph (b) of § 1.121 would apply to amendments in reissue applications. Paragraph (b)(1) of § 1.121 would relate to the manner of making amendments to the specification other than in the claims in reissue applications. Paragraph (b)(1)(i) would require the precise point to be indicated where an amendment is made. Paragraph (b)(1)(ii) would require that all amendments including deletions be made by submission of a copy of the rewritten paragraph(s) with markings. A change in one sentence, paragraph or page that results in only format changes to other pages not being amended are not to be submitted. Compare to amendments to the specification other than in the claims of non-reissue applications wherein deletions are permitted, paragraph (a)(1)(ii) of this section. Paragraph (b)(1)(iii) sets forth that each amendment to the specification must include all amendments to the specification relative to the patent as of the date of the submission. Compare to amendments to the specification other than claims in nonreissue applications wherein previous amendments to the specification are not required to accompany the current amendment to the specification, paragraph (a)(1)(iii). Paragraph (b)(1)(iv) would define the marking set forth in paragraph (b)(1)(ii) of section.

Paragraph (b)(2) of § 1.121 would relate to the manner of making amendments to the claims in reissue applications. Paragraph (b)(2)(i)(A) of § 1.121 would require the entire text of each patent claim that is being amended and of each added claim rather than continuing to permit requests that the Office hand-enter changes of five or less words, § 1.121(c)(2), but not of all pending claims, such as patent claims that have not been amended. Compare paragraph (a)(2)((ii). Additionally, provision would be made for the cancellation of a patent claim by a direction to cancel without the need for marking by brackets. Paragraph (b)(2)(i)(B) would require that patent claims not be renumbered. Paragraph (b)(2)(i)(C) would identify the type of marking required by paragraph (b)(2)(i)(A), single underlining for added material and single brackets for material deleted.

Paragraph (b)(2)(ii) of § 1.121 would require that each amendment submission set forth the status of all patent claims and all added claims as of the date of the submission, as not all claims (non-amended claims) are to be presented with each submission, paragraph (b)(2)(iv). The absence of submission of the claim status would result in an incomplete response, 35 U.S.C. 135.

Paragraph (b)(2)(iii) of § 1.121 would require that each claim amendment be accompanied by an explanation of the support in the disclosure of the patent for the amendment. The absence of an explanation would result in an incomplete response, 35 U.S.C. 135.

Paragraph (b)(2)(iv) of § 1.121 would require that each submission of an amendment to any claim (patent claim or added claim) requires copies of all amendments to the claims as of the date of the submission. A copy of a previous amendment would not meet the requirement of this section in that all amendments must be represented, as only the last amendment will be used for printing.

Paragraph (b)(2)(v) of § 1.121 would provide that the failure to submit a copy of any added claim would be construed as a direction to cancel that claim.

Paragraph (b)(2)(vi) of § 1.121 would clarify that: (1) No reissue patent would be granted enlarging the scope of the claims unless applied for within two years from the grant of the original patent (additional broadening outside the two-year limit is appropriate as long as some broadening occurred within the two-year period), and (2) no amendment may introduce new matter or be made in an expired patent.

Paragraph (b)(3) of § 1.121 clarify that amendments to the patent drawings are not permitted and that any change must be by way of a new sheet of drawings with the amended figures being identified as ''amended'' and with added figures identified as ''new'' for each sheet that has changed.

Paragraph (c) of § 1.121 would clarify that amendments in reexamination proceedings are to be made in accordance with § 1.530.

Section 1.121 as applied both to non-reissue and reissue applications does not provide for replacement pages whereby a new page would be physically substituted for a currently existing page. However, an applicant can direct that Page _____ be cancelled and the following inserted in its place. The wide availability of word processing should enable applicants to more easily submit updated material providing greater accuracy and thereby eliminating the need for the Office to hand-enter amendments. To that end, § 1.125 is proposed to be amended to provide that a substitute specification may be submitted at any point up to payment of the issue fee as a matter of right.

The proposed changes to § 1.121 relate in part to the method of presenting amendments in reissue and reexamination proceedings, that would more closely parallel each other. The Office seeks guidance on the usefulness of bringing reissue and reexamination proceedings in closer harmony. Currently, both practitioners and Office personnel must retain a working knowledge of these infrequently used but vital avenues for review of an issued patent. The Office has identified the following areas for possible harmonization and would like comments as to the appropriateness of these areas, identification of other suitable areas for consideration and specific means to achieve harmonization in the identified areas, e.g., whether a concept or practice in one area should be applied to the other area or a new practice for both should be started:

—Procedures for amending claims and the specification, § 1.121

—To utilize a reissue certificate (similar to a reexamination certificate) attached to a copy of the original patent as the reissued patent. This procedure would eliminate the need to reprint the entire reissued patent.

—Whether the special dispatch provisions of re-examination should be applied to reissue applications.

Section 1.122 is proposed to be removed and reserved as representing internal Office instruction.

Section 1.123 is proposed to be removed and reserved and its subject matter transferred to proposed § 1.115 for better context.

Section 1.124 is proposed to be removed and reserved and its subject matter transferred to proposed § 1.115 for better context.

Section 1.125 is proposed to be amended by addition of paragraphs (a)

through (d). Paragraph (a) would retain the current practice that a substitute specification may be required by the examiner and would be clarified to note that if the legibility of the application papers shall render it difficult to consider the case, the Office may require a substitute specification.

Paragraph (b) of § 1.125 would provide for the right of filing a substitute specification in an application other than a reissue application, at any point up to payment of the issue fee, if it is accompanied by a statement that the substitute specification includes no new matter and does not introduce any amendments unless they have been submitted in accordance with the requirements of § 1.121(a) either prior to or concurrent with the submission of the substitute specification. In view of the proposed continued prosecution application under § 1.53(b)(3) and the need to submit sentence, paragraph, and/or page changes under § 1.121(a), liberalization of the substitute specification requirements is desirable. The requirement for a lack of new matter statement being verified would be deleted. See comments to § 1.4(d).

Paragraph (c) of § 1.125 would clarify that a substitute specification is to be submitted without markings as to amended material.

Paragraph (d) of § 1.125 would not permit a substitute specification in reissue or reexamination proceedings as markings for changes from the patent are required therein.

Section 1.133, paragraph (b), would be amended by replacement of ''response'' with ''reply'' in accordance with the proposed change to § 1.111.

Section 1.134 would be amended by replacement of ''response'' with ''reply'' in accordance with the proposed change to § 1.111.

Section 1.135, paragraphs (a) and (c), would be amended by replacement of ''response'' with ''reply'' in accordance with the proposed change to § 1.111. Paragraph (b) is proposed to be amended to clarify that the admission of or refusal to admit any amendment after final rejection, and not just an amendment not responsive to the last Office action, shall not operate to save the application from abandonment.

Section 1.135, paragraph (c), is proposed to be amended to provide that a new ''time period'' under § 1.134 may be given if a reply to a non-final Office action is substantially complete but consideration of some matter or compliance with some requirement has been inadvertently omitted. This would replace the current practice whereby applicant may be given an opportunity to supply the omission through the setting of a ''time limit'' of one month that is not currently extendable. Generally, a new one month shortened statutory time period would be utilized enabling an applicant to petition for extensions of time under § 1.136(a). Where 35 U.S.C. 133 requires a period longer than one month, *i.e.*, actions mailed in the month of February, a shortened statutory period of 30 days will be set. The setting of a time period for reply under § 1.134 rather than a time limit would result in the date of abandonment (when no further reply is filed) being the expiration of the new time period rather than, at present, the date of expiration of the period of reply set in the original Office action for which an incomplete reply was filed. Thus, the proposed amendment to paragraph (c) of § 1.135 would permit the refiling of a continuing application as an alternative to completing the reply, whereas the current rule only permits an applicant to complete the reply that was held to be incomplete.

Section 1.135, paragraph (c), is also proposed to be amended to remove an unnecessary reference to consideration of the question of abandonment and to clarify that the reply for which applicant may be given a new time period to reply to must be a ''non-final'' Office action.

Section 1.136, paragraph (a)(1), is proposed to be amended to recite the availability of a maximum of five (5) rather than four (4) months as an extension of time when only a one (1) month or 30 day shortened statutory period or a non-statutory period for reply is set. Paragraph (a)(1) is would also be amended by replacement of ''respond'' with ''reply'' in accordance with the proposed change to § 1.111.

Section 1.136, paragraph (a)(2), would be amended by replacement of ''respond'' with ''reply'' in accordance with the proposed change to § 1.111 and other clarification changes.

Section 1.136 is proposed to be amended by addition of paragraph (a)(3) that would now provide for the filing in an application a general authorization to treat any reply requiring a petition for an extension of time for its timely submission as containing a request therefor for the appropriate length of time. The authorization may be filed at any time prior to or with the submission of a reply that would require an extension of time for its timely submission, including submission with the application papers. Currently, the mere presence of a general authorization, submitted prior to or with a reply requiring an extension of time, to charge all required fees does not amount to a petition for an extension of time for that reply (MPEP 201.06 and 714.17) and under the proposed amended rule the submission of a reply requiring an extension of time for its timely submission would not be treated as an inherent petition for an extension of time absent an authorization for all necessary extensions of time. The Office will continue to treat all petitions for an extension of time as requesting the appropriate extension period notwithstanding an inadvertent reference to a shorter period for extension and will liberally interpret comparable papers as petitions for an extension of time. Applicants are advised to file general authorizations for payment of fees and petitions for extensions of times as separate papers rather than as sentences buried in papers directed to other matters (such as an application transmittal letter). The use of individual papers directed only to an extension of time or to a general authorization for payment of fees would permit the Office to more readily identify the presence of such items and list them individually on the application file jacket thereby providing ready future identification of these authorizations.

Clarifying language is proposed for § 1.136(a)(3) to reflect current practice that general authorizations to charge fees are effective to meet the requirement for the extension of time fee for responses filed concurrent or subsequent to the authorization. However, a general authorization to charge additional fees does not represent a petition for an extension of time, which petition must be separately requested.

Section 1.137 is proposed to be amended by moving language presently codified, elsewhere to, *inter alia*, incorporate revival of abandoned applications and lapsed patents for the failure: (1) To timely reply to an Office requirement in a provisional application (§ 1.139), (2) to timely pay the issue fee for a design application (§ 1.155 paragraphs (b)–(f)), (3) to timely pay the issue fee for a utility or plant application (§ 1.316 paragraphs (b)–(f)), or to timely pay the full amount of the issue fee (§ 1.317 paragraphs (b)–(f)) (lapsed patents). Cites in parentheses reference where subject matter is contained in current rules.

Section 1.137(a), as proposed, would further move into paragraph (a)(3) the requirement that a petition thereunder be ''promptly filed after the applicant is notified of, or otherwise becomes aware of, the abandonment.'' 35 U.S.C. 133 requires that ''it be shown * * * that such delay was unavoidable.'' This

requirement is regarded as requiring not only a showing that the delay which resulted in the abandonment of the application was unavoidable, but also a showing of unavoidable delay from the time an applicant becomes aware of the abandonment of the application until the filing of a petition to revive. *See In re Application of Takao* 17 USPQ2d 1155 (Comm'r Pat. 1990). The burden of continuing the process of presenting a grantable petition in a timely manner likewise remains with the applicant until the applicant is informed that the petition is granted. *Id.* An applicant seeking to revive an ''unavoidably'' abandoned application is expected to cause a petition under § 1.137(a) to be filed without delay (*i.e.*, promptly upon becoming notified, or otherwise becoming aware, of the abandonment of the application). As such, the placement of the requirement that a petition pursuant to § 1.137(a) be filed promptly upon becoming notified, or otherwise becoming aware, of the abandonment of the application is appropriately located in paragraph (a)(3), since § 1.137(a)(3) includes the requirement for a showing of unavoidable delay.

The requirement that an applicant seeking to revive an application as ''unavoidably'' abandoned ''promptly'' file a petition under § 1.137 is regarded as a requirement that a petition pursuant to § 1.137(a) be filed without delay upon the applicant or his or her representative being notified of, or otherwise becoming aware of, the abandonment. Thus, under the current and proposed practice, the failure to file a petition under § 1.137(a) within three months of the date the applicant or his or her representative is notified of, or otherwise becomes aware of, the abandonment would generally be regarded as a failure to ''promptly'' file a petition pursuant to § 1.137.

Providing a time period based upon the date of abandonment during which a petition pursuant to § 1.137(b) must be filed to be timely, but providing no comparable time period within which a petition pursuant to § 1.137(a) must be filed to be timely, results in the misapplication of § 1.137 on the part of practitioners, which in turn results in an inordinate administrative burden to the Office. The Office is proposing to either: (1) Eliminate the time period requirement for filing a petition pursuant to § 1.137(b), or (2) provide comparable time period requirements for filing either a petition pursuant to § 1.137(a) and/or § 1.137(b), which time period will be based upon the date of the first Office notification that the application had become abandoned or that the patent had lapsed. Interested persons are advised to comment on each of these proposals, since, depending upon further consideration by the Office and the comments received in response to this notice of proposed rulemaking, either proposal may be adopted in the final rule.

Providing the period of ''within one year of the date on which the application became abandoned'' as the period during which a petition under § 1.137(b) may be timely filed has had the undesirable effect of inducing applicants, or their representatives, to delay the filing of a petition under § 1.137(b) until the end of this one year period. This deliberate delay in filing a petition under § 1.137(b), or use of this one year period as an extension of time, is considered an abuse of § 1.137(b). *See In re Application of S.*, 8 USPQ2d 1630, 1632 (Comm'r Pats 1988). In addition, § 1.137(b) was recently amended to require that any petition thereunder include a statement that the delay (*i.e.*, the entire delay), and not merely the abandonment, was unintentional. See *Final Rule*, ''Changes in Procedures for Revival of Patent Applications and Reinstatement of Patents,'' published in the Federal Register at 58 FR 44277 (August 20, 1993) and in the Patent and Trademark Office *Official Gazette* at 1154 *Off. Gaz. Pat Office* 4 (September 14, 1993). As such, any intentional delay in filing a petition under § 1.137(b) is prohibited by the current terms of the rule.

Under current rules, in instances in which an applicant, or his or her representative, intentionally delays the filing of a petition under § 1.137(b) until the end of this one year period, but files a petition under § 1.137(b) within this one year period, the petition is timely under § 1.137(b)(4), but the statement that ''the delay was unintentional'' is not appropriate.

In instances in which the filing of a petition under § 1.137(b) is intentionally delayed until the end of this one year period, and the applicant, or his or her representative, miscalculates the actual date of abandonment, or otherwise misdockets the end of this one year period, the statement that ''the delay was unintentional'' is likewise not appropriate, but the petition is also barred by the terms of the rule. In addition, subsequent petitions under § 1.137(a) are, regardless of the original cause of the abandonment, barred due to the applicant's failure to cause a petition under § 1.137(a) to be ''promptly filed after the applicant is notified of, or otherwise becomes aware of, the abandonment.'' *See Application of S.*, 8 USPQ2d at 1632.

Where the applicant deliberately permits an application to become abandoned (*e.g.*, due to a conclusion that the claims are unpatentable (*e.g.*, that a rejection in an Office action cannot be overcome), or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered a deliberately chosen course of action, and the resulting delay cannot be considered ''unintentional'' within the meaning of 37 CFR 1.137(b). *See In re Application of G.*, 11 USPQ2d 1378, 1380 (Comm'r Pat. 1989). Likewise, where the applicant deliberately chooses not to either seek or persist in seeking the revival of an abandoned application, the resulting delay in seeking revival of the application cannot be considered ''unintentional'' within the meaning of 37 CFR 1.137. The correctness or propriety of the rejection, or other objection, requirement, or decision, by the Office, the appropriateness of the applicant's decision to abandon the application or to not seek or persist in seeking revival, or the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision not to seek or persist in seeking revival, are immaterial to such intentional delay caused by the deliberate course of action chosen by the applicant.

The intentional abandonment of an application, or an intentional delay in seeking either the withdrawal of a holding of abandonment in or the revival of an abandoned application, precludes a finding of unavoidable or unintentional delay pursuant to § 1.137. *See In re Maldague*, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988).

Proposed Elimination of the Time Period Requirement for Filing a Petition Pursuant to § 1.137(b)

Under this proposal, an intentional delay in the filing of a petition under § 1.137(b) will not result in an untimely petition pursuant to § 1.137(b). The statement that ''the delay was unintentional,'' however, will continue to be inappropriate. That is, where there is an intentional delay in the filing of a petition under § 1.137(b), the statement that ''the delay was unintentional'' will continue to be inappropriate (*i.e.*, the applicant, or his or her representative cannot properly make this statement, and thus cannot properly request revival of the application), but § 1.137(b) would no longer include an additional time period requirement. It is anticipated that the effects of prosecution delay due to abandonment on patent term under Public Law 103–465, and the proposed

changes to § 1.137(c), will eliminate any incentive to intentionally delay the revival of an abandoned application.

An applicant, assignee, or his or her representative, desiring the revival of an application that has inadvertently or unintentionally become abandoned is expected to act without intentional delay in seeking revival of the application. The Office does not question whether there has been an intentional or otherwise impermissible delay when a petition pursuant to § 1.137 is filed within three months of the date the applicant is first notified by the Office that the application is abandoned. Where, however, there is a greater delay between the date the applicant is first notified by the Office that the application is abandoned and the filing of a petition pursuant to § 1.137(b), the Office may raise the question as to whether the delay was unintentional, and may require more than a mere statement that the delay was unintentional. The Office may question whether the delay was unintentional in instances in which an applicant fails to timely seek reconsideration of a decision refusing to revive an abandoned application (see § 1.137(d)).

Regardless of whether the time period requirement in § 1.137(b) is eliminated, applicants seeking revival of an abandoned application are advised to file a petition pursuant to § 1.137 within three months of first notification that the application is abandoned to avoid the question of intentional delay being raised by the Office or third parties seeking to challenge any patent issuing from the application.

While this proposal would permit revival pursuant to § 1.137(b) without regard to the period of abandonment, § 1.137(a) currently permits revival pursuant thereto without regard to the period of abandonment. In addition, the Office currently entertains petitions pursuant to § 1.183, albeit under strictly limited conditions, to waive the time period requirement in § 1.137(b). Since an application may currently be revived pursuant to § 1.137 without regard to the period of abandonment, any current reliance upon the period of abandonment to ensure that the application will never issue as a patent is misplaced. Thus, the proposed elimination of the time period requirement in § 1.137(b) would not significantly decrease the relationship between the period of abandonment of an application and the likelihood that such application would ever issue as a patent.

In the event that the proposed elimination of the time period requirement for filing a petition pursuant to § 1.137(b) is adopted, public comment is also requested on the application of this rule change to applications that were abandoned prior to the effective date of this rule change. This provision could be made effective as to petitions filed on or after the effective date of the rule change, which would permit the revival pursuant to § 1.137(b) of applications abandoned for extended periods of time, provided that the entire delay was unintentional. This provision could also be made effective as to applications abandoned on or after the effective date, with the provisions of current § 1.137(b) being applied to applications abandoned prior to the effective date of the rule change. This provision could also be made effective as to applications abandoned within and/or having a petition to revive filed within a specified period preceding the effective date of the rule change.

Proposed Comparable Time Period Requirements Each of §§ 1.137 (a) and (b) Based Upon the Date of the First Office Notification That the Application Had Become Abandoned or That the Patent Had Lapsed

The Office is also considering amending each of §§ 1.137 (a) and (b) to include an express requirement that a petition thereunder be filed within a time certain. Specifically, the Office is also considering amending § 1.137(a) to include the express requirement that a petition thereunder be filed within three months of the date of the first Office notification that the application had become abandoned or that the patent had lapsed and amending § 1.137(b) to include the requirement that a petition thereunder be filed within three months of the date of the first Office notification that the application had become abandoned or that the patent had lapsed, or within three months of the date of the first decision on a timely petition pursuant to § 1.137(a).

The ''promptly filed'' requirement in § 1.137(a) is the subject of various interpretations by applicants seeking revival pursuant to § 1.137(a). To avoid misunderstandings as to the timeliness with which the Office expects an applicant seeking revival pursuant to § 1.137(a) to file a petition thereunder, the Office is considering amending § 1.137(a) to include the express requirement that a petition thereunder be filed within a time certain. Providing a period during which a timely petition pursuant to § 1.137 (a) and/or (b) may be filed based upon the date of the first Office notification that the application had become abandoned or that the patent had lapsed, rather than the date of abandonment or patent lapse, is considered a better measure of timeliness. In addition, providing such a period will reduce uncertainty as to the expiration of the period during which a timely petition pursuant to § 1.137(b), as well as § 1.137(a), may be filed.

Therefore, the Office is also considering basing the period during which a timely petition under § 1.137 (b), as well as § 1.137(a), may be filed on the date of notification of the abandonment, rather than the date of abandonment, and considers that a period of within three months of the date of the first Office notification that the application had become abandoned or that the patent had lapsed to be the appropriate period.

Under the appropriate circumstances, petitions under § 1.183 to waive any time period requirement in §§ 1.137(a) and/or (b) would be available. Waiver of any requirement of § 1.137 will, in accordance with § 1.183, be strictly limited to an ''extraordinary situation'' in which ''justice requires'' such waiver.

Section 1.137(a)(1), as proposed, would replace the phrase ''a proposed response to continue prosecution of that application, or the filing of a continuing application, unless either has been previously filed'' with ''accompanied by the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the proposed reply requirement may be met by the filing of a continuing application. In an abandoned application or a lapsed patent, for failure to pay any portion of the required issue fee, the proposed reply must be the issue fee or any outstanding balance thereof.''

Section 1.137(b)(1), as proposed, would likewise replace the phrase ''Accompanied by a proposed response to continue prosecution of that application, or filing of a continuing application, unless either has been previously filed'' with ''accompanied by the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the proposed reply requirement may be met by the filing of a continuing application. In an abandoned application or a lapsed patent, for failure to pay any portion of the required issue fee, the proposed reply must be the issue fee or any outstanding balance thereof.''

While the revival of applications abandoned for failure to timely prosecute and for failure to timely pay the issue fee are proposed to be incorporated together in § 1.137, the statutory provisions for the revival of an application abandoned for failure to timely prosecute and for failure to

timely submit the issue fee are mutually exclusive. *See Brenner* v. *Ebbert,* 398 F.2d 762, 157 USPQ 609 (D.C. Cir.), *cert. denied* 393 U.S. 926, 159 USPQ 799 (1968). 35 U.S.C. 151 authorizes the acceptance of a delayed payment of the issue fee, if the issue fee ''is submitted * * * and the delay in payment is shown to have been unavoidable.'' 35 U.S.C. 41(a)(7) likewise authorizes the acceptance of an ''unintentionally delayed payment of the fee for issuing each patent.'' Thus, 35 U.S.C. 41(a)(7) and 151 each require payment of the issue fee as a condition of reviving an application abandoned or patent lapsed for failure to pay the issue fee. Therefore, the filing of a continuing application without payment of the issue fee or any outstanding balance thereof is not an acceptable proposed reply in an application abandoned or patent lapsed for failure to pay any portion of the required issue fee.

The Notice of Allowance requires the timely payment of the issue fee in effect on the date of its mailing to avoid abandonment of the application. In instances in which there is an increase in the issue fee by the time of payment of the issue fee required in the Notice of Allowance, the Office will mail a notice requiring payment of the balance of the issue fee then in effect. The phrase ''for failure to pay any portion of the required issue fee'' applies to those instances in which the applicant fails to pay either the issue fee required in the Notice of Allowance or the balance of the issue fee required in a subsequent notice. In such instances, the proposed reply must be the issue fee then in effect, if no portion of the issue fee was previously submitted, or any outstanding balance of the issue fee then in effect, if a portion of the issue fee was previously submitted.

These proposed changes to §§ 1.137 (a)(1) and (b)(1) are necessary to incorporate into § 1.137 the revival of abandoned applications and lapsed patents for the failure to timely reply to an Office requirement in a provisional application, to timely pay the issue fee, or to timely pay the full amount of the issue fee.

Sections 1.137 (a) and (b), as proposed, would each include a new paragraph, paragraphs (a)(4) and (b)(4), respectively, providing that any petition thereunder must be accompanied by any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to § 1.137(c), to include in §§ 1.137 (a) and (b) an explicit reference to the terminal disclaimer requirement in § 1.137(c).

Section 1.137(c), as proposed, would change the phrase ''any petition pursuant to paragraph (a) of this section'' to ''any petition pursuant to this section.'' As the period for the timely filing of a petition under § 1.137(b) would no longer be based upon the period of abandonment, administrative convenience no longer justifies not requiring, for all design applications and all other nonprovisional utility applications filed prior to June 8, 1995, a terminal disclaimer under § 1.137(c) for all petitions pursuant to § 1.137.

In addition, the phrase ''not filed within six months of the date of abandonment of the application'' is proposed to be removed from § 1.137(c). The only justification for the current six month limitation on the terminal disclaimer requirement in § 1.137(c) is administrative convenience in treating a petition pursuant to § 1.137(a) filed within six months of the date of abandonment. Since the date of abandonment is miscalculated in a significant number of instances, this provision of § 1.137(c) leads to errors in determining when a terminal disclaimer is required pursuant to § 1.137(c), and thus leads to delays in continuing prosecution of the abandoned application. In any event, administrative convenience is no longer considered an adequate justification for the effective different treatment that would result by operation of Pub. L. 103–465 of: (1) Applications filed on or after June 8, 1995, except for design applications, and (2) applications filed prior to June 8, 1995 and all design applications.

Section 1.137(d), as proposed, would change ''application'' to ''abandoned application or lapsed patent'' to incorporate into § 1.137 the revival of lapsed patents.

Section 1.137(e), as proposed, would provide that the time periods set forth in § 1.137 may be extended under the provisions of § 1.136.

Section 1.137(f), as proposed, will expressly provide that a provisional application, abandoned for failure to timely reply to an Office requirement, may be revived pursuant to § 1.137 (a) or (b) so as to be pending for a period of no longer than twelve months from its filing date. In accordance with 35 U.S.C. 111(b)(5), § 1.137(f), as proposed, will clearly indicate that ''[u]nder no circumstances will a provisional application be regarded as pending after twelve months from its filing date.'' Sections 1.139 (a) and (b) each currently provide that a provisional application may be revived so as to be pending for a period of no longer than twelve months from its filing date, and that under no circumstances will a provisional application be regarded as pending after twelve months from its filing date.

Section 1.139 is proposed to be removed and reserved and its subject matter added to § 1.137.

Section 1.142 would be amended by replacement of ''response'' with ''reply'' in accordance with the proposed change to § 1.111.

Section 1.144 is proposed to be amended for clarification purposes.

Section 1.146 is proposed to be amended for clarification purposes.

Section 1.152 is proposed to be amended by removing the prohibition against color drawings and color photographs in design applications. Section 1.152 would be amended to permit the use of color photographs and color drawings in design applications subject to the petition requirements of § 1.84(a)(2) inasmuch as color may be an integral element of the ornamental design. While pen and ink drawings may be lined for color, a clear showing of the configuration of the design may be obscured by this drafting method. New technologies, such as holographic designs, fireworks and laser light displays may not be accurately disclosed without the use of color.

The term ''article'' of § 1.152 would be replaced by the term ''design'' as 35 U.S.C. 171 requires that the claim be directed to the ''design for an article'' not the article, per se. Therefore, to comply with the requirements of 35 U.S.C. 112, first paragraph, it is only necessary that the design as embodied in the article be fully disclosed and not the article itself. The term ''must'' would be replaced by the term ''should'' to allow for latitude in the illustration of articles whose configuration may be understood without surface shading. Clarification language would be added to note that the use of solid black surfaces would be permitted for representation of the color black as well as color contrast and that photographs and ink drawings must not be combined as formal drawings in one application.

Section 1.154 paragraph (a) would be amended to clarify that a voluntary submission (see comments under § 1.152 relating to substitution of ''design'' for ''article'') may and should be made of ''a brief description of the nature and intended use of the article in which the design is embodied.'' It is current practice for design examiners, in appropriate cases, to inquire as to the nature and intended use of the article in which a claimed design is embodied. The submission of such description will allow for a more accurate initial classification, and aid in providing a proper and complete search at the time of the first action on the merits. In those

instances where this feature description is necessary to establish a clear understanding of the article in which the design is embodied, provision of the feature description would help in reducing pendency by eliminating the necessity for time consuming correspondence. Specifically, requests for information prior to first action would be avoided. Absent an amendment requesting deletion of the description it would be printed on any patent that would issue.

Sections 1.155 (b) through (f) are proposed to be removed in view of the proposed amendments to § 1.137.

Section 1.163 is proposed to be amended to remove an unnecessary and outmoded reference to a ''legible carbon copy of the original'' specification for plant applications.

Section 1.165 is proposed to be amended by removing a reference to the artistic and competent execution of plant patent drawings which is unnecessary in view of the reference to § 1.84.

Section 1.167 is proposed to be amended by removing and reserving paragraph (b) as unnecessary in view of § 1.132.

Section 1.171 would no longer require an order for a title report in reissue applications as the requirement for a certification on behalf of all the assignees under concomitantly amended § 1.172(a) obviates the need for a title report and fee therefor. Section 1.171 is also proposed to be amended by deletion of the requirement for an offer to surrender the patent, which offer is seen to be redundant in view of § 1.178.

Section 1.172 is proposed to be amended to require that all assignees establish their ownership interest by submission of evidence of the chain of title or by specifying where such evidence is recorded in the Office.

Section 1.175 relating to the content of the reissue oath or declaration (MPEP 1414), as well as §§ 1.48 and 1.324 relating to correction of inventorship in an application and in a patent, respectively, are proposed to be amended to remove the requirement for a showing of a lack of deceptive intent based on facts and circumstances. As the Office no longer investigates fraud and inequitable conduct issues and a reissue applicant's statement of a lack of deceptive intent is normally accepted on its face (*See* MPEP 1448), the current requirement in § 1.175(a)(5) that it be shown how the error(s) being relied upon arose or occurred without deceptive intent on the part of the applicant appears to be unduly burdensome upon applicants and the Office, and is proposed to be deleted. This would apply to the initially identified error(s), under paragraph (a), and any subsequently identified error(s) under paragraph (b). An initial reissue oath or declaration would be required to be filed pursuant to § 1.175(a) limited to identification of the cause(s) of the reissue, and stating generally that all errors being corrected in the reissue application at the time of filing of the oath or declaration arose without deceptive intent. The current practice under § 1.175(a)(3) and (a)(5) of specifically identifying all errors being corrected at the time of filing the initial oath or declaration would not be retained.

Paragraph (b)(1) of § 1.175 would require a supplemental reissue oath or declaration for errors corrected that were not covered by an earlier presented reissue oath or declaration, such as the initial oath or declaration pursuant to paragraph (a) of this section or one submitted subsequent thereto (a supplemental oath or declaration under this paragraph), stating generally that all errors being corrected which are not covered by an earlier presented oath or declaration pursuant to paragraphs (a) and (b) of this section arose without any deceptive intention on the part of the applicant. A supplemental oath or declaration that refers to all errors that are being corrected, including errors covered by a reissue oath or declaration submitted pursuant to paragraph (a) of this section, would be acceptable. The specific requirement for a supplemental reissue oath or declaration to cover errors sought to be corrected subsequent to the filing of an initial reissue oath or declaration is not a new practice, but merely recognition of a current requirement for a supplemental reissue oath or declaration when additional errors are to be corrected. However, the current practice of specifically identifying all supplemental errors being corrected in a supplemental reissue oath or declaration would not be retained.

A supplemental oath or declaration under paragraph (b)(1) would be required to be submitted prior to allowance. The supplemental oath or declaration may be submitted with any amendment prior to allowance, paragraph (b)(1)(i), or in order to overcome a rejection under 35 U.S.C. 251 made by the examiner where there are errors sought to be corrected that are not covered by a previously filed reissue oath or declaration, paragraph (b)(1)(ii). Any such rejection by the examiner will include a statement that the rejection may be overcome by submission of a supplemental oath or declaration, which oath or declaration states that the errors in issue arose without any deceptive intent on the part of the applicant. A supplemental oath or declaration under paragraph (b) would only be required for errors sought to be corrected during prosecution of the reissue application. Where an Office action contains only a rejection under 35 U.S.C. 251 and indicates that a supplemental oath or declaration under this paragraph would overcome the rejection, applicants are encouraged to authorize the payment of the issue fee at the time the supplemental reissue oath or declaration is submitted in view of the clear likelihood that the reissue application will be allowed on the next Office action. Such authorization will reduce the delays in the Office awaiting receipt of the issue fee. Where there are no errors to be corrected over those already covered by an oath or declaration submitted under paragraphs (a) and (b)(1) of this section, *e.g.*, the application is allowed on first action, or where a supplemental oath or declaration has been submitted prior to allowance and no further errors have been corrected, a supplemental oath or declaration under this paragraph, or additional supplemental oath or declaration under paragraph (b)(1), would not be required.

Paragraph (b)(2) would provide that for any error sought to be corrected after allowance, e.g., under § 1.312, a supplemental oath or declaration must accompany the requested correction stating that the error(s) to be corrected arose without any deceptive intent on the part of the applicant.

The quotes around lack of deceptive intent in § 1.175(a)(6) would be removed as the exact language would not be required. Section 1.175(a)(7), referencing § 1.56, is proposed to be removed as unnecessary in view of the reference to § 1.56 in § 1.63 that is also referred to by § 1.175(a). Section 1.175(b) noting the ability of applicant to file affidavits or declarations of others and the ability of the examiner to require additional information would be deleted as unnecessary in view of § 1.132 and 35 U.S.C 132. A reference to § 1.53(b) would be inserted in newly proposed § 1.175(c) to clarify that the initial oath or declaration under § 1.175(a) including those requirements under § 1.63 need not be submitted (with the specification, drawing and claims) in order to obtain a filing date.

37 CFR 1.176 would be amended to permit the Office to require restriction between claims added in a reissue application and the original patent claims, where the claims added in the reissue application are separate and distinct from the original patent claims.

This change is provided to deal with the added examination burden which results when new inventions are added via the reissue application. The Office would continue to not require restriction between original claims of the patent, i.e., between claims that were in the patent prior to filing the reissue application. In order for restriction to be required between the original patent claims and the newly added claims, the newly added claims must be separate and distinct from the original patent claims. Restriction between multiple inventions in the newly added claims would also be possible provided the newly added claims are drawn towards separate and distinct inventions.

Section 1.177 is proposed to be amended to discontinue the current practice that copending reissue applications must be issued simultaneously unless ordered otherwise by the Commissioner pursuant to petition.

Section 1.177 is proposed to be further amended by creating paragraphs (a) through (d) to clarify when multiple reissue patents may be issued and the conditions that applicant must comply with in order to have the Commissioner exercise his or her discretion and authorize issuance of multiple reissue patents. The Commissioner has discretion pursuant 35 U.S.C. 251 to permit the issuance of multiple reissue patents for distinct and separate parts of the thing patented. The Commissioner will exercise his or her statutory discretion under the limited conditions set forth in paragraph (a) of this section. Absent compliance with the provisions of paragraph (a) of this section, as defined by paragraphs (b) and (c) of this section, the Commissioner will not exercise his or her discretion under the statute and will not permit the issuance of multiple reissue applications, as is set forth in paragraph (d) of this section.

The conditions for the Commissioner to exercise his or her discretion and permit multiple reissue patents to be issued for distinct and separate parts of the thing patented set forth in paragraph (a) of this section are as follows: (1) Copending reissue applications for distinct and separate parts of the thing patented have been filed, (2) Applicant has filed in each copending reissue application a timely demand by way of petition for multiple reissue patents, (3) The required filing and issue fees for each copending reissue application have been paid, and (4) The petition for multiple reissue patents is granted prior to issuance of a reissue patent on any of the copending reissue applications.

Paragraph (b) of § 1.177 would set forth the requirements of the petition provided for in paragraph (a)(2) of this section, which requirements are: (1) A request for the issuance of multiple reissue patents for distinct and separate parts of the thing patented, (2) The petition fee pursuant to § 1.17(i), (3) An identification of the other copending reissue application(s), (4) A statement that the inventions as claimed in the copending reissue applications are distinct and separate parts of the thing patented, and (5) A showing sufficient to establish to the satisfaction of the Commissioner that the claimed subject matter of the thing patented is in fact being divided into distinct and separate parts.

The ''distinct and separate parts of the thing patented'' means two things: (1) That the thing patented is being proposed to be divided into separate parts, i.e., the claims in the original patent are being separated into different reissue applications, and (2) that the divided claims are distinct as set forth in MPEP 802.01.

Items (4) and (5) are intended to cover those situations where the Commissioner can and has determined, based on material and/or information supplied by applicant, or otherwise, that the subject matter of the thing patented is in fact being separated into parts that are distinct.

The Commissioner intends to delegate the authority for decisions on the petitions required under this section to the Group Directors of the groups where the copending reissue applications are pending.

Paragraph (c) of § 1.177 would define the timeliness requirements for submission of the petitions set forth in paragraph (a)(1) of this section. When the copending reissue applications are filed at the same time, the petitions must be filed no later than the earliest submission of the reissue oath or declaration under § 1.175(a) for any of the copending reissue applications. When the copending reissue applications are filed at different times, the petitions must be filed no later than the earliest of: (1) Payment of the issue fee for any of the copending reissue applications, or (2) submission of the reissue oath or declaration under § 1.175 in the later filed copending reissue application.

Paragraph (d) of § 1.177 sets forth that the Commissioner will not permit multiple reissue patents to be issued if the requirements of this section are not met.

It is contemplated that where the requirements of paragraphs (a) and (b) of § 1.177 are capable of being perfected, the Office will give a one-month time period for perfection, with extensions of time available under § 1.136(a). Where a first copending reissue application has issued, however, perfection would not be possible. It is not the intent of the Commissioner to provide any possibility of review by way of appeal to the Board of Patent Appeals and Interferences from his or her determination that the requirements of this section have not been complied with. Review of determinations on questions as to whether it has been established that the copending reissue applications are for distinct and separate parts of the thing patented will be by way of petition under § 1.181(a)(3) and subsequently to court as to whether the Commissioner, or his or her designate, has properly exercised the discretion provided by 35 U.S.C. 251 as is now proposed to be implemented in § 1.177.

The proposed changes are not intended to affect the type of errors that are or are not appropriate for correction under 35 U.S.C. 251, e.g., a patent granted on elected claims will not be considered to be partially inoperative by reason of claiming less than they had a right to claim and applicant's failure to timely file a divisional application is not considered to be the type of error that can be corrected by a reissue. MPEP 1402 and 1450.

Section 1.177 is also proposed to be clarified by a new more descriptive title in view of the substantive amendments and a reference to the statutory authority.

Section 1.181 is proposed to be amended by removing paragraphs (d), (e) and (g) as unnecessary and at most representing internal instructions.

Section 1.182 is proposed to be amended by providing that a petition under the section may be granted ''subject to such other requirements as may be imposed'' by the Commissioner, language similar to that appearing for petitions under § 1.183. The section would have removed as unnecessary a statement that a decision on a petition thereunder will be communicated to interested parties in writing.

Section 1.184 is proposed to be removed and reserved as representing internal instructions.

Section 1.191 would be amended, to provide for an appeal only after the claims of an applicant or a patent owner of a patent under reexamination are twice rejected, by deletion of appeal after having received a final rejection. The reference to a final rejection is deemed unnecessary in view of the proposed amendment to § 1.113 by addition of paragraph (c) prohibiting a first action final rejection. An appeal

would not then be appropriate in any application including reissue and continued prosecution (§ 1.53(b)(3)) applications or in a patent under reexamination unless that application or that patent under reexamination in which an appeal is filed has been twice rejected, particularly in view of the elimination of first action final rejections. A second rejection need not be a final rejection for an appeal to be taken as is currently the practice. However, an applicant or patent owner of a patent under reexamination would not be able to appeal after a first action rejection in a continuation, divisional or continued prosecution application as no first action would be a final rejection and the only basis to appeal would be that the claims of an applicant or patent owner of a patent under reexamination have been twice rejected in the same application or the same patent under reexamination.

Section 1.191, paragraph (a), would be amended for conformance with the language of 35 U.S.C. 134 by replacement of ''the claims of which have'' by ''whose claims have.'' Section 1.191 would also be amended by replacement of ''response'' with ''reply'' in accordance with the proposed change to § 1.111.

Sections 1.192, 1.193, 1.194, 1.196, and 1.197 are proposed to be amended to change ''the appellant'' to ''appellant'' for consistency. Paragraph (a) of § 1.192 would be amended by replacement of ''response'' with ''reply'' in accordance with the proposed change to § 1.111.

Section 1.193 would be amended in its title by addition of ''and substitute brief'' to more accurately reflect the section's contents. Section 1.193 would also be amended, by revision of paragraph (a) into paragraphs (a)(1) and (a)(2) and revision of paragraph (b) into paragraphs (b)(1) and (b)(2). Paragraph (a)(1) would retain the subject matter of current paragraph (a). Paragraph (a)(2) would specifically prohibit the inclusion of a new ground of rejection in an examiner's answer.

Paragraph (b)(1) would remove the current discretion under existing paragraph (b) of this section of the examiner to enter a new ground of rejection in an examiner's answer responding to an appeal in conformance with proposed paragraph (a)(2). Paragraph (b)(1) would require the examiner to reopen prosecution to enter any new ground of rejection. Reopening of prosecution would require entering of any previously submitted paper that has been refused entry.

Paragraph (b)(1) of § 1.193 would also provide appellant with a right to file a substitute appeal brief in compliance with § 1.192 in reply to an examiner's answer where the right to file a substitute appeal brief would not be dependent upon a new point of argument being present in the examiner's answer. The current practice of permitting reply briefs based solely on a finding of a new point of argument, as set forth in current paragraph (b), would be eliminated thereby preventing present controversies as to whether a new point of argument has been made by the primary examiner. Appellant would be assured of having the last submission prior to review by the Board. Upon receipt of a substitute appeal brief the examiner would either acknowledge its receipt and entry or reopen prosecution to respond to any new issues raised in the substitute appeal brief. Should the Board desire to remand the appeal to the primary examiner for comment on the latest submission by appellant or to clarify an examiner's answer, MPEP 1211,1211.01, and 1212, appellant would be entitled to submit a substitute appeal brief in response to the reply by the examiner to the Board's inquiry, which reply would be by way of a substitute examiner's answer. The use of substitute appeal briefs and substitute examiner's answers is intended to provide the Board with a single most current paper from each party.

Paragraph (b)(2) of § 1.193 would provide that if appellant desires that the appeal process be reinstated in reply to the examiner's reopening of prosecution under paragraph (b)(1) of this section, appellant would be able to file a new appeal brief under § 1.192 and a request to reinstate the appeal. Amendments, affidavits or other new evidence would not be entered if submitted with a request to reinstate the appeal. Reinstatement of the appeal would constitute a new notice of appeal but no additional appeal fees would be required, since such fees have been previously paid. The intent of the rule change is to give appellant (rather than the examiner) the option to continue the appeal if desired (particularly under a 20 year term), or to continue prosecution before the examiner in the face of a new ground of rejection. Should an appeal brief be elected as the response to the examiner reopening prosecution based on a new ground of rejection under paragraph (b)(1) of this section, the examiner may under paragraph (a)(1) of this section issue an examiner's answer.

Section 1.194, paragraph (b), is proposed to be amended to provide that a request for an oral hearing must be filed in a separate paper.

Section 1.194, paragraph (c), is proposed to be amended to provide that appellant will be notified when a requested oral hearing is unnecessary, e.g., a remand is required.

Section 1.196, paragraphs (b) and (d), are proposed to be combined by amending paragraph (b) to specifically provide in paragraph (b) for a new ground of rejection for both appealed claims and for allowed claims present in an application containing claims that have been appealed rather than the current practice under paragraph (d) of recommending a rejection of allowed claims that is binding on the examiner. The effect of an explicit rejection of an allowed claim by the Board of Patent Appeals and Interferences is not seen to differ from a recommendation of a rejection and would serve to advance the prosecution of the application by having the rejection made at an earlier date by the Board of Patent Appeals and Interferences rather than waiting for the application to be forwarded and acted upon by the examiner. The current practice, that the examiner is not bound by the rejection should appellant elect to proceed under paragraph (b)(1) and an amendment or showing of facts not previously of record in the opinion of the examiner overcomes the new ground of rejection, is not proposed to be changed. A period of two months would now explicitly be set forth for a reply to a decision by the Board of Patent Appeals and Interferences containing a new ground of rejection pursuant to § 1.196(b), which would alter the one month now set forth for replies to recommended rejections of previously allowed claims. MPEP 1214.01, page 1200–28. Extensions of time would continue to be governed by § 1.196(f) and § 1.136(b) (and not by § 1.136(a)).

The last sentence of paragraph (b)(2) of § 1.196 would be amended to clarify that appellants do not have to both appeal and file request for reconsideration where only a reconsideration of a portion of the decision is sought in that a decision on a request for reconsideration will incorporate the earlier decision for purposes of appeal of the earlier decision for which only a partial request for reconsideration may have been filed. Additionally it is clarified that decisions on reconsideration are final unless noted otherwise in the decision in that under some circumstances it may not be appropriate to make a decision on reconsideration final as is currently automatically provided for.

Section 1.196 would have a new paragraph (d) providing the Board of Patent Appeals and Interferences with explicit authority to have an appellant

clarify the record in addition to what is already provided by way of remand to the examiner, MPEP 1211, and appellant's compliance with the requirements of an appeal brief, § 1.192(d). Paragraph (d)(1) would provide that an appellant may be required to address any matter that is deemed appropriate for a reasoned decision on the pending appeal. Such matters would include:

(1) The applicability of particular case law that has not been previously identified as relevant to an issue in the appeal,

(2) The applicability of prior art that has not been made of record, and

(3) The availability of particular test data that would be persuasive in rebutting a ground of rejection.

Paragraph (d)(2) would provide that appellant would be given a time limit within which to reply to any inquiry under paragraph (d)(1) of this section. Time limits, unlike time periods for reply, are not extendable under § 1.136(a).

Section 1.197, paragraph (b), is proposed to be amended to provide a period of two months, rather than the one month currently provided, for the single request for reconsideration or modification of the Board decision as provided for in § 1.197(b).

Section 1.291, paragraph (c), is proposed to be amended by removing the blanket limitation of one protest per protestor and would provide for a second or subsequent submission in the form of additional prior art. Mere argument that is later submitted by an initial protestor would continue not to be entered and returned unless it is shown that the argument relates to a new issue that could not have been earlier raised. MPEP 1907(b). Although, later submitted prior art would be made of record by a previous protestor without a showing that it relates to a new issue, it should be noted that entry of later submitted prior art in the file record does not assure its consideration by the examiner if submitted late in the examination process. Accordingly, initial protests should be as complete as possible when first filed.

In view of the proposed change to § 1.291(a) of this section in the 18-Month Publication Notice of Proposed Rulemaking, discussed *supra*, e.g., at § 1.62 of the preamble, limiting the filing of protests to the issuance of patents to particular time periods (none after the notice of allowance is mailed, none after two months from publication or the filing of protests with a fee during the two-month period from publication where a notice of allowance has not been mailed), the restriction of protests by number is deemed unnecessary and is recognized as ineffective in that the current rule may allow for more than one protest to be filed on behalf of a party.

Section 1.291 paragraph (c) would be amended by replacement of ''response'' with ''reply'' in accordance with the proposed change to § 1.111.

Section 1.294 paragraph (b) would be amended by replacement of ''response'' with ''reply'' in accordance with the proposed change to § 1.111.

Section 1.304(a)(1) is proposed to be amended to replace ''consideration'' by ''reconsideration,'' an error that resulted from mistyping when it first appeared in the Federal Register.

Section 1.312, paragraph (b), is proposed to have a reference to § 1.175(b) added in view of the proposed change in § 1.175(b) referencing § 1.312(b).

Section 1.313 is proposed to be amended by the addition of paragraph (c) informing applicants that unless written notification is received that the application has been withdrawn from issue at least two weeks prior to the projected date of issue, applicants should expect that the application will issue as a patent. Once an application has issued, the Office is without authority to grant a request under § 1.313 notwithstanding submission of the request prior to issuance of the patent.

Sections 1.316 (b) through (f) are proposed to be removed as they would be combined in proposed § 1.137.

Sections 1.317 (b) through (f) are proposed to be removed as they would be combined in proposed § 1.137.

Section 1.318 is proposed to be removed and reserved as being an internal Office instruction.

Section 1.324 is proposed to be amended by creating paragraphs (a) and (b). The requirement for factual showings to establish a lack of deceptive intent would be deleted, with a statement to that effect being sufficient, paragraph (a).

As Office practice (MPEP 1481) is to require the same type and character of proof of facts as in petitions under § 1.48(a), a showing of diligence proposed to be deleted in § 1.48 would not be continued in either § 1.48 or § 1.324, which currently follows the requirements of § 1.48. The applicability of a rejection under 35 U.S.C. 102(f)/(g) against a patent with the wrong inventorship set forth therein is deemed to provide sufficient motivation for prompt correction of the inventorship without the need for a separate requirement for diligence.

The parties set forth in 35 U.S.C. 256 are interpreted to be only the person named as an inventor or not named as an inventor through error. Accordingly, § 1.324 is proposed to be amended, paragraph (b)(1), to explicitly require a statement relating to the lack of deceptive intent only from each person who is being added or deleted as an inventor, as opposed to the current practice of requiring a statement from each original named inventor and any inventor to be added.

The current requirements for an oath or declaration under § 1.63 by each actual inventor would be replaced, paragraph (b)(2) of § 1.324, by a statement from the current named inventors who have not submitted a statement under paragraph (b)(1) of § 1.324 either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change. Not every original named inventor would necessarily have knowledge of each of the contributions of the other inventors and/or how the inventorship error occurred, in which case their lack of disagreement to the requested change would be sufficient.

Paragraph (b)(3) of § 1.324 would require the written consent of the assignees of all parties who submitted a statement under paragraph (b)(1) and (b)(2) of this section similar to the current practice of consents by the assignees of all the existing patentees. A clarification reference to § 3.73(b) has been added.

Paragraph (b)(4) of § 1.324 states the requirement for a petition fee as set forth in § 1.20(b).

Section 1.325 relating to mistakes not corrected is proposed to be removed and reserved as unnecessary in that mistakes cannot be corrected unless a basis for their correction is found.

Sections 1.351 and 1.352 are proposed to be removed and reserved as unnecessary in that they are internal instructions.

Section 1.366, paragraph (b), would have the term ''certificate'' removed as unnecessary. Paragraph (c) would be clarified by changing ''serial number'' to ''application number'' which consists of the serial number and the series code (*e.g.*, ''08/''). Paragraph (d) would have the suggested requirements for the patent issue date and the application filing date removed as unnecessary in that the patent number is sufficient to identify the file and the change parallels an intended deletion of these dates from forms PTO/SB/45 and PTO/SB/47. The term ''serial'' would be removed from paragraph (d).

Section 1.377, paragraph (c), would be amended to remove the requirement

that the petition be verified in accordance with the proposed change to § 1.4(d)(2).

Section 1.378, paragraph (d), would be amended to remove the requirement that the statement be verified in accordance with the proposed change to § 1.4(d)(2).

Section 1.425 would be amended by removing paragraph (a) and its requirement for: Proof of the pertinent facts, which relates to the lack of cooperation or unavailability of the inventor for which status is sought and by deleting paragraph (b) and its requirements for: Proof of the pertinent facts, the presence of a sufficient proprietary interest, and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. Additionally, the requirement that the last known address of the non-signing inventor be stated would be removed. The current requirements are thought to be unnecessary in view of the need for submission of the same information in a petition under 37 CFR 1.47 during the national stage. The paragraph to be added would parallel the requirement in PCT Rule 4.15 for a statement explaining to the satisfaction of the Commissioner the lack of the signature concerned.

Section 1.484, paragraphs (d) through (f), would be amended by replacement of ''response'' and ''respond'' with ''reply'' in accordance with the proposed change to § 1.111.

Section 1.485 paragraph (a) would be amended by replacement of ''response'' with ''reply'' in accordance with the proposed change to § 1.111.

Section 1.488, paragraph (b), would be amended by replacement of ''response'' with ''reply'' in accordance with the proposed change to § 1.111.

Section 1.492 proposed to be amended to add new paragraph (g).

Section 1.494, paragraph (c), would be amended by replacement of ''response'' with ''reply'' in accordance with the proposed change to § 1.111.

Section 1.495, paragraph (c)(2), would be amended by replacement of ''response'' with ''reply'' in accordance with the proposed change to § 1.111.

Section 1.510, paragraph (e), would be amended to replace a reference to § 1.121(f), in view of it proposed removal, with a reference to § 1.530(d) in view of its proposed revision.

Section 1.530 the title and paragraph (a) would be amended by replacement of ''amendment'' and ''response'' with ''reply'' in accordance with the proposed change to § 1.111.

Section 1.530, paragraph (d), would be replaced by paragraphs (d)(1) through (d)(6) removing the reference to § 1.121(f) in accordance with the proposed deletion of § 1.121(f). The manner of making amendments in reexamination proceeding under the current reexamination practice is governed by § 1.530 (d)(1) through (d)(6). Paragraph (d) would apply to proposed amendments in reexamination proceedings. Paragraph (d)(1) would be directed to the manner of proposing amendments in the specification other than in the claims. Paragraph (d)(1)(i) would require the precise point to be indicated where a proposed amendment is to be made. Paragraph (d)(1)(ii) would require that all amendments including deletions be made by submission of a copy of the rewritten paragraph(s) with markings. A change in one sentence, paragraph, or page that results in only format changes to other pages not being amended are not to be submitted. Paragraph (d)(1)(iii) would require proposed amendments to the specification to be made by rewritten relative to the patent specification and not relative to a previous proposed amendment. Paragraph (d)(1)(iv) would define the markings set forth in paragraph (d)(1)(ii).

Paragraph (d)(2) of § 1.530 would relate to the manner of proposing amendment of the claims in reexamination proceedings. Paragraph (d)(2)(i)(A) would require that a proposed amendment include the entire text of each patent claim which is proposed to be amended, but not all pending claims, such as patent claims that have not been proposed to be amended. Additionally, provision would be made for the cancellation of patent or of a proposed claim by a direction to cancel without the need for marking by brackets. Compare with deletion of claims in reissue applications where only patent claims and not added claims may be cancelled by direction, paragraph (b)(2)(i)(A). Paragraph (b)(2)(i)(B) would prohibit the renumbering of the patent claims and require that any proposed added claims follow the number of the highest numbered patent claim. Paragraph (b)(2)(i)(C) would identify the type of markings required by paragraph (d)(2)(i)(A), single underlining for added material and single brackets for material deleted.

Paragraph (d)(2)(ii) would require the patent owner to set forth the status of all patent claims, of all currently proposed claims, and of all previously proposed claims that are no longer being proposed as of the date of submission of each proposed amendment. Compare with § 1.121(b)(2)(ii), which does not require the status of patent claims that were not amended or of added claims that were cancelled.

Paragraph (d)(2)(iii) of § 1.530 would require an explanation of the support in the disclosure for any proposed first-time amendments to the claims on pages separate from the amendments along with any additional comments. The absence of an explanation would result in an incomplete reply, 35 U.S.C. 135.

Paragraph (d)(2)(iv) of § 1.530 would require that each submission of a proposed amendment to any claim (patent claims and all proposed claims) requires copies of all proposed amendments to the claims as of the date of the submission. A copy of a previous amendment would not meet the requirement of this section in that all amendments must be represented, as only the last amendment will be used for printing. A copy of a patent claim that has not been proposed to be amended is not to be presented.

Paragraph (d)(2)(v) of § 1.530 would provide that the failure to submit a copy of any proposed added claim would be construed as a direction to cancel that claim.

Paragraph (d)(3) of § 1.530 would clarify that: (1) A proposed amendment may not enlarge the scope of the claims of the patent, (2) that no amendment may be proposed in an expired patent, and (3) no amendment will be incorporated into the patent by certificate issued after the expiration of the patent.

Paragraph (d)(4) of § 1.530 would clarify that amendments proposed to a patent during reexamination proceedings will not be effective until a reexamination certificate is issued.

Paragraph (d)(5) of § 1.530 would provide the specifications that the form of papers must comply with in reexamination proceedings, e.g., paper size must be either letter size or A4 size (and not legal size).

Paragraph (d)(6) of § 1.530 would clarify that proposed amendments to the patent drawings are not permitted and that any change must be by way of a new sheet of drawings with the proposed amended figures being identified as ''amended'' and with proposed added figures identified as ''new'' for each sheet that has changed.

Section 1.550, paragraphs (a), (b), and (d), would be amended by replacement of ''response,'' ''responses'' and ''respond'' with ''reply'' in accordance with the proposed change to § 1.111.

Section 1.560, paragraph (b), would be amended by replacement of ''response'' with ''reply'' in accordance with the proposed change to § 1.111.

Section 1.770 would be amended by replacement of ''response'' with ''reply''

in accordance with the proposed change to § 1.111.

Section 1.785 would be amended by replacement of ''response'' with ''reply'' in accordance with the proposed change to § 1.111.

Section 1.804, paragraph (b), would be clarified grammatically by changing ''shall state'' to ''stating'' and would be amended to delete the requirement that the statement be verified in accordance with the proposed change to § 1.4(d)(2).

Section 1.805, paragraph (c), would be amended by replacement of ''verified'' with ''statement'' in accordance with the proposed change to § 1.111 and removing unnecessary language noting that an attorney or agent registered to practice need not verify their statements.

Portions of part 3 are proposed to be amended to incorporate part 7 that is proposed to be removed and reserved.

Section 3.11(a) is proposed to be created for the current subject matter and a new paragraph (b) would be added citing Executive Order 9424 and its requirements by several departments and other executive agencies of the Government for forwarding items for recording.

Section 3.26 would be amended to remove the requirement that English language translation be verified in accordance with the proposed change to § 1.4(d)(2).

Section 3.27(a) is proposed to be added to include current subject matter and an exception for § 3.27(b) that would be added citing Executive Order 9424 and a mailing address therefor.

Section 3.31(c) is proposed to be added to require that the cover sheet must indicate that the document is to be recorded on the governmental register and if applicable that the document is to be recorded on the Secret Register and that the document will not affect title.

Section 3.41(a) is proposed to be added for the current subject matter and a § 3.41(b) added to note when no recording fee is required in § 3.41(b)(1) through (3) when it is required by Executive Order 9424.

Section 3.51 is proposed to be amended by removing the term ''certification'' as unnecessary in accordance with the proposed change to § 1.4(d)(2).

Section 3.58 is proposed to be added to provide for the maintaining of a Department Register to record Government interests required by Executive Order 9424 in § 3.58(a). New § 3.58(b) would provide that the Office maintain a Secret Register to record Government interests also required by the Executive Order.

Section 3.73(b) is proposed to be amended to remove the sentence requiring an assignee to specifically state that the evidentiary documents have been reviewed and to certify that title is in the assignee seeking to take action. The sentence is deemed to be unnecessary in view of the proposed amendment to § 1.4(d). Section 3.73(b) has been clarified by addition of a reference to an example of documentary evidence that can be submitted.

Section 5.1 is proposed to be amended by removing the current subject matter as being duplicative of material in the other sections of this part and to be replaced by subject matter proposed to be deleted from § 5.33.

Section 5.2(b) through (d) are proposed to be removed as repetitive of material in the sections following with § 5.2(b) being replaced with subject matter of the first sentence from § 5.7.

Section 5.3 would be amended by replacement of ''response'' with ''reply'' in accordance with the proposed change to § 1.111.

Section 5.4 is proposed to be amended by removing unnecessary subject matter from paragraph (a), eliminating, in paragraph (d), the requirement that the petition be verified in accordance with the proposed amendment to § 1.4(d)(2) and by adding the first sentence of § 5.8 to paragraph (d).

Section 5.5 is proposed to be amended by removing unnecessary subject matter from paragraph (b) and by replacing current § 5.5(e) with subject matter proposed to be removed from § 5.6(a).

Section 5.6 is proposed to be removed and reserved with the subject matter of § 5.6(a) being placed in proposed § 5.5(e).

Section 5.7 is proposed to be removed and reserved with the first sentence thereof being placed in proposed § 5.2(b).

Section 5.8 is proposed to be removed and reserved with the subject matter from the first sentence thereof being placed in proposed § 5.4(e).

Sections 5.11 (b) and (c) are proposed to be amended to update the references to other parts of the Code of Federal Regulations.

Section 5.13 is proposed to be amended by removing the last two sentences which are considered to be unnecessary.

Section 5.14(a) is proposed to be amended by removing unnecessary subject matter and replacing ''serial number'' with the more appropriate designation ''application number''.

Section 5.15(a) is proposed to be amended by removing unnecessary subject matter and to update the references to other parts of the Code of Federal Regulations.

Section 5.16 is proposed to be removed and reserved as unnecessary.

Section 5.17 is proposed to be removed and reserved as unnecessary.

Section 5.18 is proposed to be amended to update the references to other parts of the Code of Federal Regulations.

Sections 5.19 (a) and (b) are proposed to be amended to update the references to other parts of the Code of Federal Regulations. Section 5.19(c) is proposed to be removed as unnecessary.

Section 5.20(b) is proposed to be removed as unnecessary.

Section 5.25(c) is proposed to be removed as unnecessary.

Section 5.31 is proposed to be removed and reserved as unnecessary.

Section 5.32 is proposed to be removed and reserved as unnecessary.

Section 5.33 is proposed to be removed and reserved and the subject matter added to § 5.1.

Part 7 is proposed to be removed and reserved as the substance thereof has been incorporated into part 3.

Compilation of Inquiries to Public

The Supplementary Information portion and the preamble portion of § 1.137 request comments on the advisability of applying retroactively provisions in the final rules to papers submitted prior to the effective date of the final rule changes.

The § 1.121 portion of the preamble requests comments regarding the advisability of harmonizing reissue practice with reexamination practice.

The § 1.137(b) portion of the preamble requests comments on alternatives as to the time period for submitting a petition thereunder.

Review Under the Paperwork Reduction Act of 1995

This proposed rule contains information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995. The title, description and respondent description of each of the information collections are shown below with an estimate of each of the annual reporting burdens. The collections of information in this proposed rule have been reviewed and approved by, or are pending approval by the OMB under the following control numbers: 0651–0035, 0651–0033, 0651–0031, 0651–0016, 0651–0032 and 0651–0027. Included in each estimate is the time for reviewing instructions, gathering and maintaining the data

needed, and completing and reviewing the collection of information.

With respect to the following collections of information, the Office invites comments on: (1) Whether the proposed collection of information is necessary for the proper performance of the Office's functions, including whether the information will have practical utility; (2) The accuracy of the Office's estimate of the burden of the proposed collection of information, including the validity of the methodology and assumptions used; (3) Ways to enhance the quality, utility, and clarity of the information to be collected; and (4) Ways to minimize the burden of the collection of information on respondents, including through the use of automated collection techniques, when appropriate, and other forms of information technology.

Notwithstanding any other provision of law, no person is required to respond to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

OMB Number: 0651–0035.

Title: Address-Affecting Provisions.

Form Numbers: PTO/SB/82/83.

Type of Review: Pending OMB approval.

Affected Public: Individuals or Households, Business or Other Non-Profit, Not-for-Profit Institutions and Federal Government.

Estimated Number of Respondents: 44,850.

Estimated Time Per Response: 0.2 hour.

Estimated Total Annual Burden Hours: 8,970 hours.

Needs and Uses: Under existing law, a patent applicant or assignee may appoint, revoke or change a representative to act in a representative capacity. Also, an appointed representative may withdraw from acting in a representative capacity. This collection includes the information needed to ensure that Office correspondence reaches the appropriate individual.

OMB Number: 0651–0033.

Title: Post Allowance and Refiling.

Form Numbers: PTO/SB/13/14/44/50–57; PTOL–85b.

Type of Review: Pending OMB approval.

Affected Public: Individuals or Households, Business or Other Non-Profit, Not-for-Profit Institutions and Federal Government.

Estimated Number of Respondents: 165,900.

Estimated Time Per Response: 0.382 hour.

Estimated Total Annual Burden Hours: 63,400 hours.

Needs and Uses: This collection of information is required to administer the patent laws pursuant to Title 35 of the U.S. Code concerning the issuance of patents and related actions including correcting errors in printed patents, refiling of patent applications, requesting reexamination of a patent, and requesting a reissue patent to correct an error in a patent. The affected public includes any individual or institution whose application for a patent has been allowed or who takes action as covered by the applicable rules.

OMB Number: 0651–0031.

Title: Patent Processing (Updating).

Form Numbers: PTO/SB/08–12/21–26/31/32/42/43/61–64/67–69/91–93/96/97.

Type of Review: Pending OMB approval.

Affected Public: Individuals or Households, Business or Other Non-Profit Institutions, Not-for-Profit Institutions and Federal Government.

Estimated Number of Respondents: 364,000.

Estimated Time Per Response: 1.779 hours.

Estimated Total Annual Burden Hours: 647,720 hours.

Needs and Uses: During the processing for an application for a patent, the applicant/agent may be required or desire to submit additional information to the Office concerning the examination of a specific application. The specific information required or which may be submitted includes: Information Disclosure Citations; Terminal Disclaimers; Petitions to Revive; Express Abandonment; Appeal Notice; Small Entity; Petition for Access; Power to Inspect; Certificate of Mailing; Amendment Transmittal Letter; Deposit Account Order Form.

OMB Number: 0651–0016.

Title: Rules for Patent Maintenance Fees.

Form Numbers: PTO/SB/45/46/47/65/66.

Type of Review: Pending OMB approval.

Affected Public: Individuals or Households, Business or Other Non-Profit, Not-for-Profit Institutions and Federal Government.

Estimated Number of Respondents: 273,800.

Estimated Time Per Response: .08 hour.

Estimated Total Annual Burden Hours: 22,640 hours.

Needs and Uses: Maintenance fees are required to maintain a patent in force under Title 35 of the U.S. Code. Payment of maintenance fees are required at 3½, 7½ and 11½ years after the grant of the patent. A patent number and serial number of the patent on which maintenance fees are paid are required in order to ensure proper crediting of such payments.

OMB Number: 0651–0032.

Title: Initial Patent Application.

Form Number: PTO/SB/01–07/17–20/101–109.

Type of Review: Currently approved through 9/98.

Affected Public: Individuals or Households, Business or Other Non-Profit, Not-for-Profit Institutions and Federal Government.

Estimated Number of Respondents: 221,000.

Estimated Time Per Response: 10.8 hours.

Estimated Total Annual Burden Hours: 2,387,000 hours.

Needs and Uses: The purpose of this information collection is to permit the Office to determine whether an application meets the criteria set forth in the patent statutes and regulations. The standard Fee Transmittal form, New Utility Patent Application Transmittal form, New Design Patent Application Transmittal form, New Plant Patent Application Transmittal form, Plant Color Coding Sheet, Declaration, and Plant Patent Application Declaration will assist applicants in complying with the requirements of the patent statutes and regulations, and will further assist the Office in processing and examination of the application.

OMB Number: 0651–0027.

Title: Changes in Patent and Trademark Assignment Practices.

Form Numbers: PTO–1618 and PTO–1619, PTO/SB/15/41.

Type of Review: Currently approved through 9/98.

Affected Public: Individuals or households and businesses or other for-profit institutions.

Estimated Number of Respondents: 170,000.

Estimated Time Per Response: 0.5 hour.

Estimated Total Annual Burden Hours: 85,000 hours.

Needs and Uses: The Office records about 170,000 assignments or documents related to ownership of patent and trademark cases each year. The Office requires a cover sheet to expedite the processing of these documents and to ensure that they are properly recorded.

As required by the Paperwork Reduction Act of 1995 (44 U.S.C.

3507(d)), the Office has submitted a copy of this proposed rulemaking to OMB for its review of these information collections. Interested persons are requested to send comments regarding these information collections, including suggestions for reducing this burden, to the Office of Information and Regulatory Affairs of OMB, New Executive Office Bldg., 725 17th St. NW, rm. 10235, Washington, DC 20503, Attn: Desk Officer for the Patent and Trademark Office.

OMB is required to make a decision concerning the collections of information contained in these proposed regulations between 30 and 60 days after publication of this document in the Federal Register. Therefore, a comment to OMB is best assured of having its full effect if OMB receives it within 30 days of publication. This does not affect the deadline for the public to comment to the Office on the proposed regulations.

Other Considerations

This proposed rule change is in conformity with the requirements of the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*), Executive Order 12612, and the Paperwork Reduction Act of 1995, 44 U.S.C. 3501 *et seq.* It has been determined that this rulemaking is not significant for the purposes of Executive Order 12866.

The Assistant General Counsel for Legislation and Regulation of the Department of Commerce has certified to the Chief Counsel for Advocacy, Small Business Administration that the proposed rule change would not have a significant impact on a substantial number of small entities (Regulatory Flexibility Act, Pub. L. 96–354). The principal impact of these proposed changes is to reduce the regulatory burden on the public in filing patent applications and petitions therein.

The PTO has determined that this proposed rule change has no Federalism implications affecting the relationship between the National Government and the States as outlined in Executive Order 12612.

List of Subjects

37 CFR Part 1

Administrative practice and procedure, Deceptive intent, Inventions and patents.

37 CFR Part 3

Administrative practice and procedure, Inventions and patents.

37 CFR Part 5

Inventions and patents, Licenses and exports, Secrecy.

37 CFR Part 7

Inventions and patents.

For the reasons set forth in the preamble, 37 CFR parts 1, 3, 5 and 7 are proposed to be amended as follows, with removals indicated by brackets ([ ]) and additions are indicated by arrows (> <):

PART 1— RULES OF PRACTICE IN PATENT CASES

1. The authority citation for part 1 continues to read as follows:

Authority: 35 U.S.C. 6, 23, unless otherwise noted.

1a. Section 1.4 is proposed to be amended by revising paragraph (d) and by adding paragraph (g) to read as follows:

§ 1.4 Nature of correspondence and signature requirements.

* * * * *

(d)>(1)< Each piece of correspondence, except as provided for in paragraphs (e) and (f) of this section, filed in a patent or trademark application, reexamination proceeding, patent file or trademark registration file, trademark opposition proceeding, trademark cancellation proceeding, or trademark concurrent use proceeding, which requires a person's signature, must either:

[(1)]>(i)< Be an original, that is, have an original signature personally signed in permanent ink by that person; or

[(2)]>(ii)< Be a copy, such as a photocopy or facsimile transmission (§ 1.6(d)), of an original >or of a copy of a copy<. In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Patent and Trademark Office may require submission of the original.

>(2) By presenting to the Office any paper the party submitting such paper is certifying that to the best of the person's knowledge, information and belief, formed after an inquiry reasonable under the circumstances that:

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(3) Sanctions:

(i) Violations of paragraphs (d)(2)(i) to (iv) of this section after notice and reasonable opportunity to respond are subject to such sanctions as are deemed appropriate by the Commissioner including issuance of a Notice of Termination of Proceedings or return of papers; and

(ii) Whoever, in any matter within the jurisdiction of the Patent and Trademark Office knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth in 18 U.S.C. 1001, and may jeopardize the validity or enforceability of the application or any patent issuing thereon.<

* * * * *

>(g) An applicant who has not made of record a registered attorney or agent may be required to state whether assistance was received in the preparation or prosecution of the patent application, for which any compensation or consideration was given or charged, and if so, to disclose the name or names of the person or persons providing such assistance. Assistance includes the preparation for the applicant of the specification and amendments or other papers to be filed in the Patent and Trademark Office, as well as other assistance in such matters, but does not include merely making drawings by draftsmen or stenographic services in typing papers.<

2. Section 1.6 is proposed to be amended by revising paragraph (e) to read as follows:

§ 1.6 Receipt of correspondence.

* * * * *

(e) *Interruptions in U.S. Postal Service.* If interruptions or emergencies in the United States Postal Service which have been so designated by the Commissioner occur, the Patent and Trademark Office will consider as filed on a particular date in the Office any correspondence which is:

(1) Promptly filed after the ending of the designated interruption or emergency; and

(2) Accompanied by a statement indicating that such correspondence would have been filed on that particular

date if it were not for the designated interruption or emergency in the United States Postal Service. [Such statement must be a verified statement if made by a person other than a practitioner as defined in § 10.1(r) of this chapter.]

3. Section 1.8 is proposed to be amended by revising paragraph (b) to read as follows:

§ 1.8 Certificate of mailing or transmission.

* * * * *

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence,

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate, and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. [Such statement must be a verified statement if made by a person other than a practitioner as defined in § 10.1(r) of this chapter.] If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

* * * * *

4. Section 1.10 is proposed to be amended by revising paragraph (c) to read as follows:

§ 1.10 Filing of papers and fees by "Express Mail" with certificate.

* * * * *

(c) The Patent and Trademark Office will accept the certificate of mailing by "Express Mail" and accord the paper or fee the certificate date under 35 U.S.C. 21(a) (unless the certificate date is a Saturday, Sunday, or Federal holiday within the District of Columbia—see § 1.6(a)) without further proof of the date on which the mailing by "Express Mail" occurred unless a question is present regarding the date of mailing. If more than a reasonable time has elapsed between the certificate date and the Patent and Trademark Office receipt date or if other questions regarding the date of mailing are present, the person mailing the paper or fee may be required to file a copy of the "Express Mail" receipt showing the actual date of mailing and a statement from the person who mailed the paper or fee [averring to the fact] >stating< that the mailing occurred on the date certified. [Such statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office.]

5. Section 1.14 is proposed to be amended by revising paragraphs (a) and (e) and by adding paragraph (f) to read as follows:

§ 1.14 Patent applications preserved in [secrecy] >confidence<.

(a) Except as provided in § 1.11(b) pending patent applications are preserved in [secrecy] >confidence<. No information will be given by the Office respecting the filing by any particular person of an application for a patent, the pendency of any particular case before it, or the subject matter of any particular application, nor will access be given to or copies furnished of any pending application or papers relating thereto, without written authority in that particular application from the applicant or his >or her< assignee or attorney or agent of record, unless the application has been identified by [serial] >application< number in a published patent document or the United States of America has been indicated as a Designated State in a published international application, in which case status information >,< such as whether it is pending, abandoned, or patented >,< may be supplied, or unless it shall be necessary to the proper conduct of business before the Office or as provided by this part. Where an application has been patented, the patent number and issue date may also be supplied.

* * * * *

(e) Any request by a member of the public seeking access to, or copies of, any pending or abandoned application preserved in [secrecy] >confidence< pursuant to paragraphs (a) and (b) of this section, or any papers relating thereto, must >:<

(1) Be in the form of a petition and be accompanied by the petition fee set forth in § 1.17(i), or

(2) Include written authority granting access to the member of the public in that particular application from the applicant or the applicant's assignee or attorney or agent of record.

>(f) Information as to the filing of an application will be published in the Official Gazette as required by § 1.47(a) and (b).<

6. Section 1.17 is proposed to be amended by removing and reserving paragraphs (b) through (d) and revising paragraphs (a) and (i) to read as follows:

§ 1.17 Patent application processing fees.

(a) Extension fee>s pursuant to § 1.136(a):< [for response within first month pursuant to § 1.136(a):

By a small entity (§ 1.9(f))....$55.00
By other than a small entity ....$110.00]

>(1) For reply within first month:

By a small entity (§ 1.9(f))....$55.00
By other than a small entity $110.00

(2) For reply within second month:

By a small entity (§ 1.9(f))....$195.00
By other than a small entity $390.00

(3) For reply within third month:

By a small entity (§ 1.9(f))....$465.00
By other than a small entity $930.00

(4) For reply within fourth month:

By a small entity (§ 1.9(f))....$735.00
By other than a small entity $1,470.00

(5) For reply within fifth month:

By a small entity (§ 1.9(f))....$1,005.00
By other than a small entity ....$2,010.00<

(b) >Removed< [Extension fee for response within second month pursuant to § 1.136(a):

By a small entity (§ 1.9(f))....$190.00
By other than a small entity ....$380.00]

(c) >Removed< [Extension fee for response within third month pursuant to § 1.136(a):

By a small entity (§ 1.9(f))....$450.00
By other than a small entity ....$900.00]

(d) >Removed< [Extension fee for response within fourth month pursuant to § 1.136(a):

By a small entity (§ 1.9(f))....$700.00
By other than a small entity ....$1,400.00]

* * * * *

(i) For filing a petition to the Commissioner under a section of this part listed below which refers to this paragraph....$130.00

§ 1.12—for access to an assignment record.

§ 1.14—for access to an application.

§ 1.53—to accord a filing date, except in provisional applications.

§ 1.55—for entry of late priority papers.

>§ 1.59—for expungement and return of information.<

[§ 1.60—to accord a filing date.

§ 1.62—to accord a filing date.]

§ 1.97(d)—to consider an information disclosure statement.

§ 1.102—to make an application special.

§ 1.103—to suspend action in application.

§ 1.177>(a)<—for [divisional] >multiple reissue applications< [reissues to issue separately].

§ 1.312—for amendment after payment of issue fee.

§ 1.313—to withdraw an application from issue.

§ 1.314—to defer issuance of a patent.

§ 1.666(b)—for access to an interference settlement agreement.

§ 3.81—for a patent to issue to assignee, [where the] assignment [was] submitted after payment of the issue fee.

* * * * *

7. Section 1.21 is proposed to be amended by revising paragraph (n) to read as follows:

§ 1.21 Miscellaneous fees and charges.

* * * * *

(n) For handling an incomplete or improper application under § 1.53(c) [, § 1.60 or § 1.62].....$130.00

* * * * *

8. Section 1.26 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.26 Refunds.

(a) [Money] >Any fee< paid by [actual] mistake or in excess >of that required< will be refunded, but a mere change of purpose after the payment of money, as when a party desires to withdraw an application, an appeal, or a request for oral hearing, will not entitle a party to demand such a return. Amounts of twenty-five dollars or less will not be returned unless specifically requested within a reasonable time, nor will the payer be notified of such amounts; amounts over twenty-five may be returned by check or, if requested, by credit to a deposit account.

* * * * *

9. Section 1.27 is proposed to be revised to read as follows:

§ 1.27 Statement of status as small entity.

(a) Any person seeking to establish status as a small entity (§ 1.9(f) of this part) for purposes of paying fees in an application or a patent must file a [verified] statement in the application or patent prior to or with the first fee paid as a small entity. Such a [verified] statement need only be filed once in an application or patent and remains in effect until changed.

(b) >When establishing status as a small entity< [Any verified statement filed] pursuant to paragraph (a) of this section >, any statement filed< on behalf of an independent inventor must be signed by the independent inventor except as provided in § 1.42, § 1.43, or § 1.47 of this part and must aver that the inventor qualifies as an independent inventor in accordance with § 1.9(c) of this part. Where there are joint inventors in an application, each inventor must file a [verified] statement establishing status as an independent inventor in order to qualify as a small entity. Where any rights have been assigned, granted, conveyed, or licensed, or there is an obligation to assign, grant, convey, or license, any rights to a small business concern, a nonprofit organization, or any other individual, a [verified] statement must be filed by the individual, the owner of the small business concern, or an official of the small business concern or nonprofit organization empowered to act on behalf of the small business concern or nonprofit organization averring to their status. For purposes of a [verified] statement under this paragraph, a license to a Federal agency resulting from a funding agreement with that agency pursuant to 35 U.S.C. 202(c)(4) does not constitute a license as set forth in § 1.9 of this part.

(c) Any [verified] statement filed pursuant to paragraph (a) of this section on behalf of a small business concern must (1) be signed by the owner or an official of the small business concern empowered to act on behalf of the concern; (2) aver that the concern qualifies as a small business concern as defined in § 1.9(d); and (3) aver that the exclusive rights to the invention have been conveyed to and remain with the small business concern or, if the rights are not exclusive, that all other rights belong to small entities as defined in § 1.9. Where the rights of the small business concern as a small entity are not exclusive, a [verified] statement must also be filed by the other small entities having rights averring to their status as such. For purposes of a [verified] statement under this paragraph, a license to a Federal agency resulting from a funding agreement with that agency pursuant to 35 U.S.C. 202(c)(4) does not constitute a license as set forth in § 1.9 of this part.

(d) Any [verified] statement filed pursuant to paragraph (a) of this section on behalf of a nonprofit organization must

(1) be signed by an official of the nonprofit organization empowered to act on behalf of the organization;

(2) aver that the organization qualifies as a nonprofit organization as defined in § 1.9(e) of this part specifying under which one of § 1.9(e) (1), (2), (3), or (4) of this part the organization qualifies; and

(3) aver that exclusive rights to the invention have been conveyed to and remain with the organization or if the rights are not exclusive that all other rights belong to small entities as defined in § 1.9 of this part. Where the rights of the nonprofit organization as a small entity are not exclusive, a [verified] statement must also be filed by the other small entities having rights averring to their status as such. For purposes of a [verified] statement under this paragraph, a license to a Federal agency pursuant to 35 U.S.C. 202(c)(4) does not constitute a conveyance of rights as set forth in this paragraph.

10. Section 1.28 is proposed to be amended by revising paragraphs (a) and (c) to read as follows:

§ 1.28 Effect on fees of failure to establish status, or change status, as a small entity.

(a) The failure to establish status as a small entity (§§ 1.9(f) and 1.27 of this part) in any application or patent prior to paying, or at the time of paying, any fee precludes payment of the fee in the amount established for small entities. A refund pursuant to § 1.26 of this part, based on establishment of small entity status, of a portion of fees timely paid in full prior to establishing status as a small entity may only be obtained if a [verified] statement under § 1.27 and a request for a refund of the excess amount are filed within two months of the date of the timely payment of the full fee. The two-month time period is not extendable under § 1.136. Status as a small entity is waived for any fee by the failure to establish the status prior to paying, at the time of paying, or within two months of the date of payment of, the fee. Status as a small entity must be specifically established in each application or patent in which the status is available and desired. Status as a small entity in one application or patent does not affect any other application or patent, including applications or patents which are directly or indirectly dependent upon the application or patent in which the status has been established. >The refiling of an application under § 1.53 as a continuation, division, continuation-in-part or continued prosecution application or the filing of a reissue application requires a new determination as to continued entitlement to small entity status for the refiled application or the reissue application.< A nonprovisional application claiming benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) of a prior application, >a continued prosecution application, or a reissue application< may rely on a [verified] statement filed in the prior application >or in the patent< if the nonprovisional application >, the continued prosecution application or the reissue application< includes a reference to the [verified] statement in the prior application >or in the patent< or includes a copy of the [verified] statement in the prior application >or in the patent< and status as a small entity is still proper and desired. >The payment of a small entity basic statutory filing fee will substitute for the reference.< Once status as a small entity has been established in an application or patent, the status remains in that application or patent without the filing of a further [verified] statement

pursuant to § 1.27 of this part unless the Office is notified of a change in status.

* * * * *

(c) If status as a small entity is established in good faith, and fees as a small entity are paid in good faith, in any application or patent, and it is later discovered that such status as a small entity was established in error or that through error the Office was not notified of a change in status as required by paragraph (b) of this section, the error will be excused [(1) if any deficiency between the amount paid and the amount due is paid within three months after the date the error occurred or (2) if any] >upon payment of the< deficiency between the amount paid and the amount due [is paid more than three months after the date the error occurred and the payment is accompanied by a statement explaining how the error in good faith occurred and how and when the error was discovered. The statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office]. The deficiency is based on the amount of the fee, for other than a small entity, in effect at the time the deficiency is paid in full.

* * * * *

11. Section 1.33 is proposed to be amended by revising paragraph (a) to read as follows and to remove and reserve paragraph (b):

§ 1.33 Correspondence >address< respecting patent applications, reexamination proceedings, and other proceedings.

(a) [The residence and post office address of the applicant must appear in the oath or declaration if not stated elsewhere in the application.] The applicant [may also specify and] >, the assignee(s) of the entire interest (see §§ 3.71 and 3.73) or< an attorney or agent of record >(see § 1.34(b))< may specify a correspondence address to which communications about the application are to be directed. All notices, official letters, and other communications in the [case] >application< will be directed to the correspondence address or, if no such correspondence address is specified, to an attorney or agent of record (see § 1.34(b)), or, if no attorney or agent is of record, to the applicant [, or to any assignee of record of the entire interest if the applicant or such assignee so requests, or to an assignee of an undivided part if the applicant so requests, at the] >provided a< post office address [of which the Office] has been [notified] >furnished< in the [case] >application<. Amendments and other papers filed in the application must be signed:

(1) by the applicant, or

(2) if there is an assignee of record of an undivided part interest, by the applicant and such assignee, or

(3) if there is an assignee of record of the entire interest, by such assignee, or

(4) by an attorney or agent of record, or

(5) by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a). Double correspondence with an applicant and [his] >an< attorney or agent, or with more than one attorney or agent, will not be undertaken. If more than one attorney or agent [be] >is< made of record and a correspondence address has not been specified, correspondence will be held with the one last made of record.

(b) >[Reserved]<

* * * * *

12. Section 1.41 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.41 Applicant for patent.

(a) A patent [must be] >is< applied for in the name of the actual inventor or inventors. >The inventorship of an application is set forth in the oath or declaration that is executed in accordance with § 1.63.< [Full names must be stated, including the family name, and at least one given name without abbreviation together with any other given name or initial.] >For identification purposes, the name of the actual inventor or inventors should be supplied when the specification and any required drawing are filed. If the name of the actual inventor or inventors are not supplied when the specification and any required drawing are filed, the application should include an applicant identification consisting of alphanumeric characters.<

* * * * *

13. Section 1.47 is proposed to be revised to read as follows:

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the [omitted] >nonsigning< inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts >,< [and] by the [required] fee >set forth in< [(]§ 1.17(h)[)]>,< and [must state] the last known address of the [omitted]>nonsigning< inventor. The Patent and Trademark Office shall forward notice of the filing of the application to the [omitted] >nonsigning< inventor at said address[. Should such notice be returned to the Office undelivered, or should the address of the omitted inventor be unknown,] >and< notice of the filing of the application shall be published in the *Official Gazette*. The [omitted] >nonsigning< inventor may subsequently join in the application on filing an oath or declaration [of the character required by] >complying with< § 1.63. [A patent may be granted to the inventor making the application, upon a showing satisfactory to the Commissioner, subject to the same rights which the omitted inventor would have had if he or she had been joined.]

(b) Whenever [an] >all the< [inventor] >inventors< [refuses] >refuse< to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom [the] >an< inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action may make application for patent on behalf of and as agent for >all< the [inventor] >inventors<. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts >,< [and] a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, [and by] the [required] fee > set forth in< [(]§ 1.17(h)[)]>,< and [must state] the last known address of >all< the [inventor] >inventors<. [The assignment, written agreement to assign or other evidence of proprietary interest, or a verified copy thereof, must be filed in the Patent and Trademark Office.] The Office shall forward notice of the filing of the application to >all< the [inventor] >inventors< at the [address] >addresses< stated in the application[. Should such notice be returned to the Office undelivered, or should the address of the inventor be unknown] >and< notice of the filing of the application shall be published in the *Official Gazette*. [The] >An< inventor may subsequently join in the application on filing an oath or declaration [of the character required by] >complying with< § 1.63. [A patent may be granted to the inventor upon a showing satisfactory to the Commissioner.]

14. Section 1.48 is proposed to be revised to read as follows:

§ 1.48 Correction of inventorship >in a patent application<.

(a) [If the correct inventor or inventors are not named in a nonprovisional application through error without any

deceptive intention on the part of the actual inventor or inventors,] >If the inventive entity is set forth in error in an executed § 1.63 or § 1.175 oath or declaration and such error arose without any deceptive intention on the part of the person named as an inventor in error or on the part of the person who through error was not named as an inventor<, the application may be amended to name only the actual inventor or inventors. >When the application is involved in an interference, the amendment shall comply with the requirements of this section and shall be accompanied by a motion under § 1.634.< Such amendment must be [diligently made and must be] accompanied by:

(1) A petition including a statement [of facts verified by the original named inventor or inventors establishing when the error without deceptive intention was discovered and how it occurred] >from each person who is being added as an inventor and from each person who is being deleted as an inventor that the error in inventorship occurred without deceptive intention on their part<;

(2) An oath or declaration by each actual inventor or inventors as required by § 1.63 >or as permitted by §§ 1.42, 1.43 or 1.47<;

(3) The fee set forth in § 1.17(h); and

(4) >If an assignment has been executed by any of the original named inventors the,< [The] written consent of [any] >the< assignee >, see § 3.73(b)<. [When the application is involved in an interference, the petition shall comply with the requirements of this section and shall be accompanied by a motion under § 1.634.]

(b) If the correct inventors are named in [the] >a< nonprovisional application when filed and the prosecution of the application results in the amendment or cancellation of claims so that less than all of the originally named inventors are the actual inventors of the invention being claimed in the application, an amendment shall be filed deleting the names of the person or persons who are not inventors of the invention being claimed. >When the application is involved in an interference, the amendment shall comply with the requirements of this section and shall be accompanied by a motion under § 1.634. Such< [The] amendment must be [diligently made and shall be] accompanied by:

(1) A petition including a statement identifying each named inventor who is being deleted and acknowledging that the inventor's invention is no longer being claimed in the application; and

(2) The fee set forth in § 1.17(h).

(c) If a nonprovisional application discloses unclaimed subject matter by an inventor or inventors not named in the application, the application may be amended [pursuant to paragraph (a) of this section] to add claims to the subject matter and name the correct inventors for the application. >When the application is involved in an interference, the amendment shall comply with the requirements of this section and shall be accompanied by a motion under § 1.634. Such amendment must be accompanied by:

(1) A petition including a statement from each person being added as an inventor that the amendment is necessitated by amendment of the claims and that the inventorship error occurred without deceptive intention on their part;

(2) An oath or declaration by each actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or 1.47;

(3) The fee set forth in § 1.17(h); and

(4) If an assignment has been executed by any of the original named inventors, the written consent of the assignee, see § 3.73(b)<.

(d) If the name or names of an inventor or inventors were omitted in a provisional application through error without any deceptive intention on >their part< [the part of the actual inventor or inventors], the provisional application may be amended to add the name or names of the [actual] >omitted< inventor or inventors. Such amendment must be accompanied by:

(1) A petition including a statement that the >inventorship< error occurred without deceptive intention on the part of the [actual] >omitted< inventor or inventors[, which statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office]; and

(2) The fee set forth in § 1.17(q).

(e) If a person or persons were named as an inventor or inventors in a provisional application through error without any deceptive intention >on their part<, an amendment may be filed in the provisional application deleting the name or names of the person or persons who were erroneously named. Such amendment must be accompanied by:

(1) A petition including a statement [of facts verified] by the person or persons whose name or names are being deleted [establishing] that the >inventorship< error occurred without deceptive intention >on their part<;

(2) The fee set forth in § 1.17(q); and

(3) [The written consent of any assignee.] >If an assignment has been executed by any of the original named inventors, the written consent of the assignee, see § 3.73(b).

(f) If the correct inventor or inventors are not named on filing a nonprovisional application without an executed oath or declaration under § 1.63, the later submission of an executed oath or declaration under § 1.63 will act to correct the earlier identification of inventorship.

(g) The Office may require such other information as may be deemed appropriate under the particular circumstances surrounding the correction of inventorship.<

15. Section 1.51 is proposed to be amended by removing paragraph (c).

§ 1.51 General requisites of an application.

* * * * *

(c) [Removed]

16. Section 1.52 is proposed to be amended by revising paragraphs (a) and (d) as follows:

§ 1.52 Language, paper, writing, margins.

(a) The application, any amendments or corrections thereto, and the oath or declaration must be in the English language except as provided for in § 1.69 and paragraph (d) of this section, or be accompanied by a [verified] translation of the application and a translation of any corrections or amendments into the English language >together with a statement that the translation is accurate<. All papers which are to become a part of the permanent records of the Patent and Trademark Office must be legibly written, typed, or printed in permanent ink or its equivalent in quality. All of the application papers must be presented in a form having sufficient clarity and contrast between the paper and the writing, typing, or printing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes. If the papers are not of the required quality, substitute typewritten or printed papers of suitable quality may be required.

* * * * *

(d) An application may be filed in a language other than English. [A verified] >An< English translation of the non-English-language application >, a statement that the translation is accurate,< and the fee set forth in § 1.17(k) are required to be filed with the application or within such time as may be set by the Office.

17. Section 1.53 is proposed to be amended by revising paragraphs (b) through (d) as follows:

§ 1.53 Application number, filing date, and completion of application.

* * * * *

(b)(1) The filing date of an application for patent filed under this section, except for a provisional application >under paragraph (b)(2) of this section or a continued prosecution application under paragraph (b)(3) of this section<, is the date on which: a specification containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75; and any drawing required by § 1.81(a), are filed in the Patent and Trademark Office [in the name of the actual inventor or inventors as required by § 1.41]. No new matter may be introduced into an application after its filing date >(1.115(b)(1))< [(§ 1.118)]. [If all the names of the actual inventor or inventors are not supplied when the specification and any required drawing are filed, the application will not be given a filing date earlier than the date upon which the names are supplied unless a petition with the fee set forth in § 1.17(i) is filed which sets forth the reasons the delay in supplying the names should be excused.] A continuation or divisional application (filed under the conditions specified in 35 U.S.C. 120, 121 or 365(c) and § 1.78(a)) may be filed under this >paragraph or paragraph (b)(3) of this< section [, § 1.60 or § 1.62]. A continuation-in-part application >must< [may also] be filed under this >paragraph< [section or § 1.62].

>(i) Any continuation or divisional application may be filed by all or by less than all of the inventors named in a prior application. A newly executed oath or declaration is not required (§ 1.51(a)(1)(ii)) and paragraph (d) of this section in a continuation or divisional application filed by all or by less than all of the inventors named in a prior application, provided that one of the following is submitted: A copy of the executed oath or declaration filed to complete (§ 1.51(a)(1)) the most immediate prior national application for which priority is claimed under 35 U.S.C. 120, 121 or 365(c), or a copy of an unexecuted oath or declaration, and a statement that the copy is a true copy of the oath or declaration that was subsequently executed and filed to complete (§ 1.51(a)(1)) the most immediate prior national application for which priority is claimed under 35 U.S.C. 120, 121 or 365(c). See paragraph (d) of this section for the filing of a continuation or divisional application without the submission of a newly executed oath or declaration or a copy of the oath or declaration for the most immediate prior national application for which priority is claimed under 35 U.S.C. 120, 121 or 365(c).

(A) The copy of the executed or unexecuted oath or declaration for the most immediate prior national application for which priority is claimed under 35 U.S.C. 120, 121 or 365(c) must be accompanied by a statement requesting the deletion of the names of the person or persons who are not inventors in the continuation or divisional application.

(B) Where the power of attorney or correspondence address was changed during the prosecution of the prior application, the change in power of attorney or correspondence address must be identified in the continuation or divisional application.

(ii) A newly executed oath or declaration must be filed in a continuation or divisional application naming an inventor not named in the prior application. A newly executed oath or declaration must be filed in a continuation-in-part application, which application may name all, more, or less than all of the inventors named in the prior application.

(iii) The inventorship of an application is set forth in the oath or declaration that is executed in accordance with § 1.63.<

(2) The filing date of a provisional application is the date on which: A specification as prescribed by 35 U.S.C. 112, first paragraph; and any drawing required by § 1.81(a), are filed in the Patent and Trademark Office [in the name of the actual inventor or inventors as required by § 1.41]. No amendment, other than to make the provisional application comply with all applicable regulations, may be made to the provisional application after the filing date of the provisional application. [If all the names of the actual inventor or inventors are not supplied when the specification and any required drawing are filed, the provisional application will not be given a filing date earlier than the date upon which the names are supplied unless a petition with the fee set forth in § 1.17(q) is filed which sets forth the reasons the delay in supplying the names should be excused.]

(i) A provisional application must also include a cover sheet identifying the application as a provisional application. Otherwise, the application will be treated as an application filed under >paragraph (b)(1) of this section< [§ 1.53(b)(1)].

(ii) An application for patent filed under >paragraph (b)(1) of this section< [§ 1.53(b)(1)] may be [treated as] >converted to< a provisional application and be accorded the original filing date provided that a petition requesting the conversion, with the fee set forth in § 1.17(q), is filed prior to the earlier of the abandonment of the [§ 1.53(b)(1)] application >under paragraph (b)(1) of this section<, the payment of the issue fee, the expiration of 12 months after the filing date of the [§ 1.53(b)(1)] application >under paragraph (b)(1) of this section<, or the filing of a request for a statutory invention registration under § 1.293. The grant of any such petition will not entitle applicant to a refund of the fees which were properly paid in the application filed under >paragraph (b)(1) of this section< [§ 1.53(b)(1)].

(iii) A provisional application shall not be entitled to the right of priority under § 1.55 or 35 U.S.C. 119 or 365(a) or to the benefit of an earlier filing date under § 1.78 or 35 U.S.C. 120, 121 or 365(c) of any other application. No claim for priority under § 1.78(a)(3) may be made in a design application based on a provisional application. No request under § 1.293 for a statutory invention registration may be filed in a provisional application. The requirements of §§ 1.821 through 1.825 regarding application disclosures containing nucleotide and/or amino acid sequences are not mandatory for provisional applications.

>(3) In a nonprovisional application that is complete as defined by § 1.51(a)(1) and filed on or after June 8, 1995, a continuation or divisional application that discloses and claims only subject matter disclosed in and names as inventors the same or less than all the inventors named in that prior complete application may be filed as a continued prosecution application under this paragraph. The filing date of a continued prosecution application is the date on which a request for an application under this paragraph including identification of the prior application number is filed.

(i) An application filed under this paragraph:

(A) Will utilize the file jacket and contents of the prior application, including the specification, drawings and oath or declaration, from the prior complete application (§ 1.51(a)) to constitute the new application, and will be assigned the application number of the prior application for identification purposes,

(B) Is a request to expressly abandon the prior application as of the filing date of the request for an application under this paragraph, and

(C) Must be filed before the payment of the issue fee, abandonment of, or termination of proceedings on the prior application, or after payment of the

issue fee if a petition under § 1.313(b)(5) is granted in the prior application.

(ii) The filing fee for a continued prosecution application filed under this paragraph is:

(A) The basic filing fee as set forth in § 1.16(a), and

(B) Any additional § 1.16 fee due based on the number of claims remaining in the application after entry of any amendment accompanying the request for an application under this paragraph and entry of any amendments under § 1.116 unentered in the prior application which applicant has requested to be entered in the continued prosecution application.

(iii) If an application filed under this paragraph is filed by less than all the inventors named in the prior application, a statement must accompany the application when filed requesting deletion of the names of the person or persons who are not inventors of the invention being claimed in the new application.

(iv) Any new change must be made in the form of an amendment to the prior application. Any new specification filed with the request for an application under this paragraph will not be considered part of the original application papers, but will be treated as a substitute specification in accordance with § 1.125.

(v) The filing of a continued prosecution application under this paragraph will be construed to include a waiver of confidence by the applicant under 35 U.S.C. 122 to the extent that any member of the public who is entitled under the provisions of § 1.14 to access to, or information concerning either the prior application or any application filed under the provisions of this paragraph may be given similar access to, or similar information concerning, the other application(s) in the file jacket.

(vi) In addition to identifying the application number of the prior application, applicant is urged to furnish in the request for an application under this paragraph the following information relating to the prior application to the best of his or her ability:

(A) Title of invention;

(B) Name of applicant(s);

(C) Correspondence address;

(D) Identification of any priority claim under 35 U.S.C. 119, 120 and 121.

(vii) Envelopes containing only requests and fees for filing an application under this paragraph should be marked ''Box CPA.''<

(c)>(1) If any application filed under paragraph (b) of this section is found to be incomplete or improper, applicant will be so notified and given a time period within which to correct the filing error.

(2) Any request for review of a notification pursuant to paragraph (c)(1) of this section, or a notification that the original application papers lack a portion of the specification or drawing(s), must be by way of a petition pursuant to this paragraph. Any petition under this paragraph must be accompanied by the fee set forth in § 1.17(i) in an application filed under paragraphs (b)(1) or (b)(3) of this section, and the fee set forth in § 1.17(q) in an application filed under paragraph (b)(2) of this section. In the absence of a timely (§ 1.181(f)) petition pursuant to this paragraph, the filing date of an application in which the applicant was notified of a filing error pursuant to paragraph (c)(1) of this section will be the date the filing error is corrected.

(3) If an applicant is notified of a filing error pursuant to paragraph (c)(1) of this section, but fails to correct the filing error within the given time period or otherwise timely (§ 1.181(f)) take action pursuant to paragraph (c)(2) of this section, proceedings in the application will be considered terminated. Where proceedings in an application are terminated pursuant to this paragraph, the application may be returned or otherwise disposed of, and any filing fees, less the handling fee set forth in § 1.21(n), will be refunded.< [If any application is filed without the specification, drawing or name, or names, of the actual inventor or inventors required by paragraph (b)(1) or (b)(2) of this section, applicant will be so notified and given a time period within which to submit the omitted specification, drawing, name, or names, of the actual inventor, or inventors, in order to obtain a filing date as of the date of filing of such submission. A copy of the ''Notice of Incomplete Application'' form notifying the applicant should accompany any response thereto submitted to the Office. If the omission is not corrected within the time period set, the application will be returned or otherwise disposed of; the fee, if submitted, will be refunded less the handling fee set forth in § 1.21(n). Any request for review of a refusal to accord an application a filing date must be by way of a petition accompanied by the fee set forth in § 1.17(i), if the application was filed under § 1.53(b)(1), or by the fee set forth in § 1.17(q), if the application was filed under § 1.53(b)(2).]

(d)(1) If an application which has been accorded a filing date pursuant to [paragraph] >paragraphs< (b)(1) >or (b)(3)< of this section >, including a continuation, divisional, or continuation-in-part application,< does not include the appropriate filing fee or an oath or declaration by the applicant [,] >pursuant to §§ 1.63 or 1.175, which may be a copy of the executed oath or declaration filed to complete, pursuant to § 1.51(a)(1), the most immediate prior national application for which priority is claimed under 35 U.S.C. 120, 121 or 365(c), or a copy of an unexecuted oath or declaration, and a statement that the copy is a true copy of the oath or declaration that was subsequently executed and filed to complete (§ 1.51(a)(1)) the most immediate prior national application for which priority is claimed under 35 U.S.C. 120, 121 or 365(c), in a continuation or divisional application,< applicant will be so notified, if a correspondence address has been provided, given a period of time within which to file the fee, oath [,] or declaration and to pay the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application. [A copy of the ''Notice to File Missing Parts'' form mailed to applicant should accompany any response thereto submitted to the Office.] If the required filing fee is not timely paid, or if the processing and retention fee set forth in § 1.21(l) is not paid within one year of the date of mailing of the notification required by this paragraph, the application will be disposed of. No copies will be provided or certified by the Office of an application which has been disposed of or in which neither the required basic filing fee nor the processing and retention fee has been paid. The notification pursuant to this paragraph may be made simultaneously with any notification pursuant to paragraph (c) of this section. If no correspondence address is included in the application, applicant has two months from the filing date to file the basic filing fee, oath or declaration and to pay the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application; or, if no basic filing fee has been paid, one year from the filing date to pay the processing and retention fee set forth in § 1.21(l) to prevent disposal of the application.

* * * * *

18. Section 1.54 is proposed to be amended by revising paragraph (b) to read as follows:

§ 1.54 Parts of application to be filed together; filing receipt.

* * * * *

(b) Applicant will be informed of the application number and filing date by a filing receipt >, unless the application is an application filed under § 1.53(b)(3)<.

19. Section 1.55 is proposed to be amended revising paragraph (a) to read as follows:

§ 1.55 Claim for foreign priority.

(a) An applicant in a nonprovisional application may claim the benefit of the filing date of one or more prior foreign applications under the conditions specified in 35 U.S.C. 119 (a) through (d) and 172. The claim to priority need be in no special form and may be made by the attorney or agent if the foreign application is referred to in the oath or declaration as required by § 1.63. The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) must be filed in the case of an interference (§ 1.630), when necessary to overcome the date of a reference relied upon by the examiner, when specifically required by the examiner, and in all other cases, before the patent is granted. If the certified copy is not in the English language, a translation need not be filed except in the case of interference; or when necessary to overcome the date of a reference relied upon by the examiner; or specifically required by the examiner, in which event an English language translation must be filed together with a statement that the translation of the certified copy is accurate. [The statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office.]

* * * * *

20. Section 1.59 is proposed to be revised to read as follows:

§ 1.59 >Expungement of information or copy of papers in application file< [Papers of application with filing date not to be returned].

>(a)(1) Information< [Papers] in an application which has received a filing date pursuant to § 1.53 will not be >expunged and< returned [for any purpose whatever] >, except as provided in paragraph (b) of this section<. [If applicants have not preserved copies of the papers, the Office will furnish copies at the usual cost of any application in which either the required basic filing fee (§ 1.16) or, if the application was filed under § 1.53(b)(1), the processing and retention fee § 1.21(l) has been paid.] See § 1.618 for return of unauthorized and improper papers in interferences.

>(2) Information forming part of the original disclosure, i.e., written specification, drawings, claims and any preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175, will not be expunged from the application file.

(b) Information, other than what is excluded by paragraph (a)(2) of this section, may be requested to be expunged and returned to applicant upon petition under this paragraph and payment of the petition fee set forth in § 1.17(i). Any petition to expunge and return information from an application must establish to the satisfaction of the Commissioner that the return of the information is appropriate.

(c) If applicants have not preserved copies of any application papers, the Office will furnish copies upon request, at the usual cost, for any application in which either the required basic filing fee (§ 1.16) or, if the application was filed under § 1.53(b)(1), the processing and retention fee (§ 1.21(l)) has been paid.<

§ 1.60 [Removed and reserved]

21. Section 1.60 is proposed to be removed and reserved.

§ 1.62 [Removed and reserved]

22. Section 1.62 is proposed to be removed and reserved.

23. Section 1.63 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.63 Oath or declaration.

(a) An oath or declaration filed under § 1.51(a)(1)(ii) as a part of an application must:

(1) Be executed in accordance with either § 1.66 or § 1.68;

(2) Identify the specification to which it is directed;

(3) Identify each inventor >by: full name, including the family name, and at least one given name without abbreviation together with any other given name or initial,< and the residence >, post office address< and country of citizenship of each inventor; and

(4) State whether the inventor is a sole or joint inventor of the invention claimed.

* * * * *

24. Section 1.69 is proposed to be amended by revising paragraph (b) to read as follows:

§ 1.69 Foreign language oaths and declarations.

* * * * *

(b) Unless the text of any oath or declaration in a language other than English is a form provided or approved by the Patent and Trademark Office, it must be accompanied by [a verified] >an< English translation >together with a statement that the translation is accurate<, except that in the case of an oath or declaration filed under § 1.63 the translation may be filed in the Office no later than two months from the date applicant is notified to file the translation.

25. Section 1.78 is proposed to be amended by revising paragraph (a)(1) as follows:

§ 1.78 Claiming benefit of [an] earlier filing date and cross-references to other applications.

(a)(1) A nonprovisional application may claim an invention disclosed in one or more prior filed copending nonprovisional applications or international applications designating the United States of America. In order for a nonprovisional application to claim the benefit of a prior filed copending nonprovisional application or international application designating the United States of America, each prior application must name as an inventor at least one inventor named in the later filed nonprovisional application and disclose the named inventor's invention claimed in at least one claim of the later filed nonprovisional application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior application must be:

(i) Complete as set forth in § 1.51(a)(1); or

(ii) Entitled to a filing date as set forth in § >§ < 1.53(b)(1) >or (b)(3)< [, § 1.60 or § 1.62] and include the basic filing fee set forth in § 1.16; or

(iii) Entitled to a filing date as set forth in § 1.53(b)(1) and have paid therein the processing and retention fee set forth in § 1.21(l) within the time period set forth in § 1.53(d)(1).

* * * * *

26. Section 1.84 is proposed to be amended by revising paragraph (b) as follows:

§ 1.84 Standards for drawings.

* * * * *

(b) *Photographs.*

(1) Black and white. Photographs are not ordinarily permitted in utility [and design] applications. However, the Office will accept photographs in utility [and design] applications only after >the< granting of a petition filed under this paragraph which requests that photographs be accepted. Any such petition must include the following:

(i) The appropriate fee set forth in § 1.17(h); and

(ii) Three (3) sets of photographs. Photographs must either be developed on double weight photographic paper or be permanently mounted on bristol board. The photographs must be of sufficient quality so that all details in the drawings are reproducible in the printed patent.

(2) Color. Color photographs will be accepted in utility patent applications if the conditions for accepting color drawings have been satisfied. See paragraph (a)(2) of this section.

* * * * *

27. Section 1.91 is proposed to be revised to read as follows:

§ 1.91 Models >and exhibits< not generally required as part of application or patent.

Models >and exhibits< [were once required in all cases admitting a model, as a part of the application, and these models became a part of the record of the patent. Such models are no longer generally required (the description of the invention in the specification, and the drawings, must be sufficiently full and complete, and capable of being understood, to disclose the invention without the aid of a model), and] will not be admitted unless specifically [called for.] >required by the Office. A model, working model, or other physical exhibit may be required if deemed necessary for any purpose in examination of the application.<

§ 1.92 [Removed and reserved]

28. Section 1.92 is proposed to be removed and reserved.

29. Section 1.97 is proposed to be amended by revising paragraphs (c) through (e) to read as follows:

§ 1.97 Filing of information disclosure statement.

* * * * *

(c) An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, but before the mailing date of either:

(1) A final action under § 1.113>;< or

(2) A notice of allowance under § 1.311, whichever occurs first, provided the >information disclosure< statement is accompanied by either a [certification] >statement< as specified in paragraph (e) of this section or the fee set forth in § 1.17(p).

(d) An information disclosure statement shall be considered by the Office if filed after the mailing date of either:

>(1) A< [a] final action under § 1.113>;< or

>(2) A< [a] notice of allowance under § 1.311, whichever occurs first, but before payment of the issue fee, provided the >information disclosure< statement is accompanied by:

[(1) >(i)< A [certification] >statement< as specified in paragraph (e) of this section,

[2] >(ii)< A petition requesting consideration of the information disclosure statement, and

[3] >(iii)< The petition fee set forth in § 1.17(i)(1).

(e) A [certification] >statement< under this section must state either:

(1) That each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the >information disclosure< statement [,] >;< or

(2) That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application [or] >and<, to the knowledge of the person signing the [certification] >statement< after making reasonable inquiry, was known to any individual designated in § 1.56(c) more than three months prior to the filing of the >information disclosure< statement.

* * * * *

§ 1.101 [Removed and reserved]

30. Section 1.101 is proposed to be removed and reserved.

31. Section 1.102 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.102 Advancement of examination.

(a) Applications will not be advanced out of turn for examination or for further action except as provided by this part, or upon order of the Commissioner to expedite the business of the Office, or upon filing of a request under paragraph (b) of this section or upon filing a petition under paragraphs (c) or (d) of this section with a [verified] showing which, in the opinion of the Commissioner, will justify so advancing it.

* * * * *

32. Section 1.103 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.103 Suspension of action.

(a) Suspension of action by the Office will be granted for good and sufficient cause and for a reasonable time specified upon petition by the applicant and, if such cause is not the fault of the Office, the payment of the fee set forth in § 1.17(i)(1). Action will not be suspended when a >reply< [response] by the applicant to an Office action is required.

* * * * *

§ 1.104 [Removed and reserved].

33. Section 1.104 is proposed to be removed and reserved.

§ 1.105 [Removed and reserved].

34. Section 1.105 is proposed to be removed and reserved.

§ 1.108 [Removed and reserved].

35. Section 1.108 is proposed to be removed and reserved.

36. Section 1.111 is proposed to be amended by revising paragraph (b) to read as follows:

§ 1.111 Reply by applicant or patent owner.

* * * * *

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must [make request therefor in writing] >reply<. The reply by the applicant or patent owner must >be reduced to a writing which< distinctly and specifically [point] >points< out the supposed errors in the examiner's action and must [respond] >reply< to every ground of objection and rejection in the prior Office action. >The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over the applied references.< If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the case to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

* * * * *

37. Section 1.112 is proposed to be revised to read as follows:

§ 1.112 Reconsideration >before final action<.

After [response] >reply< by applicant or patent owner (§ 1.111) >to a non-final action<, the application or patent under reexamination will be reconsidered and again examined. The applicant or patent owner will be notified if claims are rejected, or objections or requirements made, in the same manner as after the first examination. Applicant or patent owner may [respond] >reply< to such Office action in the same manner provided in § 1.111, with or without amendment. [Any amendments after the second Office action must ordinarily be restricted to the rejection or to the objections or requirements made. The application or patent under

reexamination will be again considered, and so on repeatedly, unless the examiner has indicated that the action is final.]

38. Section 1.113 is proposed to be revised to read as follows:

§ 1.113 Final rejection or action.

(a) On the second or any subsequent examination or consideration >by the examiner< the rejection or other action may be made final, whereupon applicant's or patent owner's >reply< [response] is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). >Reply< [Response] to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the >reply< [response] to a final rejection or action must comply with any requirements or objections >as< to form.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the case, clearly stating the reasons >in support thereof< [therefor].

>(c) The first action in an application will not be made final.<

39. Section 1.115 is proposed to be revised to read as follows:

§ 1.115 Amendment.

[The applicant may amend before or after the first examination and action and also after the second or subsequent examination or reconsideration as specified in 1.112 or when and as specifically required by the examiner. The patent owner may amend in accordance with 1.510(e) and 1.530(b) prior to reexamination and during reexamination proceedings in accordance with 1.112 and 1.116.]

>(a) The applicant or the patent owner may amend the disclosure (*e.g.*, specification, claims, drawings and abstract) of an application before final action as indicated in § 1.121, except for nonprovisional applications which are subject to § 1.53(b)(2). The patent owner may amend the patent in a reexamination proceeding in accordance with § § 1.510(e) and 1.530(d).

(b)(1) No amendment shall introduce new matter into the disclosure of an application.

(2) If it is determined that an amendment filed after the filing date of the application introduces new matter into the disclosure, the claims containing the new matter will be rejected and deletion of the new matter in the description and drawings will be required.

(c) Claims may be amended by canceling particular claims, by presenting new claims, or by rewriting particular claims as indicated in § 1.121(b). If an amendment is in reply to an Office action note § 1.111.

(d) The disclosure must be amended when required to correct inaccuracies of description and definition, and to secure correspondence between the claims, the specification, and the drawing.

(e) No amendment to the drawing may be made except with permission of the Office. Permissible changes in the construction shown in any drawing may be made only by the submission of a substitute drawing by applicant. A sketch in permanent ink showing proposed changes in red, to become part of the record, must be filed for approval by the examiner and should be in a separate paper.

(f) To amend a clause that was previously amended, the clause should be wholly rewritten so that no interlineations or deletions shall appear in the clause as finally presented. Matter canceled by amendment can be reinstated only by a subsequent amendment presenting the canceled matter as a new insertion.<

40. Section 1.116 is proposed to be amended by revising paragraphs (a) and (b) to read as follows:

§ 1.116 Amendments after final action.

(a) After >a< final rejection or >other final< action (§ 1.113) >,< amendments >are limited to< [may be made] cancelling claims or complying with any requirement of form >expressly set forth in a previous Office action.< [which has been made. Amendments presenting rejected claims in better form for consideration on appeal may be admitted.] The admission of, or refusal to admit, any amendment after final rejection, and any >related< proceedings [relative thereto], shall not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135.

(b) >Any amendment not in compliance with paragraph (a) of this section must be submitted with a request for an application under § 1.53(b)(3) to ensure its consideration.< [If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented.]

* * * * *

§ 1.117 [Removed and reserved]

41. Section 1.117 is proposed to be removed and reserved

§ 1.118 [Removed and reserved]

42. Section 1.118 is proposed to be removed and reserved

§ 1.119 [Removed and reserved]

43. Section 1.119 is proposed to be removed and reserved

44. Section 1.121 is proposed to be revised to read as follows:

§ 1.121 Manner of making amendments.

[(a) Erasures, additions, insertions, or alterations of the Office file of papers and records must not be physically entered by the applicant. Amendments to the application (excluding the claims) are made by filing a paper (which should conform to § 1.52) directing or requesting that specified amendments be made. The exact word or words to be stricken out or inserted by said amendment must be specified and the precise point indicated where the deletion or insertion is to be made.

(b) Except as otherwise provided herein, a particular claim may be amended only by directions to cancel or by rewriting such claim with underlining below the word or words added and brackets around the word or words deleted. The rewriting of a claim in this form will be construed as directing the cancellation of the original claim; however, the original claim number followed by the parenthetical word must be used for the rewritten claim. If a previously rewritten claim is rewritten, underlining and bracketing will be applied in reference to the previously rewritten claim with the parenthetical expression ''twice amended,'' ''three times amended,'' etc., following the original claim number.

(c) A particular claim may be amended in the manner indicated for the application in paragraph (a) of this section to the extent of corrections in spelling, punctuation, and typographical errors. Additional amendments in this manner will be admitted provided the changes are limited to (1) deletions and/or (2) the addition of no more than five words in any one claim. Any amendment submitted with instructions to amend particular claims but failing to conform to the provisions of paragraphs (b) and (c) of this section may be considered nonresponsive and treated accordingly.

(d) Where underlining or brackets are intended to appear in the printed patent

or are properly part of the claimed material and not intended as symbolic of changes in the particular claim, amendment by rewriting in accordance with paragraph (b) of this section shall be prohibited.

(e) In reissue applications, both the descriptive portion and the claims are to be amended by either (1) submitting a copy of a portion of the description or an entire claim with all matter to be deleted from the patent being placed between brackets and all matter to be added to the patent being underlined, or (2) indicating the exact word or words to be stricken out or inserted and the precise point where the deletion or insertion is to be made. Any word or words to be inserted must be underlined. See 1.173.

(f) Proposed amendments presented in patents involved in reexamination proceedings must be presented in the form of a full copy of the text of: (1) Each claim which is amended and (2) each paragraph of the description which is amended. Matter deleted from the patent shall be placed between brackets and matter added shall be underlined. Copies of the printed claims from the patent may be used with any additions being indicated by carets and deleted material being placed between brackets. Claims must not be renumbered and the numbering of the claims added for reexamination must follow the number of the highest numbered patent claim. No amendment may enlarge the scope of the claims of the patent. No new matter may be introduced into the patent.]

>(a) *Amendments in non-reissue applications:* Amendments in applications excluding reissue applications are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.

(1) *Specification other than claims:* Amendments to the specification other than claims may only be made as follows:

(i) The precise point in the specification must be indicated where an amendment is to be made.

(ii) If the only changes to the specification are deletions, amendments may only be made by precise directions to delete.

(iii) Except as provided by paragraph (a)(1)(ii) of this section, amendments must be made by submission of a copy of the rewritten sentence(s), paragraph(s) and/or page(s) with marking pursuant to paragraph (a)(1)(iv) of this section.

(iv) Underlining below the subject matter added and brackets around the subject matter deleted are to be used to mark the amendments being made. If a previously rewritten sentence(s), paragraph(s) or page(s) is again rewritten, marking will be applied in reference to the sentence(s), paragraph(s) or page(s) as previously rewritten.

(2) *Claims:* Amendments to the claims may only be made as follows:

(i)(A) A claim may be cancelled by a direction to cancel the claim or by omitting the claim when submitting a complete copy of all pending claims as required by (a)(2)(ii) of this section.

(B) A previously submitted claim may only be amended, other than by cancellation pursuant to paragraph (a)(2)(i)(A) of this section, by submitting a copy of the claim completely rewritten with markings, pursuant to paragraph (a)(2)(iii) of this section, of the subject matter added and/or deleted. The rewriting of a claim in this form will be construed as directing that the rewritten claim be a replacement for the previously submitted claim; however, the previously submitted claim number followed by the parenthetical word ''amended'' must be used for the rewritten claim.

(C) A new claim may only be added by submitting a clean copy of the new claim. The numbering of any new claims added must follow the number of the highest numbered previously submitted claim.

(ii) Whenever a previously submitted claim is amended by rewriting pursuant to paragraph (a)(2)(i)(B) of this section or a new claim is added pursuant to paragraph (a)(2)(i)(C) of this section, applicant must submit a separate complete copy of all pending claims. Such separate complete copy must include all newly rewritten, all newly added, all previously rewritten claims that are still pending, and any unamended claims that are still pending. For all claims, other than those claims being newly rewritten, the copy must be submitted in clean form without markings as to previous amendments.

(iii) Underlining below the subject matter added and brackets around the subject matter deleted relative to the previously submitted claim are to be used to mark the amendments being made. If a previously rewritten claim is again rewritten, marking will be applied in reference to the claim as previously rewritten, and the parenthetical expression will be ''twice amended,'' ''three times amended,'' *etc.*, following the original claim number.

(iv) The failure to include a copy of any previously submitted claim with the separate complete copy of all pending claims required by paragraph (a)(2)(ii) of this section will be construed as a direction to cancel that claim.

(3) *Drawings:* Amendments to the original application drawings are not permitted. Any change to the application drawings must be by way of a substitute sheet of drawings for each sheet changed submitted in compliance with § 1.84.

(4) Any amendment to an application that is present in a substitute specification submitted pursuant to § 1.125 must be presented under the provisions of § 1.121(a)(1) either prior to or concurrent with submission of the substitute specification.

(b) *Amendments in reissue applications:* Amendments in reissue applications are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.

(1) *Specification other than claims:* Amendments to the specification other than claims may only be made as follows:

(i) The precise point in the specification must be indicated where an amendment is to be made.

(ii) Amendments must be made by submission of the entire text of the rewritten paragraph(s) with markings pursuant to paragraph (b)(1)(iv) of this section.

(iii) Each submission of an amendment to the specification must include all amendments to the specification relative to the patent as of the date of the submission. This would include amendments to the specification of the patent submitted for the first time as well as any previously submitted amendments that are still desired. Any previously submitted amendments to the specification that are no longer desired must not be included in the submission.

(iv) Underlining below the subject matter added to the patent and brackets around the subject matter deleted from the patent are to be used to mark the amendments being made.

(2) *Claims:* Amendments to the claims are made as follows:

(i)(A) The amendment must include the entire text of each patent claim which is amended and of each added claim with marking pursuant to paragraph (b)(2)(i)(C), of this section except a patent claim should be cancelled by a statement cancelling the patent claim without presentation of the text of the patent claim.

(B) Patent claims must not be renumbered and the numbering of any claims added to the patent must follow the number of the highest numbered patent claim.

(C) Underlining below the subject matter added to the patent and brackets around the subject matter deleted from the patent are to be used to mark the

amendments being made. If a claim is amended pursuant to paragraph (b)(2)(i)(A) of this section, a parenthetical expression ''amended,'' ''twice amended,'' *etc.*, should follow the original claim number.

(ii) Each amendment submission must set forth the status, as of the date of the amendment, of all patent claims and of all added claims.

(iii) Each amendment when originally submitted must be accompanied by an explanation of the support in the disclosure of the patent for the amendment along with any additional comments on page(s) separate from the page(s) containing the amendment.

(iv) Each submission of an amendment to any claim (patent claims and all added claims) must include all pending amendments to the claims as of the date of the submission. This would include amendments to the claims submitted for the first time as well as any previously submitted amendments to the claims that are still desired. Any previously submitted amendments to the claims that are no longer desired must not be included in the submission. A copy of any patent claims that have not been amended are not to be presented with each amendment submission.

(v) The failure to submit a copy of any added claim, as required by paragraph (b)(2)(iv) of this section, will be construed as a direction to cancel that claim.

(vi) No reissue patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent, pursuant to 35 U.S.C. 251. No amendment to the patent claims may introduce new matter or be made in an expired patent.

(3) *Drawings:* Amendments to the original patent drawings are not permitted. Any change to the patent drawings must be by way of a new sheet of drawings with the amended figures identified as ''amended'' and with added figures identified as ''new'' for each sheet changed submitted in compliance with § 1.84.

(c) *Amendments in reexamination proceedings:* Any proposed amendment to the description and claims in patents involved in reexamination proceedings must be made in accordance with § 1.530.<

§ 1.122 [Removed and reserved]

45. Section 1.122 is proposed to be removed and reserved.

§ 1.123 [Removed and reserved]

46. Section 1.123 is proposed to be removed and reserved.

§ 1.124 [Removed and reserved]

47. Section 1.124 is proposed to be removed and reserved.

§ 1.125 Substitute specification.

48. Section 1.125 is proposed to be revised as follows:

>(a)< If the number or nature of the amendments > or the legibility of the specification< [shall] render it difficult to [consider the case, or to arrange the papers for printing or copying] >process an application<, the Office may require the entire specification, including the claims, or any part thereof, to be rewritten in clean form incorporating all amendments.

>(b)< A substitute specification for an application other than a reissue application may [not be accepted unless it has been required by the examiner or unless it is clear to the examiner that acceptance of a substitute specification would facilitate processing of the application. Any substitute specification] >be< filed [must be] >at any point up to payment of the issue fee if it is< accompanied by a statement that the substitute specification>:

(1)< includes no new matter >, and

(2) includes only amendments submitted in accordance with the requirements of § 1.121(a) either prior to or concurrent with submission of the substitute specification<. [Such statement must be a verified statement if made by a person not registered to practice before the Office.].

>(c) A substitute specification submitted under this section must be submitted in clean form without markings as to amended material.

(d) A substitute specification under this section is not permitted in reissue applications or in reexamination proceedings.<

49. Section 1.133 is proposed to be amended by revising paragraph (b) to read as follows:

§ 1.133 Interviews.

* * * * *

(b) In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for >reply< [response] to Office actions as specified in § 1.111, § 1.135.

50. The undesignated center heading in Subpart B–National processing Provisions, following § 1.133 is proposed to be revised to read as follows:

Time for >Reply< [Response] by Applicant; Abandonment of Application

51. Section 1.134 is proposed to be revised as follows:

§ 1.134 Time period for >reply< [response] to an Office action.

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for >reply< [response] to an Office action. Unless the applicant is notified in writing that [response] >a reply< is required in less than six months, a maximum period of six months is allowed.

52. Section 1.135 is proposed to be revised to read as follows:

§ 1.135 Abandonment for failure to >reply< [respond] within time period.

(a) If an applicant of a patent application fails to >reply< [respond] within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper action as the condition of the case may require. The admission of >, or refusal to admit, any amendment after final rejection, and any related proceedings,< an amendment not responsive to the last Office action, or refusal to admit the same, and any proceedings relative thereto, shall not operate to save the application from abandonment.

(c) When action by the applicant is a bona fide attempt to >reply< [respond] and to advance the case to final action, and is substantially a complete [response] >reply< to the >non-final< Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, >applicant< [opportunity to explain and supply the omission] may be given >a new time period for reply under § 1.134 to supply the omission or to file a continuing application< [before the question of abandonment is considered].

53. Section 1.136 is proposed to be amended by revising the heading and paragraph (a) to read as follows:

§ 1.136 Filing of timely >replies< [responses] with petition and fee for extension of time and extensions of time for cause.

(a)(1) If an applicant is required to >reply< [respond] within a nonstatutory or shortened statutory time period, applicant may >reply< [respond] up to [four] >five< months after the time

period set >and within the statutory period, if applicable,< if a petition for an extension of time and the fee set in § 1.17>(a)< are filed [prior to or with the response], unless:

(i) Applicant is notified otherwise in an Office action,

(ii) The >reply< [response] is a reply brief submitted pursuant to § 1.193(b),

(iii) The >reply< [response] is a request for an oral hearing submitted pursuant to § 1.194(b),

(iv) The >reply< [response] is to a decision by the Board of Patent Appeals and Interferences pursuant to § 1.196, § 1.197 or § 1.304, or

(v) The application is involved in an interference declared pursuant to § 1.611.

(2) The date on which the [response, the] petition [,] and the fee have been filed is the date [of the response and also the date] for purposes of determining the period of extension and the corresponding amount of the fee. The expiration of the time period is determined by the amount of the fee paid. >A reply must be filed prior to the expiration of the period of extension to avoid abandonment of the application (§ 1.135), but in< [In] no case may an applicant >reply< [respond] later than the maximum time period set by statute, or be granted an extension of time under paragraph (b) of this section when the provisions of this paragraph are available. See § 1.136(b) for extensions of time relating to proceedings pursuant to §§ 1.193(b), 1.194, 1.196 or 1.197. See § 1.304 for extension of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action. See § 1.550(c) for extension of time in reexamination proceedings and § 1.645 for extension of time in interference proceedings.

>(3) A paper may be submitted in an application with an authorization to treat any concurrent or future reply requiring a petition for an extension of time under paragraph (a) of this section for its timely submission as incorporating such petition for the appropriate length of time. An authorization to charge all required fees, fees under § 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under paragraph (a) of this section for its timely submission.<

* * * * *

54. Section 1.137 is proposed to be revised to read as follows:

§ 1.137 Revival of abandoned application >or lapsed patent<.

(a) An >abandoned< application [abandoned for failure to prosecute] may be revived as a pending application >or a lapsed patent may be revived as a patent< if it is shown to the satisfaction of the Commissioner that the delay >in prosecution or payment of any portion of the required issue fee< was unavoidable. A petition to revive an >unavoidably< abandoned application >or unavoidably lapsed patent< must be [promptly filed after the applicant is notified of, or otherwise becomes aware of, the abandonment, and must be] accompanied by:

[(1) A proposed response to continue prosecution of that application, or the filing of a continuing application, unless either has been previously filed;]

>(1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the proposed reply requirement may be met by the filing of a continuing application. In an abandoned application or a lapsed patent, for failure to pay any portion of the required issue fee, the proposed reply must be the issue fee or any outstanding balance thereof;<

(2) The petition fee as set forth in § 1.17(l); [and]

(3) A showing that the delay was unavoidable >and that the petition was promptly filed after the applicant was notified of, or otherwise became aware of, the abandonment or lapse; and< [The showing must be a verified showing if made by a person not registered to practice before the Patent and Trademark Office.]

>(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (c) of this section.<

(b) An >abandoned< application [unintentionally abandoned for failure to prosecute] may be revived as a pending application >or lapsed patent may be revived as a patent< if the delay >in prosecution or payment of any portion of the required issue fee< was unintentional. A petition to revive an unintentionally abandoned application >or lapsed patent< must be >accompanied by<:

>(1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the proposed reply requirement may be met by the filing of a continuing application. In an abandoned application or a lapsed patent, for failure to pay any portion of the required issue fee, the proposed reply must be the issue fee or any outstanding balance thereof;<

[(1) Accompanied by a proposed response to continue prosecution of that application, or filing of a continuing application, unless either has been previously filed;]

(2) [Accompanied by the] The petition fee as set forth in § 1.17(m);

(3) [Accompanied by a] A statement that the delay was unintentional. [The statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office.] The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) >Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (c) of this section.< [Filed either:

(i) Within one year of the date on which the application became abandoned; or

(ii) Within three months of the date of the first decision on a petition to revive under paragraph (a) of this section which was filed within one year of the date on which the application became abandoned.]

(c) >In all design applications and in all nonprovisional utility or plant applications filed before June 8, 1995< [In all applications filed before June 8, 1995, and all design applications filed on or after June 8, 1995], any petition pursuant to [paragraph (a) of] this section [not filed within six months of the date of abandonment of the application,] must be accompanied by a terminal disclaimer with fee under § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application. The terminal disclaimer must also apply to any patent granted on any continuing application entitled under 35 U.S.C. 120 to the benefit of the filing date of the application for which revival is sought.

(d) Any request for reconsideration or review of a decision refusing to revive an >abandoned< application >or lapsed patent< upon petition filed pursuant to paragraphs (a) or (b) of this section, to be considered timely, must be filed within two months of the decision refusing to revive or within such time as set in the decision.

(e) The time periods set forth in this section [cannot be extended, except that the three-month period set forth in paragraph (b)(4)(ii) and the time period set forth in paragraph (d) of this section] may be extended under the provisions of § 1.136.

>(f) A provisional application, abandoned for failure to timely reply to an Office requirement, may be revived pursuant to paragraphs (a) or (b) this

section so as to be pending for a period of no longer than twelve months from its filing date. Under no circumstances will a provisional application be regarded as pending after twelve months from its filing date.<

§ 1.139 [Removed and reserved]

55. Section 1.139 is proposed to be removed and reserved.

56. Section 1.142 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.142 Requirement for restriction.

(a) If two or more independent and distinct inventions are claimed in a single application, the examiner in [his] >an Office< action shall require the applicant in [his] >a reply< [response] to that action to elect [that] >an< invention to which [his] >the< [claim] >claims< shall be restricted, this official action being called a requirement for restriction (also known as a requirement for division). [If the distinctness and independence of the inventions be clear, such] >Such< requirement will >normally< be made before any action on the merits; however, it may be made at any time before final action [in the case at the discretion of the examiner].

* * * * *

57. Section 1.144 is proposed to be revised to read as follows:

§ 1.144 Petition from requirement for restriction.

After a final requirement for restriction, the applicant, in addition to making any >reply< [response] due on the remainder of the action, may petition the Commissioner to review the requirement. Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested.

58. Section 1.146 is proposed to be revised to read as follows:

§ 1.146 Election of species.

In the first action on an application containing a [generic] claim >to a generic invention (genus)< and claims [restricted separately to each of] >to< more than one >patentably distinct< species embraced thereby, the examiner may require the applicant in his >or her reply< [response] to that action to elect [that] >a< species of his or her invention to which his or her claim shall be restricted if no [generic] claim >to the genus< is [held] >found to be< allowable. However, if such application contains claims directed to more than a reasonable number of species, the examiner may require restriction of the claims to not more than a reasonable number of species before taking further action in the case.

59. Section 1.152 is proposed to be revised to read as follows:

§ 1.152 Design drawings.

The design must be represented by a drawing that complies with the requirements of § 1.84, and must contain a sufficient number of views to constitute a complete disclosure of the appearance of the [article] >design<. Appropriate >and adequate< surface shading [must] >should< be used to show the character or contour of the surfaces represented. Solid black surface shading is not permitted except when used to represent >the color black as well as< color contrast. Broken lines may be used to show visible environmental structure, but may not be used to show hidden planes and surfaces which cannot be seen through opaque materials. Alternate positions of a design component, illustrated by full and broken lines in the same view are not permitted in a design drawing. >Color photographs and color drawings will be permitted in design applications only after the granting of a petition filed under § 1.84(a)(2).< Photographs and ink drawings must not be combined >as formal drawings< in one application. Photographs submitted in lieu of ink drawings in design patent applications must comply with § 1.84(b) and must not disclose environmental structure but must be limited to the design for the article claimed. [Color drawings and color photographs are not permitted in design patent applications.]

60. Section 1.154 is proposed to be amended by revising paragraph (a) as follows:

§ 1.154 Arrangement of specification.

* * * * *

(a) Preamble, stating name of the applicant>,< [and] title of the designn>, and a brief description of the nature and intended use of the article in which the design is embodied<.

* * * * *

61. Section 1.155 is proposed to be amended by removing paragraphs (b) through (f).

§ 1.155 Issue and term of design patents.

* * * * *

(b) [Removed].

(c) [Removed].

(d) [Removed].

(e) [Removed].

(f) [Removed].

62. Section 1.163 is proposed to be amended by revising paragraph (b) to read as follows:

§ 1.163 Specification.

* * * * *

(b) Two copies of the specification (including the claim) must be submitted, but only one signed oath or declaration is required. [The second copy of the specification may be a legible carbon copy of the original.]

63. Section 1.165 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.165 Plant drawings.

(a) Plant patent drawings [should be artistically and competently executed and] must comply with the requirements of § 1.84. View numbers and reference characters need not be employed unless required by the examiner. The drawing must disclose all the distinctive characteristics of the plant capable of visual representation.

* * * * *

64. Section 1.167(b) is proposed to be removed and reserved.

§ 1.167 Examination.

* * * * *

(b) [Reserved].

65. Section 1.171 is proposed to be revised to read as follows:

§ 1.171 Application for reissue.

An application for reissue must contain the same parts required for an application for an original patent, complying with all the rules relating thereto except as otherwise provided, and in addition, must comply with the requirements of the rules relating to reissue applications. [The application must be accompanied by a certified copy of an abstract of title or an order for a title report accompanied by the fee set forth in § 1.19(b)(4), to be placed in the file, and by an offer to surrender the original patent (§ 1.178).]

66. Section 1.172 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.172 Applicants, assignees.

(a) A reissue oath must be signed and sworn to or declaration made by the inventor or inventors except as otherwise provided (see §§ 1.42, 1.43, 1.47), and must be accompanied by the written [assent] >consent< of all assignees, if any, owning an undivided interest in the patent, but a reissue oath may be made and sworn to or declaration made by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent. >All assignees consenting to the reissue must establish their ownership interest in the patent to the satisfaction of the Commissioner. Ownership is

established by submitting to the Office documentary evidence of a chain of title from the original owner to the assignee or by specifying (e.g., reel and frame number, etc.) where such evidence is recorded in the Office. Documents submitted to establish ownership may be required to be recorded.<

* * * * *

67. Section 1.175 is proposed to be revised to read as follows:

§ 1.175 Reissue oath or declaration.

(a) [Applicants for reissue,] >The reissue oath or declaration< in addition to complying with the requirements of § 1.63, must also [file with their applications] >include< [a statement] >statement(s)< [under oath or declaration] as follows:

(1) [When] >That< the applicant [verily] believes the original patent to be wholly or partly inoperative or invalid [, stating such belief and the reasons why.

(2) When it is claimed that such patent is so inoperative or invalid ''] by reason of a defective specification or drawing, ['' particularly specifying such defects.

(3) When it is claimed that such patent is inoperative or invalid ''] >or< by reason of the patentee claiming more or less than [he] >patentee< had the right to claim in the patent, ['' distinctly specifying the excess or insufficiency in the claims.] >and<

[(4)] [Reserved]

[(5) Particularly] >(2) stating< [specifying at least one error relied upon, and how they arose or occurred] >that all errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose without deceptive intention on the part of the applicant<.

[(6)] >(b)(1) For any error corrected not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration< [Stating] >stating< that> every such error< [said errors] arose [''] without any deceptive intention [''] on the part of the applicant. >Any supplemental oath or declaration required by this paragraph must be submitted before allowance and may be submitted:

(i) With any amendment prior to allowance, or

(ii) In order to overcome a rejection under 35 U.S.C 251 made by the examiner where it is indicated that the submission of a supplemental oath or declaration as required by this paragraph will overcome the rejection.

(2) For any error sought to be corrected after allowance, a supplemental oath or declaration must accompany the requested correction stating that the error(s) to be corrected arose without any deceptive intention on the part of the applicant.

(c) Other than as set forth in paragraphs (a)(2) and (b) of this section, an oath or declaration under this section need not specifically identify the error or errors that are being corrected.<

[(7) Acknowledging the duty to disclose to the Office all information known to applicants to be material to patentability as defined in § 1.56.

(b) Corroborating affidavits or declarations of others may be filed and the examiner may, in any case, require additional information or affidavits or declarations concerning the application for reissue and its object.]

>(d) The oath or declaration required by paragraph (a) of this section may be submitted under the provisions of § 1.53(d)(1).<

68. Section 1.176 is proposed to be revised to read as follows:

§ 1.176 Examination of reissue.

[An original claim, if re-presented in the reissue application, is subject to reexamination, and the] >The< entire >reissue< application will be examined in the same manner as original applications, subject to the rules relating thereto, excepting that division will not be required >between the original claims of the patent<. Applications for reissue will be acted on by the examiner in advance of other applications, but not sooner than two months after the announcement of the filing of the reissue application has appeared in the Official Gazette.

69. Section 1.177 is proposed to be revised to read as follows:

§ 1.177 >Multiple reissue applications< [Reissue in divisions].

>(a)< The Commissioner [may] >will pursuant to< [, in] his or her discretion, >under 35 U.S.C. 251,< [cause several] >permit multiple reissue< patents to be issued for distinct and separate parts of the thing patented[,upon] >if the following conditions are met:

(1) Copending reissue applications for distinct and separate parts of the thing patented have been filed,

(2) Applicant has filed in each copending application a timely< demand [of the applicant] >by way of petition for multiple reissue patents,

(3)< [upon payment of the] >The< required >filing and issue< [fee]>fees< for each [division] >copending reissue application have been paid, and

(4) Each petition for multiple reissue patents is granted prior to issuance of a reissue patent on any of the copending reissue applications.

(b) Each petition under paragraph (a) of this section must be accompanied by:

(1) A request for the issuance of multiple reissue patents for distinct and separate parts of the thing patented,

(2) The petition fee pursuant to § 1.17(i),

(3) An identification of the other copending reissue application(s),

(4) A statement that the inventions as claimed in the copending reissue applications are distinct and separate parts of the thing patented, and

(5) A showing sufficient to establish to the satisfaction of the Commissioner that the claimed subject matter of the thing patented is in fact being divided into distinct and separate parts<. [Each division of a reissue constitutes the subject of a separate specification descriptive of the part or parts of the invention claimed in such division; and the drawing may represent only such part or parts, subject to the provisions of §§ 1.83 and 1.84.]

>(c) When the copending reissue applications are filed at the same time, each petition under paragraph (a) of this section, must be filed no later than the earliest submission of the reissue oath or declaration under § 1.175(a) for any of the copending reissue applications. When the copending reissue applications are filed at different times, each petition under paragraph (a) of this section must be filed no later than the earliest of:

(1) Payment of the issue fee for any of the copending reissue applications, or

(2) Submission of the reissue oath or declaration under § 1.175(a) in the later filed copending reissue application.< [On filing divisional reissue applications, they shall be referred to the Commissioner. Unless otherwise ordered by the Commissioner upon petition and payment of the fee set forth in § 1.17(i), all the divisions of a reissue will issue simultaneously, if there is any controversy as to one division, the others will be withheld from issue until the controversy is ended, unless the Commissioner orders otherwise].

>(d) Where the requirements of this section have not been complied with, the Commissioner will not permit multiple reissue patents to be issued.<

70. Section 1.181 is proposed to be amended by removing paragraphs (d), (e) and (g).

§ 1.181 Petition to the Commissioner.

* * * * *

(d) [Removed].

(e) [Removed].

* * * * *

(g) [Removed].

71. Section 1.182 is proposed to be revised to read as follows:

§ 1.182 Questions not specifically provided for.

All cases not specifically provided for in the regulations of this part will be decided in accordance with the merits of each case by or under the authority of the Commissioner, >subject to such other requirements as may be imposed< [and such decision will be communicated to the interested parties in writing]. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(h).

§ 1.184 [Removed and reserved]

72. Section 1.184 is proposed to be removed and reserved.

73. Section 1.191 is proposed to be amended by revising paragraphs (a) and (b) to read as follows:

§ 1.191 Appeal to Board of Patent Appeals and Interferences.

(a) Every applicant for a patent or for reissue of a patent, or every owner of a patent under reexamination[, any of] >whose claims have< [the claims of which have] been twice rejected >in a particular application or patent under reexamination< [or who has been given a final rejection (§ 1.113)], may >file an< [, upon the payment of the fee set forth in § 1.17(e),] appeal from the decision of the examiner to the Board of Patent Appeals and Interferences >by filing a notice of appeal and paying the fee set forth in § 1.17(e)< within the time allowed for >reply< [response].

(b) The >notice of< appeal in an application or reexamination proceeding must identify the rejected claim or claims appealed, and must be signed by the applicant, patent owner or duly authorized attorney or agent.

* * * * *

74. Section 1.192 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.192 Appellant's brief.

(a) >Appellant< [The appellant] shall, within [2] >two< months from the date of the notice of appeal under § 1.191 in an application, reissue application, or patent under reexamination, or within the time allowed for >reply< [response] to the action appealed from, if such time is later, file a brief in triplicate. The brief must be accompanied by the requisite fee set forth in § 1.17(f) and must set forth the authorities and arguments on which the appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief may be refused consideration by the Board of Patent Appeals and Interferences.

* * * * *

75. Section 1.193 is proposed to be revised to read as follows:

§ 1.193 Examiner's answer >and substitute brief<.

(a)>(1)< The primary examiner may, within such time as may be directed by the Commissioner, furnish a written statement in answer to [the] appellant's brief including such explanation of the invention claimed and of the references and grounds of rejection as may be necessary, supplying a copy to [the] appellant. If the primary examiner shall find that the appeal is not regular in form or does not relate to an appealable action, [he] >the primary examiner< shall so state [and a petition from such decision may be taken to the Commissioner as provided in § 1.181].

>(a)(2) An examiner's answer may not include a new ground of rejection.<

(b)>(1) Appellant< [The appellant] may file a [reply] >substitute appeal< brief [directed only to such new points of argument as may be raised in the] >under § 1.192 to an< examiner's answer, within two months from the date of [such answer] >the examiner's answer.< [The new points or argument shall be specifically identified in the reply brief. If the examiner determines that the reply brief is not directed only to new points of argument raised in the examiner's answer, the examiner may refuse entry of the reply brief and will so notify the appellant. If the examiner's answer expressly states that it includes a new ground of rejection, appellant must file a reply thereto within two months from the date of such answer to avoid dismissal of the appeal as to the claims subject to the new ground of rejection; such reply may be accompanied by any amendment or material appropriate to then new ground.] See § 1.136(b) for extensions of time for filing a [reply] >substitute< brief in a patent application and § 1.550(c) for extensions of time in a reexamination proceeding. >The primary examiner may either acknowledge receipt and entry of the substitute appeal brief or reopen prosecution to respond to any new issues raised in the substitute appeal brief. A substitute examiner's answer is not permitted, except where the application has been remanded by the Board of Patent Appeals and Interferences for such purpose.<

>(2) Where prosecution is reopened by the primary examiner after an appeal brief has been filed, an appeal brief under § 1.192 is an appropriate reply by an applicant to the reopening of prosecution if it is accompanied by a request that the appeal be reinstated. If reinstatement of the appeal is elected, no amendments, affidavits (§§ 1.131 or 1.132) or other new evidence are permitted. If reinstatement of the appeal is not elected, amendments, affidavits and other new evidence are permitted.<

76. Section 1.194 is proposed to be revised to read as follows:

§ 1.194 Oral hearing.

(a) An oral hearing should be requested only in those circumstances in which [the] appellant considers such a hearing necessary or desirable for a proper presentation of [his] >the< appeal. An appeal decided without an oral hearing will receive the same consideration by the Board of Patent Appeals and Interferences as appeals decided after oral hearing.

(b) If appellant desires an oral hearing, appellant must file>, in a separate paper,< a written request for such hearing accompanied by the fee set forth in § 1.17(g) within two months after the date of the examiner's answer. If appellant requests an oral hearing and submits therewith the fee set forth in § 1.17(g), an oral argument may be presented by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board. See § 1.136(b) for extensions of time for requesting an oral hearing in a patent application and § 1.550(c) for extensions of time in a reexamination proceeding.

(c) If no request and fee for oral hearing have been timely filed by [the] appellant, the appeal will be assigned for consideration and decision. If [the] appellant has requested an oral hearing and has submitted the fee set forth in § 1.17(g), a day of hearing will be set, and due notice thereof given to [the] appellant and to the primary examiner. >A< [Hearing] >hearing< will be held as stated in the notice, and oral argument will be limited to twenty minutes for [the] appellant and fifteen minutes for the primary examiner unless otherwise ordered before the hearing begins. >If the Board decides that a hearing is not necessary, the Board will so notify appellant.<

77. Section 1.196 is proposed to be amended by revising paragraphs (b) and (d) to read as follows:

§ 1.196 Decision by the Board of Patent Appeals and Interferences.

* * * * *

(b) Should the Board of Patent Appeals and Interferences have knowledge of any grounds not involved in the appeal for rejecting any [appealed] >pending< claim, it may include in the decision a statement to that effect with its reasons for so holding, which statement shall

constitute a new >ground of< rejection of the [claims] >claim<. A new >ground of< rejection shall not be considered final for purposes of judicial review. When the Board of Patent Appeals and Interferences makes a new >ground of< rejection [of an appealed claim], the appellant>, within two months from the date of the decision,< may exercise [any one] >either< of the following two options with respect to the new ground >of rejection<:

(1) The appellant may submit an appropriate amendment of the claims so rejected or a showing of facts >relating to the claims so rejected<, or both, and have the matter reconsidered by the examiner in which event the application will be remanded to the examiner. The [statement] >new ground of rejection< shall be binding upon the examiner unless an amendment or showing of facts not previously of record be made which, in the opinion of the examiner, overcomes the new ground [for] >of< rejection stated in the decision. Should the examiner [again reject the application] >reject the claims, appellant< [the applicant] may again appeal >pursuant to §§ 1.191 through 1.195< to the Board of Patent Appeals and Interferences.

(2) The appellant may have the case reconsidered under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. The request for reconsideration [shall] >must< address the new ground [for] >of< rejection and state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which reconsideration is sought. Where request for such reconsideration is made, the Board of Patent Appeals and Interferences shall reconsider the new ground [for] >of< rejection and, if necessary, render a new decision which shall include all grounds >of rejection< upon which a patent is refused. The decision on reconsideration is deemed to incorporate the earlier decision >for purposes of appeal<, except for those portions specifically withdrawn on reconsideration, and is final for the purpose of judicial review>, except when noted otherwise in the decision<.

* * * * *

[(d) Although the Board of Patent Appeals and Interferences normally will confine its decision to a review of rejections made by the examiner, should it have knowledge of any grounds for rejecting any allowed claim it may include in its decision a recommended rejection of the claim and remand the case to the examiner. In such event, the Board shall set a period, not less than one month, within which the appellant may submit to the examiner an appropriate amendment, a showing of facts or reasons, or both, in order to avoid the grounds set forth in the recommendation of the Board of Patent Appeals and Interferences. The examiner shall be bound by the recommendation and shall enter and maintain the recommended rejection unless an amendment or showing of facts not previously of record is filed which, in the opinion of the examiner, overcomes the recommended rejection. Should the examiner make the recommended rejection final the applicant may again appeal to the Board of Patent Appeals and Interferences.]

>(1) The Board of Patent Appeals and Interferences may require Appellant to address any matter that is deemed appropriate for a reasoned decision on the pending appeal.

(2) Appellant will be given a time limit within which to reply to the inquiry made under paragraph (d)(1) of this section.<

* * * * *

78. Section 1.197 is proposed to be amended by revising paragraphs (a) and (b) to read as follows:

§ 1.197 Action following decision.

(a) After decision by the Board of Patent Appeals and Interferences, the case shall be returned to the examiner, subject to [the] appellant's right of appeal or other review, for such further action by [the] appellant or by the examiner, as the condition of the case may require, to carry into effect the decision.

(b) A single request for reconsideration or modification of the decision may be made if filed within >two months< [one month] from the date of the original decision, unless the original decision is so modified by the decision on reconsideration as to become, in effect, a new decision, and the Board of Patent Appeals and Interferences so states. The request for reconsideration shall state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which reconsideration is sought. See § 1.136(b) for extensions of time for seeking reconsideration in a patent application and § 1.550(c) for extensions of time in a reexamination proceeding.

* * * * *

79. Section 1.291 is proposed to be amended by revising paragraph (c) to read as follows:

§ 1.291 Protests by the public against pending applications.

* * * * *

(c) A member of the public filing a protest in an application under paragraph (a) of this section will not receive any communications from the Office relating to the protest, other than the return of a self-addressed postcard which the member of the public may include with the protest in order to receive an acknowledgment by the Office that the protest has been received. The Office may communicate with the applicant regarding any protest and may require the applicant to >reply< [respond] to specific questions raised by the protest. In the absence of a request by the Office, an applicant has no duty to, and need not, >reply< [respond] to a protest. The limited involvement of the member of the public filing a protest pursuant to paragraph (a) of this section ends with the filing of the protest, and no further submission on behalf of the protestor will be considered >,except for additional prior art, or< unless such submission raises new issues which could not have been earlier presented.

80. Section 1.294 is proposed to be amended by revising paragraph (b) to read as follows:

§ 1.294 Examination of request for publication of a statutory invention registration and patent application to which the request is directed.

* * * * *

(b) Applicant will be notified of the results of the examination set forth in paragraph (a) of this section. If the requirements of § 1.293 and this section are not met by the request filed, the notification to applicant will set a period of time within which to comply with the requirements in order to avoid abandonment of the application. If the application does not meet the requirements of 35 U.S.C. 112, the notification to applicant will include a rejection under the appropriate provisions of 35 U.S.C. 112. The periods for >reply< [response] established pursuant to this section are subject to the extension of time provisions of § 1.136. After >reply< [response] by the applicant, the application will again be considered for publication of a statutory invention registration. If the requirements of § 1.293 and this section are not timely met, the refusal to publish will be made final. If the requirements of 35 U.S.C. 112 are not met, the rejection pursuant to 35 U.S.C. 112 will be made final.

* * * * *

81. Section 1.304 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.304 Time for appeal or civil action.

(a)(1) The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (§ 1.302) or for commencing a civil action (§ 1.303) is two months from the date of the decision of the Board of Patent Appeals and Interferences. If a request for [consideration] >reconsideration< or modification of the decision is filed within the time period provided under § 1.197(b) or § 1.658(b), the time for filing an appeal or commencing a civil action shall expire two months after action on the request. In interferences, the time for filing a cross-appeal or cross-action expires:

(i) 14 days after service of the notice of appeal or the summons and complaint, or

(ii) Two months after the date of decision of the Board of Patent Appeals and Interferences, whichever is later.

* * * * *

82. Section 1.312 is proposed to be amended by revising paragraph (b) to read as follows:

§ 1.312 Amendments after allowance.

* * * * *

(b) Any amendment pursuant to paragraph (a) of this section filed after the date the issue fee is paid must be accompanied by a petition including the fee set forth in § 1.17(i) and a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented. >For reissue applications, see § 1.175(b), which requires a supplemental oath or declaration to accompany the amendment.<

83. Section 1.313 is proposed to be amended by adding a new paragraph (c) to read as follows:

§ 1.313 Withdrawal from issue.

* * * * *

>(c) Unless an applicant receives written notification that the application has been withdrawn from issue at least two weeks prior to the projected date of issue, applicant should expect that the application will issue as a patent.<

84. Section 1.316 paragraphs (b) through (f) are proposed to be removed.

§ 1.316 Application abandoned for failure to pay issue fee.

* * * * *

(b) [Removed].

(c) [Removed].

(d) [Removed].

(e) [Removed].

(f) [Removed].

85. Section 1.317 paragraphs (b) through (f) are proposed to be removed.

§ 1.317 Lapsed patents; delayed payment of balance of issue fee.

* * * * *

(b) [Removed].

(c) [Removed].

(d) [Removed].

(e) [Removed].

(f) [Removed].

§ 1.318 [Removed and reserved].

86. Section 1.318 is proposed to be removed and reserved.

87. Section 1.324 is proposed to be revised to read as follows:

§ 1.324 Correction of inventorship in patent.

>(a) Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his or her part, < [Whenever a patent is issued and it appears that the correct inventor or inventors were not named through error without deceptive intention on the part of the actual inventor or inventors,] the Commissioner may, on petition [of all the parties and the assignees and satisfactory proof of the facts and payment of the fee set forth in § 1.20(b)], or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors. A >petition< [request] to correct inventorship of a patent involved in an interference shall comply with the requirements of this section and shall be accompanied by a motion under § 1.634.

>(b) Any petition pursuant to paragraph (a) of this section must be accompanied by:

(1) A statement from each person who is being added as an inventor and from each person who is being deleted as an inventor that the inventorship error occurred without any deceptive intention on their part;

(2) A statement from the current named inventors who have not submitted a statement under paragraph (b)(1) of this section either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change;

(3) A statement from all assignees of the parties submitting a statement under paragraphs (b)(1) and (b)(2) of this section agreeing to the change of inventorship in the patent; such statement must comply with the requirements of § 3.73(b); and

(4) The fee set forth in § 1.20(b).<

§ 1.325 [Removed and reserved]

88. Section 1.325 is proposed to be removed and reserved.

§ 1.351 [Removed and reserved]

89. Sections 1.351 is proposed to be removed and reserved.

§ 1.352 [Removed and reserved]

90. Section 1.352 is proposed to be removed and reserved.

91. Section 1.366 is proposed to be amended by revising paragraphs (b) through (d) to read as follows:

§ 1.366 Submission of maintenance fees.

* * * * *

(b) A maintenance fee and any necessary surcharge submitted for a patent must be submitted in the amount due on the date the maintenance fee and any necessary surcharge are paid and may be paid in the manner set forth in § 1.23 or by an authorization to charge a deposit account established pursuant to § 1.25. Payment of a maintenance fee and any necessary surcharge or the authorization to charge a deposit account must be submitted within the periods set forth in § 1.362(d), (e), or (f). Any payment or authorization of maintenance fees and surcharges filed at any other time will not be accepted and will not serve as a payment of the maintenance fee except insofar as a delayed payment of the maintenance fee is accepted by the Commissioner in an expired patent pursuant to a petition filed under § 1.378. Any authorization to charge a deposit account must authorize the immediate charging of the maintenance fee and any necessary surcharge to the deposit account. Payment of less than the required amount, payment in a manner other than that set forth in the filing of an authorization to charge a deposit account having insufficient funds will not constitute payment of a maintenance fee or surcharge on a patent. The [certificate] procedures of either § 1.8 or § 1.10 may be utilized in paying maintenance fees and any necessary surcharges.

(c) In submitting maintenance fees and any necessary surcharges, identification of the patents for which maintenance fees are being paid must include the following:

(1) The patent number, and

(2) The [serial] >application< number of the United States application for the patent on which the maintenance fee is being paid.

(d) Payment of maintenance fees and any surcharges should identify the fee being paid for each patent as to whether it is the 3½-,7½-, or 11½-year fee, whether small entity status is being

changed or claimed, the amount of the maintenance fee and any surcharge being paid, and any assigned payor number[, the patent issue date and the United States application filing date]. If the maintenance fee and any necessary surcharge is being paid on a reissue patent, the payment must identify the reissue patent by reissue patent number and reissue application [serial] number as required by paragraph (c) of this section and should also include the original patent number[, the original patent issue date, and the original United States application filing date].

* * * * *

92. Section 1.377 is proposed to be amended by revising paragraph (c) to read as follows:

§ 1.377 Review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of patent.

* * * * *

(c) Any petition filed under this section must comply with the requirements of paragraph (b) of § 1.181 and must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest. [Such petition must be in the form of a verified statement if made by a person not registered to practice before the Patent and Trademark Office.]

93. Section 1.378 is proposed to be amended by revising paragraph (d) to read as follows:

§ 1.378 Acceptance of delayed payment of maintenance fee in expired patent to reinstate patent.

* * * * *

(d) Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest. [Such petition must be in the form of a verified statement if made by a person not registered to practice before the Patent and Trademark Office.]

* * * * *

94. Section 1.425 is proposed to be revised to read as follows:

§ 1.425 Filing by other than inventor.

[(a) If a joint inventor refuses to join in an international application which designates the United States of America or cannot be found or reached after diligent effort, the international application which designates the United States of America may be filed by the other inventor on behalf of himself or herself and the omitted inventor. Such an international application which designates the United States of America must be accompanied by proof of the pertinent facts and must state the last known address of the omitted inventor. The Patent and Trademark Office shall forward notice of the filing of the international application to the omitted inventor at said address.

(b) Whenever an inventor refuses to execute an international application which designates the United States of America, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action may file the international application on behalf of and as agent for the inventor. Such an international application which designates the United States of America must be accompanied by proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage and must state the last known address of the inventor. The assignment, written agreement to assign or other evidence of proprietary interest, or a verified copy thereof, must be filed in the Patent and Trademark Office. The Office shall forward notice of the filing of the application to the inventor at the address stated in the application.] Where an international application which designates the United States of America is filed and where one or more inventors refuse to sign the request for the international application or could not be found or reached after diligent effort, the request need not be signed by such inventor if it is signed by another applicant. Such international application must be accompanied by a statement explaining to the satisfaction of the Commissioner the lack of the signature concerned.

95. Section 1.484 is proposed to be amended by revising paragraphs (d) through (f) to read as follows:

§ 1.484 Conduct of international preliminary examination.

* * * * *

(d) The International Preliminary Examining Authority will establish a written opinion if any defect exists or if the claimed invention lacks novelty, inventive step or industrial applicability and will set a non-extendable time limit in the written opinion for the applicant to >reply< [respond].

(e) If no written opinion under paragraph (d) of this section is necessary, or after any written opinion and the >reply< [response] thereto or the expiration of the time limit for >reply< [response] to such written opinion, an international preliminary examination report will be established by the International Preliminary Examining Authority. One copy will be submitted to the International Bureau and one copy will be submitted to the applicant.

(f) An applicant will be permitted a personal or telephone interview with the examiner, which must be conducted during the non-extendable time limit for >reply< [response] by the applicant to a written opinion. Additional interviews may be conducted where the examiner determines that such additional interviews may be helpful to advancing the international preliminary examination procedure. A summary of any such personal or telephone interview must be filed by the applicant as a part of the >reply< [response] to the written opinion or, if applicant files no >reply< [response], be made of record in the file by the examiner.

96. Section 1.485 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.485 Amendments by applicant during international preliminary examination.

(a) The applicant may make amendments at the time of filing of the Demand and within the time limit set by the International Preliminary Examining Authority for >reply< [response] to any notification under § 1.484(b) or to any written opinion. Any such amendments must:

(1) Be made by submitting a replacement sheet for every sheet of the application which differs from the sheet it replaces unless an entire sheet is cancelled, and

(2) Include a description of how the replacement sheet differs from the replaced sheet.

* * * * *

97. Section 1.488 is proposed to be amended by revising paragraph (b) to read as follows:

§ 1.488 Determination of unity of invention before the International Preliminary Examining Authority.

* * * * *

(b) If the International Preliminary Examining Authority considers that the international application does not comply with the requirement of unity of invention, it may:

(1) Issue a written opinion and/or an international preliminary examination report, in respect of the entire international application and indicate that unity of invention is lacking and specify the reasons therefor without extending an invitation to restrict or pay additional fees. No international preliminary examination will be conducted on inventions not previously

searched by an International Searching Authority.

(2) Invite the applicant to restrict the claims or pay additional fees, pointing out the categories of the invention found, within a set time limit which will not be extended. No international preliminary examination will be conducted on inventions not previously searched by an International Preliminary Examining Authority, or

(3) If applicant fails to restrict the claims or pay additional fees within the time limit set for >reply< [response], the International Preliminary Examining Authority will issue a written opinion and/or establish an international preliminary examination report on the main invention and shall indicate the relevant facts in the said report. In case of any doubt as to which invention is the main invention, the invention first mentioned in the claims and previously searched by an International Searching Authority shall be considered the main invention.

* * * * *

98. Section 1.492 is proposed to be amended by adding a new paragraph (g) to read as follows:

§ 1.492 National stage fees.

* * * * *

>(g) If the additional fees required by paragraphs (b), (c), and (d) are not paid on presentation of the claims for which the additional fees are due, they must be paid or the claims cancelled by amendment, prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency.<

99. Section 1.494 is proposed to be amended by revising paragraph (c) to read as follows:

§ 1.494 Entering the national stage in the United States of America as a Designated Office.

* * * * *

(c) If applicant complies with paragraph (b) of this section before expiration of 20 months from the priority date but omits:

(1) A translation of the international application, as filed, into the English language, if it was originally filed in another language (35 U.S.C. 371(c)(2)) and/or

(2) The oath or declaration of the inventor (35 U.S.C. 371(c)(4); see § 1.497), applicant will be so notified and given a period of time within which to file the translation and/or oath or declaration in order to prevent abandonment of the application. The payment of the processing fee set forth in § 1.492(f) is required for acceptance of an English translation later than the expiration of 20 months after the priority date. The payment of the surcharge set forth in § 1.492(e) is required for acceptance of the oath or declaration of the inventor later than the expiration of 20 months after the priority date. A copy of the notification mailed to applicant should accompany any >reply< [response] thereto submitted to the Office.

* * * * *

100. Section 1.495 is proposed to be amended by revising paragraph (c) to read as follows:

§ 1.495 Entering the national stage in the United States of America as an Elected Office.

* * * * *

(c) If applicant complies with paragraph (b) of this section before expiration of 30 months from the priority date but omits:

(1) A translation of the international application, as filed, into the English language, if it was originally filed in another language (35 U.S.C. 371(c)(2)) and/or

(2) The oath or declaration of the inventor (35 U.S.C. 371(c)(4); see § 1.497), applicant will be so notified and given a period of time within which to file the translation and/or oath or declaration in order to prevent abandonment of the application. The payment of the processing fee set forth in § 1.492(f) is required for acceptance of an English translation later than the expiration of 30 months after the priority date. The payment of the surcharge set forth in § 1.492(e) is required for acceptance of the oath or declaration of the inventor later than the expiration of 30 months after the priority date. A copy of the notification mailed to applicant should accompany any >reply< [response] thereto submitted to the Office.

* * * * *

101. Section 1.510 is proposed to be amended by revising paragraph (e) to read as follows:

§ 1.510 Request for reexamination.

* * * * *

(e) A request filed by the patent owner may include a proposed amendment in accordance with [§ 1.121(f)] >§ 1.530(d)<.

102. Section 1.530 is proposed to be amended by revising the heading and paragraphs (a) and (d) to read as follows:

§ 1.530 Statement and [amendment] >reply< by patent owner.

(a) Except as provided in § 1.510(e), no statement or other >reply< [response] by the patent owner shall be filed prior to the determinations made in accordance with §§ 1.515 or 1.520. If a premature statement or other >reply< [response] is filed by the patent owner it will not be acknowledged or considered in making the determination.

* * * * *

[(d) Any proposed amendment to the description and claims must be made in accordance with § 1.121(f). No amendment may enlarge the scope of the claims of the patent or introduce new matter. No amended or new claims may be proposed for entry in an expired patent. Moreover, no amended or new claims will be incorporated into the patent by certificate issued after the expiration of the patent.]

>(d) *Amendments in reexamination proceedings:* Amendments in reexamination proceedings are made by filing a paper, in compliance with paragraph (d)(5) of this section, directing that specified amendments be made.

(1) *Specification other than claims:* Amendments to the specification other than claims may only be made as follows:

(i) The precise point in the specification must be indicated where an amendment is to be made.

(ii) Amendments must be made by submission of the entire text of the rewritten paragraph(s) with markings pursuant to paragraph (d)(1)(iv) of this section.

(iii) Each submission of an amendment to the specification of the patent must include all amendments to the specification relative to the patent as of the date of the submission. This would include amendments to the specification of the patent submitted for the first time as well as any previously submitted amendments that are still desired. Any previously submitted amendments to the specification that are no longer desired must not be included in the submission.

(iv) Underlining below the subject matter added to the patent and brackets around the subject matter deleted from the patent are to be used to mark the amendments being made.

(2) *Claims:* Amendments to the claims are made as follows:

(i)(A) The amendment must include the entire text of each patent claim which is amended and each proposed claim with marking pursuant to paragraph (d)(2)(i)(C) of this section, except a patent or proposed claim should be cancelled by a statement cancelling the patent or proposed claim without presentation of the text of the patent or proposed claim.

(B) Patent claims must not be renumbered and the numbering of any

claims proposed to be added to the patent must follow the number of the highest numbered patent claim.

(C) Underlining below the subject matter added to the patent and brackets around the subject matter deleted from the patent are to be used to mark the amendments being made. If a claim is amended pursuant to paragraph (d)(2)(i)(A) of this section, a parenthetical expression ''amended,'' ''twice amended,'' *etc.*, should follow the original claim number.

(ii) Each amendment submission must set forth the status, as of the date of the amendment, of all patent claims, of all claims currently proposed, and of all previously proposed claims that are no longer being proposed.

(iii) Each amendment when originally submitted must be accompanied by an explanation of the support in the disclosure of the patent for the amendment along with any additional comments on page(s) separate from the page(s) containing the amendment.

(iv) Each submission of an amendment to any claim (patent claims and all proposed claims) must include all amendments to the claims as of the date of the submission. This would include amendments to the claims submitted for the first time as well as any previously submitted amendments to the claims that are still desired. Any previously submitted amendments to the claims that are no longer desired must not be included in the submission. A copy of any patent claims that have not been amended are not to be presented with each amendment submission.

(v) The failure to submit a copy of any proposed claim will be construed as a direction to cancel that claim.

(3) No amendment may enlarge the scope of the claims of the patent or introduce new matter. No amendment may be proposed for entry in an expired patent. Moreover, no amendment will be incorporated into the patent by certificate issued after the expiration of the patent.

(4) Amendments made to a patent during a reexamination proceeding will not be effective until a reexamination certificate is issued.

(5) The form of replies, amendments, briefs, appendices and other papers must be in accordance with the following requirements. All documents, including any amendments or corrections thereto, must be in the English language. All papers which are to become a part of the permanent records of the Patent and Trademark Office must be legibly written either by a typewriter or mechanical printer in permanent dark ink or its equivalent in portrait orientation on flexible, strong, smooth, non-shiny, durable, and white paper. All printed matter must appear in at least 11 point type. All of the papers must be presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic reproduction by use of digital imaging and optical character recognition. If the papers are not of the required quality, substitute typewritten or mechanically printed papers of suitable quality will be required. The papers, including the drawings, must have each page plainly written on only one side of a sheet of paper. The sheets of paper must be the same size and either 21.0 cm. by 29.7 cm. (DIN size A4) or 21.6 cm. by 27.9 cm. (8½ by 11 inches). Each sheet must include a top margin of at least 2.0 cm. (¾ inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 2.0 cm. (¾ inch), and a bottom margin of at least 2.0 cm. (¾ inch), and no holes should be made in the sheets as submitted. The lines must be 1½ or double spaced. The pages must be numbered consecutively, starting with 1, the numbers being centrally located above or preferably, below, the text.

(6) *Drawings:* The original patent drawing sheets may not be altered. Any proposed change to the patent drawings must be by way of a new sheet of drawings with the amended figures identified as ''amended'' and with added figures identified as ''new'' for each sheet changed submitted in compliance with § 1.84<

* * * * *

103. Section 1.550 is proposed to be amended by revising paragraphs (a), (b) and (d) to read as follows:

§ 1.550 Conduct of reexamination proceedings.

(a) All reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. After issuance of the reexamination order and expiration of the time for submitting any >replies< [responses] thereto, the examination will be conducted in accordance with §§ 1.104 through 1.116 and will result in the issuance of a reexamination certificate under § 1.570.

(b) The patent owner will be given at least [30] >thirty< days to >reply< [respond] to any Office action. Such >reply< [response] may include further statements in >reply< [response] to any rejections and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable.

* * * * *

(d) If the patent owner fails to file a timely and appropriate >reply< [response] to any Office action, the reexamination proceeding will be terminated and the Commissioner will proceed to issue a certificate under § 1.570 in accordance with the last action of the Office.

* * * * *

104. Section 1.560 is proposed to be amended by revising paragraph (b) to read as follows:

§ 1.560 Interviews in reexamination proceedings.

* * * * *

(b) In every instance of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for >reply< [response] to Office actions as specified in § 1.111.

105. Section 1.770 is proposed to be revised to read as follows:

§ 1.770 Express withdrawal of application for extension of patent term.

An application for extension of patent term may be expressly withdrawn before a determination is made pursuant to § 1.750 by filing in the Office, in duplicate, a written declaration of withdrawal signed by the owner of record of the patent or its agent. An application may not be expressly withdrawn after the date permitted for >reply< [response] to the final determination on the application. An express withdrawal pursuant to this section is effective when acknowledged in writing by the Office. The filing of an express withdrawal pursuant to this section and its acceptance by the Office does not entitle applicant to a refund of the filing fee § 1.20(j)) or any portion thereof.

106. Section 1.785 is proposed to be amended by revising paragraph (d) to read as follows:

§ 1.785 Multiple applications for extension of term of the same patent or different patents for the same regulatory review period for a product.

* * * * *

(d) An application for extension shall be considered complete and formal regardless of whether it contains the identification of the holder of the regulatory approval granted with respect to the regulatory review period or express and exclusive authorization from the holder of the regulatory

approval to rely on the regulatory review period for extension. When an application contains such information, or is amended to contain such information, it will be considered in determining whether an application is eligible for an extension under this section. A request may be made of any applicant to supply such information within a non-extendable period of not less than one [(1)] month whenever multiple applications for extension of more than one patent are received and rely upon the same regulatory review period. Failure to provide such information within the period for >reply< [response] set shall be regarded as conclusively establishing that the applicant is not the holder of the regulatory approval and is not expressly and exclusively authorized by the holder of the regulatory approval to seek the extension being sought.

* * * * *

107. Section 1.804 is proposed to be amended by revising paragraph (b) to read as follows:

§ 1.804 Time of making an original deposit.

* * * * *

(b) When the original deposit is made after the effective filing date of an application for patent, the applicant shall promptly submit a [verified] statement from a person in a position to corroborate the fact, [and shall state] >stating<, that the biological material which is deposited is a biological material specifically identified in the application as filed[, except if the person is an attorney or agent registered to practice before the Office, in which case the statement need not be verified].

108. Section 1.805 is proposed to be amended by revising paragraph (c) to read as follows:

§ 1.805 Replacement or supplement of deposit.

* * * * *

(c) A request for a certificate of correction under this section shall not be granted unless the request is made promptly after the replacement or supplemental deposit has been made and:

(1) Includes a [verified] statement of the reason for making the replacement or supplemental deposit;

(2) Includes a [verified] statement from a person in a position to corroborate the fact, and [shall state] >stating<, that the replacement or supplemental deposit is of a biological material which is identical to that originally deposited;

(3) Includes a [verified] showing that the patent owner acted diligently[–]>:<

(i) In the case of a replacement deposit, in making the deposit after receiving notice that samples could no longer be furnished from an earlier deposit, or

(ii) In the case of a supplemental deposit, in making the deposit after receiving notice that the earlier deposit had become contaminated or had lost its capability to function as described in the specification;

(4) Includes a [verified] statement that the term of the replacement or supplemental deposit expires no earlier than the term of the deposit being replaced or supplemented; and

(5) Otherwise establishes compliance with these regulations[, except that if the person making one or more of the required statements or showing is an attorney or agent registered to practice before the Office, that statement or showing need not be verified].

* * * * *

PART 3—ASSIGNMENT, RECORDING, AND RIGHTS OF ASSIGNEE

The authority citation for part 3 continues to read as follows:

Authority: 15 U.S.C. 1123; 35 U.S.C. 6.

109a. Section 3.11 is proposed to be revised to read as follows:

§ 3.11 Documents which will be recorded.

>(a)< Assignments of applications, patents, and registrations, accompanied by completed cover sheets as specified in §§ 3.28 and 3.31, will be recorded in the Office. Other documents, accompanied by completed cover sheets as specified in §§ 3.28 and 3.31, affecting title to applications, patents, or registrations, will be recorded as provided in this part or at the discretion of the Commissioner.

>(b) Executive Order 9424 (3 CFR 1943—1948 Comp.) requires the several departments and other executive agencies of the Government, including Government-owned or Government-controlled corporations, to forward promptly to the Commissioner of Patents and Trademarks for recording all licenses, assignments, or other interests of the Government in or under patents or patent applications. Assignments and other documents affecting title to patents or patent applications and documents not affecting title to patents or patent applications required by Executive order 9424 (3 CFR 1943—1948 Comp.) to be filed will be recorded as provided in this Part.<

110. Section 3.26 is proposed to be revised to read as follows:

§ 3.26 English language requirement.

The Office will accept and record non-English language documents only if accompanied by [a verified] >an< English translation signed by the individual making the translation.

110a. Section 3.27 is proposed to be revised to read as follows:

§ 3.27 Mailing address for submitting documents to be recorded.

>(a) Except as provided in paragraph (b) of this section, documents< [Documents] and cover sheets to be recorded should be addressed to the Commissioner of Patents and Trademarks, Box Assignments, Washington, DC 20231, unless they are filed together with new applications or with a petition under § 3.81(b).

>(b) A document required by Executive Order 9424 (3 CFR 1943—1948 Comp.) to be filed which does not affect title and is so identified in the cover sheet (see § 3.31(c)(2)) must be addressed and mailed to the Commissioner of Patents and Trademarks, Box Government Interest, Washington, DC 20231.<

111. Section 3.31 is proposed to be amended by adding paragraph (c) to read as follows:

§ 3.31 Cover sheet content.

* * * * *

>(c) Each patent cover sheet required by § 3.28 seeking to record a governmental interest as provided by § 3.11(b) must:

(1) Indicate that the document is to be recorded on the governmental register, and, if applicable, that the document is to be recorded on the Secret Register (see § 3.58), and

(2) Indicate, if applicable, that the document to be recorded is not a document affecting title (see § 3.41(b)).<

112. Section 3.41 is proposed to be revised to read as follows:

§ 3.41 Recording fees.

>(a)< All requests to record documents must be accompanied by the appropriate fee. >Except as provided in paragraph (b) of this section, a< [A] fee is required for each application, patent and registration against which the document is recorded as identified in the cover sheet. The recording fee is set in § 1.21(h) of this [Chapter] >chapter< for patents and in § 2.6(q) of this [Chapter] >chapter< for trademarks.

>(b) No fee is required for each patent application and patent against which a document required by Executive Order 9424 (3 CFR 1943–1948 Comp.) is to be filed if:

(1) The document does not affect title and is so identified in the cover sheet (see § 3.31(c)(2));

(2) The cover sheet is filed in a format approved by the Office; and

(3) The document and cover sheet are mailed to the Office in compliance with § 3.27(b).<

113. Section 3.51 is proposed to be revised to read as follows:

§ 3.51 Recording date.

The date of recording of a document is the date the document meeting the requirements for recording set forth in this [Part] >part< is filed in the Office. A document which does not comply with the identification requirements of 3.21 will not be recorded. Documents not meeting the other requirements for recording, for example, a document submitted without a completed cover sheet or without the required fee, will be returned for correction to the sender where a correspondence address is available. The returned papers, stamped with the original date of receipt by the Office, will be accompanied by a letter which will indicate that if the returned papers are corrected and resubmitted to the Office within the time specified in the letter, the Office will consider the original date of filing of the papers as the date of recording of the document. The [certification] procedure under either § 1.8 or § 1.10 of this [Chapter] >chapter< may be used for resubmissions of returned papers to have the benefit of the date of deposit in the United States Postal Service. If the returned papers are not corrected and resubmitted within the specified period, the date of filing of the corrected papers will be considered to be the date of recording of the document. The specified period to resubmit the returned papers will not be extended.

114. Section 3.58 is proposed to be added to read as follows:

§ 3.58 Governmental registers.

(a) The Office will maintain a Departmental Register to record governmental interests required to be recorded by Executive Order 9424 (3 CFR 1943–1948 Comp.). This Departmental Register will not be open to public inspection but will be available for examination and inspection by duly authorized representatives of the Government. Governmental interests recorded on the Departmental Register will be available for public inspection as provided in § 1.12.

(b) The Office will maintain a Secret Register to record governmental interests required to be recorded by Executive Order 9424 (3 CFR 1943–1948 Comp.). Any instrument to be recorded will be placed on this Secret Register at the request of the department or agency submitting the same. No information will be given concerning any instrument in such record or register, and no examination or inspection thereof or of the index thereto will be permitted, except on the written authority of the head of the department or agency which submitted the instrument and requested secrecy, and the approval of such authority by the Commissioner of Patents and Trademarks. No instrument or record other than the one specified may be examined, and the examination must take place in the presence of a designated official of the Patent and Trademark Office. When the department or agency which submitted an instrument no longer requires secrecy with respect to that instrument, it must be recorded anew in the Departmental Register.<

115. Section 3.73 is proposed to be amended by revising paragraph (b) to read as follows:

§ 3.73 Establishing right of assignee to prosecute.

* * * * *

(b) When the assignee of the entire right, title and interest seeks to take action in a matter before the Office with respect to a patent application, trademark application, patent registration, or reexamination proceeding, the assignee must establish its ownership of the property to the satisfaction of the Commissioner. Ownership is established by submitting to the Office documentary evidence of a chain of title from the original owner to the assignee >(*e.g.,* copy of an executed assignment submitted for recording, *etc.*)< or by specifying (*e.g.,* reel and frame number, *etc.*) where such evidence is recorded in the Office. Documents submitted to establish ownership may be required to be recorded as a condition to permitting the assignee to take action in a matter pending before the Office. [In addition, the assignee of a patent application or patent must submit a statement specifying that the evidentiary documents have been reviewed and certifying that, to the best of assignee's knowledge and belief, title is in the assignee seeking to take the action.]

PART 5—SECRECY OF CERTAIN INVENTIONS AND LICENSES TO EXPORT AND FILE APPLICATIONS IN FOREIGN COUNTRIES

116. The authority citation for Part 5 is proposed to be revised to read as follows:

Authority: 35 U.S.C. 6, 41, 181–188; 22 U.S.C. 2751 *et seq.;* 22 U.S.C. 3201 *et seq.;* 42 U.S.C. 2011 *et seq.*.

117. Section 5.1 is proposed to be revised to read as follows:

§ 5.1 [Defense inspection of certain applications]>Correspondence<.

[(a) The provisions of this part shall apply to both national and international applications filed in the Patent and Trademark Office and, with respect to inventions made in the United States, to applications filed in any foreign country or any international authority other than the United States Receiving Office. The

(1) filing of a national or an international application in a foreign country or with an international authority other than the United States Receiving Office, or

(2) transmittal of an international application to a foreign agency or an international authority other than the United States Receiving Office is considered to be a foreign filing within the meaning of Chapter 17 of Title 35, United States Code.

(b) In accordance with the provisions of 35 U.S.C. 181, patent applications containing subject matter the disclosure of which might be detrimental to the national security are made available for inspection by defense agencies as specified in said section. Only applications obviously relating to national security, and applications within fields indicated to the Patent and Trademark Office by the defense agencies as so related, are made available. The inspection will be made only by responsible representatives authorized by the agency to review applications. Such representatives are required to sign a dated acknowledgment of access accepting the condition that information obtained from the inspection will be used for no purpose other than the administration of 35 U.S.C. 181–188. Copies of applications may be made available to such representatives for inspection outside the Patent and Trademark Office under conditions assuring that the confidentiality of the applications will be maintained, including the conditions that: (1) All copies will be returned to the Patent and Trademark Office promptly if no secrecy order is imposed, or upon rescission of such order if one is imposed, and (2) no additional copies will be made by the defense agencies. A record of the removal and return of copies made available for defense inspection will be maintained by the Patent and Trademark Office. Applications relating to atomic energy are made available to the Department of Energy as specified in 1.14 of this chapter.]

> All correspondence in connection with this part, including petitions, must

be addressed to ''Assistant Commissioner for Patents (Attention Licensing and Review), Washington, DC 20231.''<

118. Section 5.2 proposed to be amended by revising paragraph (b) and removing paragraphs (c) and (d) to read as follows:

§ 5.2 Secrecy order.

* * * * *

(b) [The secrecy order is directed to the applicant, his successors, any and all assignees, and their legal representatives; hereinafter designated as principals.] >Any request for compensation as provided in 35 U.S.C. 183 must not be made to the Patent and Trademark Office, but directly to the department or agency which caused the secrecy order to be issued.<

[(c) A copy of the secrecy order will be forwarded to each principal of record in the application and will be accompanied by a receipt, identifying the particular principal, to be signed and returned.

(d) The secrecy order is directed to the subject matter of the application. Where any other application in which a secrecy order has not been issued discloses a significant part of the subject matter of the application under secrecy order, the other application and the common subject matter should be called to the attention of the Patent and Trademark Office. Such a notice may include any material such as would be urged in a petition to rescind secrecy orders on either of the applications.]

119. Section 5.3 is proposed to be amended by revising paragraph (c) to read as follows:

§ 5.3 Prosecution of application under secrecy orders; withholding patent.

* * * * *

(c) When the national application is found to be in condition for allowance except for the secrecy order the applicant and the agency which caused the secrecy order to be issued will be notified. This notice (which is not a notice of allowance under § 1.311 of this chapter) does not require >reply< [response] by the applicant and places the national application in a condition of suspension until the secrecy order is removed. When the secrecy order is removed the Patent and Trademark Office will issue a notice of allowance under § 1.311 of this chapter, or take such other action as may then be warranted.

* * * * *

120. Section 5.4 is proposed to be amended by revising paragraphs (a) and (d) to read as follows:

§ 5.4 Petition for rescission of secrecy order.

(a) A petition for rescission or removal of a secrecy order may be filed by, or on behalf of, any principal affected thereby. Such petition may be in letter form, and it must be in duplicate. [The petition must be accompanied by one copy of the application or an order for the same, unless a showing is made that such a copy has already been furnished to the department or agency which caused the secrecy order to be issued.]

* * * * *

(d) [Unless based upon facts of public record, the petition must be verified.] > Appeal to the Secretary of Commerce, as provided by 35 U.S.C. 181, from a secrecy order cannot be taken until after a petition for rescission of the secrecy order has been made and denied.<

121. Section 5.5 is proposed to be amended by revising paragraphs (b) and (e) to read as follows:

§ 5.5 Permit to disclose or modification of secrecy order.

* * * * *

(b) Petitions for a permit or modification must fully recite the reason or purpose for the proposed disclosure. Where any proposed disclosee is known to be cleared by a defense agency to receive classified information, adequate explanation of such clearance should be made in the petition including the name of the agency or department granting the clearance and the date and degree thereof. The petition must be filed in duplicate [and be accompanied by one copy of the application or an order for the same, unless a showing is made that such a copy has already been furnished to the department or agency which caused the secrecy order to be issued].

* * * * *

(e) [The permit or modification may contain conditions and limitations.] >Organizations requiring consent for disclosure of applications under secrecy order to persons or organizations in connection with repeated routine operation may petition for such consent in the form of a general permit. To be successful such petitions must ordinarily recite the security clearance status of the disclosees as sufficient for the highest classification of material that may be involved.<

§ 5.6 [Removed and reserved]

122. Section 5.6 is proposed to be removed and reserved.

§ 5.7 [Removed and reserved]

123. Section 5.7 is proposed to be removed and reserved.

§ 5.8 [Removed and reserved]

124. Section 5.8 is proposed to be removed and reserved.

125. Section 5.11 is proposed to be amended by revising paragraphs (b) and (c) to read as follows:

§ 5.11 License for filing in a foreign country an application on an invention made in the United States or for transmitting international application.

* * * * *

(b) The license from the Commissioner of Patents and Trademarks referred to in paragraph (a) of this section would also authorize the export of technical data abroad for purposes relating to the preparation, filing or possible filing and prosecution of a foreign patent application without separately complying with the regulations contained in 22 CFR Parts [121] >120< through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR [Part 379 (Regulations of the Bureau of Export Administration, Department of Commerce)] >Parts 768–799 (Export Administration Regulations of the Department of Commerce)< and 10 CFR Part 810 [(Foreign Atomic Energy Programs of the Department of Energy)] >(Assistance to Foreign Atomic Energy Activities—Regulations of the Department of Energy)<.

(c) Where technical data in the form of a patent application, or in any form, is being exported for purposes related to the preparation, filing or possible filing and prosecution of a foreign patent application, without the license from the Commissioner of Patents and Trademarks referred to in paragraphs (a) or (b) of this section, or on an invention not made in the United States, the export regulations contained in 22 CFR Parts [121] >120< through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR [Part 379 (Regulations of the Bureau of Export Administration, Department of Commerce)] >Parts 768–799 (Export Administration Regulations of the Department of Commerce)< and 10 CFR Part 810 [(Foreign Atomic Energy Programs of the Department of Energy)] >(Assistance to Foreign Atomic Energy Activities—Regulations of the Department of Energy)< must be complied with unless a license is not required because a United States application was on file at the time of export for at least six months without a secrecy order under § 5.2 being placed thereon. The term ''exported'' means export as it is defined in 22 CFR [Parts 121 through 130] >Part 120<, 15 CFR

Part [379] >779< and >activities covered by< 10 CFR Part 810.

* * * * *

126. Section 5.13 is proposed to be revised to read as follows:

§ 5.13 Petition for license; no corresponding application.

If no corresponding national or international application has been filed in the United States, the petition for license under § 5.12(b) must be accompanied by the required fee (§ 1.17(h)), if expedited handling of the petition is also sought, and a legible copy of the material upon which a license is desired. This copy will be retained as a measure of the license granted. [For assistance in the identification of the subject matter of each license so issued, it is suggested that the petition be submitted in duplicate and provide a title and other description of the material. The duplicate copy of the petition will be returned with the license or other action on the petition.]

127. Section 5.14 is proposed to be amended by revising paragraph (a) to read as follows:

§ 5.14 Petition for license; corresponding U.S. application.

(a) When there is a corresponding United States application on file, a petition for license under § 5.12(b) must include the required fee (§ 1.17(h)), if expedited handling of the petition is also sought, and must identify this application by [serial] >application< number, filing date, inventor, and title, but a copy of the material upon which the license is desired is not required. The subject matter licensed will be measured by the disclosure of the United States application. [Where the title is not descriptive, and the subject matter is clearly of no interest from a security standpoint, time may be saved by a short statement in the petition as to the nature of the invention.]

* * * * *

128. Section 5.15 is proposed to be amended by revising paragraph (a) to read as follows.

§ 5.15 Scope of license.

(a) Applications or other materials reviewed pursuant to §§ 5.12 through 5.14, which were not required to be made available for inspection by defense agencies under 35 U.S.C. 181 and § 5.1, will be eligible for a license of the scope provided in this paragraph. This license permits subsequent modifications, amendments, and supplements containing additional subject matter to, or divisions of, a foreign patent application, if such changes to the application do not alter the general nature of the invention in a manner which would require the United States application to have been made available for inspection under 35 U.S.C. 181 and § 5.1. [This license also covers the inventions disclosed in foreign applications which have been granted a license under this part prior to April 4, 1984, and which were not subject to security inspection under 35 U.S.C. 181 and § 5.1.] Grant of this license authorizing the export and filing of an application in a foreign country or the transmitting of an international application to any foreign patent agency when the subject matter of the foreign or international application corresponds to that of the domestic application. This license includes authority:

(1) To export and file all duplicate and formal application papers in foreign countries or with international agencies;

(2) To make amendments, modifications, and supplements, including divisions, changes or supporting matter consisting of the illustration, exemplification, comparison, or explanation of subject matter disclosed in the application; and

(3) To take any action in the prosecution of the foreign or international application provided that the adding of subject matter of taking of any action under paragraphs (a)(1) or (2) of this section does not change the general nature of the invention disclosed in the application in a manner which would require such application to have been made available for inspection under 35 U.S.C. 181 and § 5.1 by including technical data pertaining to:

(i) Defense services or articles designated in the United States Munitions List applicable at the time of foreign filing, the unlicensed exportation of which is prohibited pursuant to the Arms Export Control Act, as amended and 22 CFR Parts [121] >120< through 130; or

(ii) Restricted Data, sensitive nuclear technology or technology useful for the production or utilization of special nuclear material or atomic energy, dissemination of which is subject to restrictions of the Atomic Energy Act of 1954, as amended, and the Nuclear Non-Proliferation Act of 1978, as implemented by the regulations [for Unclassified Activities in Assistance to Foreign Atomic Energy Activities] >of the Department of Energy for assistance to foreign energy activities<, 10 CFR Part 810, in effect at the time of foreign filing.

* * * * *

§ 5.16 [Removed and reserved]

129. Section 5.16 is proposed to be removed and reserved.

§ 5.17 [Removed and reserved]

130. Section 5.17 is proposed to be revised and removed.

131. Section 5.18 is proposed to be revised to read as follows:

§ 5.18 Arms, ammunition, and implements of war.

(a) The exportation of technical data relating to arms, ammunition, and implements of war generally is subject to the International Traffic in Arms Regulations of the Department of State (22 CFR Parts [121] >120< through [128] >130<); the articles designated as arms, ammunition, and implements of war are enumerated in the U.S. Munitions List, 22 CFR [121.01] >Part 121<. However, if a patent applicant complies with regulations issued by the Commissioner of Patents and Trademarks under 35 U.S.C. 184, no separate approval from the Department of State is required unless the applicant seeks to export technical data exceeding that used to support a patent application in a foreign country. This exemption from Department of State regulations is applicable regardless of whether a license from the Commissioner is required by the provisions of §§ 5.11 and [5.15 (22 CFR 125.04(b), 125.20(b))] >5.12 (22 CFR Part 125)<.

(b) When a patent application containing subject matter on the Munitions List (22 CFR [121.01] >Part 121<) is subject to a secrecy order under § 5.2 and a petition is made under § 5.5 for a modification of the secrecy order to permit filing abroad, a separate request to the Department of State for authority to export classified information is not required (22 CFR [125.05(d)] >Part 125<).

132. Section 5.19 is proposed to be revised to read as follows:

§ 5.19 Export of technical data.

(a) Under regulations (15 CFR 770.10(j)) established by the [U.S.] Department of Commerce, [Bureau of Export Administration, Office of Export Licensing,] a [validated export] license is not required in any case to file a patent application or part thereof in a foreign country if the foreign filing is in accordance with the regulations (37 CFR 5.11 through 5.33) of the Patent and Trademark Office.

(b) [A validated] >An< export license is not required for data contained in a patent application prepared wholly from foreign-origin technical data where such application is being sent to the foreign inventor to be executed and

returned to the United States for subsequent filing in the U.S. Patent and Trademark Office (15 CFR 779A.3(e)).

(c) [Removed].

133. Section 5.20, paragraph (b), is proposed to be removed.

§ 5.20 Export of technical data relating to sensitive nuclear technology.

* * * * *

(b) [Removed].

134. Section 5.25, paragraph (c), is proposed to be removed.

§ 5.25 Petition for retroactive license.

* * * * *

(c) [Removed].

§ 5.31 [Removed and reserved]

135. Section 5.31 is proposed to be removed and reserved.

§ 5.32 [Removed and reserved]

136. Section 5.32 is proposed to be removed and reserved.

§ 5.33 [Removed and reserved]

137. Section 5.33 is proposed to be removed and reserved.

PART 7—[REMOVED AND RESERVED]

138. Part 7 is proposed to be removed and reserved.

Dated: September 10, 1996.

Bruce A. Lehman,

Assistant Secretary of Commerce and Commissioner of Patents and Trademarks.

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