

DEPARTMENT OF COMMERCE**Patent and Trademark Office****37 CFR Parts 1, 3, 5, and 10**

[Docket No.: 980826226-9185-02]

RIN 0651-AA98

Changes To Implement the Patent Business Goals**AGENCY:** Patent and Trademark Office, Commerce.**ACTION:** Notice of proposed rulemaking.

SUMMARY: The Patent and Trademark Office (Office) has established business goals for the organizations reporting to the Assistant Commissioner for Patents (Patent Business Goals). The focus of the Patent Business Goals is to increase the level of service to the public by raising the efficiency and effectiveness of the Office's business processes. In furtherance of the Patent Business Goals, the Office is proposing changes to the rules of practice to eliminate unnecessary formal requirements, streamline the patent application process, and simplify and clarify their provisions.

DATES: *Comment Deadline Date:* To be ensured of consideration, written comments must be received on or before December 3, 1999. While comments may be submitted after this date, the Office cannot ensure that consideration will be given to such comments. No public hearing will be held.

ADDRESSES: Comments should be sent by electronic 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, D.C. 20231, or by facsimile to (703) 308-6916, marked to the attention of Hiram H. Bernstein. Although comments may be submitted by mail or facsimile, the Office prefers to receive comments via the Internet. Where comments are submitted by mail, the Office would prefer that the comments be submitted on a DOS formatted 3¼ inch disk accompanied by a paper copy.

The comments will be available for public inspection at the Special Program Law Office, Office of the Deputy Assistant Commissioner for Patent Policy and Projects, located at Room 3-C23 of Crystal Plaza 4, 2201 South Clark Place, Arlington, Virginia, and will be available through anonymous file transfer protocol (ftp) via the Internet (address: [ftp.uspto.gov](ftp://ftp.uspto.gov)). Since comments will be made available for public inspection, information that is

not desired to be made public, such as an address or phone number, should not be included in the comments.

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

SUPPLEMENTARY INFORMATION: The organizations reporting to the Assistant Commissioner for Patents have established five business goals (Patent Business Goals) to meet the Office's Year 2000 commitments. The Patent Business Goals have been adopted as part of the Fiscal Year 1999 Corporate Plan Submission of the President. The five Patent Business Goals are:

- Goal 1: Reduce Office processing time (cycle time) to twelve months or less for all inventions.
- Goal 2: Establish fully-supported and integrated Industry Sectors.
- Goal 3: Receive applications and publish patents electronically.
- Goal 4: Exceed our customers' quality expectations, through the competencies and empowerment of our employees.
- Goal 5: Align fees commensurate with resource utilization and customer efficiency.

This rulemaking proposes changes to the regulations to support the Patent Business Goals. A properly reengineered or reinvented system eliminates the redundant or unnecessary steps that slow down processing and frustrate customers. In furtherance of the Patent Business Goals, these proposed changes to the rules of practice take a fresh view of the business end of issuing patents, and continue a process of simplification. Formal requirements of rules that are no longer useful would be eliminated. When the intent of an applicant is understood, the Office would simply go forward with the processing. The essentials are maintained, while formalities are greatly reduced. The object is to focus on the substance of examination and decrease the time that an application for patent is sidelined with unnecessary procedural issues.

Additionally, the Office desires to continue to make its rules more understandable, such as by using plain language instead of legalese. The Office is seeking efficiency by improving the clarity of the wording of the regulations so that applicants and Office employees understand unequivocally what is required at each stage of the prosecution and can get it right on the first try. The

Office welcomes comments and suggestions on this effort.

In streamlining this process, the Office will be able to issue a patent in a shorter time by eliminating formal requirements that must be performed by the applicant, his or her representatives and the Office itself. Applicants will benefit from a reduced overall cost to them for receiving patent protection and from a faster receipt of their patents.

Finally, these proposed changes are intended to improve the Office's business processes in the context of the current legal and technological environment. Should these environments change (e.g., by adoption of an international Patent Law Treaty, enactment of patent legislation, or implementation of new automation capabilities), the Office would have to reconsider its business processes and make such further changes to the rules of practice as are necessary.

Advance Notice of Proposed Rulemaking

The Office published an advance notice of proposed rulemaking (Advance Notice) presenting a number of changes to patent practice and procedure under consideration to implement the Patent Business Goals. See *Changes to Implement the Patent Business Goals; Advance Notice of Proposed Rulemaking*, 63 FR 53497 (October 5, 1998), 1215 Off. Gaz. Pat. Office 87 (October 27, 1998). The Advance Notice set forth twenty-one topics on which the Office specifically requested public input:

- Topic (1) Simplifying requests for small entity status;
- Topic (2) Requiring separate surcharges and supplying filing receipts;
- Topic (3) Permitting delayed submission of an oath or declaration, and changing time period for submission of the basic filing fee and English translation;
- Topic (4) Limiting the number of claims in an application;
- Topic (5) Harmonizing standards for patent drawings;
- Topic (6) Printing patents in color;
- Topic (7) Reducing time for filing corrected or formal drawings;
- Topic (8) Permitting electronic submission of voluminous material;
- Topic (9) Imposing limits/requirements on information disclosure statement submissions;
- Topic (10) Refusing information disclosure statement consideration under certain circumstances;
- Topic (11) Providing no cause suspension of action;
- Topic (12) Requiring a handling fee for preliminary amendments and supplemental replies;

Topic (13) Changing amendment practice to replacement by paragraphs/claims;

Topic (14) Providing for presumptive elections;

Topic (15) Creating a rocket docket for design applications;

Topic (16) Requiring identification of broadening in a reissue application;

Topic (17) Changing multiple reissue application treatment;

Topic (18) Creating alternative review procedures for applications under appeal;

Topic (19) Eliminating preauthorization of payment of the issue fee;

Topic (20) Reevaluating the Disclosure Document Program; and

Topic (21) Creating a Patent and Trademark Office review service for applicant-created forms.

See Changes to Implement the Patent Business Goals, 63 FR at 53499, 1215 Off. Gaz. Pat. Office at 89.

Changes Set Forth in the Advance Notice Included in This Notice of Proposed Rulemaking (Notice)

This notice proposes changes to the rules of practice based upon the following topics in the Advance Notice:

(1) Simplifying request for small entity status (Topic 1—§§ 1.9, 1.27, and 1.28);

(2) Harmonizing standards for patent drawings (Topic 5—§ 1.84);

(3) Printing patents in color (Topic 6—§ 1.84);

(4) Reducing time for filing corrected or formal drawings (Topic 7—§§ 1.85 and 1.136);

(5) Permitting electronic submission of voluminous material (Topic 8—§§ 1.96, 1.821, 1.823, and 1.825);

(6) Imposing limits/requirements on information disclosure statement submissions (Topic 9—§§ 1.97 and 1.98);

(7) Requiring a handling fee for preliminary amendments and supplemental replies (Topic 12—§§ 1.111 and 1.115);

(8) Changing amendment practice to replacement by paragraphs/claims (Topic 13—§§ 1.52 and 1.121);

(9) Creating a rocket docket for design applications (Topic 15—§ 1.155);

(10) Changing multiple reissue application treatment (Topic 17—§ 1.177); and

(11) Eliminating preauthorization of payment of the issue fee (Topic 19—§§ 1.25 and 1.311).

The Office has taken into account the comments submitted in reply to the Advance Notice in arriving at the specific changes to the rules of practice being proposed in this notice. These

comments are addressed with the relevant proposed rule change in the section-by-section discussion portion of this notice.

This notice also includes a number of proposed changes to the rules of practice that are not based upon proposals set forth in the Advance Notice. This notice proposes changes to the following sections of title 37 of the Code of Federal Regulations: 1.4, 1.6, 1.9, 1.12, 1.14, 1.17, 1.19, 1.22, 1.25, 1.26, 1.27, 1.28, 1.33, 1.41, 1.47, 1.48, 1.51, 1.52, 1.53, 1.55, 1.56, 1.59, 1.63, 1.64, 1.67, 1.72, 1.77, 1.78, 1.84, 1.85, 1.91, 1.96, 1.97, 1.98, 1.102, 1.103, 1.111, 1.112, 1.121, 1.125, 1.131, 1.132, 1.133, 1.136, 1.137, 1.138, 1.152, 1.154, 1.155, 1.163, 1.173, 1.176, 1.177, 1.178, 1.193, 1.303, 1.311, 1.312, 1.313, 1.314, 1.322, 1.323, 1.324, 1.366, 1.446, 1.497, 1.510, 1.530, 1.550, 1.666, 1.720, 1.730, 1.740, 1.741, 1.780, 1.809, 1.821, 1.823, 1.825, 3.27, 3.71, 3.73, 3.81, 5.1, 5.2, 5.12, and 10.23. Additionally, this notice proposes to amend title 37 of the Code of Federal Regulations by removing §§ 1.44 and 1.174, and adding §§ 1.76, 1.105, and 1.115.

Changes Set Forth in the Advance Notice That Are NOT Included in This Notice

This notice does not include proposed changes to the rules of practice based upon the following topics in the Advance Notice:

(1) Requiring separate surcharges and supplying filing receipts (Topic 2);

(2) Permitting delayed submission of an oath or declaration, and changing the time period for submission of the basic filing fee and English translation (Topic 3);

(3) Limiting the number of claims in an application (Topic 4);

(4) Refusing information disclosure statement consideration under certain circumstances (Topic 10);

(5) Providing no cause suspension of action (Topic 11);

(6) Providing for presumptive elections (Topic 14);

(7) Requiring identification of broadening in a reissue application (Topic 16);

(8) Creating alternative review procedures for applications under appeal (Topic 18);

(9) Reevaluating the Disclosure Document Program (Topic 20); and (10) Creating a Patent and Trademark Office review service for applicant-created forms (Topic 21).

Comments received in response to the Advance Notice on these topics are addressed below.

Requiring Separate Surcharges and Supplying Filing Receipts (Topic 2)

The Office indicated that it was considering charging separate surcharges in a nonprovisional application under 35 U.S.C. 111(a) for (a) the delayed submission of an oath or declaration, and (b) the delayed submission of the basic filing fee. That is, a single surcharge (currently \$130) would be required if one of (a) the oath or declaration or (b) the basic filing fee were not present on filing. Two surcharges (totaling \$260) would be required if both the oath or declaration and the basic filing fee were not present on filing. Therefore, the absence (on filing) of the oath or declaration or the basic filing fee would have necessitated a separate surcharge. The Office also indicated that it was considering issuing another filing receipt, without charge, to correct any errors or to update filing information, as needed.

While a few comments supported the proposal (indicating that the additional services were worth the additional fees), a majority of comments opposed charging separate surcharges. These included arguments that: (1) the proposal is simply a fee increase with no advantage to applicants; and (2) a separate surcharge should be required only if the oath or declaration and the basic filing fee are submitted separately because there is no additional cost to the Office to process both the oath or declaration and the basic filing fee in the same submission.

Response: This notice does not propose changing § 1.53 to charge separate surcharges in a nonprovisional application under 35 U.S.C. 111(a) for the delayed submission of an oath or declaration, and for the delayed submission of the basic filing fee.

Permitting Delayed Submission of an Oath or Declaration, and Changing the Time Period for Submission of the Basic Filing Fee and English Translation (Topic 3)

The Office indicated that it was considering: (1) Amending § 1.53 to provide that an executed oath or declaration for a nonprovisional application would not be required until the expiration of a period that would be set in a "Notice of Allowability" (PTOL-37); and (2) amending §§ 1.52 and 1.53 to provide that the basic filing fee and an English translation (if necessary) for a nonprovisional application must be submitted within one month (plus any extensions under § 1.136) from the filing date of the application. The Office was specifically considering amending § 1.53 to provide

that an executed oath or declaration for a nonprovisional application would not be required until the applicant is notified that it must be submitted within a one-month period that would be set in a "Notice of Allowability," provided that the following are submitted within one month (plus any extensions under § 1.136) from the filing date of the application: (1) The name(s), residence(s), and citizenship(s) of the person(s) believed to be the inventor(s); (2) all foreign priority claims; and (3) a statement submitted by a registered practitioner that: (a) an inventorship inquiry has been made, (b) the practitioner has sent a copy of the application (as filed) to each of the person(s) believed to be the inventor(s), (c) the practitioner believes that the inventorship of the application is as indicated by the practitioner, and (d) the practitioner has given the person(s) believed to be the inventor(s) notice of their obligations under § 1.63(b). The Office was also specifically considering amending §§ 1.52 and 1.53 to provide, by rule, that the basic filing fee and an English translation (if the application was filed in a language other than English) for a nonprovisional application must be submitted within one month (plus any extensions under § 1.136) from the filing date of the application. Applicants would not be given a notice (e.g., a "Notice To File Missing Parts of Application" (PTO-1533)) that the basic filing fee is missing or insufficient, unless the application is filed with an insufficient basic filing fee that at least equals the basic filing fee that was in effect the previous fiscal year. The filing receipt, however, would indicate the amount of filing fee received. Further, the filing receipt would remind applicants that the basic filing fee must be submitted within one month (plus any extensions under § 1.136) from the filing date of the application.

While some comments supported this proposed change, a majority of comments opposed permitting delayed submission of an oath or declaration; and changing the time period for submission of the basic filing fee and English translation.

The reasons given for opposition to the proposed change to permit delayed submission of an oath or declaration included arguments that: (1) The proposed inventorship inquiry and notification requirements for practitioners who submitted an application without an executed oath or declaration would be too onerous; (2) an application should not be examined until inventorship is settled and the inventors have acknowledged their duty

of disclosure; (3) the delayed submission of an oath or declaration would cause confusion as to ownership of the application, which would cause confusion as to who is authorized to appoint a representative in the application; (4) the delayed submission of an oath or declaration would increase the difficulty in acquiring the inventor's signatures on an oath or declaration, which would lead to an increase in the number of petitions under § 1.47, as well as an increase in the number of oaths or declarations signed by the legal representatives of deceased inventors; and (5) the delayed submission of an oath or declaration would increase the number of certified copies of an application not having a copy of the executed oath or declaration (considered undesirable). Some comments suggested that the Office seek legislation to eliminate the oath requirement of 35 U.S.C. 115.

The reasons given for opposition to the proposed change to the time period for submission of the basic filing fee and English translation included arguments that: (1) A one-month period for submitting the basic filing fee or English translation is too short because applicants may not know the assigned application number within one month of the application filing date (i.e., this period should be two or three months); (2) the period for submitting the basic filing fee or English translation should be tied to the mail date of the Filing Receipt; and (3) the public relies upon the current Notice to File Missing Parts of Application practice to inform applicants as to whether the filing fee and the oath or declaration has been received by the Office (i.e., verify whether the Office has received the basic filing fee and oath or declaration), and to inform applicants of the period for reply for supplying the missing basic filing fee and/or oath or declaration.

Response: This notice does not propose changing §§ 1.52 and 1.53 to provide that: (1) An executed oath or declaration for a nonprovisional application would not be required until the expiration of a period that would be set in a "Notice of Allowability" (PTOL-37); or (2) the basic filing fee and an English translation (if necessary) for a nonprovisional application must be submitted within one month (plus any extensions under § 1.136) from the filing date of the application.

Limiting the Number of Claims in an Application (Topic 4)

The Office indicated in the Advance Notice that it was considering a change to § 1.75 to limit the number of total and independent claims that will be

examined (at one time) in an application. The Office was specifically considering a change to the rules of practice to: (1) Limit the number of total claims that will be examined (at one time) in an application to forty; and (2) limit the number of independent claims that will be examined (at one time) in an application to six. In the event that an applicant presented more than forty total claims or six independent claims for examination at one time, the Office would withdraw the excess claims from consideration, and require the applicant to cancel the excess claims.

While the comments included sporadic support for this proposed change, the vast majority of comments included strong opposition to placing limits on the number of claims in an application. The reasons given for opposition to the proposed change included arguments that: (1) Decisions by the Court of Appeals for the Federal Circuit (Federal Circuit) leave such uncertainty as to how claims will be interpreted that additional claims are necessary to adequately protect the invention; (2) the applicant (and not the Office) should be permitted to decide how many claims are necessary to adequately protect the invention; (3) there are situations in which an applicant justifiably needs more than six independent and forty total claims to adequately protect an invention; (4) the proposed change exceeds the Commissioner's rule making authority; (5) the change will simply result in more continuing applications and is just a fee raising scheme; (6) the Office currently abuses restriction practice and this change will further that abuse; and (7) since only five percent of all applicants exceed the proposed claim ceiling, there is no problem. Several comments which opposed the proposed change offered the following alternatives: (1) Charge higher fees (or a surcharge) for applications containing an excessive number of claims; (2) charge fees for an application based upon what it costs (e.g., number of claims, pages of specification, technology, IDS citations) to examine the application; and (3) credit examiners based upon the number of claims in the application. Several comments which indicated that the proposed change would be acceptable, placed the following conditions on that indication: (1) That a multiple dependent claim be treated as a single claim for counting against the cap; (2) that a multiple dependent claim be permitted to depend upon a multiple dependent claim; (3) that a Markush claim be treated as a single claim for counting

against the cap; (4) that any additional applications are taken up by the same examiner in the same time frame; (5) that allowed dependent claims rewritten in independent form do not count against the independent claim limit; (6) that the Office permit rejoinder of dependent claims upon allowance; and (7) that higher claim limits are used.

Response: This notice does not propose changing § 1.75 to place a limit on the number of claims that will be examined in a single application.

Refusing Information Disclosure Statement Consideration Under Certain Circumstances (Topic 10)

The Office indicated in the Advance Notice that it was considering revising § 1.98 to reserve the Office's authority to not consider submissions of an Information Disclosure Statement (IDS) in unduly burdensome circumstances, even where all the stated requirements of § 1.98 are met. The Office was specifically considering an amendment to § 1.98 to permit the Office to refuse consideration of an unduly burdensome IDS submission (e.g., extremely large documents and compendiums), and give the applicant an opportunity to modify the submission to eliminate the burdensome aspect of the IDS.

While the proposal received support from a significant minority of the comments, the large majority of comments included strong opposition to the proposal to revise § 1.98. The reasons given for opposition to the proposed change included arguments that: (1) The term "unduly burdensome" is not defined objectively; thus, decisions as to whether a submission is too burdensome for consideration will be subjective; (2) without a clear definition of "unduly burdensome" (to provide a standard), the proposal would not pass the Administrative Procedure Act tests of scrutiny; (3) the Office will have to expend time and effort in deciding the petitions and defending, in court, its subjective decisions not to consider "unduly burdensome" IDSs (thus, the proposal will cost the Office time in the long run); (4) the proposal gives the examiner unlimited ability to not consider art submitted due to the ambiguous standard for refusal of an IDS submission coupled with the examiner's discretion to advance the status of the application to a point where the IDS would not be timely even though it is corrected; (5) the Office's refusal to examine unduly burdensome IDS submissions despite compliance with the rules (other than the burdensome aspect) would impose a huge financial and time burden upon applicants to fix what the examiner

deems as unduly burdensome; (6) imposing this new financial and time burden would be contrary to the stated purpose of the Office to expedite prosecution and to relieve the burdens on the examination process; (7) burdensome IDS situations exist, and the Office should learn to deal with them as a service to its customers and in order to meet its mission of issuing valid patents (the Office cannot realistically ignore situations where the IDS documents cited are complex or lengthy, and nothing can be done about the complexity or length by applicant); (8) the burdensome IDS problem is not frequent and the rare unduly burdensome IDS submissions should be addressed on a case-by-case basis (thus, no rule change is needed); (9) no data has been presented to show the problem is wide-spread, and more facts are needed to show the extent and nature of the unduly burdensome IDS problem; (10) citations should not be discarded from the record where the unduly burdensome IDS has not been corrected since an original and only copy of the citation (which is submitted so the examiner can more fully appreciate the citation) may be very expensive or even impossible to replace; (11) reducing the size of a citation can make it less valuable, the submitted "relevant portions" (the partial citation) may be taken out-of-context of the entire citation, and the excerpt containing the relevant portion would not provide additional assistance to the examiner as to background, terminology, and alternative subject matter which may bear on the examination.

Response: This notice does not propose changing § 1.98 to reserve the Office's authority to not consider submissions of an IDS in unduly burdensome circumstances, even where all the stated requirements of § 1.98 are met.

Providing No Cause Suspension of Action (Topic 11)

The Office indicated that it was considering adding an additional suspension of action practice, under which an applicant may request deferred examination of an application without a showing of "good and sufficient cause," and for an extended period of time, provided that the applicant waived the confidential status of the application under 35 U.S.C. 122, and agreed to publication of the application. The Office was specifically considering a procedure under which the applicant may (prior to the first Office action) request deferred examination for a period not to exceed three years, provided that: (1) The

application is entitled to a filing date; (2) the filing fee has been paid; (3) any needed English-language translation of the application has been filed; and (4) all "outstanding requirements" have been satisfied (except that the oath or declaration need not be submitted if the names of all of the persons believed to be the inventors are identified).

The comments included support and opposition in roughly equal measure to the proposed extended suspension of action procedure. The reasons given for opposition to the proposal included arguments that: (1) The "deferred examination" of application under an extended suspension of action and the publication of an application under such suspension of action would create uncertainty over legal rights; and (2) the publication provisions of such a suspension of action procedure amount to an eighteen-month publication system that is not authorized by 35 U.S.C. 122.

Response: This notice does not propose changing § 1.103 to provide for extended suspension of action.

Providing for Presumptive Elections (Topic 14)

The Office indicated in the Advance Notice that it was considering a change to the restriction practice to eliminate the need for a written restriction requirement and express election in most restriction situations. The Office was specifically considering a change to the restriction practice to provide: (1) That if more than one independent and distinct invention is claimed in an application, the applicant is considered to have constructively elected the invention first presented in the claims; (2) for rejoinder of certain process claims in an application containing allowed product claims; and (3) for rejoinder of certain combination claims in an application containing allowed subcombination claims.

While some comments supported this proposed change, a large majority of comments opposed providing for presumptive elections. The reasons given for opposition to the proposed change included arguments that: (1) The commercially important invention may change (or is not known until) after the application is prepared and filed; (2) the change will increase cost of preparing an application since the order of claims must be carefully considered; (3) examiners aggressively apply restriction, and presumptive elections will increase the number of restrictions; and (4) the loss of the ability to contest improper restrictions prior to examination on the merits will lead to less likelihood of success in persuading

examiner to withdraw an improper restriction. Several comments which opposed the proposed change offered as an alternative that the Office adopt the PCT unity of invention standard in considering restriction. Several comments which indicated that the proposed change would be acceptable placed the following conditions on that indication: (1) That any presumptive election practice not apply to an election of species; and (2) that an election by presumption apply only if an attempted telephone restriction requirement is not successful.

Response: This notice does not propose changing § 1.141 *et seq.* to provide for a presumptive election. The Office is considering the impact of applying the "unity of invention" standard of the PCT, rather than the "independent and distinct" standard of 35 U.S.C. 121, in restriction practice. Nevertheless, this change to restriction practice, without a corresponding change to other patent fees, would have a negative impact on the Office's ability to obtain the necessary operating funding.

Requiring Identification of Broadening in a Reissue Application (Topic 16)

The Office indicated in the Advance Notice that it was considering a change to § 1.173 to require reissue applicants to identify all occurrences of broadening of the patent claims in a reissue application. As proposed, reissue applicants would have to point out all occurrences of broadening in the claims as an aid to examiners who should consider issues involving broadening relative to the two-year limit and the recapture doctrine.

While a few comments supported this proposed change, a large majority of comments strongly opposed the concept. A number of those commenting were wary of the consequences in court resulting from their failure to identify all issues of broadening in a reissue application. Several of the commenters expressed concerns that patent owners could have their patent claims put at risk in litigation if they unintentionally failed to identify all occurrences of broadening, which they feared could be a basis for charging patentees with inequitable conduct. Some were concerned about saddling applicants with yet another burden which more properly should be left with the Office and the examiner. Others felt that any unintentional omission of a broadening identification could raise problems for the practitioner, which problems are not offset by any increase in benefits derived by presenting this information to the Office.

Response: This notice does not propose changing § 1.173 to require an identification of all occurrences of broadening in reissue claims. In view of the comments received, the Office will continue to rely on the examiner to identify any occurrences of broadening during the examination of the reissue application, and not impose any additional burden on the reissue applicants. The Office does not wish to undo the benefits of the recently liberalized reissue oath/declaration requirements by proposing additional rule changes which may add burdens as well as possible unforeseen risks.

Creating Alternative Review Procedures for Applications Under Appeal (Topic 18)

The Office indicated in the Advance Notice that it was considering alternative review procedures to reduce the number of appeals forwarded to the Board of Patent Appeals and Interferences. The Office was specifically considering two alternative review procedures to reduce the number of appeals having to be forwarded to the Board of Patent Appeals and Interferences for decision. Both review procedures would have involved a review that would be available upon request and payment of a fee by the appellant, and would have involved review by at least one other Office official. The first review would have occurred after the filing of a notice of appeal but before the filing of an appeal brief and have involved a review of all rejections of a single claim being appealed to see whether any rejection plainly fails to establish a *prima facie* case of unpatentability. The second review would have occurred after the filing of an appeal brief and have involved a review of all rejections on appeal.

The comments were split between supporting and opposing the appeal review procedures under consideration. Most comments opposing the appeal review procedures under consideration supported the concept of screening the tenability of rejections in applications before they are forwarded to the Board of Patent Appeals and Interferences, but argued that: (1) The proposed appeal review amounts to quality control for which the applicant should not be required to pay (appeal fees should be raised if appropriate); (2) an appeal review is meaningless (only advisory) unless the decision is binding on the examiner; (3) the Board of Patent Appeals and Interferences may give undue deference to a rejection that has been through an appeal review; and (4) the proposed appeal review will delay

ultimate review by the Board of Patent Appeals and Interferences. Several comments indicated that the proposed change would be acceptable, but included the following conditions with that indication: (1) That the applicant need not pay for either review; (2) that the reviewer be someone outside the normal chain of review for an application being forwarded to the Board of Patent Appeals and Interferences for decision; (3) that the reviewer be someone who has at least full signatory authority; (4) that the report gives a detailed explanation of the results of the appeal review (especially if a position is changed/application allowed); (5) that fees (appeal or appeal review) be refunded if the review results in the allowance of the application; (6) that the pre-brief review involve review of the application by more than one person; (7) that the pre-brief review also determine whether any *prima facie* case of unpatentability has been overcome; and (8) that the appeal process should be revised to model the German Patent Office.

Response: This notice does not propose changing § 1.191 *et seq.* to provide for appeal reviews. The Office intends to increase the use of the current appeal conference procedures as set forth in section 1208 of the Manual of Patent Examining Procedure (7th ed. 1998)(MPEP).

Reevaluating the Disclosure Document Program (Topic 20):

The Office indicated in the Advance Notice that it was reevaluating the Disclosure Document Program (DDP) because this program has been the subject of numerous abuses by so-called "invention development companies" resulting in complaints from individual inventors, and therefore may be *detrimental* to the interests of its customers. At the same time, the distinctly different provisional applications provide a viable alternate route whereby, for the basic small entity filing fee of \$75 (§ 1.16(k)), a provisional application may be filed by a small entity. A provisional application does not require a claim in compliance with 35 U.S.C. 112, ¶ 2, or an inventor's oath under 35 U.S.C. 115. Although abandoned after one year, provisional applications are retained by the Office for at least twenty years, or longer if it is referenced in a patent. A provisional application is considered a constructive reduction to practice of an invention as of the filing date accorded the provisional application if it describes the invention in sufficient detail to enable a person of ordinary skill in the art to make and use the invention and

discloses the best mode known by the inventor for carrying out the invention. Unlike the DDP, a provisional application may be used under the Paris Convention to establish a priority date for foreign filing. In other words, except for adding the best mode requirement, the disclosure requirements for a provisional application are identical to the disclosure requirements for a Disclosure Document and a provisional application provides users with a filing date without starting the patent term period. Thus, almost any paper filed today as a proper Disclosure Document can now be filed as a provisional application with the necessary cover sheet.

For these reasons, the Office posed in the Advance Notice several questions directed to whether the DDP served a useful function. Only one comment presented evidence of a single instance where a disclosure document was used in conjunction with an interference, but this person was an extensive user of the DDP and cautioned that independent inventors fail to keep records of the date of their invention. The same commenter suggested that if the attorney signing the provisional application could also claim small entity status for his client, this would diminish the need for the DDP. This appears likely to be adopted since, contemporaneously with this proposal, under Topic 1 (relating to the simplification of the request for small entity status), it is being proposed that applicant or applicant's attorney may assert entitlement to small entity status. This proposal will make it easier for both attorneys or applicants to assert small entity status when filing provisional applications. See discussion of proposed changes to §§ 1.9, 1.27 and 1.28 relating to small entity status for further details.

Six commenters felt that the program should be eliminated because there is no value to applicants in light of the provisional application procedure. Some felt that the program creates a dangerous situation in that applicants may assume they are getting some type of patent protection or that the statutory bar provision in 35 U.S.C. 102(b) has been avoided. One commenter characterized the DDP as an "unwitting vehicle and accomplice for fraud and delusion of small inventors by so-called 'invention development companies', or self-delusions of independent inventors, who have been mailing thousands of these 'Disclosure Documents' to the PTO * * *." Another commenter, however, postulated that if the only difference between the DDP and provisional applications was the cost, then the cancellation of the DDP would

only result in the abuse of the provisional patent applications at a higher cost to unsuspecting inventors.

Four commenters confused the DDP with defensive publications as their responses wrongfully indicated a belief that the DDP involved publication of the disclosures. One commenter suggested that before the program is eliminated that the Office should engage in an educational program (with a survey) to explain the questionable value of the program and alternative procedures available to the public. The commenter further stated that the education program should focus on those individuals who use the DDP and could include a survey of those individuals to determine the benefit to the public. A second commenter supported the concept of contacting the independent inventors. At least one other comment suggested that elimination might be detrimental to individual inventors.

Response: A review of the comments on this proposal reveals that the independent inventor community submitted only a few of the responses. The Office considers it inappropriate to proceed with this proposal in the absence of greater input from the independent inventor community. Therefore, this notice does not propose changes to the rules of practice concerning the Disclosure Document Program. The Office will continue to study the Disclosure Document Program and seek greater input from the independent inventor community before any further action is taken. In this regard, the matter will be referred to the Office of Independent Inventor Programs, headed by Director Donald Grant Kelly. The Office of Independent Inventor Programs was established on March 15, 1999. Reporting directly to the Commissioner, this new office was established to provide assistance to independent inventors, particularly in terms of improved communications, educational outreach, and Office-based support. In addition, the Office of Independent Inventor Programs will work to establish or strengthen cooperative efforts with the Federal Trade Commission, the Department of Justice, and various Bar Associations to address the growing problem of invention development company marketing scams.

Creating a Patent and Trademark Office Review Service for Applicant-Created Forms (Topic 21)

The Office indicated that it was considering establishing a new service, under which the Office would (for a fee) review applicant-created forms intended to be used for future correspondence to

the Office. After the review is completed, the Office would provide a written report, including comments and suggestions (if any), but the Office would not formally "approve" any form. If a (reviewed) form is modified in view of a Office written report, comments and/or suggestion, the revised form could be resubmitted to the Office for a follow up review for an additional charge (roughly estimated at approximately \$50). After a form has been reviewed and revised, as may be needed, to comply with the Office's written report, it would be acceptable for the form to indicate if it is a substitute for an Office form, and that it has been "reviewed by the Patent and Trademark Office."

The Office received few comments on this proposal. Of those comments received on this proposal, most supported this new service. The comments included the following specific concerns and suggestions: (1) That the form review service be optional and not mandatory; (2) that there be one fee per form, regardless of the number of submissions needed to have the form reviewed; (3) the service had little value unless the Office would be willing to approve a form; and (4) the time has come to require the use of mandatory forms.

Response: The Office indicated in the Advance Notice that this new service would involve significant start-up costs, and, absent positive feedback on the matter, the Office does not intend to implement this new service. See Changes to Implement the Patent Business Goals, 63 FR at 53530, 1215 Off. Gaz. Pat. Office at 117. In view of the limited interest shown by the comments in this new service, the Office has decided not to proceed with the proposal to provide a review service for applicant-created forms.

Discussion of Specific Rules

Title 37 of the Code of Federal Regulations, Parts 1, 3, 5, and 10, are proposed to be amended as follows:

Part 1

Section 1.4: Section 1.4(b) is proposed to be amended to refer to a patent or trademark application, patent file, trademark registration file, or other proceeding, rather than only an application file. Section 1.4(b) is also proposed to be amended to provide that the filing of duplicate copies of correspondence in a patent or trademark application, patent file, trademark registration file, or other proceeding should be avoided (except in situations in which the Office requires the filing of duplicate copies), and that the Office

may dispose of duplicate copies of correspondence in a patent or trademark application, patent file, trademark registration file, or other proceeding. Finally, § 1.4(b) and § 1.4(c) are also proposed to be amended to change "should" to "must" because the Office needs separate copies of papers directed to two or more files, or of papers dealing with different subjects.

Section 1.6: Section 1.6(d)(9) is proposed to be amended to delete the reference to recorded answers under § 1.684(c), as § 1.684(c) has been removed and reserved.

Section 1.9: Section 1.9(f) is proposed to be amended to provide the definition of who can qualify to pay small entity fees, and paragraphs (c) through (e) of § 1.9 are proposed to be removed and reserved.

Paragraph (f) of § 1.9 is proposed to: (1) Be reformatted, (2) define a "person" to include inventors and also noninventors holding rights in the invention, (3) explain that qualification depends on whether any rights in the invention were transferred and to whom, and (4) provide that a license by a person to the Government under certain situations does not bar entitlement to small entity status.

Section 1.9 paragraph (f) is proposed to be reformatted to place the subject matter relating to definitions of small entities: (1) Persons, (2) small business concerns; and (3) nonprofit organizations, in one paragraph rather than as currently in paragraphs (c) through (e). The expression "independent inventor" of current paragraph (c) is proposed to be replaced with the term "person" in paragraph (f)(1) (and other paragraphs of this section). The term "person" in paragraph (f) is proposed to be defined to include individuals who are inventors and also individuals who are not inventors but who have been transferred some right or rights in the invention. This would clarify that individuals who are not inventors but who have rights in the invention are covered by the provisions of §§ 1.9 and 1.27.

Paragraphs (f)(2)(i) and (f)(3)(i) of § 1.9 are proposed to be added to clarify that in order for small entity businesses and nonprofit organizations to remain entitled to small entity status, they must not in some manner transfer or be under an obligation to transfer any rights in the invention to any party that would not qualify for small entity status. Current § 1.27 paragraphs (b), (f)(1)(iii), and (f)(1)(iii) make clear that this rights transfer requirement applies to all parties (independent inventors, small businesses and nonprofit organizations,

respectively). The absence of this requirement however, from current § 1.9 paragraphs (d) and (e) (small business and nonprofit organization, respectively), notwithstanding its presence in § 1.9 paragraph (c) (independent inventor), has led to confusion as to the existence of such a requirement for small businesses and nonprofit organizations. In view of the appearance of the rights transfer requirement in § 1.9, it is proposed to be removed from all paragraphs of § 1.27.

Paragraph (f)(4)(i) of § 1.9 is proposed to be added to provide a new exception relating to the granting of a license to the U.S. Government by a person, that results from a particular rights determination. Such a license would not bar entitlement to small entity status. Similarly paragraph (f)(4)(ii) of § 1.9 is proposed to be added to have transferred to it (from current § 1.27 paragraphs (c)(2) and (d)(2)) the current exceptions relating to a license to a Federal agency by a small business or a nonprofit organization resulting from a particular funding agreement. Again, such a license would not bar entitlement to small entity status.

For additional proposed changes to small entity requirements see §§ 1.27 and 1.28.

Section 1.9(i) is proposed to be added to define "national security classified." Section 1.9(i), as proposed, defines "national security classified" as used in 37 CFR Chapter 1 as meaning "specifically authorized under criteria established by an Act of Congress or Executive order to be kept secret in the interest of national defense or foreign policy and, in fact, properly classified pursuant to Act of Congress or Executive order."

Section 1.12: Section 1.12(c)(1) is proposed to be amended to change the reference to the fee set forth in "§§ 1.17(i)" to the fee set forth in "§ 1.17(h)." This change is for consistency with the changes to § 1.17(h) and § 1.17(i). See discussion of changes to § 1.17(h) and § 1.17(i).

Section 1.14: Section 1.14 is proposed to be amended to make it easier to understand. Section 1.14 is also proposed to be amended to provide that the Office will no longer give status information or access in certain situations where applicants have an expectation of confidentiality.

Section 1.14(a) is proposed to be amended to define "status information" and "access." "Status information" is proposed to be defined as information that the application is pending, abandoned, or patented, as well as the application numeric identifier. An application's numeric identifier is (a)

the application number, or (b) the serial number and filing date, or date of entry into the national stage. If an international application has not been assigned a U.S. application number, no such application number can be provided by the Office.

Section 1.14 as proposed would also eliminate the provisions making available data on any continuing cases of an application identified in a patent. (The provisions of current § 1.14(a)(1)(ii) are proposed to be deleted.)

Section 1.14(b) is proposed to be amended to state when status information may be supplied, retaining the reasons set forth in current § 1.14(a)(1)(i). Section 1.14(b)(3) is proposed to be simplified so as to indicate that status information will be given for international applications in which the United States is designated, even if that application has not yet entered the national stage.

Section 1.14(c) is proposed to be amended to contain the provisions of current § 1.14(a)(2).

The provisions of current §§ 1.14(a)(3)(i), 1.14(a)(3)(iv)(C) and 1.14(a)(3)(iv)(D) are proposed to be deleted, and the remaining provisions of § 1.14(a)(3) are proposed to be separated into § 1.14(d) and 1.14(e).

Section 1.14(d), as proposed, substantially corresponds to current § 1.14(a)(3)(iii) with additional text from current § 1.14(e)(2). Section 1.14(d), as proposed, states that an applicant, an attorney or agent of record, or an applicant's assignee may have access to an application by filing a power to inspect. In addition, § 1.14(d), as proposed, provides that if an executed oath or declaration has not been filed, a registered attorney or agent named in the papers filed with the application may have access, or authorize another person to have access, to an application by filing a power to inspect. The form for a power to inspect is PTO/SB/67.

Section 1.14(e), as proposed, substantially corresponds to current § 1.14(a)(3) and states that any person may obtain access to an application by submitting a request for access if certain conditions apply. Access to international phase application files is governed by the provisions of the PCT and not by § 1.14. The form for a request for access to an abandoned application is PTO/SB/68. Section 1.14(e)(1), as proposed, corresponds to current § 1.14(a)(3)(ii). Section 1.14(e)(2)(i) corresponds to current § 1.14(a)(3)(iv)(A). Section 1.14(e)(2)(ii), as proposed, corresponds to current § 1.14(a)(3)(iv)(B).

Current § 1.14 (b), (c), (d), (f), and (g) are proposed to be redesignated § 1.14 (f), (g), (h), (i) and (j), respectively.

Current § 1.14(e) is proposed to be redesignated § 1.14(k) and to be amended to explain the requirements of a petition for access and include the provisions of current § 1.14(e)(1). Current § 1.14(e)(2) is proposed to be moved to proposed § 1.14(d).

Section 1.14(k) is also proposed to indicate that the Office may provide access or copies of an application if necessary to carry out an Act of Congress or if warranted by other special circumstances. The Office may, for example, provide access to, or copies of, applications to another federal government agency, such as a law enforcement agency, whether the Office is acting on its own initiative or in response to a petition from the other agency when access is needed for a criminal investigation. The Office may additionally provide access or copies without requiring the other federal agency to file a petition including a showing that access to the application is necessary to carry out an Act of Congress or that special circumstances exist which warrant petitioner being granted access to the application.

Section 1.17: Section 1.17(h) and § 1.17(i) are proposed to be amended to characterize the fee set forth in § 1.17(h) as a petition fee, and the fee set forth in § 1.17(i) as a processing fee. Section 1.17(h) is proposed to be amended to list only those matters that require the exercise of judgment or discretion in determining whether the request/petition will be granted or denied (e.g., 1.47, 1.53, 1.182, 1.183, 1.313). Section 1.17(i) is proposed to be amended to list those matters that do not require the exercise of judgment or discretion, but which are routinely granted once the applicant has complied with the stated requirements (e.g., 1.41, 1.48, 1.55). Thus, the Office proposes to amend § 1.17(h) and § 1.17(i) to locate matters requiring a petition in § 1.17(h), and those matters that do not require a petition, but only a processing fee, in § 1.17(i). Section 1.17(i) is also proposed to be amended to provide a processing fee for: (1) Filing a nonprovisional application in a language other than English (§ 1.52(d)), now in § 1.17(k); and (2) filing an oath or declaration pursuant to 35 U.S.C. 371(c)(4) naming an inventive entity different from the inventive entity set forth in the international stage (§ 1.497(d)).

Section 1.17(k) is proposed to be amended to provide a \$200 fee for processing an application containing color drawings or photographs.

Section 1.17 (l) and (m) are proposed to be amended for clarity and to eliminate unassociated text.

Section 1.17(q) is proposed to be amended for consistency with § 1.17(h) and § 1.17(i), as the matters listed therein apply to provisional applications.

Section 1.17(t) is proposed to be added to provide a fee for filing a request for expedited examination under § 1.155(a).

Section 1.19: Section 1.19(a) is proposed to be amended to clarify that the fees set forth in § 1.19(a)(1) do not apply to patents containing a color photograph or drawing, that the fee in § 1.19(a)(2) applies to plant patents in color, and that the fee in § 1.19(a)(3) applies to patents (other than plant patents) containing a color drawing.

Section 1.19(b)(2) is proposed to be amended to provide a fee of \$250 for a certified or uncertified copy of a patent-related file wrapper and contents of 400 or fewer pages, and an additional fee of \$25 for each additional 100 pages or portion thereof. Due to increases in the number of pages in the contents of patent, patent application, and patent-related interference files, the Office is adjusting the fee specified in § 1.19(b)(2) to recover its cost of providing copies of these files. To better allocate costs, the Office is proposing to charge a "flat" rate of \$250 for a copy of a patent-related file wrapper and contents of 400 or fewer pages (which includes most patent-related files), but charge an additional fee of \$25 for each additional 100 pages or portion thereof to make persons requesting copies of patent-related files having contents containing a large number of pages (e.g., interference proceedings) bear the cost of making copies of such files. Since the Office cannot ascertain the exact number of pages of the contents of a patent-related file, the Office expects to determine the additional fee in proposed § 1.19(b)(2)(ii) by estimating (e.g., by measuring file thickness) rather than actually counting pages.

Section 1.19(h) is proposed to be removed. The \$25 fee under § 1.19(h) for obtaining a corrected or duplicate filing receipt is no longer necessary as the Office is now performing that service without charge. Consequently, where a filing receipt has an error in it, applicants no longer need to provide a showing that the error was due to Office mistake or pay a \$25 fee for the corrected receipt. See Changes In Practice In Supplying Certified Copies And Filing Receipts, Notice, 1199 Off. Gaz. Pat. Office 38 (June 10, 1997).

Section 1.22: Section 1.22(b) is proposed to be amended to change

"should" to "must" because the Office needs fees to be submitted in such a manner that it is clear for which purpose the fees are paid. Section 1.22(b) is also proposed to be amended to provide that the Office may return fees that are not itemized as required by § 1.22(b), and that the provisions of § 1.5(a) do not apply to the resubmission of fees returned pursuant to § 1.22.

Section 1.22(c) is proposed to be added to define, based upon current Office practice, when a fee is considered paid. Section 1.22(c)(1)(i) is proposed to provide that a fee paid by an authorization to charge such fee to a deposit account containing sufficient funds to cover the applicable fee amount (§ 1.25) is considered paid on the date the paper for which the fee is payable is received in the Office (§ 1.6), if the paper including the deposit account charge authorization was filed prior to or concurrently with such paper. Section 1.22(c)(1)(ii) is proposed to provide that a fee paid by an authorization to charge such fee to a deposit account containing sufficient funds to cover the applicable fee amount (§ 1.25) is considered paid on the date the paper including the deposit account charge authorization is received in the Office (§ 1.6), if the deposit account charge authorization is filed after the filing of the paper for which the fee is payable. The provision of § 1.22(c)(1)(ii) would apply, for example, in the following situation: In reply to an Office action setting a three-month shortened statutory period for reply, a paper is filed three and one-half months after the mail date of the Office action without payment of the fee for a one-month extension of time. Thereafter, the applicant discovers the lack of payment and files a second paper including an authorization to charge the appropriate fee for any extension of time required, but the second paper is received in the Office (§ 1.6) four and one-half months from the mail date of the Office action. The fee required for the reply to the Office action to be timely is considered paid when the second paper was received (§ 1.6) in the Office. Section 1.22(c)(1)(iii) is proposed to provide that a fee paid by an authorization to charge such fee to a deposit account containing sufficient funds to cover the applicable fee amount (§ 1.25) is considered paid on the date of the agreement, if the deposit account charge authorization is the result of an agreement between the applicant and an Office employee as long as the agreement is reduced to a writing. That is, the fee is considered paid on the date of the agreement (e.g.,

the date of the interview), and the date the agreement is subsequently reduced to writing (e.g., the mail date of the interview summary) is not relevant to the date the fee is considered paid.

Section 1.22(c)(2) is proposed to provide that a fee paid other than by an authorization to charge such fee to a deposit account is considered paid on the date the applicable fee amount is received in the Office (§ 1.6). Section 1.22(c)(3) is proposed to provide that the applicable fee amount is determined by the fee in effect on the date such fee is paid in full. When fees change (due to a CPI increase under 35 U.S.C. 41(f) or other legislative change), the Office generally accords fee payments the benefit of the provisions of § 1.8 vis-à-vis the applicable fee amount even though the fee is not considered paid until it is received in the Office (§ 1.6). See Revision of Patent Fees for Fiscal Year 1999, Final Rule Notice, 63 FR 67578, 67578-79 (December 8, 1998), 1217 Off. Gaz. Pat. Office 148, 148 (December 29, 1998). This treatment of fee payments is an "exception" to the provisions of § 1.22(c) as proposed, in that such fee would be not be entitled to any benefit under § 1.8 vis-à-vis the applicable fee amount but for the express exception provided in the fee change rulemaking. Of course, a fee is considered timely if the fee is submitted to the Office under the procedure set forth in § 1.8(a) (unless excluded under § 1.8(a)(2)), even though the fee is not considered paid until it is actually received in the Office (§ 1.6).

Section 1.25: Section 1.25(b) is proposed to be amended to provide that an authorization to charge fees under § 1.16 in an application submitted under § 1.494 or § 1.495 will be treated as an authorization to charge fees under § 1.492. There are many instances in which papers filed for the purpose of entering the national stage under 35 U.S.C. 371 and § 1.494 or § 1.495 include an authorization to charge fees under § 1.16 (rather than fees under § 1.492). In such instances, the Office treats the authorization as an authorization to charge fees under § 1.492 since: (1) Timely payment of the appropriate national fee under § 1.492 is necessary to avoid abandonment of the application as to the United States; and (2) the basic filing fee under § 1.16 is not applicable to such papers or applications. Therefore, the Office is proposing to change § 1.25(b) to place persons filing papers to enter the national stage under 35 U.S.C. 371 and § 1.494 or § 1.495 on notice as to how an authorization to charge fees under § 1.16 will be treated.

Section 1.25(b) is also proposed to be amended to provide that an authorization to charge fees set forth in § 1.18 to a deposit account is subject to the provisions of § 1.311(b).

Section 1.26: The Office is proposing to amend the rules of practice to provide that all requests for refund must be filed within specified time periods. The rules of practice do not (other than in the situation in which a request for refund is based upon subsequent entitlement to small entity status) set any time period (other than "a reasonable time") within which a request for refund must be filed. In the absence of such a time period, Office fee record keeping systems and business planning must account for the possibility that a request for refund may be filed at any time, including many years after payment of the fee at issue.

It is a severe burden on the Office to treat a request for refund filed years after payment of the fee at issue. Since Office fee record keeping systems change over time, the Office must check any system on which fees for the application, patent or trademark registration have been posted to determine what fees were in fact paid. In addition, changes in fee amounts, which usually occur on October 1 of each year, make it difficult to determine with certainty whether a fee paid years ago was the correct fee at the time and under the condition it was paid.

It also causes business planning problems to account for the possibility that a request for refund may be filed years after payment of the fee at issue. Without any set time period within which a request for refund must be filed, the Office must maintain fee records, in any automated fee record keeping system ever used by the Office, in perpetuity. Finally, as the Office can never be absolutely certain that a submitted fee was not paid by mistake or in excess of that required, the absence of such a time period subjects the Office to unending and uncertain financial obligations.

Accordingly, the Office is proposing to amend § 1.26 to provide non-extendable time periods within which any request for refund must be filed to be timely.

Section 1.26(a) is proposed to be amended by dividing its first sentence into two sentences. Section 1.26(a) is further amended for consistency with 35 U.S.C. 42(d) ("[t]he Commissioner may refund a fee paid by mistake or any amount paid in excess of that required"). Under 35 U.S.C. 42(d), the Office may refund: (1) a fee paid when no fee is required (a fee paid by mistake); or (2) any fee paid in excess

of the amount of fee that is required. See *Ex parte Grady*, 59 USPQ 276, 277 (Comm'r Pats. 1943) (the statutory authorization for the refund of fees under the "by mistake" clause is applicable only to a mistake relating to the fee payment). In the situation in which an applicant or patentee takes an action "by mistake" (e.g., files an application or maintains a patent in force "by mistake"), the submission of fees required to take that action (e.g., a filing fee submitted with such application or a maintenance fee submitted for such patent) is not a "fee paid by mistake" within the meaning of 35 U.S.C. 42(d). Section 1.26(a) is also proposed to be amended to revise the "change of purpose" provisions to read "[a] change of purpose after the payment of a fee, as when a party desires to withdraw a patent or trademark filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee."

Section 1.26(a) is also proposed to be amended to change the sentence "[a]mounts 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 amount; amounts over twenty-five dollars may be returned by check or, if requested, by credit to a deposit account" to "[t]he Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify the payor of such amounts." Except as discussed below, the Office intends to continue to review submitted fees to determine that they have not been paid by mistake or in excess of that required, and to *sua sponte* refund fees (of amounts over twenty-five dollars) determined to have been paid by mistake or in excess of that required. Section 1.26(a), however, is proposed to be amended to eliminate language that appears to obligate the Office to *sua sponte* refund fees to be consistent with the provisions of § 1.26(b) which requires that any request for refund be filed within a specified time period.

Section 1.26(a) is also proposed to be amended to facilitate refunds by electronic funds transfer. Section 31001(x) of the Omnibus Consolidated Rescissions and Appropriations Act of 1996, Pub. L. 104-134, 110 Stat. 1321 (1996) (the Debt Collection Improvement Act of 1996), amended 31 U.S.C. 3332 to require that all disbursements by Federal agencies (subject to certain exceptions and waivers) be made by electronic funds transfer. The Department of the

Treasury has implemented this legislation at 31 CFR Part 208. See Management of Federal Agency Disbursements, Final Rule Notice, 63 FR 51489 (September 25, 1998). Thus, § 1.26(a) is proposed to be amended to enable the Office to obtain the banking information necessary for making refunds by electronic funds transfer in accordance with 31 U.S.C. 3332 and 31 CFR Part 208.

Specifically, § 1.26(a) is also proposed to be amended such that if a party paying a fee or requesting a refund does not instruct that refunds be credited to a deposit account, the Office will attempt to make any refund by electronic funds transfer. If such party does not provide the banking information necessary for making refunds by electronic funds transfer, the Commissioner may either require such banking information or use the banking information on the payment instrument to make a refund. This provision will authorize the Office to: (1) Use the banking information on the payment instrument (e.g., a personal check is submitted to pay the fee) when making a refund due to an excess payment; or (2) require such banking information in other situations (e.g., a refund is requested or a money order or certified bank check is submitted containing an excess payment). The purpose of this proposed change to § 1.26(a) is to encourage parties to submit the banking information necessary for making refunds by electronic funds transfer (if not on the payment instrument) up-front, and not to add a step (requiring such banking information) to the refund process. If it is not cost-effective to require the banking information necessary for making refunds by electronic funds transfer, the Office may simply issue any refund by treasury check. See 31 CFR 208.4(f).

Section 1.26(b) is proposed to be added to provide that any request for refund must be filed within two years from the date the fee was paid, except as otherwise provided in § 1.26(b) or in § 1.28(a). See the discussion of proposed § 1.22(c) concerning the date a fee is considered paid.

Section 1.26(b) is also proposed to provide that if the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization (§ 1.25(b)), any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge, and that such request must be accompanied by a copy of that deposit account statement. This provision of § 1.26(b) would apply, for example, in the following types of

situations: (1) A deposit account is charged for an extension of time as a result of there being a prior general authorization in the application (§ 1.136(a)(3)); or (2) a deposit account is charged for the outstanding balance of a fee as a result of an insufficient fee being submitted with an authorization to charge the deposit account for any additional fees that are due. In these situations, the party providing the authorization is not in a position to know the exact amount by which the deposit account will be charged until the date of the deposit account statement indicating the amount of the charge.

Finally, § 1.26(b) is proposed to provide that the time periods set forth in § 1.26(b) are not extendable.

Section 1.27: The Office is considering simplifying applicant's request for small entity status under § 1.27. The currently used small entity statement forms are proposed to be eliminated as they would no longer be needed. Some material in § 1.28 is proposed to be reorganized into § 1.27.

Small entity status would be established at any time by a simple assertion of entitlement to small entity status. The currently required statements, which include a formalistic reference to § 1.9, would no longer be required. Payment of an exact small entity basic filing or national fee would also be considered an assertion of small entity status. This would be so even if the wrong exact basic filing or national fee was selected. To establish small entity status after payment of the basic filing fee as a non-small entity, a written assertion of small entity status would be required to be submitted. The parties who could assert small entity status would be liberalized to include one of several inventors or a partial assignee.

Other clarifying changes are proposed to be made including a transfer of material into § 1.27 from § 1.28 drawn towards: (1) Assertions in related, continuing and reissue applications; (2) notification of loss of entitlement to small entity status; and (3) fraud on the Office in regard to establishing small entity status or paying small entity fees.

While there would be no change in the current requirement to make an investigation in order to determine entitlement to small entity status, a recitation would be added noting the need for a determination of entitlement prior to an assertion of status; the Office would only be changing the ease with which small entity status could be claimed once it has been determined that a claim to such status is appropriate.

For additional proposed changes to small entity requirements see §§ 1.9 and 1.28.

Problem and Background

Section 1.27 currently requires that a request for small entity status be accompanied by submission of an appropriate statement that the party seeking small entity status qualifies in accordance with § 1.9. Either a reference to § 1.9 or a specific statement relating to the provisions of § 1.9 is mandatory. For a small business, the small business must either state that exclusive rights remain with the small business, or if not, identify the party to which some rights have been transferred so that the party to which rights have been transferred can submit its own small entity statement (current § 1.27(c)(1)(iii)). This can lead to the submission of multiple small entity statements for each request for small entity status where rights in the invention are split. The request for small entity status and reference/statement may be submitted prior to paying, or, at the latest, at the time of paying, any small entity fee. In part, to ensure that at least the reference to § 1.9 is complied with, the Office has produced four types of small entity statement forms (including ones for the inventors, small businesses and non-profit organizations) that include the required reference to § 1.9 and specific statements as to exclusive rights in the invention. Where an application has not been assigned and there are multiple inventors, each inventor must actually sign a small entity statement, the execution of which must all be coordinated and submitted at the same time. Similarly, coordination of execution and submission of statements is needed where there is more than one assignee. Additionally, the statement forms relating to small businesses and non-profit organizations need to be signed by an appropriate official empowered to act on behalf of the small business or non-profit organization. Refunds of non-small entity fees can only be obtained if a refund is specifically requested within two months of the payment of the full (non-small entity) fee and is supported by all required small entity statements. See current § 1.28(a)(1). The current two-month refund window under § 1.28 is not extendable.

The rigid requirements of §§ 1.27 and 1.28 have led to a substantial number of problems. Applicants, particularly *pro se* applicants, do not always recognize that a particular reference to § 1.9 is required in their request to establish small entity status. They believe that all

they have to do is pay the small entity fee and state that they are a small entity. Further, the time required to ascertain who are the appropriate officials to sign the statement and to have the statements (referring to § 1.9) signed and collected (where more than one is necessary), results, in many instances, in having to pay the higher non-small entity fees and then seek a refund. These situations result in: (1) Small entity applicants also having to pay additional fees (e.g., surcharges and extension(s) of time fees for the delayed submission of the small entity statement form); (2) additional correspondence with the office to perfect a claim for small entity status; and (3) the filing of petitions with petition fees to revive abandoned applications. This increases the pendency of the prosecution of the application in the Office and, in some cases, results in loss of patent term. For example, under current procedures, if a *pro se* applicant files a new application with small entity fees but without a small entity statement, the office mails a notice to the *pro se* applicant requiring the full basic filing fee of a non-small entity. Even if the applicant timely files a small entity statement, the applicant must still timely pay the small entity surcharge for the delayed submission of the small entity statement to avoid abandonment of the application. A second example is a non-profit organization paying the basic filing fee as a non-small entity because of difficulty in obtaining the non-profit small entity statement form signed by an appropriate official. In this situation, a refund pursuant to § 1.26, based on establishing status as a small entity, may only be obtained if a statement under § 1.27 and the request for a refund of the excess amount are filed within the non-extendable two-month period from the date of the timely payment of the full fee. A third example is an application filed without the basic filing fee on behalf of a small business by a practitioner who includes the standard authorization to pay additional fees. The Office will immediately charge the non-small entity basic filing fee without specific notification thereof at the time of the charge. By the time the deposit account statement is received and reviewed, the two-month period for refund may have expired.

Accordingly, a simpler procedure to establish small entity status would reduce processing time within the Office (Patent Business Goal 1) and would be a tremendous benefit to small entity applicants as it would eliminate the time-consuming and aggravating processing requirements that are

mandated by the current rules. Thus, the proposed simplification would help small entity applicants to receive patents sooner with fewer expenditures in fees and resources and the office could issue the patent with fewer resources (Patent Business Goals 4 and 5).

Assertion as to Entitlement to Small Entity Status; Assertion by Writing

The Office is proposing to allow small entity status to be established by the submission of a simple written assertion of entitlement to small entity status. The current formal requirements of § 1.27, which include a reference to either § 1.9, or to the exclusive rights in the invention, would be eliminated.

The written assertion would not be required to be presented in any particular form. Written assertions of small entity status or references to small entity fees would be liberally interpreted to represent the required assertion. The written assertion could be made in any paper filed in or with the application and need be no more than a simple sentence or a box checked on an application transmittal letter or reply cover sheet. It is the intent of the Office to modify its application transmittal forms to provide for such a check box. Accordingly, small entity status could be established without submission of any of the current small entity statement forms (PTO/SB/09-12) that embody and comply with the current requirements of § 1.27 and which are now used to establish small entity status.

Assertion by Payment of Small Entity Basic Filing or National Fee

The payment of an exact small entity basic filing or national fee will also be considered to be a sufficient assertion of entitlement to small entity status. An applicant filing a patent application and paying an exact small entity basic filing or national fee would automatically establish small entity status for the application even without any further written assertion of small entity status. This is so even if an applicant were to inadvertently select the wrong type of small entity basic filing or national fee for the application being filed. If small entity status was not established when the basic filing fee was paid, such as by payment of a large entity basic filing or national fee, a later claim to small entity status would require a written assertion. Payment of a small entity fee other than a small entity basic filing or national fee (e.g., extension of time, or issue fee) without inclusion of a written assertion would not be sufficient.

Even though applicants can assert small entity status by payment of an

exact small entity basic filing or national fee, the Office strongly encourages applicants to file a written assertion of small entity status. A written assertion would guarantee the applicant that the application will have small entity status even if applicant fails to pay the exact small entity basic filing or national fee. The limited provision providing for small entity status by payment of an exact small entity basic filing or national fee is only intended to act as a safety net to avoid possible financial loss to inventors or small businesses that can qualify for small entity status.

Caution: Even though small entity status would be accorded where the wrong type of small entity basic filing fee or national fee were selected but the exact amount of the fee were paid, applicant would still need to pay the correct small entity amount for the basic filing or national fee where selection of the wrong type of fee results in a deficiency. While an accompanying *general* authorization to charge any additional fees would suffice to pay the balance due of the proper small entity basic filing or national fee, *specific* authorizations to charge fees under § 1.17 or extension of time fees would not suffice to pay any balance due of the proper small entity basic filing or national fee because they do not actually authorize payment of small entity amounts.

Examples: Applications under 35 U.S.C. 111: If an applicant were to file a utility application under 35 U.S.C. 111 yet only pay the exact small entity amount for a design application (currently the small entity filing fees for utility and design applications are \$380 and \$155, respectively), small entity status for the utility application would be accorded. See the following examples:

(1) Where the utility application was filed inadvertently with the exact small entity basic filing fee for a design application rather than for a utility application and an authorization to charge the filing fee was not present, the Office would accord small entity status and mail a Notice to File Missing Parts of Application, requiring the \$225 difference between the small entity utility application filing fee owed and the small entity design application filing fee actually paid plus a small entity surcharge (of \$65) for the late submission of the correct filing fee.

(2) Where the utility application was filed without any filing fee but the \$155 exact small entity filing fee for a design application was inadvertently paid in response to a Notice to File Missing Parts of Application, small entity status would be established even though the correct small entity filing fee for a utility application was not fully paid. While the Office will notify applicant of the

remaining amount due, the period for reply to pay the correct small entity utility basic filing fee would, however, continue to run. Small entity extensions of time under § 1.136(a) would be needed for the later submission of the \$225 difference between the \$380 small entity utility basic filing fee owed and the \$155 small entity design filing fee inadvertently paid. If there was an authorization to charge a deposit account in the response to the Notice, the \$225 difference would have been charged along with the small entity \$65 surcharge and the period for response to the Notice to File Missing Parts of Application would not continue to run.

Applications entering that national stage under 35 U.S.C. 371: Section 1.492(a) sets forth five (5) different basic national fee amounts which apply to different situations. If an applicant pays a basic national fee which is the exact small entity amount for one of the fees set forth in § 1.492(a), but not the particular fee which applies to that application, the applicant will be considered to have made an assertion of small entity status. This is true whether the fee paid is higher or lower than the actual fee required. See the following examples.

(1) An applicant pays \$485 (the small entity amount due under § 1.492(a)(3), where the United States was neither the International Searching Authority (ISA) nor the International Preliminary Examining Authority (IPEA) and the search report was not prepared by the European Patent Office (EPO) or Japanese Patent Office (JPO)) when in fact the required small entity fee is \$420 under § 1.492(a)(5), because the JPO or EPO prepared the search report. The applicant will be considered to have made the assertion of small entity status. The office will apply \$420 to the payment of the basic national fee and refund the overpayment of \$65.

(2) An applicant pays \$420 (the small entity fee due under § 1.492(a)(5) where the search report was prepared by the EPO or JPO). In fact, the search report was prepared by the Australian Patent Office and no preliminary examination fee was paid to the Patent and Trademark Office. Thus, the required small entity fee is \$485 under § 1.492(a)(3). The applicant will be considered to have made the assertion of small entity status. If the applicant has authorized payment of fee deficiencies to a deposit account, the Office will charge the \$65 to the deposit account and apply it and the \$420 to the basic national fee. If there is no authorization or there are insufficient fees in the deposit account, the basic national fee payment is insufficient. If the balance is not provided before 20 or 30 months from the priority date has expired, the application is abandoned.

If payment is attempted to be made of the proper type of basic filing or national fee, but it is not the exact small entity fee required (an incorrect fee amount is supplied) and a written assertion of small entity status is not

present, small entity status would not be accorded. The Office would mail a notice of insufficient basic filing or national fee with a surcharge due as in current practice if an authorization to charge the basic filing or national fee were not present. The Office would not consider a basic filing or national fee submitted in an amount above the correct fee amount, but below the non-small entity fee amount, as a request to establish small entity status unless an additional written assertion is also present. Of course, the submission of a basic filing or national fee below the correct fee amount would not serve to establish small entity status.

Where an application is originally filed by a party, who is in fact a small entity, with an authorization to charge fees (including basic filing or national fees) and there is no indication (assertion) of entitlement to small entity status present, that authorization would not be sufficient to establish small entity status unless the authorization was specifically directed to *small entity* basic filing or national fees. The general authorization to charge fees would continue to be acted upon immediately and the full (not small entity) basic filing or national fees would be charged with applicant having three months to request a refund by asserting entitlement to small entity status. This would be so even if the application were a continuing application where small entity status had been established in the prior application.

Parties Who Could Assert Entitlement to Small Entity Status by Writing

The parties who could submit a written assertion of entitlement to small entity status would be any party permitted by Office regulations, § 1.33(b), to file a paper in an application. This eliminates the additional requirement of obtaining the signature of an appropriate party other than the party prosecuting the application. By way of example, in the case of three *pro se* inventors for a particular application, the three inventors upon filing the application could submit a written assertion of entitlement to small entity status and thereby establish small entity status for the application. For small business concerns and non-profit organizations, the practitioner could supply the assertion rather than the current requirement for an appropriate official of the organization to execute a small entity statement form. In addition, a written assertion of entitlement to small entity status would be able to be made by one of several inventors or a partial assignee. Current practice does not

require an assignee asserting small entity status to submit a § 3.73(b) certification, and such certifications would not be required under the proposed revision either for partial assignees or for an assignee of the entire right, title, and interest.

Parties who Could Assert Entitlement to Small Entity Status by Payment of Basic Filing or National Fee

Where small entity status is sought by way of payment of the basic filing or national fee, any party may submit payment, such as by check, and small entity status would be accorded.

Inventors Asserting Small Entity Status

Any inventor would be permitted to submit a written assertion of small entity status, including inventors who are not officially named of record until an executed oath/declaration is submitted. See § 1.41(a)(1). Where an application is filed without an executed oath/declaration pursuant to § 1.53(f), the Office will accept the written assertion of an individual who has merely been identified as an inventor on filing of the application (e.g., application transmittal letter) as opposed to being named as an inventor. Sections 1.4(d)(2) and 10.18(b) are seen as sufficient basis to permit any individual to provide a written assertion so long as the individual identifies himself or herself as an inventor. Where a § 1.63 oath or declaration is later filed, any original written assertion as to small entity status will remain unless changed by an appropriate party under § 1.27(f)(2). Where a later filed § 1.63 oath or declaration sets forth an inventive entity that does not include the person who initially was identified as an inventor and who asserted small entity status, small entity status will also remain. Where small entity status is asserted by payment of the small entity basic filing, or national fee any party may submit such fee, including an inventor who was not identified in the application transmittal letter, or a third party.

Caution: The fact that certain parties can execute a written assertion of entitlement to small entity status, such as one of several inventors, or a partial assignee, does not entitle that written assertion to be entered in the Official file record and become an effective paper unless the person submitting the paper is authorized to do so under § 1.33(b). In other words, the fact that one of several inventors can sign a written assertion of entitlement to small entity status does not also imply that the same inventor can submit the paper to the Office and have it entered of record.

The written assertion, even though effective once entered in the Official file record, must still be submitted by a party entitled to file a paper under § 1.33(b). Payment of the small entity basic filing or national stage fee would not be subject to such submission requirement and any payment thereof would be accepted and treated as an effective assertion of small entity status.

Policy Considerations

Office policy and procedures already permit establishment of small entity status in certain applications through simplified procedures. For example, small entity status may be established in a continuing or reissue application simply by payment of the small entity basic filing fee if the prior application/patent had small entity status. See current § 1.28(a)(2). The instant concept of payment of the small entity basic statutory filing fee to establish small entity status in a new application is merely a logical extension of that practice.

There may be some concern that elimination of the small entity statement forms will result in applicants who are not actually entitled to small entity status requesting such status. On balance, it seems that more errors occur where small entity applicants who are entitled to such status run afoul of procedural hurdles created by the requirements of § 1.27 than the requirements help to prevent status claims for those who are not in fact entitled to such status.

Continued Obligations for Thorough Investigation of Small Entity Status

Applicants should not confuse the fact that the Office is making it easier to qualify for small entity status with the need to do a complete and thorough investigation before an assertion is made that they do, in fact, qualify for small entity status. *It should be clearly understood that, even though it would be much easier to assert and thereby establish small entity status, applicants would continue to need to make a full and complete investigation of all facts and circumstances before making a determination of actual entitlement to small entity status. Where entitlement to small entity status is uncertain it should not be claimed.* See MPEP 509.03. The assertion of small entity status (even by mere payment of the exact small entity basic filing fee) is not appropriate until such an investigation has been completed. Thus, in the previous example of the three *pro se* inventors, before one of the inventors could pay the small entity basic filing or national fee to establish small entity status, the

single inventor asserting entitlement to small entity status would need to check with the other two inventors to determine whether small entity status was appropriate.

The intent of § 1.27 is that the person making the assertion of entitlement to small entity status is the person in a position to know the facts about whether or not status as a small entity can be properly established. That person, thus, has a duty to investigate the circumstances surrounding entitlement to small entity status to the fullest extent. Therefore, while the Office is interested in making it easier to claim small entity status, it is important to note that small entity status must not be claimed unless the person or persons can unequivocally make the required self-certification. Section 1.27(g) would recite current provisions in § 1.28(d)(1) and (2) relating to fraud practiced on the Office.

Consistent with § 1.4(d)(2), the payment of a small entity basic filing or national fee, would constitute a certification under § 10.18(b). Thus, a simple payment of the small entity basic filing or national fee, without a specific written assertion, will activate the provisions of § 1.4(d)(2) and, by that, invoke the self-certification requirement set forth in § 10.18(b), regardless of whether the party is a practitioner or non-practitioner.

Clarification of Need for Investigation

Section 1.27 is proposed to be clarified (paragraph (e)) by explicitly providing that a determination "should" be made of entitlement to small entity status according to the requirement set forth in § 1.9 prior to asserting small entity status. The need for such a determination of entitlement to small entity status prior to assertion of small entity status is set forth in terms of that there "should" be such a determination, rather than there "must" be such a determination. In view of the ease with which small entity status would now be obtainable, it is deemed advisable to provide an explicit direction that a determination of entitlement to small entity status pursuant to § 1.9 be made before its assertion. Consideration was given to making the need for a determination a requirement rather than advisory; however, the decision was made to make it advisory, particularly in view of the following possible scenario: One of three inventors submits a written assertion of entitlement to small entity status without making any determination of entitlement to such status, such as by checking with the other two inventors to see if they have assigned any rights in the invention.

Small entity status was proper at the time asserted notwithstanding the lack of a proper determination. If the determination is set forth as a requirement ("must"), the lack of such a determination might act to cause an unduly harsh result where small entity status was in fact appropriate and the failure to check prior to assertion was innocent. It is recognized that the use of "should" may cause concern that a cavalier approach to asserting entitlement to small entity status may be taken by encouraging some who are asserting status not to make a complete determination as the determination is not set forth as being mandatory. On balance, it is thought that the use of "should" would lead to more equitable results. The danger of encouraging the assertion of small entity status without a prior determination as to qualification for small entity status is thought to be small, because, should status turn out to be improper, the lack of a prior determination may result in a failure to meet the lack of deceptive intent requirements under § 1.27(g) or § 1.28(c). The Office has noted that any attempt to improperly establish status as a small entity will be viewed as a serious matter. See MPEP 509.03.

Removal of Status

Section 1.27 is also proposed to be clarified (paragraph (f)(2)) that once small entity status is established in an application, any change in status from small to large, would also require a specific written assertion to that extent, rather than only payment of a large entity fee, similar to current practice. For example, when paying the issue fee in an application that has previously been accorded small entity status and the required new determination of continued entitlement to small entity status reveals that status has been lost, applicant should not just simply pay the large issue fee or cross out the recitation of small entity status on the returned copy of the notice of allowance (PTOL-85(b)), but submit a separate paper requesting removal of small entity status pursuant to proposed § 1.27(f)(2).

Correction of any inadvertent and incorrect establishment of small entity status would be by way of a paper under proposed § 1.28(c) as in current practice.

Response to Comments

Many comments supported the proposal without qualification. Only two, however, explicitly mentioned the payment option for obtaining small entity status with one recognizing that any error is now easier to correct under § 1.28(c). Others would eliminate the possibility of obtaining small entity

status based on payment of the exact small entity basic filing (or national fee) due to possible error in paying an unintended small entity basic filing (or national fee) and being accorded an unwanted small entity status. There was only one total opposition to the proposal as a "bad" idea.

Comment: Several comments supported the proposal as a positive change that is both helpful to applicants and attorneys and one that will reduce the cost of establishing small entity status, particularly where there are multiple forms required due to joint ownership or licensing of multiple rights. It was noted that the proposal eliminates the time-consuming requirement for obtaining a signature of a person, such as an officer of the company, who may not have been involved in the application drafting process. It was also stated that the need to withhold the filing fee on filing an original application would be eliminated where the current small entity statement cannot be signed in time.

Response: The comments were adopted. The proposal from the Advance Notice is being carried forward in the instant notice. The particular parties who may assert entitlement to small entity status is being further liberalized over the Advance Notice to include only one of the inventors or a partial assignee.

Comment: One individual opposed the proposal because the submission of a paper is the only effective way an attorney can be certain that a client is complying with the requirements for small entity status. Eliminating the form removes the incentive of the client to provide the attorney with needed information, particularly with respect to foreign clients.

Response: A copy of §§ 1.9 and 1.27 can be supplied to a client as easily as the form and should be just as effective with foreign clients. It is not seen that the requirement of signing the form would be a more certain means that compliance exists than if the client would have to state to the attorney, either orally or in a letter, that the client complies with the requirements for asserting entitlement to small entity status. The form itself does not provide the underlying factual basis for entitlement to small entity status. It merely recites the requirement of § 1.9 and that the party executing it seeks small entity status. The attorney is not now required to confirm that a client is in compliance once the form is signed by the client and would not be required to make such confirmation under the proposal. It would continue to be up to

the client to determine whether it wishes to assume whatever risk there may be should it decide to do the small entity determination by itself rather than rely on the attorney for aid.

Comment: A few comments would eliminate the option of asserting small entity status by payment of the basic filing (or national fee) due to possible errors in fee payments thereby obtaining unwanted small entity status. One comment recognized that the Office's adoption in the last rulemaking of a straightforward approach to correction under § 1.28(c) would make correction of improper status for good faith errors a simple procedure.

Response: The comment seeking elimination of the payment option is not adopted. The comment noting the previous easing of correction for good faith errors so that the possibility of inadvertent errors should not be a bar to the payment option is adopted. It is expected that this would occur very infrequently if at all in that the exact small entity amount must be submitted. Only errors in amounts paid where the error was the exact small entity amount for the basic filing (or national fee) would trigger small entity status. In view of the continued need for an affirmative determination of entitlement to small entity status to be made, the error would mostly occur by a misreading of a fee chart. Such type of error if it inadvertently leads to the establishment of small entity status would be easily correctable by the current § 1.28(c).

Comment: Some comments sought to ensure that the written assertion would be easy to make by adding a check box to provide for an assertion on: Office forms, the § 1.63 declaration, on the application, or on the transmittal sheet.

Response: The comments are adopted to the extent that this is an implementation issue to be addressed when a final rule is issued. The Office intends at this time to at least supply a check box on its application transmittal forms.

Paragraph by Paragraph Analysis

Section 1.27 is proposed to be amended in its title to recognize a new means of establishing small entity status by replacing "statement" with "assertion," to indicate that an assertion of small entity status would permit the payment of small entity fees, and to reflect transfer of subject matter from § 1.28 relating to determination of entitlement to and notification of loss of entitlement to small entity status, and fraud on the Office.

Paragraphs (a) through (d) of § 1.27 is proposed to be reformatted and

amended to recite "assertion" as a new means for establishing small entity status to replace "statement", and new paragraphs (e), (f)(1) and (f)(2), and (g) are proposed to be added.

Paragraph (b) of § 1.27 is proposed to be reformatted to add paragraphs (b)(1) through (b)(4) of § 1.27. Paragraph (b) (1) of § 1.27 would permit assertion of small entity status by a writing that is clearly identifiable as present ((b)(1)(i)), signed ((b)(1)(ii)), and convey the concept of small entity status without the need for specific words but with a clear indication of an intent to assert entitlement to small entity status ((b)(1)(iii)). Paragraph (b)(2) of § 1.27 would make submission of a written assertion to obtain small entity status easier in view of increased categories of parties who could submit such a paper. The parties who could sign the written assertion are identified as: one of the parties who can currently submit a paper under § 1.33(b) ((b)(2)(i) of § 1.27), at least one of the inventors ((b)(2)(ii) of § 1.27) rather than all the inventors (applicants) as required by § 1.33(b)(4) for other types of papers, or a partial assignee ((b)(2)(iii) of § 1.27) rather than all the partial assignees and any applicant retaining an interest as required by § 1.33(b)(3) for other types of papers. A § 3.73(b) certification would not be required for an assignee under either paragraphs (b)(2)(i) or (iii). Paragraph (b)(3) of § 1.27 would permit the payment, by any party, of an exact amount of one of the small entity basic filing or national fees set forth in § 1.16(a), (f), (g), (h), or (k), or § 1.492(a)(1) through (a)(5) to be treated as a written assertion of entitlement to small entity status even where an incorrect type of basic filing or national fee is inadvertently selected in error. Paragraph (b)(3)(i) would provide that where small entity status was accorded based on the payment of a wrong type of small entity basic filing or national fee, the correct small entity amount would still be owed. Paragraph (b)(3)(ii) would provide that payment of a small entity fee in its exact amount for a fee other than what is provided for in paragraph (b)(3) would not be sufficient to establish small entity status absent a concomitant written assertion of entitlement to small entity status. After a basic filing or national fee is paid as a large entity, a refund under § 1.28(a) of the large entity portion can only be obtained by establishing small entity status by a written assertion and not by paying a second basic filing or national fee in a small entity amount. Payment of a large entity basic filing or national fee precludes paying a second basic

filing or national fee in a small entity amount to establish small entity status. Paragraph (b)(4) of § 1.27 recites material transferred from current § 1.28(a)(2).

Paragraph (c) of § 1.27 is proposed to be amended to provide that fees other than the basic filing and national fees can only be paid in small entity amounts if submitted with or subsequent to a written assertion of entitlement to small entity status. The paragraph would clarify that an exception exists under § 1.28(a) for refunds of the large entity portion of a fee within three months of payment thereof if the refund request is accompanied by a written assertion of entitlement to small entity status.

Paragraph (d)(1) of § 1.27 is proposed to be amended to reference § 1.28(b) as the means of changing small entity status. It would be clarified that where rights in an invention are assigned, or there is an obligation to assign, to a small entity subsequent to an assertion of entitlement to small entity status, a second assertion is not required. Paragraph (d)(2) would clarify that once small entity status is withdrawn a new written assertion would be required to again obtain small entity status.

Paragraph (e) of § 1.27 is proposed to be added to clarify the need to do a determination of entitlement to small entity status prior to asserting small entity status, and that the Office generally does not question assertions of entitlement to small entity status.

Paragraph (f)(1) of § 1.27 is proposed to be added to contain material transferred from current § 1.28. Paragraph (f)(2) is proposed to be added to revise the current reference to the party who can sign a notification of loss of entitlement to small entity status to require a party identified in § 1.33(b).

Paragraph (g) of § 1.27 is proposed to be added to contain material transferred from paragraphs (d)(1) and (d)(2) of current § 1.28 relating to fraud attempted or committed on the Office in regard to paying small entity fees.

Section 1.28: Section 1.28 is proposed to be amended to be entirely reformatted with some material transferred to § 1.27.

Section 1.28(a) is proposed to be amended to allow a three-month period (presently a two-month period) for refunds based on later establishment of small entity status. See further discussion in § 1.28(b)(1).

Section 1.28(b)(1) is proposed to be amended to refer to § 1.22(c). Section 1.22(c) sets forth that the filing date for an authorization to charge fees starts the period for refunds under § 1.28(a). The current time period for a refund request is two months from payment of the full

fee and the date of payment for refund purposes can vary depending on the means the applicant used to pay the required fee. For example, if the applicant paid the required fee by check, the date of payment is the date on which the fee paper, including the check, was filed in the Office. If the applicant authorized a charge to a deposit account, however, the date of payment is the date the Office debited the deposit account. In view of the proposed change in practice under §§ 1.22(c) and 1.28(b)(1) to accord the same date of payment for checks and authorizations to charge deposit accounts, the refund period would be extended to three months in order to in-part offset any shortening of the refund time period that may result in starting the time period from the filing date of the fee paper instead of the debit date for an authorization to charge a deposit account. Additionally, in view of changes in practice under § 1.27 to ease the claiming of small entity status, the need for refunds should diminish, and the different payment date of an authorization to charge a deposit account for small entity refund purposes should not cause much inconvenience to applicants.

Section 1.28(b)(2) is proposed to be amended to state that the deficiency amount owed under § 1.28(c) is calculated by using the date on which the deficiency was paid in full.

Section 1.28(c) is proposed to be amended to require that deficiency payments must be submitted separately for each file (§ 1.28(c)(1)) and must include the itemization of the deficiency payment by identifying: type of fee along with the current fee amount (§ 1.28(c)(2)(ii)(A)), the small entity amount paid and when (§ 1.28(c)(2)(ii)(B)), the deficiency owed for each individual fee paid in error (§ 1.28(c)(2)(ii)(C)), the total deficiency payment owed (§ 1.28(c)(2)(ii)(D)), and that any failure to comply with the separate payment and itemization requirements would allow the Office at its option to charge a processing fee or set a non-extendable one month period for compliance to avoid return of the paper (§ 1.28(c)(3)).

Paragraph by Paragraph Analysis

The title of § 1.28 is proposed to be revised to focus on refunds and on how errors in status are excused in view of transfer of material to § 1.27.

Paragraphs (a)–(c) of § 1.28 are proposed to be reformatted.

Paragraph (a)(1) of § 1.28 is proposed to be amended as paragraph (a).

Paragraph (a) of § 1.28 is proposed to be amended to clarify that the period for

a refund runs from payment of the “full fee,” and that it is the payment of the full fee that is considered the significant event relative to establishing status for a particular fee. Additionally, paragraph (a) would amend the time period for requesting a refund based upon later establishment of small entity status. The proposed time period would be three months measured from the filing date of the fee paper.

Paragraph (a)(2) of § 1.28 is proposed to be amended to have some subject matter transferred to § 1.27(b)(4). The next to last sentence, relating to filing a continuing or reissue application and referencing a small entity statement in the prior application or patent, would be deleted as unnecessary. The currently required reference to status in the prior application or patent would be replaced by the equally easily written assertion of § 1.27(b)(1). Written references to small entity status in a prior application, including submission of a copy of the small entity statement in a prior application, submitted in a continuing application subsequent to the effective date of any final rule, would be liberally construed under the proposed § 1.27(b)(1)(iii). Similarly, the last sentence of current paragraph (a)(2) would be deleted as the payment option for establishing small entity status in continuing or reissue applications has been expanded in § 1.27(b)(3) to include all applications.

Caution: Although the Office intends to liberally construe what is deemed to be an assertion of small entity status, the concept of entitlement must be clearly conveyed.

Example: A prior application has been accorded small entity status. A continued prosecution application (CPA) under § 1.53(d) is filed with a general authorization to charge fees that does not state that the fees to be charged are small entity fees. Even though the CPA contains the same application number as its prior application (and the small entity statement), it would not be accorded small entity status and large entity filing fees would be immediately charged. This would be so because a new determination of entitlement to small entity status must be made upon filing of a new application, such as a CPA. Accordingly, in filing the CPA there must be some affirmative act to indicate that the determination has been done anew and small entity status is still appropriate. Where a copy of the small entity statement from the prior application, or a written assertion in the CPA application transmittal letter, or an authorization to charge small entity fees were present, the result would be reversed and small entity status would be accorded the CPA application on filing.

Paragraph (a)(3) of § 1.28 is proposed to be amended to have its subject matter transferred to § 1.27(d)(1).

Paragraph (b) of § 1.28 is proposed to be amended to have its subject matter transferred to § 1.27(f)(1) and (2). New paragraphs (b)(1) and (b)(2) are proposed to be added. Paragraph (b)(1) of § 1.28 would refer to § 1.22(c) to define the date a fee is paid for the purpose of starting the three-month period for refund. Current practice for authorizations to charge deposit accounts is to give benefit of the date that the deposit account is actually debited by the Office, which is a later time than when the paper authorizing charge of the fee to a deposit account is filed with the Office. Current practice would therefore be changed so that it is the date the paper is filed, not the date of debit of the fee, that would start the three-month refund period. Paragraph (b)(2) of § 1.28 would refer to § 1.22(c) to define the date when a deficiency payment is paid in full, which is the date that determines the amount of deficiency that is due.

Example: A small entity issue fee has been paid in error in January and a paper under § 1.28(c) was submitted the following June with the deficiency payment. The deficiency payment of the issue fee was incorrectly determined so that the full amount owed (for the issue fee) was not submitted in June. If the mistake in the June payment is not discovered until the following November, the extra amount owed must be recalculated to take into account any October 1 increase in the issue fee.

Paragraph (c) of § 1.28 is proposed to be amended to recite that separate submissions, including separate payments and itemizations, are required for any deficiency payment. Paragraph (c)(1) would require that a deficiency paper/submission be limited to one application or patent file. Where, for example, the same set of facts has caused errors in payment in more than one application and/or patent file, a separate paper would need to be submitted in each file for which an error is to be excused. Paragraph (c)(2) would now require that for each fee that was erroneously paid in error the following itemization be provided: The particular fee (e.g., basic filing fee, extension of time fee) (paragraph (c)(2)(ii)(A)), the small entity fee amount actually paid and when (for example, distinguishing between two one-month extension of time fees erroneously paid on two different dates) (paragraph (c)(2)(ii)(B)), the actual deficiency owed for each fee previously paid in error (paragraph (c)(2)(ii)(C)), and the total deficiency owed that is the sum of the individual deficiencies owed (paragraph (c)(2)(ii)(D)). Paragraph (c)(3) would address the failure to comply with the separate submission, including separate

payment and itemization requirements of paragraph (c)(1) and (2) of this section. Paragraph (c)(3), upon failure to comply, would permit the Office at its option either to charge a processing fee (§ 1.17(i) would be suitably amended) to process the paper or require compliance within a one-month non-extendable time period to avoid return of the paper.

Paragraphs (d) (1) and (2) of § 1.28, are proposed to be amended to have the material relating to fraud attempted or committed on the Office as to paying of small entity fees, transferred to § 1.27(g). New paragraph (d) of § 1.28 is proposed to be added to clarify that any paper submitted under paragraph (c) of § 1.28 would also be treated as a notification of loss of small entity status under paragraph (f)(2) of § 1.27.

Section 1.33: Paragraph (a) of § 1.33 would be reformatted to create additional paragraphs (a)(1) and (a)(2) to separately identify the parties who can change a correspondence address depending upon the presence or absence of a § 1.63 oath/declaration. The revision is intended to make clear what may be a confusing practice to applicants as to which parties can set forth or change a correspondence address when an application does not yet have a § 1.63 oath or declaration by any of the inventors. See § 1.14(d)(4) for a similar change regarding status and access information. References to a § 1.63 oath/declaration are intended to mean an executed oath/declaration by any inventor, but not necessarily all the inventors.

Paragraph (a) of § 1.33 is proposed to be amended to provide that in a patent application the applicant must, either in an application data sheet (§ 1.76) or in a clearly identifiable manner elsewhere in any papers submitted with an application filing, specify a correspondence address to which the Office will send notices, letters and other communications in or about the application. It is now stated that where more than one correspondence address is specified, the Office would determine which one to establish as the correspondence address. This is intended to cover the situation where an unexecuted application is submitted with conflicting correspondence addresses in the application transmittal letter and in an unexecuted oath/declaration, or other similar situations.

Paragraph (a) of § 1.33 would request the submission of a daytime telephone number of the party to whom correspondence is to be addressed. While business is to be conducted on the written record, § 1.2, a daytime telephone number would be useful in initiating contact that could later be

reduced to a writing. The phone number would be changeable by any party who could change the correspondence address.

Paragraph (a)(1) of § 1.33 would provide that any party filing the application and setting forth a correspondence address could later change the correspondence address provided that a § 1.63 oath/declaration by any of the inventors has not been submitted. The parties who may so change the correspondence address would include only the one inventor filing the application even if more than one inventor was identified on the application transmittal letter. If two of three inventors filed the application, the two inventors filing the application would be needed to change the correspondence address. Additionally, any registered practitioner named in the application transmittal letter, or a person who has the authority to act on behalf of the party that will be the assignee (if the application was filed by the party that will be the assignee), could change the correspondence address. A registered practitioner named in a letterhead would not be sufficient, but rather a clear identification of the individual as being a representative would be required. The intent is to permit a company (to whom the invention has been assigned, or to whom there is an obligation to assign the invention) who files an application, to designate the correspondence address, and to change the correspondence address, until such time as a (first) § 1.63 oath/declaration is filed. The mere filing of a § 1.63 oath/declaration, that does not include a correspondence address, including when the company is only a potential partial assignee would not affect any correspondence address previously established on filing of the application, or changed per paragraph (a)(1) of this section. The expression "party that will be the assignee" rather than assignee is used in that until a declaration is submitted, inventors have only been identified and any attempted assignment, or partial assignment, cannot operate for Office purposes until the declaration is supplied. Hence, the mere identification of a party as a party that will be an assignee or assignee would be sufficient for it to change the correspondence address without resort to § 3.73(b).

Paragraph (a)(2) of § 1.33 would retain the current requirements for changing a correspondence address when a § 1.63 oath/declaration by any of the inventors has been filed. Where a correspondence address was set forth or changed pursuant to paragraph (a)(1) (prior to the

filing of a § 1.63 oath or declaration), that correspondence address remains in effect upon filing of a § 1.63 declaration and can then only be changed pursuant to paragraph (a)(2).

Paragraph (b) of § 1.33 would be simplified to make it easier to understand who are appropriate parties to file papers, particularly in view of the proposed change under § 3.71(b).

Paragraph (b)(3) of § 1.33 is proposed to be amended to add a reference to § 3.71.

Section 1.41: Section 1.41(a)(1) is proposed to be amended to indicate that a paper including the processing fee set forth in § 1.17(i) is required for supplying or changing the name(s) of the inventor(s) where an oath or declaration prescribed in § 1.63 is not filed during pendency of a nonprovisional application, rather than a petition including a petition fee, for consistency with the proposed amendment to § 1.17(i). Section 1.41(a)(2) is proposed to be amended to indicate that a paper including the processing fee set forth in § 1.17(q) is required for supplying or changing the name(s) of the inventor(s) where a cover sheet prescribed by § 1.53(c)(1) is not filed during the pendency of a provisional application, rather than a petition including a petition fee, for consistency with the proposed amendment to § 1.17(q). Section 1.41(a)(3) is proposed to be amended to delete the language concerning an alphanumeric identifier, and to provide that the name, residence, and citizenship of each person believed to be an actual inventor should be provided when the application papers pursuant to § 1.53(b) are filed without an oath or declaration or application papers pursuant to § 1.53(c) are filed without a cover sheet. Section 1.41(a)(4) is proposed to be added to set forth that the inventors who submitted an application under § 1.494 or § 1.495 are the inventors in the international application designating the United States.

Section 1.44: Section 1.44 is proposed to be removed and reserved to eliminate the requirement that proof of the power or authority of the legal representative be recorded in the Office or filed in an application under §§ 1.42 or 1.43.

Section 1.47: Section 1.47 is proposed to be amended to refer to "the fee set forth in § 1.17(h)" for consistency with the proposed amendment to § 1.17(h) and (i). See discussion of the proposed amendment to § 1.17. Section 1.47 is also proposed to be amended to add a new paragraph (c) providing that the Office will send notice of the filing of the application to all inventors who

have not joined in the application at the address(es) provided in the petition under § 1.47, and will publish notice of the filing of the application in the *Official Gazette*. This provision is currently included in each of § 1.47(a) and § 1.47(b). Section 1.47(c) is also proposed to provide that the Office may dispense with such notice provisions in a continuation or divisional application where notice regarding the filing of the prior application has already been sent to the nonsigning inventor(s). The patent statute gives the Office great latitude as to the notice that must be given to an inventor who has not joined in an application for patent. See 35 U.S.C. 116, ¶2 ("after such notice to the omitted inventor as [the Commissioner] prescribes"), and 118 (upon such notice to [the inventor] as the Commissioner deems sufficient"). Providing notice to a non-joined inventor in a continuation or divisional application places a significant burden on the Office, especially when such continuation or divisional application is filed using a copy of the oath or declaration from a prior application under § 1.63(d). In addition, providing additional notice to the non-joined inventor in the continuation or divisional application provides little (if any) actual benefit to the non-joined inventor, as identical notice was previously given during the processing of the prior application. Thus, the Office considers it appropriate to dispense with notice under § 1.47 in situations (continuations or divisionals of an application accorded status under § 1.47) in which the non-joined inventor was previously given such notice in a prior application.

Section 1.48: Section 1.48 is proposed to be amended to have the title revised to reference the statutory basis for the rule, 35 U.S.C. 116.

Section 1.48 paragraphs (a) through (c) are proposed to be amended to: delete the recitation of "other than a reissue application" as such words are unnecessary in view of the indication in the title of the section that the section does not apply to reissue applications and the revision to paragraph (a) (discussed below), to change "When" to "If," and to add "nonprovisional" before "application" where it does not already appear.

Sections 1.48 paragraphs (a)(1) through (e)(1) would be revised to replace the reference to a "petition" with a reference to a "request." What is meant to be encompassed by the term "petition," as it is currently used in the section, may be better defined by the term "request." The presence of "petition" currently in the section is misleading to the extent that it may

indicate to applicants that papers under this section have to be filed with the Office of Petitions when in fact amendments to correct the inventorship under § 1.48 are to be decided by the primary examiners in the Technology Centers and should be submitted there. See MPEP 1002.02(e). The requirements for a statement currently in § 1.48 paragraphs (a)(1), (c)(1), and (e)(1) would be placed in § 1.48 paragraphs (a)(2), (c)(2), and (e)(2) and corresponding changes made in subsequent paragraphs.

Section 1.48 paragraphs (b) and (d) are proposed to be revised to indicate that a request to correct the inventorship thereunder must be signed by a party as set forth in § 1.33(b) (which would enable a practitioner alone to sign all the needed papers). The inventors, whether being added, deleted or retained, are not required to participate in a correction under these paragraphs. Thus, the inventor(s) to be deleted pursuant to paragraph (b) in a nonprovisional application, or added pursuant to paragraph (d) in a provisional application, and those inventors that are retained in either situation, are not required to participate in the inventorship correction, such as by signing a statement of facts, or a new oath or declaration under § 1.63.

Section 1.48 paragraphs (a) through (e) are proposed to be revised to define the fee required as a "processing" fee, to delete the reference to a "petition," and to indicate that amendment of the application to correct the inventorship would require the filing of a request to correct the inventorship along with other items, as set forth in the respective paragraphs of this section. The latter change is not one of substance but a clarification that the amendment requirement of the statute, 35 U.S.C. 116, merely refers to the change in Office records (face of the application file wrapper corrected, notation on a previously submitted § 1.63 oath/declaration, change in Patent Application Location and Monitoring (PALM) data, and a corrected filing receipt issued) that would be made upon the grant of a § 1.48 request. Thus, amendment of the inventorship in an application is not made as an amendment under § 1.121. Where there is a need to make an actual § 1.121(a)(1) amendment, such as when a cover page of the specification recites the inventive entity, that should also be submitted. In the absence of such an amendment, the Office may, at its option, correct the inventor's names on the cover sheet or in the specification. Where an application needs correction of inventorship under § 1.48 and a paper is

submitted with a title that does not set forth the paper as a request under § 1.48, but it is clear from the papers submitted that an inventorship correction is desired, a request for a correction of inventorship under § 1.48 will be inferred from the papers submitted and will be treated under § 1.48.

A request for a corrected filing receipt correcting a typing or office error in the names of the inventors will not ordinarily be treated under § 1.48. Any request to correct inventorship should be presented as a separate paper. For example, placing a request under § 1.48(b) to correct the inventorship in the remarks section of an amendment may cause the Office to overlook the request and not act on it.

Paragraph (f)(1) of § 1.48 is proposed to be clarified to recite that its provision for changing the inventorship only applies if an oath or declaration under § 1.63 has not been submitted by any of the inventors, and that submission of an oath or declaration under § 1.63 by any of the inventors is sufficient to correct an earlier identification of the inventorship.

Example 1: An unexecuted application is filed identifying A, B, and C as the inventors. A § 1.63 declaration is also submitted signed only by A and naming A, B, and C as the inventors. To complete the application (§ 1.53(f)) a § 1.63 oath or declaration by B and C is needed. In attempting to reply to a Notice to File Missing Parts of Application requiring the missing oath or declaration by B and C it is discovered that D is also an inventor. A declaration by A, B, C, and D if submitted without a petition under § 1.48(a) to correct the inventorship to A–D from A–C will not be accepted as a reply to the Notice to File Missing Parts of Application.

Thus, it should be clear that a first oath or declaration under § 1.63 completed by less than all the inventors initially identified, when the oath or declaration is submitted when the application is filed (or after), will under § 1.48(f)(1) lock in the inventorship, and the later filing of another declaration by a different but complete inventive entity will not be effective under § 1.48(f)(1) to correct the inventorship.

Example 2: An application is filed identifying A, B, and C as the inventors in the application transmittal letter, and a § 1.63 declaration is concomitantly submitted only by A naming only A as the sole inventor. The inventorship of the application is A (because of the declaration of A). A later submitted § 1.63 declaration by A, B, and C would require a petition under § 1.48(a) to correct the inventorship to A, B, and C before the declaration by A, B, and C could be accepted.

Paragraph (f)(1) of § 1.48 is proposed to be amended to reference § 1.497(d) for submission of an executed oath or declaration naming an inventive entity

different from the inventive entity set forth in the international stage when entering the national stage under 35 U.S.C. 371 and §§ 1.494 or 1.495.

Section 1.48(h) is proposed to be added to indicate that the provisions of this section do not apply to reissue applications, and referencing §§ 1.171 and 1.175 for correction of inventorship in reissue applications.

Section 1.48(i) is proposed to be added to reference §§ 1.324 and 1.634 for corrections of inventorship in patents and interference proceedings, respectively.

Section 1.48 paragraphs (a) through (i) are proposed to have titles added to make locating the appropriate paragraph easier.

Section 1.51: Section 1.51(b) is proposed to be amended to include a reference to § 1.53(d), as a proper continued prosecution application under § 1.53(d) in which the basic filing fee has been paid is a complete application under § 1.51(b).

Section 1.52: Section 1.52(a) and (b) are proposed to be amended to clarify the paper standard requirements for papers submitted as part of the record of a patent application. Section 1.52(a) sets forth the paper standard requirements for all papers which are to become a part of the permanent records of the Office, and § 1.52(b) sets forth the paper standard requirements for the application (specification, including the claims, drawings, and oath or declaration) and any amendments or corrections to the application. Papers making up the application or an amendment or correction to the application must meet the requirements of § 1.52 (a) and (b), but papers submitted for the record that do not make up the application (e.g., a declaration under § 1.132) need not meet the requirements of § 1.52(b).

The Office is proposing in § 1.52(b)(6) an optional procedure for numbering the paragraphs of the specification, but not including the claims or the abstract. Although not required to do so, applicants would be strongly encouraged to present, at the time of filing, each paragraph of the specification as individually and consecutively numbered. The presentation of numbered paragraphs at the time of filing would facilitate the entry of amendments (in compliance with proposed § 1.121) during the prosecution of the application. If the paragraphs of the specification are not numbered at the time of filing, applicants would be urged, when the first response to an Office action is submitted, to supply a substitute specification including numbered

paragraphs, consistent with the requirement of § 1.121 for amending the specification. Thereafter, amendments would be made through the use of numbered paragraph replacement.

The proposal to include paragraph numbering is to provide a consistent and uniform basis for the amendment practice being proposed in § 1.121 and as an aid to transitioning into total electronic filing. The proposed rule language establishes a procedure for numbering the paragraphs of the specification at the time of filing. This procedure would facilitate the entry of amendments by providing a uniform method for identifying paragraphs in the specification, thus overcoming any differences created by word processor formatting and pagination variations. Concurrently proposed changes to § 1.121 for amendment practice would additionally require the submission of clean copies of numbered replacement paragraphs, which would eliminate much of the red ink associated with hand entry of amendments and expedite the Optical Character Recognition (OCR) scanning and reading employed in the patent printing process, ultimately resulting in patents containing fewer errors.

The Office will neither number the paragraphs or sections of the specification, nor accept any instructions from applicants to do the same.

The proposed procedure for paragraph numbering, in the interest of uniformity, encourages applicants to use four digit Arabic numerals enclosed within square brackets and including leading zeroes as the first element of the paragraph. The numbers and brackets should be highlighted in bold (e.g., [0001], [0002]), and should appear as the first part of the paragraph immediately to the right of the left margin. Approximately four character spaces should follow the bracketed number before the beginning of the actual text of the paragraph. Paragraph (or section) headers, such as "Description of the Invention" or "Example 3," are not considered part of any paragraph and should not be numbered. Nontext elements, such as tables, mathematical formulae, etc., are considered part of the paragraph around or above the element, and should not be numbered separately. All portions of any nontext elements should be kept from extending to the left margin.

Response to Comments: Although paragraph numbering (as it appears in proposed § 1.52) was not an independent topic in the Advance Notice, the proposal did appear in conjunction with the replacement

paragraph concept as part of Topic 13. While there was some opposition to paragraph numbering in the comments received relative to Topic 13 as being burdensome and inconsistent with the requirements of other countries, the Office proposes to move forward with this concept as the most effective plan currently under consideration for identifying paragraphs of the specification. The JPO and EPO have already begun to use paragraph numbering in their application and publication processing.

Some of the comments received in response to Topic 13 suggested identification of paragraphs by page and line number. Inasmuch as the Office proposal must be consistent with future electronic requirements, this suggestion of identification by page and line number could not be adopted in that fixed pages do not exist in documents created on a computer. Page and line numbering are affected by font size, line spacing and formatting and can vary between different hardware and software components. Once each paragraph has been individually identified and tagged with a number, however, all future processing of the application, whether by paper or electronic version, may be done uniformly and accurately by both the Office and the applicant.

Section 1.52(b)(7) is proposed to be added to provide that if papers submitted as part of the application do not comply with § 1.52 (b)(1) through (b)(5), the Office may require the applicant to provide substitute papers that comply with § 1.52(b)(1) through (b)(5), or the Office may convert the papers submitted by applicant into papers that do comply with § 1.52(b)(1) through (b)(5) and charge the applicant for the costs incurred by the Office in doing so (§ 1.21(j)).

Section 1.52(c) is proposed to be amended to provide that: (1) Alterations to the application papers must (rather than "should") be made before the oath or declaration is signed; (2) a substitute specification (§ 1.125) is required if the application papers do not comply with § 1.52(a) and (b) due to interlineations, erasures, cancellations or other alterations of the application papers; and (3) if an oath or declaration is a copy of the oath or declaration from a prior application, the application for which such copy is submitted may contain alterations that do not introduce matter that would have been new matter in the prior application.

Section 1.52(d) is proposed to be amended to provide separately for nonprovisional applications and provisional applications filed in a

language other than English. Section 1.52(d)(1) is proposed to be added to provide that: (1) If a nonprovisional application is filed in a language other than English, an English language translation of the non-English-language application, a statement that the translation is accurate, and the processing fee set forth in § 1.17(i) are required; and (2) if these items are not filed with the application, applicant will be notified and given a period of time within which they must be filed in order to avoid abandonment. Section 1.52(d)(2) is proposed to be added to provide that: (1) If a provisional application is filed in a language other than English, an English language translation of the non-English-language provisional application will not be required in the provisional application; but (2) if a nonprovisional application claims the benefit of such provisional application, an English-language translation of the non-English-language provisional application and a statement that the translation is accurate must be supplied if the nonprovisional application is involved in an interference (§ 1.630), or when specifically required by the examiner.

Section 1.53: Section 1.53(c)(1) is proposed to be amended to clearly provide that the cover sheet required by § 1.51(c)(1) may be an application data sheet (§ 1.76).

Section 1.53(c)(2) is proposed to be amended for clarity and to refer to "the processing fee set forth in § 1.17(q)" for consistency with the proposed amendment to § 1.17(q).

Section 1.53(d)(4) is proposed to be amended to eliminate the reference to a petition under § 1.48 for consistency with the proposed amendment to § 1.48. Section 1.53(d) is also proposed to be amended to add a new § 1.53(d)(10) to provide a reference to § 1.103(b) for requesting a limited suspension of action in a continued prosecution application (CPA) under § 1.53(d).

Section 1.53(e)(2) is proposed to be amended to require that a petition under § 1.53(e) be accompanied by the fee set forth in § 1.17(h), regardless of whether the application is filed under § 1.53(b), § 1.53(c), or § 1.53(d). While provisional applications filed under § 1.53(c) are not subject to examination under 35 U.S.C. 131 (35 U.S.C. 111(b)(8)), petitions under § 1.53(e) in provisional applications under § 1.53(c) are as burdensome as petitions under § 1.53(e) in nonprovisional applications under § 1.53(b) or § 1.53(d). Therefore, it is appropriate to charge the petition fee set forth in § 1.17(h) for petitions under § 1.53(e) in applications filed under § 1.53(b), § 1.53(c), or § 1.53(d).

Section 1.53(f) and (g) are proposed to be amended for clarity and to include a reference to "or reissue" in the paragraph heading to clarify that the provisions of § 1.53(f) apply to all nonprovisional applications, which include continuation, divisional, and continuation-in-part applications, as well as reissue applications and continued prosecution applications. Section 1.53(f) is also proposed to be amended to provide that if applicant does not pay one of either the basic filing fee or the processing and retention fee set forth in § 1.21(l) during the pendency of the application (rather than within one year of the mailing of a Notice to File Missing Parts of Application), the Office may dispose of the application.

Section 1.55: Section 1.55(a) is proposed to be amended to refer to "the processing fee set forth in § 1.17(i)" for consistency with the proposed amendment to § 1.17(h) and (i). See discussion of the proposed amendment to § 1.17.

Section 1.55(a)(2)(i) through (iii) is proposed to clarify the current Office practice concerning when the claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) must be filed. Specifically § 1.55(a)(2)(i) clarifies current Office practice that in an application filed under 35 U.S.C. 111(a) that the Office requires the claim for priority and the certified copy of the foreign application be filed before a patent is granted. Section 1.55(a)(2)(ii) clarifies current Office practice that in an application that entered the national stage of an international application after compliance with 35 U.S.C. 371, the time limits set in the PCT and the Regulations under the PCT control the time limit for making the claim for priority, while the certified copy of the foreign application must be filed before the patent is granted if the certified copy was not filed in accordance with the PCT and the Regulation under the PCT. Section 1.55(a)(2)(iii) clarifies current Office practice that the Office may require both the claim for priority and certified copy of the foreign application be filed at an earlier time than in §§ 1.55(a)(2)(i) or 1.55(a)(2)(ii) under certain circumstances.

Section 1.55(a)(2)(iv) is also proposed to provide that priority claims and documents may be submitted after payment of the issue fee but with no further review by the Office other than placement in the application file. Changes to the patent printing process will dramatically reduce the period between the date of issue fee payment and the date a patent is issued. See

Filing of Continuing Applications, Amendments, or Petitions after Payment of Issue Fee, Notice, 1221 Off. Gaz. Pat. Office 14 (April 6, 1999); and Patents to Issue More Quickly After Issue Fee Payment, Notice, 1220 Off. Gaz. Pat. Office 42 (March 9, 1999). Thus, it is now difficult for the Office to match a petition containing a priority claim or certified priority document filed after payment of the issue fee with an application file, and determine whether the applicant has met the conditions of 35 U.S.C. 119(a)–(d) to make the priority claim, before the date the application will issue as a patent. Nevertheless, it is also undesirable to prohibit applicants from filing a priority claim or certified priority document between the date the issue fee is paid and the date a patent is issued. Therefore, the Office will permit applicants to file a priority claim or certified priority document (with the processing fee set forth in § 1.17(i)) between the date the issue fee is paid and the date a patent is issued. The Office will, however, merely place such submission in the application file but will not attempt to determine whether the applicant has met the conditions of 35 U.S.C. 119(a)–(d) to make the priority claim nor include the priority claim information in the text of the patent. In such a situation (as is currently the situation when a petition under § 1.55 is granted), the patent will not contain the priority claim information, and the patentee may request a certificate of correction under 35 U.S.C. 255 and § 1.323 at which point a determination of entitlement for such priority will be made.

Section 1.56: Section 1.56 is proposed to be amended to add a new § 1.56(e) to provide that in any continuation-in-part application, the duty under § 1.56 includes the duty to disclose to the Office all information known to the person to be material to patentability which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application. Section 1.63(e) currently requires that the oath or declaration in a continuation-in-part application acknowledge that the duty under § 1.56 includes the duty to disclose to the Office all information known to the person to be material to patentability (as defined in § 1.56(b)) which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application. Thus, the examiner must object to an oath or declaration in a continuation-in-part that does not contain this statement. By

amending § 1.56 to expressly provide that the duty under § 1.56 includes this duty, an acknowledgment of the duty of disclosure under § 1.56 is an acknowledgment of this duty in a continuation-in-part application, and an express statement to that effect in the oath or declaration will no longer be required.

Section 1.59: Section 1.59 is proposed to be amended to refer “the fee set forth in § 1.17(h)” for consistency with the proposed amendment to § 1.17(h) and (i). See discussion of the proposed amendment to § 1.17.

Section 1.63: Section 1.63 is proposed to be amended for clarity and simplicity. Section 1.63(a) is proposed to be amended to set forth the oath or declaration requirements that are requirements of 35 U.S.C. 115 (and thus cannot be waived by the Office pursuant to § 1.183). Specifically, § 1.63(a) is proposed to be amended to provide that an oath or declaration filed under § 1.51(b)(2) as a part of a nonprovisional application must: (1) Be executed (*i.e.*, signed) in accordance with either § 1.66 or § 1.68; (2) identify each inventor and country of citizenship of each inventor; and (3) state that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

Section 1.63(b) is proposed to be amended to provide that in addition to meeting the requirements of § 1.63(a), the oath or declaration must also: (1) Identify the application to which it is directed; (2) state that the person making the oath or declaration has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration; and (3) state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56. These requirements are currently located at § 1.63(a)(2), (b)(1), and (b)(3).

Section 1.63(c) is proposed to provide that an applicant may provide identifying information either in an application data sheet (§ 1.76) or in the oath or declaration. Permitting applicants to provide such identifying information in an application data sheet (rather than in the oath or declaration) should result in: (1) An increase in the use of application data sheets; and (2) a decrease in the need for supplemental oaths or declarations (providing omitted information) for applications in which

an application data sheet was submitted.

Section 1.63(e) is proposed to be amended to eliminate the requirement that an oath or declaration in a continuation-in-part application state that the person making the oath or declaration also acknowledge that the duty under § 1.56 includes the duty to disclose to the Office all information known to the person to be material to patentability (as defined in § 1.56(b)) which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application. See discussion of the proposed amendment to § 1.56(e).

Section 1.64: Section 1.64 is proposed to be amended to also refer to any supplemental oath or declaration (§ 1.67). In addition, § 1.64(b) is proposed to be amended to provide that if the person making the oath or declaration is the legal representative, the oath or declaration shall state that the person is the legal representative and shall also state the citizenship, residence and mailing address of the legal representative.

Section 1.67: Section 1.67(a) is proposed to be amended to also refer to § 1.162, and to provide that if the earlier-filed oath or declaration complied with § 1.63(a), the Office may permit the supplemental oath or declaration to be made by fewer than all of the inventors or by an applicant other than the inventor.

Section 1.67(c) is proposed to be deleted as unnecessary because it simply reiterates other provisions of the rules of practice. If the application was altered after the oath or declaration was signed (except as permitted by § 1.52(c)), § 1.52(c) requires a supplemental oath or declaration under § 1.67. If the oath or declaration was signed in blank (while incomplete), without review thereof by the person making the oath or declaration, or without review of the specification, including the claims, the oath or declaration does not meet the requirements of § 1.63. In this situation, § 1.67(a) requires a supplemental oath or declaration.

Section 1.72: Section 1.72(a) is proposed to be amended to state “[u]nless the title is supplied in an application data sheet (§ 1.76)” to clarify that the title is not requested to be a heading on the first page of the specification if supplied in an application data sheet. Section 1.72(b) is proposed to be amended to provide that “[t]he abstract in an application filed under 35 U.S.C. 111 may not exceed 150

words in length" to harmonize with PCT guidelines.

Section 1.76: A new § 1.76 is proposed to be added to provide for the inclusion of an application data sheet in an application. Section 1.76(a) is proposed to: (1) Explain that an application data sheet is a sheet or set of sheets containing bibliographic information concerning the associated patent application, which is arranged in a specified format; and (2) when an application data sheet is provided, the application data sheet becomes part of the application. While the use of an application data sheet is optional, the Office would prefer its use to help facilitate the machine reading of this important information. Entry of the information in this manner is more timely and accurate than the current practice of presenting the information on numerous other documents. Applicants benefit from the use of application data sheets by being provided with more accurate and timely filing receipts, by reducing the time required to collect bibliographic information and by having such information printed on the granted patents. The applicant also benefits by receiving an official notice of the receipt of papers from the Office at an earlier stage of the processing.

Section 1.76(b) is proposed to provide that bibliographic data as used in § 1.76(a) includes: (1) applicant information; (2) correspondence information; (3) specified application information; (4) representative information; (5) domestic priority information; and (6) foreign priority information. Section 1.76(b) as proposed also reminds applicants that the citizenship of each inventor must be provided in the oath or declaration under § 1.63 (as is required by 35 U.S.C. 115) even if this information is provided in the application data sheet.

Applicant information includes the name, residence, mailing address, and citizenship of each applicant (§ 1.41(b)). The name of each applicant must include the family name, and at least one given name without abbreviation together with any other given name or initial. If the applicant is not an inventor, this information also includes the applicant's authority (§§ 1.42, 1.43 and 1.47) to apply for the patent on behalf of the inventor.

Correspondence information includes the correspondence address, which may be indicated by reference to a customer number, to which correspondence is to be directed (see § 1.33(a)).

Application information includes the title of the invention, the total number of drawing sheets, whether the drawings

are formal, any docket number assigned to the application, the type (e.g., utility, plant, design, reissue utility, provisional) of application. Application information also indicates whether the application discloses any significant part of the subject matter of an application under a secrecy order pursuant to § 5.2 of this chapter (see § 5.2(c)).

Representative information includes the registration number of each practitioner, or the customer number, appointed with a power of attorney or authorization of agent in the application. Section 1.76(b)(4) is proposed to state that providing this information in the application data sheet does not constitute a power of attorney or authorization of agent in the application (see § 1.34(b)). This is because the Office does not expect the application data sheet to be executed (signed) by the party (applicant or assignee) who may appoint a power of attorney or authorization of agent in the application.

Domestic priority information includes the application number (series code and serial number), the filing date, the status (including patent number if available), and relationship of each application for which a benefit is claimed under 35 U.S.C. 119(e), 120, 121, or 365(c). Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120. While the rules of practice (§ 1.78(a)(2) or § 1.78(a)(4)) require that this claim or specific reference be in the first line of the specification the patent statute requires that a claim to the benefit of (specific reference to) a provisional (35 U.S.C. 119(e)(1)) or nonprovisional (35 U.S.C. 120) be in the application. Since the application data sheet (if provided) is considered part of the application, the specific reference to an earlier filed provisional or nonprovisional application in the application data sheet meets the "specific reference" requirement of 35 U.S.C. 119(e)(1) or 120.

Foreign priority information includes the application number, country, and filing date of each foreign application for which priority is claimed, as well as any foreign application having a filing date before that of the application for which priority is claimed. Providing this information in the application data sheet constitutes the claim for priority as required by 35 U.S.C. 119(b) and § 1.55(a). The patent statute (35 U.S.C. 119(b)) does not require that a claim to the benefit of a prior foreign application take any particular form.

Section 1.76(c) as proposed indicates that inconsistencies between the information in the application data sheet (if provided) and the oath or declaration under § 1.63 will be resolved in favor of the application data sheet. This is because the application data sheet (and not the oath or declaration) is intended as the means by which applicants will provide information to the Office. Section 1.76(c) is also proposed to provide that a supplemental application data sheet may be submitted to correct or update information provided in a previous application data sheet.

Section 1.77: Section 1.77(a) is proposed to be separated into sections 1.77(a) and 1.77(b). New § 1.77(a) would list the order of the papers in a utility patent application, including the proposed application data sheet (see § 1.76). New § 1.77(b) would list the order of the sections in the specification of a utility patent application. Current § 1.77(b) is proposed to be redesignated 1.77(c).

Section 1.78: Section 1.78(a)(2) is proposed to be amended to provide that the specification must contain or be amended to contain a specific reference required by 35 U.S.C. 120 in the first sentence following the title, unless the reference is included in an application data sheet. Section 1.78(a)(4) is proposed to be amended to provide that the specification must contain or be amended to contain a specific reference required by 35 U.S.C. 119(e)(1) in the first sentence following the title, unless the reference is included in an application data sheet. See discussion of proposed § 1.76(b)(5).

Section 1.78(c) is proposed to be amended for consistency with § 1.110 and for clarity.

Section 1.84: Section 1.84 is proposed to be amended to delete some requirements that are more stringent than the requirements of the PCT, while retaining the provisions related to acceptance of color drawings/photographs which are, at this time, more lenient.

The Office is proposing to delete the petition requirements in § 1.84(a)(2) and § 1.84(b)(1) and the requirement for three copies of black and white photographs. This change would make § 1.84 consistent with current Office practice. See Interim Waiver of 37 CFR § 1.84(b)(1) for Petitions to Accept Black and White Photographs and Advance Notice of Change to M.P.E.P. § 608.02, Notice, 1213 Off. Gaz. Pat. Office 108 (August 4, 1998); and Interim Waiver of 37 CFR 1.84(b)(1) for Petitions to Accept Black and White Photographs Filed with only One Set of Photographs, Notice,

1211 Off. Gaz. Pat. Office 34 (June 9, 1998). In addition, paragraphs (d), (h), (i), (j), (k)(1) and (3), (m), (n), (p), (r), (s), and (x) of § 1.84 are proposed to be deleted for simplification. These paragraphs describe characteristics of patent drawings which are desirable because they assist in clearly communicating the disclosed invention, but which are not necessary for the reproduction of drawings. The requirements set forth in paragraphs (d), (h), (i), (j), (k)(1) and (3), (m), (n), (p), (r), (s), and (x) of § 1.84 will continue to be described in the MPEP and/or publications such as the Guide for the Preparation of Patent Drawings.

Section 1.84(g) is proposed to be changed to 1.84(f). In addition, the dimensions of sight on 21.6 cm by 27.9 cm (8½ by 11 inch) drawing sheets are proposed to be changed 17.0 cm by 24.4 cm (6¾ by 9⅝ inches) to standardize the sight with that for A4 paper.

In Topic 5 of the Advance Notice the Office proposed to harmonize patent drawing standards with those of the PCT. The Office received a number of comments. The majority of the comments welcomed a single standard for patent drawings in PCT and United States patent applications so long as applicants do not lose their ability to file color drawings/photographs or to use 8½ by 11 paper. Some expressed confusion about the exact requirements of the PCT and its regulations. Furthermore, many commented that drawing standards should be enforced in the same manner, and that drawings should not be objected to in the national stage if they were not objected to in the international stage. In this vein, several argued that only the patent examiners should be allowed to review the patent drawings. If the examiners could understand the invention from the drawings, no draftsman should be permitted to make "petty objections" unrelated to how well the invention is disclosed in the drawings. On the other hand, several people commented that the standards for PCT applications are too low, since many PCT applications are published with illegible drawings or drawings that do not adequately communicate the invention. Several observed that the PCT rules do not permit color drawings or photographs and stated that the requirements of the two systems should be the same. Others observed that the PCT rules essentially require formal drawings on filing, which is contrary to U.S. practice, and argued that such a policy would be unnecessarily expensive to applicants.

Careful consideration of the comments and the business practice of drawing review has led the Office to

conclude that, in general, drawings should only be objected to by the Office if they cannot be reproduced or there is an error in the drawings. The Office should accept drawings that would be acceptable under the PCT rules, but should not copy PCT rules solely for the sake of uniformity. A proper application of a low standard for drawing review will result in fewer drawings being objected to and fewer corrected or formal drawings being filed after allowance of a patent application. This should reduce delays during the printing cycle (during which time the Office waits for corrected or formal drawings to be filed). Applicants who submit informal drawings on filing will be unlikely to encounter a draftsman's objection because few drawings will fail to meet the reduced standards. Any formal drawings filed after allowance which were not required by the Office, however, are unlikely to be included in the printed patent because the printing process will have begun before payment of the issue fee and the formal drawings are unlikely to catch up to the application file in time to be included in the printed patent.

Patents printed with high quality drawings look better and should be easier to understand. Applicants interested in having their patents printed with good quality drawings should be motivated by their own interests to submit good quality drawings. However, the Office should not spend resources to insist upon high-quality drawings when lesser quality drawings would suffice to communicate the invention and to meet the printer's requirements. Accordingly, if applicants submit drawings which are of inferior quality, but acceptable to the Office, applicants should not be surprised when a patent issues with those very same drawings.

Section 1.84 is also proposed to provide for a fee for processing and printing patents with color drawings or photographs in color rather than in black and white. The petition fee set forth in § 1.84(a)(2)(i) is proposed to be deleted and a fee commensurate with the Office costs of handling and printing color photographs will be charged instead.

Many comments were received welcoming printing of patents in color, and stating that applicants would be willing to pay any required fees for their patent to be printed in color.

When filing international applications under the PCT, applicants must remember to consult the PCT and its regulations regarding requirements of drawings, especially the provisions related to amendment or correction of

drawings. While color drawings are permitted in U.S. patent applications, submission of color drawings in international applications is not permitted and may cause difficulties in international processing which cannot be overcome. Black and white drawings submitted after the international filing date to overcome objections to color drawings may be refused if they do not comply with the requirements of PCT Rule 91.1, which could result in significant loss to applicants.

Section 1.85: Section 1.85 is proposed to be amended to make the period for filing corrected or formal drawings in response to a Notice of Allowability a non-extendable period.

In Topic 7 of the Advance Notice the Office proposed to reduce the time for filing corrected or formal drawings after the mailing date of the "Notice of Allowability" from three months to one month. In response, many comments were received which explained that one month was too short of a period of time in which to make the necessary changes to the drawings. In addition, many stated that having two different time periods running against the applicant makes docketing of the required replies too complicated. Several comments received indicated that corrected or formal drawings should be required at the same time as the issue fee, with no opportunity for the drawings to be filed later. Others indicated that, while one month was too short of a period of time, two months would be adequate.

After consideration of the comments and the Office's business goal of decreasing cycle time for all inventions, the Office is proposing to amend § 1.85(c) to provide that corrected or formal drawings must be filed within three months of the date of mailing of the "Notice of Allowability" requiring such drawings, and that no extensions of time under § 1.136(a) or (b) will be permitted. Refusing to permit an extension of time when formal or corrected drawings cannot be filed within the three-month period and sufficient cause exists for an extension may appear to be harsh. A strong policy is considered necessary, however, to ensure that the drawings are filed within the set period. The Office has also considered that many applicants are in the habit of filing formal or corrected drawings with an extension of time and may, out of habit and ignorance of the rule change, continue to do so. These applicants will have to file a petition to revive under § 1.137(b) as the failure to timely file any formal drawings that were required will cause the application to go abandoned.

The Office is taking positive steps to make it easier for applicants to submit drawings which will be approved. See the changes proposed in § 1.84. Thus, the instances where formal drawings will be required when the case is allowable will be reduced as more drawings will be approved as submitted.

If the amendment to § 1.85 is adopted, the time period for filing any required supplemental oath or declaration in compliance with § 1.63 will be set to be the same non-extendable time period of three months from the date of mailing of the Notice of Allowability requiring the supplemental oath or declaration.

Section 1.91: Section 1.91(a)(3)(i) is proposed to be amended to refer to "[t]he fee set forth in § 1.17(h)" for consistency with the changes to § 1.17(h) and § 1.17(i). See discussion of changes to § 1.17(h) and § 1.17(i).

Section 1.96: The Office indicated in the Advance Notice that the submission of computer program listings on microfiche placed a burden on applicants and the Office, and that it was considering changes to § 1.96 to permit machine readable computer program listings to be submitted on electronic media in lieu of microfiche. See Changes to Implement the Patent Business Goals, 63 FR at 53510-12, 1215 Off. Gaz. Pat. Office at 99-100.

Section 1.96 is proposed to be amended to provide for voluminous program listings to be submitted on archival electronic media instead of microfiche. Section 1.96(b) is proposed to be amended to limit computer program listings that may be submitted as drawings or part of the specification to computer program listings that are contained on one sheet.

Under § 1.96 as proposed, any computer program listing may, and any computer program listing that would be contained on more than one sheet must, be submitted as a computer program listing appendix pursuant to § 1.96(c) (subject to the "transitional" practice discussed below).

Section 1.96(c) is specifically proposed to provide that a "computer program listing appendix" be submitted on a Compact Disk-Read Only Memory (CD-ROM) or Compact Disk-Recordable (CD-R). A CD-ROM is the only practical electronic medium of archival quality under the current standards of the National Archives and Records Administration (NARA). See 36 CFR 1228.188(c) and (d) and 1234.30. The Office considers CD-R to be an electronic medium having an archival quality equivalent to the archival quality of CD-ROM. The information so submitted will be considered a "computer program listing appendix"

(rather than a microfiche appendix). Section 1.96(c) will continue to require a reference at the beginning of the specification as itemized in § 1.77(b)(4). As with a microfiche appendix, the contents of the "computer program listing appendix" on a CD-ROM or CD-R will not be printed with the published patent, but will be available at the Office on a medium to be specified by the Office. The contents of a "computer program listing appendix" on a CD-ROM or CD-R may not be amended pursuant to § 1.121, but must be submitted on a substitute CD-ROM or CD-R. Section 1.96(c) does not apply to international applications filed in the United States Receiving Office.

Section 1.96(c)(1) is proposed to provide that the availability of the computer program will be directly analogous to that of the microfiche. The Office will make the contents available for inspection, for example at electronic workstations in the Public Search Room. If needed, multiple CD-ROMs or CD-Rs may be used for the submissions pertaining to a single patent application, but each application with an electronic medium appendix must be supplied with its own copy of the medium or media. Section 1.96(c)(2) is proposed to provide submission requirements that refer to the relevant NARA standards in 36 CFR Part 1228 for submissions of Government electronic records to NARA. Section 1.96(c)(2) is also proposed to provide that a CD-ROM or CD-R "computer program listing appendix" must be labeled with the following information: (1) The name of each inventor (if known); (2) title of the invention; and (3) the docket number used by the person filing the application to identify the application (if applicable).

Even after adoption of this proposed change to § 1.96, the Office will continue to accept a computer program listing that complies with current § 1.96 (i.e., a computer program listing contained on ten or fewer sheets as drawings or part of the specification, or a "computer program listing appendix" on microfiche) for some period of time (e.g., two years) that will be specified in any final rule notice adopting this proposed change to § 1.96. Should these provisions be adopted, conforming changes may be made in the regulations to accommodate international applications in the national stage.

Comments: The comments (almost without exception) were supportive of this proposal. Comments specifically indicated that this proposal was "long overdue," and that the proposal should include provisional applications and other technologies including chemical

and manufacturing processes requiring precise computer control. The comments provided advice including the concepts of safeguarding the information from alteration, of making the public access and examiner access easy, and of assuring the submissions are readable. The only negative comment was an expression of disbelief that the Office was equipped to handle electronic media submissions.

Response: The Office is proposing changes to § 1.96 to provide for voluminous program listings to be submitted on archival electronic media instead of microfiche. The effective date of the proposed change will be linked to the development and deployment of electronic systems at the Office to capture, store and retrieve information submitted on archival electronic media in a manner to assure the integrity and authenticity of the information, and provide its display as needed for the Office, the patentee (and applicants), and the public.

The proposed change to § 1.96 and § 1.821 *et seq.* (discussed below) contemplated for computer program listings and sequence listings would eliminate the need for submissions of hard to handle and reproduce microfiche computer program listings and voluminous paper sequence listings. To focus specifically on the Office's difficult paper handling problem, and to simplify this project so it can be deployed in a short time span, only the computer program listings and the nucleotide and/or amino acid sequences would be accepted in machine readable format.

Relationship to Office automation plans: These changes being proposed are understood to be the initial steps towards solutions to difficult Office paper-handling problems. The Office is planning for full electronic submission of applications and related documents by fiscal year 2003. The changes proposed in this notice are an initial step in that direction, permitting certain application and related material to be submitted on an acceptable archival medium.

Sections 1.97 and 1.98: The Office proposes to go forward, at the present time, with only one aspect of the plan for information disclosure statement (IDS) revision that was set forth in the Advance Notice: the proposal to require that an IDS include a legible copy of each cited pending U.S. application. The proposed IDS rules are also being revised for consistency and grammar, and to tie up a number of loose ends, as will be discussed below.

Other than the proposed requirement for a copy of each cited U.S. application,

the IDS proposals as set forth in Topics 9 and 10 of the Advance Notice have been withdrawn. Accordingly, there is no proposal at this time for a statement of personal review nor for a unique description as were called for in the Advance Notice, and the amount of citations that may be submitted is not presently proposed to be limited. The Office issued a notice of hearing and request for public comments to obtain views of the public on issues associated with the identification and consideration of prior art during patentability determinations. See Notice of Public Hearing and Request for Comments on Issues Related to the Identification of Prior Art During the Examination of a Patent Application, Notice of Hearing and Request for Public Comments, 64 FR 28803 (May 27, 1999), 1223 Off. Gaz. Pat. Office 91 (June 15, 1999). Pursuant to that notice, the Office held public hearings on June 28th and July 14th of 1999 on the issues. These prior art issues are related to the changes presently being considered by the Office to impose requirements/limits on IDS submissions. Thus, it would be premature to go forward with a comprehensive new IDS alternative until the results of the hearings and comments submitted in response to the notice have been appropriately evaluated. It is contemplated that any new IDS alternatives will be advanced in any rulemaking notice which may result from the evaluation of the results of the public hearings and comments submitted in response to the notice.

The Office recently issued guidelines for reviewing requests for reexaminations and ongoing reexaminations for compliance with *In re Portola Packaging, Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997). See Guidelines for Reexamination of Cases in View of *In re Portola Packaging, Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997), Notice, 64 FR 15346 (March 31, 1999), 1223 Off. Gaz. Pat. Office 124 (June 22, 1999). These guidelines are pertinent to the consideration given IDS citations, stating:

Where the IDS citations are submitted but not described, the examiner is only responsible for cursorily reviewing the references. The initials of the examiner on the PTOL-1449 indicate only that degree of review unless the reference is either applied against the claims, or discussed by the examiner as pertinent art of interest, in a subsequent office action.

See Guidelines for Reexamination of Cases in View of *In re Portola Packaging, Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997), 64 FR at 15347, 1223 Off. Gaz. Pat. Office at 125 (response to comment 6).

The public should thus be aware that full consideration of all citations submitted in compliance with §§ 1.97 and 1.98 is *not* required on the part of the examiner. The examiner performs a *cursory* review of each IDS citation to the extent that he/she needs in order to determine whether he/she will evaluate the citation further. If the cursory review reveals the citation not to be useful, the examiner will simply stop looking at it. The examiner will be understood to have provided full consideration only where the examiner applies the IDS citation as a reference against the claims in the application being examined, or otherwise deems the citation useful to the examination and discusses that use. Further, the applying of the IDS citation as a reference, or the discussion of the use of the citation (where the citation is *not* applied as a reference), must be in writing:

[T]he Office cannot presume that a prior art reference was previously relied upon to reject or discussed in a prior PTO proceeding if there is no basis in the written record to so conclude other than the examiner's initials or a check mark on a PTO 1449 form, or equivalent, submitted with an information disclosure statement. Thus, any discussion of prior art must appear on the record of a prior related PTO proceeding.

See Guidelines for Reexamination of Cases in View of *In re Portola Packaging, Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997), 64 FR at 15349, 1223 Off. Gaz. Pat. Office at 127 (endnote 7).

It is also noted that the Office intends to issue a notice dealing with printing of IDS citations on the face of the patent. Currently, all IDS citations which are listed on a PTO-1449 form, or an equivalent of the PTO-1449, and are initialed by the examiner, are printed on the face of the patent together with art cited by the examiner. In the notice, the public would be informed that IDS citations printed on the face of the patent will be distinguished from citations made by the examiner, using a separate printing field, markings, or some other means.

Specifics of the contemplated IDS revisions: The specifics of the contemplated revisions to § 1.97 and § 1.98 will now be discussed as to the one Advance Notice proposed change that is being retained, as to newly advanced changes, and as to Advance Notice proposed changes that are being dropped. The discussion is presented in the following twelve parts which separately address identifiable portions of the subject matter: (1) Deletion of unassociated text; (2) items cited in continued prosecution applications (CPAs); (3) filing the IDS before the mail

date of final Office actions; (4) required fee and statement for IDS submission made after close of prosecution; (5) newly cited item in foreign office must be cited for the *first* time; (6) IDS that does not comply with either § 1.97 or § 1.98; (7) copies of cited U.S. applications required; (8) how to identify a cited U.S. application; (9) citation was previously made in parent application; (10) grammar and consistency; (11) aspects of Topic 9 in the Advance Notice not being pursued in this notice; and (12) comments generally directed at revision of the IDS rules.

Part (1) Deletion of Unassociated Text

The phrase "whichever event occurs last" appears at the end of paragraph (b)(3) of § 1.97, and thus it physically appears to apply only to paragraph (b)(3). In reality, "whichever event occurs last" should be associated with each of paragraphs (b)(1), (b)(2) and (b)(3). Accordingly, it is proposed to delete "whichever event occurs last" from paragraph (b)(3), and to insert "within any one of the following time periods" in paragraph (b). This would eliminate the unassociated text "whichever event occurs last" from paragraph (b)(3), while, at the same time, making it clear that the IDS will be entered if it is filed within any of the time periods of paragraphs (b)(1), (b)(2) or (b)(3). Additionally, paragraph (c) of § 1.97 is proposed to be revised, in conformance with paragraph (b), to delete "whichever occurs first."

Part (2) Items Cited in Continued Prosecution Applications (CPAs)

Section 1.97(b)(1) is proposed to be amended to insert "other than an application under § 1.53(d)" to eliminate the three-month window for filing an IDS in a CPA. Because of the streamlined processing for CPAs, it is expected that the examiner will issue an action on the merits before three months from the filing date. Under the current rule, should an examiner issue an action on the merits prior to three months from the filing date and an IDS is submitted after the Office action is mailed but within the three-month window, the examiner must redo the action to consider the IDS. A CPA is a continuing application, and, thus, applicant should have had ample opportunity to file an IDS. In addition, as pointed out below, it is being proposed to revise § 1.103 to provide for a request of a three-month suspension of action upon filing of a CPA; thus, in an unusual instance where a need to file an IDS newly arises, applicant can request the three-month suspension based upon that need. In

view of the above, it is deemed appropriate to require that any IDS be filed before filing the CPA, or concurrently with the filing of the CPA.

Part (3) Filing the IDS Before the Mail Date of Final Office Actions

Paragraph (c) of § 1.97 would be revised to include, in addition to a final action under § 1.113 and a notice of allowance under § 1.311, other Office actions which close prosecution in the application. This would typically occur when an Office action under *Ex parte Quayle*, 1935 Dec. Comm'r Pat. 11 (1935), is issued. No reason is seen for including only two of the types of actions which close prosecution (that under § 1.113, and that under § 1.311), while not including other types.

Part (4) Required Fee and Statement for IDS Submission Made After Close of Prosecution:

Paragraph(d)(3) of § 1.97 would be revised to delete reference to the fee as a petition fee under § 1.17(i) and instead make reference to the fee as an IDS fee under § 1.17(p). There is no reason for the reduced fee of \$130 that is currently recited by paragraph (d), as opposed to the larger \$240 IDS fee set forth in paragraph (c). On the contrary, the paragraph (d) submission is made *later in the prosecution* than that of paragraph (c), and thus interrupts the process at least as much as the paragraph (c) submission. Therefore, the fee for the paragraph (d) submission should be at least as much the \$240 IDS fee required for the paragraph (c) submission.

In addition, paragraph(d)(2) of § 1.97 has been deleted in its entirety, to remove all reference to the filing of a petition. A petition unduly complicates the matter, while there is really no issue to be decided other than the entry of the IDS, which issue is ordinarily decided by the patent examiner. As it is contemplated to be amended, paragraph (d) of § 1.97 would simply require (for an IDS submitted *after* the close of prosecution and before payment of the issue fee) the combination of the IDS fee and a statement as is specified in paragraph (e) of § 1.97.

Part (5) Newly Cited Item in Foreign office Must Be Cited for the First Time

Section 1.97(e)(1) is proposed to be amended to specify that an item *first* 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 statement is entitled to special consideration for entry into the record. An item *first cited* by a foreign patent office (for example)

a year before in a communication from that foreign patent office, which item is *once again cited* by another foreign patent office within three months prior to the filing of the statement in the Office, is not entitled to special consideration for entry, since applicant was aware of the item a year ago, yet did not submit that item.

Part (6) IDS That Does Not Comply With Either § 1.97 or § 1.98

Paragraph (i) of § 1.97 is proposed for revision to delete "filed before the grant of a patent." This phrase is surplusage since there can be no information disclosure statement after the grant of the patent. A submission of information items after the patent grant is a "prior art citation" which is made, and treated, under § 501.

Paragraph (i) of § 1.97 would also be revised to make it a little clearer as to what sections must be complied with, and to change the paragraph (i) plural recitation of information disclosure statements to a singular recitation, which would be in conformance with the rest of § 1.97.

Part (7) Copies of Cited U.S. Applications Required

The Office proposes to go forward, at the present time, with one aspect of the Advance Notice IDS proposal. Section 1.98(a)(2) would be revised to require that an IDS include a legible copy of each cited pending U.S. application. Thus, the current exception to the requirement for supplying citation copies set forth in § 1.98(a)(2)(ii) for pending U.S. applications would be eliminated.

The Office noted, in the Advance Notice, its concern that current § 1.98 does not require applicant to supply copies of U.S. *application* citations. It was pointed out that there is a real burden on the examiner to locate and copy one or more pending applications, thus delaying the examination of the application being examined (in which the U.S. application citation is made). Further, copying a cited application has the potential for interfering with the processing and examination of the cited application itself. Accordingly, § 1.98(a)(2) is proposed for revision to require, for each U.S. application citation listed, that applicant submit either a copy of the application specification, including the claims, and any drawing of the application, or as a minimum, the portion of the application which caused it to be listed, including any claims directed to the portion which caused it to be listed. This proposed revision would, additionally, be a benefit to the public since the copy

of the application would be readily available upon issuance of the application as a patent.

Comments Received in Response to the Advance Notice: In response to the Advance Notice, a significant number of comments were in favor of adopting the requirement for copies of U.S. applications, and indicated that there should be no problem with requiring submission of copies. Comments noted that the submission of copies of cited applications will speed up the application process. It will decrease the time burden on examiners in obtaining and copying such applications. It will also avoid interruption of the examination of the application being cited, as otherwise, papers in the original file of the cited application must be removed and copied in order to be reviewed. Even further, it was noted that this revision of the rule should reduce risks of application papers in the cited cases being misplaced or lost.

A number of comments were concerned that submission of copies of multiple U.S. patent applications in an IDS will overwhelm the Office with an increased volume of paper. Some comments opposed the requirement for copies of U.S. patent applications on the grounds that it will place a difficult burden on counsel/applicants to provide the Office with a copy of each cited U.S. application. An example was given, where the client has an extensive patent portfolio distributed among several patent firms (e.g., the result of licensing agreements or other conflicts of interest which require different counsel to be responsible for different cases in a portfolio). In such a scenario, counsel may not be able to receive/view copies of related applications due to constraints imposed by applicable ethical rules and thus may not be able to supply copies. Another example was given, where a practitioner may be aware that a pending application is relevant and may not have access to that pending application, since it is that of another party.

With respect to these grounds for opposition to the requirement, it should initially be noted that citation of another application in an IDS is relatively rare and, as such, should not significantly increase the volume of paper the Office must deal with. Also, in those few situations where U.S. applications are cited and counsel cannot provide copies of the applications, a petition could be submitted for waiver of the rules, and the petition would be decided on a case-by-case basis. In addition, if a practitioner is not permitted, due to ethical considerations, to review material that may be of significance in

the prosecution of a particular application, it is not clear why the practitioner would be involved in the prosecution of that application. As to the comment relating to lack of access by practitioner, such lack of access may result from the fact that the application to be cited is that of a third party and is not available to the public, which includes the practitioner or the practitioner's client; the patent rules should not be a means whereby the Office will provide practitioner with a copy of a pending U.S. application merely because the practitioner or the client thereof has come across the application number.

It was suggested in the comments that review of the Office file is better than review of a supplied copy; *i.e.*, it is more useful for the examiner to review the Office file, which is more comprehensive, than to review the copies that applicant would send. As to this concern, the benefits of eliminating the Office's burden of obtaining and copying such applications, as well as avoiding interruption of examination of the cases being cited, are deemed to be greater than the possible benefit associated with the review of the Office file. If the submitted copy of a cited U.S. patent application is found by the examiner to be of sufficient relevance for further review of the application, at that point in time, the examiner can expend the extra effort to obtain and review the file. On the other hand, for the majority of the cited applications that are not worthy of looking into further, this extra expenditure of time and effort will be saved.

The comments further urged that if a cited U.S. application supplied with an IDS is later abandoned, a petition to expunge the copy of the cited application must be submitted to remove the application from the file, and the Office would then need to consider if the U.S. application is immaterial to patentability of the invention such that it can be expunged (see MPEP 724.05). This concern is noted; however, it should be the exception rather than the rule. The time expended in deciding the relatively few petitions to expunge that are filed should more than be counterbalanced by the reduction of the burden to obtain and copy applications and the avoidance of interruption of examination of the application being cited. In addition, even under the current system where application-citation copies are not required, a petition to expunge is still needed to expunge the listed application number, in cases where the content of that application citation is sufficiently

identified in the record. Thus, the increase in petitions to expunge (generated by the proposal) should be very small indeed.

It was suggested that the examiner's time in obtaining U.S. application files could be saved by providing clerical support in the groups, which would function to assist the examiner with obtaining the cited application files. This, however, would be a large drain on Office resources, which are limited, and would still result in undesirable interruptions of examination of the application being cited.

It was suggested that, instead of requiring copies of all cited applications with the IDS, the Office should reserve the right to later request copies from applicant where specific application files are not easily available. As to this suggestion, it is first noted that it would not at all reduce the time that the cited application would be away from the examiner of the cited application, and thus does not deal with the problem of interruption of the examination of the application being cited. In addition, making a requirement for applicant for the application after the IDS is received (for difficult-to-obtain cases) slows the examination process since the examiner must wait for the copy, while if the copy were submitted with the IDS, the examiner could immediately begin the examination. Furthermore, a large expenditure of time would have been made in finding out that the application file is not easily available. Even after the application is obtained and reviewed, it is, at times, found that some portion is missing. At that time, the effort would already have been expended, and only then would the copy of the application first be required from applicant.

Part (8) How To Identify a Cited U.S. Application

Section 1.98(b) is proposed to be amended to require that each listed U.S. application to be identified by the inventors, application number and filing date.

Part (9) Citation Was Previously Made in Parent Application

Paragraph (d) of § 1.98 is proposed to be revised to make it clear that the mere submission of the citation in the parent application (by applicant) is not enough to take advantage of paragraph (d) when submitting the citation in the "child" application. A copy of the citation must have been submitted in the parent, and the submission of the citation made in the parent must have complied with § 1.97, except for an application filed under § 1.53(d).

A situation might arise where applicant would establish continuity with an existing application having listed U.S. applications for which copies were not supplied (under the current practice, *i.e.*, before the changes proposed in this notice would go into effect), and applicant would thereby take advantage of paragraph (d) of § 1.98 to have the cited applications reviewed in the newly filed "continuation" (*i.e.*, filed after the changes proposed in this notice would go into effect) without submitting copies. To deal with this possibility, paragraph (d) of § 1.98 would be revised to require that where the cited U.S. application (the listed information) was not cited "by * * * the Office" (*i.e.*, not cited by the examiner in the parent), the information submission made in the prior application must have been in compliance with paragraphs (a) through (c) of § 1.98 as they are drafted in this notice. In other words, if the copy of the application papers (for the cited application) was not present in the parent, it must now be submitted in the continuation.

It might be argued that because a copy of the citation was submitted in the parent, paragraph (d) is satisfied even though the submission of the citation made in the parent did not comply with § 1.97. Paragraph (d) of § 1.98 as proposed for revision deals with this argument.

Part (10) Grammar and Consistency

All changes which are proposed in §§ 1.97 and 1.98 other than those explicitly identified above would be made for grammar and consistency within the sections. This includes, for example, deleting the last sentence of § 1.98(c) and inserting it as the last sentence of § 1.98(a)(3) where it more appropriately belongs.

Part (11) Aspects of Topic 9 in the Advance Notice Not Being Pursued Further

Statement of Personal Review: In the Advance Notice, it was proposed that the IDS submitter be required to state that he/she personally reviewed each submitted IDS citation to determine whether or not that citation is relevant to the claimed invention(s) and is appropriate to cite to the Office in the IDS. This statement of personal review would have to be made by a registered practitioner (where applicant is represented by a practitioner), or by at least one of the inventors (where applicant is not represented).

A large majority of the comments (in response to the Advance Notice) opposed requiring the statement of

personal review as proposed in the Advance Notice. Opposition was based upon the following: (1) The required statement of personal review as proposed in the Advance Notice would greatly increase prosecution costs; (2) the impact of the cost burden imposed would be extremely hard on small entities and independent inventors, and may be contrary to the Office's Independent Inventor Initiative; (3) the proposed review by the practitioner (where applicant is represented) will result in a duplication of the prior efforts of inventors, in-house counsel (not representing the inventor before the Office), or foreign associates who initially provided the information (the practitioner must "second guess" the inventor, *etc.* as to whether the citation is relevant and how it is relevant; (4) the proposed practitioner review would provide new grounds for allegations of inequitable conduct (whether the subjective requirements of the personal review statement were complied with), and the possibility of malpractice as to the review conducted; (5) the statement of review is already inherent in any IDS (§ 10.18(b)(2), § 1.56), and an explicit statement is not needed; (6) the proposed practitioner review would raise problems as to attorney-client relations, *e.g.*, conflict of interest, and potentially a breach of attorney-client privilege as to the review of the documents made; and (7) the statement of personal review would not be effective (it will not prevent marginally related and unrelated citations from being submitted), since one could make a cursory personal review of a citation, reach no decision, and simply submit the citation, with minimal comment.

There was some limited support for adoption of the proposal requiring a statement of personal review (at least in part); however, a substantial majority of the comments expressed opposition to the statement of personal review. The Office has taken note of the duplication of review effort, the potential increased costs, the subjectivity of the statement, the resulting potential for charges of inequitable conduct, and the conflict-of-interest problems that could be brought about by going forward with the proposed requirement for a statement of personal review. Accordingly, a decision has been made to not go forward with the requirement for a statement of personal review at this time.

Citations To Be Uniquely Described: The Advance Notice proposed that applicant be required to compare each of the citations to each of the independent claims, or specific dependent claim(s), in a meaningful

way unique to each citation. The description of each citation would have to point out why applicant believes the citation to be unique in its teaching/showing relative to the claimed invention(s). Description would not be required for any ten citations, and for citations in a corresponding application by a foreign patent office, PCT international searching authority, or PCT international preliminary examining authority, provided the search report or office action in the English language is also submitted.

The comments in opposition to the unique description proposal were both numerous and varied as to the reasons for opposition. Reasons for opposition are summarized: (1) A potential for adverse future litigation implications, and for admissions which otherwise need not be made, would result from the proposal; (2) the proposal would impose an unreasonable cost and time burden upon the public; (3) the impact of the burden imposed would be extremely hard on small entities and independent inventors, and may be contrary to the Office's Independent Inventor Initiative; (4) the proposed description of the citations is unduly burdensome, and the many possible description permutations impose an impossible task (description would be needed to cover all claim meanings, art settings and potential art combinations, and would need to be updated each time the claims are amended); (5) reasonable minds will differ on which portions of a citation are significant, which citations are cumulative, and the relevant teachings of any particular citation; (6) the appropriate standard for determining if an item should be considered is whether the item is material, not whether it is cumulative (so, explanation of why the citation is not cumulative should not be imposed); (7) the description proposal discriminates against foreign applications and U.S. practitioners representing foreign applicants, since the U.S. practitioner, who is not the author of the case, is not completely familiar with the technology; (8) the proposed unique description requirement is not fair since examiners do not have this burden; (9) experience has shown that the submitted description may not be a useful tool to the examiner, and some examiners do/did not even read the descriptions; (10) the description proposal would provide a "role reversal" where applicant does the examiner's job of evaluating the citations but not as well, *i.e.*, the proposal appears to force applicant's representative to "play" examiner, review each of the citations, and

essentially make a rejection for the examiner in an IDS; (11) there is no statute or case law that requires the applicant to comment on citations submitted to satisfy the duty to disclose (thus, applicant should not be charged with that responsibility); (12) it should take no longer for the examiner to evaluate IDS art than the time it takes him/her to review art when searching through shoes of patents; (13) no data/facts have been presented to show a need for the description of the citations; (14) the pre-set number of ten "free" citations (without description) proposed in the Advance Notice is an artificial and arbitrary number, and it would be difficult to decide which ten to choose (it encourages gamesmanship and planning in selecting which citations to describe); (15) the proposed selection of an arbitrary ten free citations opens up a "Pandora's Box" regarding inferences as to the particular ten citations selected; and (16) the number "ten" for the free citations is too small, and the number actually needed depends upon many factors surrounding the application such as complexity, technology, and number of claims.

Conclusion: The overwhelming majority of the comments expressed opposition to the unique description proposal of the Advance Notice. The Office has taken note of the large burden that would be imposed on applicants and attorneys by the description proposal of the Advance Notice, the potential for future adverse consequences stemming from doing the description or the choice not to describe, and the applicant's role reversal that would be imposed by the description proposal. Accordingly, a decision has been made to not go forward with the unique description proposal at this time.

Suggestions Regarding Topic 9: A substantial number of suggestions were submitted for modification of the Advance Notice Topic 9 proposal as to the required statement of personal review and the unique description requirement and its exceptions. It was also widely suggested that the Office charge fees for consideration and evaluation of an excessive number of submitted citations. These suggestions have not been accepted in view of the decision not to go forward with the Topic 9 proposal other than the requirement for copies of applications (as discussed above).

Part (12) Comments Generally Directed at Revision of the IDS Rules

Some comments on the Advance Notice IDS proposals were not directed to specific aspects of Topics 9 and 10,

but commented on the IDS proposals on the whole. Those comments noted: (1) No reason nor incentive has been provided to the public to give up the current IDS system; (2) the proposed Advance Notice IDS changes do not serve the public nor applicant's interest, and would eliminate a significant number of application filings each year; (3) the current IDS submission rules work well and should not be changed (the Office should not over-react by adopting a drastic cure that would be more harmful than the disease); (4) it is not an excessive burden on the Office to review large numbers of submitted documents, but actually helps the process (this issue was previously visited during the promulgation of the current § 1.98, and the Office found that examiners' review of all submitted documents would not constitute an excessive burden); (5) the IDS proposals set forth in the Advance Notice will not be effective to discourage submissions to the point that the Office problem is solved since the duty of disclosure remains in effect, and on the other hand, the proposals will discourage pre-searches and other mechanisms for disclosure that strengthen patents; (6) the proposal imposes significant new limitations on the practitioner's ability to freely disclose information to the Office due to cost accountability to clients and potential adverse litigation consequences; (7) the Office desire to reduce application processing time via the IDS proposals would be expected to reduce the quality of examination, and that is an undesirable trade-off; (8) the IDS proposals conflict with world patent harmonization (the U.S. is the only patent-granting body in the world that requires citations of relevant art, and it runs counter to world patent harmonization that applicant's burden in this regard should now be increased by the proposals to further impose requirements on applicant not required by other patent granting bodies); (9) the IDS proposals are complicated; and (10) the Office's IDS problem is at least partly generated by MPEP 2004 which calls for citation of even questionable or marginal items.

Summary: The overall support for the IDS proposals as set forth in the Advance Notice was relatively limited, and, for the most part, where support was advanced, it was advanced as a qualified support. On the other hand, a large majority of the comments opposed the Advance Notice IDS proposals, often stating their objection to the proposals using strong language. Accordingly, the IDS proposals as set forth in Topics 9 and 10 of the Advance Notice have been

withdrawn at this time (with the exception of the proposed requirement for a copy of each cited U.S. application, which did have some support and is being retained for reasons discussed both below and above).

The present IDS proposal addresses the major concerns of the comments in that it does not call for a statement of personal review, nor a unique description, as were called for in the Advance Notice. It also does not propose to limit the number of citations that may be submitted. As noted, the present IDS proposal does in fact retain one aspect of the Advance Notice IDS proposal—applicant would be required to provide a copy of the specification including the claims (and any drawing) of each U.S. application cited in the IDS, or the portion of the application which caused it to be listed, including any claims directed to that portion of the application. Any increase in applicant's burden due to this one retained aspect should be minor since: (1) The citation of U.S. applications represents a very small minority of documents cited, and (2) the original of the application is usually readily available to the applicant as a related application (and where not so, a petition can be filed requesting that a copy not be required in that isolated and rare case). The need for any such minor increase in burden is, however, heavily outweighed by the many benefits obtained. As pointed out above, the presence of the application copies with the IDS will (1) decrease the time burden on examiners in obtaining and copying the applications, (2) avoid interruption of examination of the cited cases, (3) reduce risks of application papers in the actual file of the cited applications being misplaced or lost, and (4) be advantageous to the public as such copies being in the application file would be readily available to the public upon issuance of the application as a patent.

The presently proposed IDS rules also include a number of revisions for consistency and grammar, and to tie up a number of loose ends as discussed above. These proposed revisions should not, however, represent any significant burden on the public.

Section 1.102: Section 1.102(d) is proposed to be amended to refer to "the fee set forth in § 1.17(h)" for consistency with the changes to § 1.17(h) and § 1.17(i). See discussion of changes to § 1.17(h) and § 1.17(i).

Section 1.103: Section 1.103 is proposed to be revised for clarity and to provide a procedure for obtaining a limited suspension of action in a continued prosecution application

(CPA) under § 1.53(d). The heading of § 1.103 is proposed to be amended to add the phrase "by the Office" to clarify that this section does not apply to requests for suspension of action (or reply) by the applicant.

Section 1.103(a) is proposed to provide for suspension of action for cause. Specifically, § 1.103(a) is proposed to provide that on request of the applicant, the Office may grant a suspension of action under this paragraph for good and sufficient cause. Section 1.103(a) is also proposed to provide that: (1) The Office will not suspend action if reply by applicant to an Office action is outstanding; and (2) any petition for suspension of action under § 1.103(a) must specify a period of suspension not exceeding six months. Section 1.103(a) is proposed to specifically provide that any petition for suspension of action under § 1.103(a) must also include: (1) A showing of good and sufficient cause for suspension of action; and (2) the fee set forth in § 1.17(h), unless such cause is the fault of the Office. If an additional suspension period is desired applicant may submit another petition under § 1.103(a) requesting same.

Section 1.103(b) is proposed to provide for a limited suspension of action in a continued prosecution application (CPA) under § 1.53(d). Section 1.103(b) is specifically proposed to provide that on request of the applicant, the Office may grant a suspension of action under § 1.103(b) in a CPA for a period not exceeding three months. Section 1.103(b) is proposed to specifically provide that any request for suspension of action under § 1.103(b) must be filed with the request for a CPA and include the processing fee set forth in § 1.17(i).

Section 1.103(c) is proposed to provide that the Office will notify applicant if the Office suspends action on an application on its own initiative.

Section 1.103(d) is proposed to provide for suspension of action for public safety or defense. Section 1.103(b) is specifically proposed to provide that the Office may suspend action by order of the Commissioner if the following conditions are met: (1) The application is owned by the United States; (2) publication of the invention may be detrimental to the public safety or defense; and (3) the appropriate department or agency requests such suspension.

Section 1.103(e) is proposed to provide that the Office will suspend action for the entire pendency of an application if the Office has accepted a request to publish a statutory invention registration in the application, except

for purposes relating to patent interference proceedings under Subpart E.

Section 1.105: Section 1.105 would be a new section containing paragraphs (a) through (c), relating to requirements by the Office that certain information be supplied.

Paragraph (a)(1) of § 1.105 would provide examiners or other Office employees explicit authority to require submission of such information as may be reasonably necessary for the Office to properly examine or treat a matter being addressed in an application under 35 U.S.C. 111 or 371, in a patent, or in a reexamination proceeding. Abandoned applications would also fall within the scope of the rule to provide for handling of petition matters. New § 1.105 is simply an explicit recitation of inherent authority that exists pursuant to 35 U.S.C. 131 and 132, and continues the practice of providing explicit authority to Office employees as was done with the Board of Patent Appeals and Interferences under § 1.196(d) and with Trademark examiners under § 2.61.

The use of the authority under proposed paragraph (a)(1) of § 1.105 would be encouraged so that the Office can perform the best quality examination possible. The authority is not intended to be used by examiners without a reasonable basis, but to address legitimate concerns that may arise during the examination of an application or consideration of some matter. Any abuse in implementation of the authority, such as a requirement for information that is not in fact reasonably necessary to properly examine the application, would be addressed by way of petition under § 1.181. For example, the Office may, under appropriate circumstances, desire the authority to ask for:

1. The existence of any particularly relevant commercial data base that could be searched for a particular aspect of an invention, in certain technologies where pertinent prior art is highly likely to be found in a commercial data base.

2. Information that may not be required to be submitted by § 1.56, but that the examiner would deem useful on an application-by-application basis (which could be done prior to the application being taken up for examination, such as when the application is assigned to an examiner): (a) Submission of any published articles, authored by any of the inventors, that relate to a claimed invention, and (b) any non-patent literature or patents that were used to draft the application or in the invention process, such as where the invention is

an improvement over the prior information.

3. A reply to a matter raised in a protest under § 1.291.

4. An explanation of technical material in a publication, such as one of the inventors' publications.

5. The identification of changes made in a reformatted continuing application filed under § 1.53(b).

6. A mark-up for a continuation-in-part application showing the new matter where there is an intervening reference.

7. Comments on a new Federal Circuit decision that appears on point.

The proposed § 1.105 is not intended to change current Office practice in regard to questions of fraud under § 1.56, and inquiries relating thereto would not be authorized. See MPEP 2010.

Paragraph (a)(2) of § 1.105 would provide a safety net by specifically recognizing that where the information required to be submitted is unknown and/or is not available, a complete response to the requirement for information would be a statement to that effect. There would be no requirement for a showing that in fact the information was unknown or not available such as by way of disclosing what was done to attempt to satisfy the requirement for information. Nonetheless, it should be understood that a good faith attempt must be made to obtain the information and a reasonable inquiry made once the information is requested even though the Office will not look behind the answer given. An Office employee should not continue to question the scope of a specific answer merely because it is not as complete as the Office employee desires.

Example: In a first action on the merits of an application with an effective filing date of May 1, 1999, the examiner notes the submission of a protest under § 1.291 relating to a public sale of the subject matter of the invention and requests a date of publication for a business circular authored by the assignee of the invention, which circular was submitted with the protest. It is expected that the attempt to respond to the requirement for information would involve contacting the assignee who would then make a good faith attempt to determine the publication date of the circular. The response to the requirement states that the publication date of the circular is "around May 1, 1998." As "around May 1, 1998" covers dates both prior and subsequent to May 1, 1998, a *prima facie* case under 35 U.S.C. 102(b) would not exist. The examiner cannot require that the response be more specific or

hold the response to be incomplete based on such reply. The examiner can, however, in the next Office action seek confirmation that this is the most specific date that was obtained or can be obtained based on a reasonable inquiry being made if that is not already clear from the response to the initial requirement for information.

Paragraph (b) of § 1.105 would provide that the requirement for information may be included in an Office action, which would include a restriction requirement if appropriate, or can be sent as a separate letter independent of an Office action on the merits such as when the information required is critical to an issue or issues that need to be addressed in a subsequent Office action. It is expected that due to cycle time concerns the use of a requirement for information independent of an Office action on the merits would be limited.

Paragraph (c) of § 1.105 would provide that a response to a requirement for information or failure to respond thereto would be governed by §§ 1.135 and 1.136. Note the Example provided in the discussion of paragraph (a)(2) of § 1.105.

Section 1.111: The heading of § 1.111 is proposed to be amended to clarify that it applies to a reply by the applicant or patent owner to a non-final Office action. Section 1.111 is proposed to be amended to: (1) Provide a reference to § 1.104 concerning the first examination of an application; (2) change the reference to § 1.135 and § 1.136 (for time for reply to avoid abandonment) from paragraph (c) to paragraph (a); and (3) add the sentence "[a] second or subsequent supplemental reply will be entered unless disapproved by the Commissioner."

The Office indicated in the Advance Notice that it was considering charging a handling fee for all supplemental replies. The Office was specifically considering replacing the current practice of allowing unlimited supplemental replies to be filed without requiring any fee with a new practice in which a handling fee would be charged for each supplemental reply that is filed after the initial reply to an Office action has been filed.

While some comments supported this proposed change, a majority of comments opposed charging a handling fee for supplemental replies. The reasons given for opposition to the proposal included arguments that: (1) The proposal was simply a revenue-raising proposition; (2) the primary cause of supplemental replies crossing with an Office action is Office mail room delay and paper processing

delays; (3) applicants may need to file a supplemental amendment due to later-discovered prior art. The comments also suggested that: (1) The PALM system be enhanced to flag supplemental replies to avoid issuing an Office action until any supplemental reply is matched with the application; and (2) examiners call applicants two weeks prior to acting on an application to determine whether a supplemental reply has been filed.

This notice does not propose changing the rules of practice to charge a handling fee for supplemental replies. Based upon the comments and its own evaluation, the Office has concluded that the proposed handling charge would not discourage the filing of supplemental replies, but would only result in such replies being filed with the handling fee.

The Office, however, is proposing a change to the rules of practice to provide that the entry of second or subsequent supplemental replies may be disapproved by the Commissioner. It is expected that disapproval of a second or subsequent supplemental amendment will be delegated to the appropriate Technology Center Group Director under MPEP 1002.02(c). As most supplemental replies cause only a minor inconvenience to the Office, the Office is not inclined to propose a change that would affect the ability to file a supplemental reply when such is warranted. There are, however, some applicants who routinely file preliminary or supplemental amendments that place a significant burden on the Office by: (1) Canceling the pending claims and adding many new claims; (2) adding numerous new claims; (3) being filed approximately two months from the date the original reply was filed (*i.e.*, when the examiner is likely to be preparing an Office action responsive to the original reply). These applicants also tend to be those having many applications simultaneously on file in the Office.

The provision that the entry of a second or subsequent supplemental reply may be disapproved by the Commissioner would give the Office the latitude to permit entry of those supplemental replies that do not unduly interfere with the preparation of an Office action, but would also give the Office the latitude to refuse entry of those supplemental replies that do unduly interfere with the preparation of an Office action. The factors that would be taken into consideration when deciding whether to disapprove entry of such a supplemental reply are: (1) The state of preparation of an Office action responsive to the initial reply; and (2) the nature of the change to the pending

claims that would result from entry of the supplemental reply. That is, if the examiner has devoted a significant amount of time to preparing an Office action before such a supplemental amendment is matched with the application, it would be appropriate for the Office to disapprove entry of the supplemental amendment. If, however, such a supplemental amendment merely cancels claims (as opposed to canceling claims and adding claims, or simply adding claims), it would not be appropriate to disapprove entry of such a supplemental amendment even if the examiner has devoted a significant amount of time to preparing an Office action before such a supplemental amendment is matched with the application.

Obviously, if a supplemental reply is received in the Office (§ 1.6) after the mail date of the Office action responsive to the original reply and is not responsive to that Office action, the Office will continue the current practice of not mailing a new Office action responsive to that supplemental reply, but simply advising the applicant that the supplemental reply is non-responsive to such Office action and that a responsive reply (under § 1.111 or 1.113 as the situation may be) must be timely filed to avoid abandonment. Put simply, the mailing of an Office action responsive to the original reply will continue to cut off the applicant's right to have any later-filed supplemental reply considered by the Office.

The proposed change to § 1.111(a) in this notice: (1) Is not a revenue-raising proposition; and (2) will not affect the vast majority of supplemental replies. It will only apply to a supplemental reply if: (1) the applicant has already filed one (a first) supplemental reply; and (2) the supplemental reply is not matched with the application until after the examiner has devoted a significant amount of time to preparing an Office action.

The suggestion regarding enhancement to the PALM system is being taken under advisement. Such an enhancement, however, would not discourage the filing of the supplemental replies that place a burden on the Office, but would only inform the examiner that such a reply has not yet been matched with the application. In the absence of a procedure for disapproving the entry of such burdensome replies, the so-enhanced PALM system would simply advise the Office not to act on the affected application for extended periods of time, which would have an adverse effect on the Office's efforts to reduce cycle time.

The suggestion that examiners call applicants two weeks prior to acting on an application to determine whether a supplemental reply has been filed is not practicable. The Office issues hundreds of thousands of Office actions each year. Thus, implementing this suggestion would require the Office (examiners) to make hundreds of thousands of additional telephone calls to applicants each year.

Section 1.112: Section 1.112 is proposed to be amended to provide a reference to § 1.104 concerning the first examination of an application. Section 1.112 is proposed to be amended to add the phrase "or an appeal (§ 1.191) has been taken" to the last sentence. This addition is to clarify that once an appeal has been taken in an application, any amendment is subject to the provisions of § 1.116 (b) and (c), even if the appeal is in reply to a non-final Office action.

Section 1.115: A new § 1.115 is proposed to be added to provide for preliminary amendments. The Office indicated in the Advance Notice that it was considering charging a handling fee for certain preliminary amendments. The Office was specifically considering replacing the current practice of allowing unlimited preliminary amendments to be filed without requiring any fee with a new practice in which a handling fee would be charged for each preliminary amendment filed later than a specified time period (one month) after the filing date of the application.

While some comments supported this proposed change, a majority of comments opposed charging a handling fee for certain preliminary amendments. The reasons given for opposition to the proposal included arguments that: (1) The proposal was simply a revenue-raising proposition; (2) the primary cause of preliminary amendments crossing with an Office action is Office mail room delay and paper processing delays; (3) applicants should not be forced to file preliminary amendments and other papers until after receiving a filing receipt and application number; and (4) applicants may need to file a preliminary amendment due to later-discovered prior art. The comments also suggested that: (1) The PALM system be enhanced to flag preliminary amendments to avoid issuing an Office action until the preliminary amendment is matched with the application; (2) examiners call applicants two weeks prior to acting on an application to determine whether a preliminary amendment has been filed; and (3) applicants filing a continued prosecution application under § 1.53(d)

(CPA) be given a few weeks to file any necessary preliminary amendment.

The Office is not proposing a change to the rules of practice to charge a handling fee for certain preliminary amendments. Based upon the comments and its own evaluation, the Office has concluded the proposed handling charge would not discourage the filing of preliminary amendments, but would only result in such amendments being filed with the handling fee. The Office, however, is proposing a change to the rules of practice to provide that the entry of certain preliminary amendments may be disapproved by the Commissioner. See the discussion of § 1.111 for an explanation of the need for this change to the rules of practice.

Section 1.115(a) as proposed provides that a preliminary amendment is an amendment that is received in the Office (§ 1.6) on or before the mail date of the first Office action under § 1.104. That is, an amendment received in the Office (§ 1.6) after the mail date of the first Office action is not a preliminary amendment, even if it is non-responsive to the first Office action and seeks to amend the application prior to the first examination.

Section 1.115(b) is proposed to provide that a preliminary amendment will be entered unless disapproved by the Commissioner, and also provide that a preliminary amendment will not be disapproved if it is filed no later than: (1) Three months from the filing date of an application under § 1.53(b); (2) the filing date of a continued prosecution application under § 1.53(d); or (3) three months from the date the national stage is entered as set forth in § 1.491 in an international application. Thus, the entry of a preliminary amendment will not be disapproved under § 1.115(b) if it is filed within one of the periods specified in § 1.115(b)(1) through (b)(3). Nevertheless, if a "preliminary" amendment is filed after the mail date of the first Office action, it is not a preliminary amendment under § 1.115(a). If a ("preliminary") amendment is received in the Office (§ 1.6) after the mail date of the first Office action and is not responsive to the first Office action, the Office will continue the current practice of not mailing a new Office action responsive to that amendment, but simply advising the applicant that the amendment is non-responsive to first Office action and that a responsive reply must be timely filed to avoid abandonment. Put simply, the mailing of the first Office action will continue to cut off the applicant's right to have any later-filed preliminary amendment considered by the Office, even if that amendment is filed within

the time periods specified in proposed § 1.115(b).

Section 1.115(c) is proposed to provide that the time periods specified in § 1.115(b) are not extendable.

It is expected that disapproval of a preliminary amendment filed outside the period specified in § 1.115(b) will be delegated to the appropriate Technology Center Group Director under MPEP 1002.02(c). The provision that the entry of a preliminary amendment filed outside the period specified in § 1.115(b) may be disapproved by the Commissioner would give the Office the latitude to permit entry of those preliminary amendments filed outside the period specified in § 1.115(b) that do not unduly interfere with the preparation of an Office action, but would also give the Office the latitude to refuse entry of those preliminary amendments filed outside the period specified in § 1.115(b) that do unduly interfere with the preparation of an Office action. As with the proposed change to § 1.111(a), the factors that would be taken into consideration when deciding whether to disapprove entry of such a preliminary amendment are: (1) The state of preparation of the first Office action; and (2) the nature of the change to the pending claims that would result from entry of the preliminary amendment.

The proposed change to § 1.115 in this notice: (1) Is not a revenue-raising proposition; and (2) will not affect the vast majority of preliminary amendments. It will only apply to a preliminary amendment if: (1) The preliminary amendment is filed outside the time periods specified in § 1.115(b)(1) through (b)(3); and (2) the preliminary amendment is not matched with the application until after the examiner has devoted a significant amount of time to preparing an Office action. The suggestions that the PALM system be enhanced and that examiners call applicants two weeks prior to acting on an application are addressed above in the discussion of § 1.111(a).

In an application filed under 35 U.S.C. 111(a) and § 1.53(b) or a PCT international application entering the national stage under § 1.491, the time periods specified in § 1.115(b) should give the applicant time between the mailing of a filing receipt and the mailing of a first Office action to file any necessary preliminary amendment. CPA practice under § 1.53(d), however, is designed to provide a first Office action sooner than if the application had been filed as a continuation under § 1.53(b) (or under former §§ 1.60 or 1.62). See Continued Prosecution Application (CPA) Practice, Notice, 1214 Off. Gaz.

Pat. Office 32, 32 (September 8, 1998). An applicant filing a CPA under § 1.53(d) who needs time to prepare a preliminary amendment should file a request for suspension of action under § 1.103(b) with the CPA request. See discussion of § 1.103(b).

Section 1.121: Section 1.121 is proposed to be amended to change the manner of making amendments in non-reissue applications. The proposed practice to amend the specification by replacement of a section or paragraph (or claim) would eliminate the need for the Office to enter changes by handwriting in red ink. This change would result in a specification (including claims) in clean-copy form that can be Optical Character Recognition (OCR) scanned during the patent publishing process. The proposed practice also requires the applicant to provide a marked-up copy of the changed section or paragraphs (or claims), using the applicant's choice of marking system, which will aid the examiner in ascertaining the changes to the specification.

The proposed change to § 1.121 involves concurrent changes to § 1.52(b) (see discussion of § 1.52(b)(6)) to provide for numbering of the paragraphs of the specification, except for the claims. If the paragraphs of the specification are numbered as proposed in § 1.52, the applicant will be able to amend the specification by merely submitting a replacement paragraph (with the same number) with the desired changes made in the replacement paragraph.

As discussed above, the adoption of the proposed changes to § 1.121 will result in relatively clean (e.g., without underlining, bracketing, or red ink) application specifications that can be OCR scanned as part of the printing process in the Office of Patent Publications, which will result in a higher quality of printed patents. Complete OCR scanning of the amended portions of the specification and claims is not possible today because insertions of words, phrases or sentences made by handwriting in red ink and deletions made by words which have been lined through with red ink are ignored by the scanner. Further, while text marked with underlining and bracketing can be scanned, extra processing is required to delete the brackets and the text within the brackets and to correct misreading of letters caused by the underlining. Thus, using clean replacement sections or paragraphs and claims will permit complete OCR scanning which is a faster and more accurate method of capturing the application for printing while eliminating an extensive amount

of key-entry of subject matter. This should result in patents with fewer errors in need of correction by certificate of correction, which will be a clear benefit to the patentees and conserve Office resources.

In addition to submitting a replacement section or paragraph/claim to make an amendment, applicant would also be required to submit a marked-up copy of the section or paragraph/claim to show the differences between the original and the replacement. The marked-up copy may be created by any method applicant chooses, such as underlining and bracketing, redlining, or by any system designed to provide text comparison.

The proposed change to § 1.121 will make the amendment process simpler, reduce processing time and operating costs, and reduce the opportunity for error associated with amendment entry. In addition, it is consistent with standardizing processing of amendments in both paper and electronic format in anticipation of a total Electronic File Wrapper (EFW) environment, which is currently under development. Further, the changes being proposed are consistent with the Office's efforts to harmonize with PCT practice and any changes being contemplated for that system.

Section 1.121(a) is specifically proposed to be amended by replacing paragraphs (a)(1) through (a)(6) with new paragraphs (a)(1) through (a)(5), which treat the manner of making amendments in nonprovisional applications other than reissue applications. Section 1.121(b) relates to amendments in reissue applications and § 1.121(c) relates to amendments in reexamination proceedings.

Section 1.121(a)(1)(i) is proposed to provide procedures to delete, replace or add a paragraph to the specification of an application by requiring instructions for such accompanied by the replacement or added paragraph(s). By following the four-digit numbering system concurrently proposed in § 1.52(b)(6), applicants can easily refer to a specific paragraph by number and present an amendment thereto. Proposed § 1.121(a) requires that the replacement or added paragraph(s) not include any markings to indicate the changes that have been made. A copy of the replacement or added paragraph(s) marked-up to show the changes would be required to accompany the amendment as an aid to the examiner.

If a numbered paragraph is to be replaced by a single paragraph, the added replacement paragraph bearing the same number as the paragraph being replaced should be submitted. If more

than one paragraph is to replace a single paragraph, the numbering of the added replacement paragraphs must begin first with the number of the paragraph being replaced, then subsequently by the number of the replaced paragraph together with a single decimal and sequential integers (e.g., paragraph [0071] is replaced by [0071], [0071.1] and [0071.2]). Any paragraphs being added between existing paragraphs must take the number of the preceding paragraph followed by a decimal and sequential integers (e.g., [0071.1] and [0071.2] are being inserted between paragraphs [0071] and [0072]). Unaffected paragraphs would retain their original numbers. Once an amendment is entered, subsequent amendments would be made *vis-a-vis* the numbering created by the previous amendment. Amendments to titles or headers, which are not considered paragraphs and thus not numbered, would be identified by reference to their location relative to a numbered paragraph (e.g., "the title appearing after paragraph [0062]").

Section 1.121(a)(1)(ii) as proposed also permits applicants to amend the specification by replacement sections (e.g., as provided in §§ 1.77(a), 1.154(a) or 1.163(c)). As with replacement paragraphs, the amended version of a replacement section would be required to be provided in clean form and not include any markings to show the changes which have been made. A marked-up version showing the changes must accompany the actual amendment as an aid to the examiner.

Section 1.121(a)(1)(ii) as proposed also permits applicants to amend the specification by submitting a substitute specification. Sections 1.52, 1.77, 1.154, 1.163 and 1.121(a) as proposed do not require applicants to number the paragraphs of the specification (§ 1.52(b)(6)) or provide section headings (§§ 1.77, 1.154, 1.163). Without numbered paragraphs of the specification or section headings, however, an applicant will be limited to amending the application by submitting a substitute specification. Thus, applicants submitting a substitute specification as a means of amending the application (including "transition applications" filed before but amended after this proposed change to § 1.121(a) is adopted) are urged to include numbered paragraphs in the substitute specification (in the manner proposed in § 1.52(b)(6)), so that further amendments may be made by replacement paragraphs in accordance with § 1.121(a)(1)(i). An accompanying marked-up copy showing amended portions of the specification would be

required. The addition of paragraph numbers in a substitute specification, however, need not be considered as an amendment to the specification requiring a marked-up showing.

Further, in applications not having numbered paragraphs, even if no amendments to the specification are being made, applicants are urged to supply a substitute specification including numbered paragraphs (consistent with § 1.52 (b)(6)) as part of the response to the first Office action, so that any future amendments to the specification may be made by numbered paragraph replacement. As stated immediately above, a marked-up copy, showing paragraph numbers as the only change, is not required.

The Office will not, upon request of applicants, number the paragraphs or sections of the specification, or accept any instructions to do the same. The Office reserves the right, however, to number or renumber the paragraphs in the printed patent as part of the publication process.

Section 1.121(a)(1)(iv) as proposed requires that matter deleted by amendment pursuant to any of the earlier paragraphs of § 1.121 could only be reinstated by a subsequent amendment presenting the previously deleted subject matter. No unentering of previously entered amendments will be permitted.

Section 1.121(a)(2) as proposed requires that all amendments to the claims be presented as totally rewritten claims. Any rewriting of a claim will be construed as a direction to cancel the previous version of the claim. See *In re Byers*, 230 F.2d 451, 455, 109 USPQ 53, 55 (CCPA 1956) (amendment of a claim by inclusion of an additional limitation had exactly the same effect as if the claim as originally presented had been canceled and replaced by a new claim). The new (or rewritten) claim must be submitted in clean form with no markings showing the changes which have been made. A marked-up version of any amended claim must be submitted on pages separate from the amendment showing the changes which have been made by way of brackets (for deleted matter) and underlining (for added matter), or by any other suitable method of comparison, in order to clearly indicate the changes made by the amendment in a form that will assist the examiner in the examination process.

Section 1.121(a)(3) is proposed to be amended to clarify the requirements for amending figures of drawing in an application. A sketch showing changes in red must be filed for approval by the examiner before new drawings in compliance with § 1.84 can be filed.

Sections 1.121(a)(5) and (a)(6) will be redesignated without change as new § 1.121(a)(4) and (a)(5).

Section 1.121(b) is proposed to be amended to transfer the provisions for amending reissue applications to § 1.173 (see discussion of § 1.173). Section 1.121(b) is specifically proposed to simply include a reference to § 1.173 for amendment of reissue applications.

Most of the comments received were in support of the proposed change to amendment practice. Some criticisms and suggestions are addressed below.

Comment: A concern was raised by a number of commenters that replacement paragraphs would make the identification of changes more obscure than the present system of using bracketing and underlining, would place an extra burden on practitioners and their staffs, and would work against reducing paper submissions if applicants were required to submit marked-up copies of the desired changes.

Response: The proposed replacement paragraph requirement is necessary to facilitate the publication of patents more expeditiously and with fewer errors. The Office's goal is to eliminate the use of red ink and bracketing/underlining in the amendment of patent applications, since OCR techniques now employed in the preparation of patents for publication can best accommodate "clean copy" insertions of amended subject matter.

The submission of marked-up copies would, for a time, increase file size but would provide the examiner with an easy way to compare the most recent amendments with earlier versions in the application files. While it may be possible for examiners to compare the clean copy with the previous version in order to detect changes, in the interest of reduced cycle time, a review of a marked-up copy of an amendment has been determined to be most effective in the examination process. The proposed requirements would provide the needed comparative basis (for paper copies) during the transition phase into an EFW environment.

Comment: A number of comments were received which expressed concern about the harmonization of the Office's amendment requirements with those of PCT and/or other foreign countries.

Response: While PCT practice currently provides for the use of replacement pages, it appears that paragraph or section replacement is being considered worldwide as electronic filing requirements are being developed. Both the JPO and the EPO currently employ paragraph numbering in their application requirements and

publication procedures. No other patent examining authority has yet developed procedures for transitioning into electronic filing and practice.

Comment: Several comments received questioned the ability of word processing software to handle paragraph numbering and renumbering without extensive clerical intervention.

Response: The objective of the proposed amendment practice and the concept of paragraph numbering is to easily identify a paragraph in the specification and to not disturb the numbering of the paragraphs preceding and following the amendments/insertions. It is being concurrently proposed that § 1.52 provide for paragraph numbering according to a four digit Arabic numeral arrangement enclosed in bold brackets to be placed at the beginning of each paragraph immediately to the right of the left margin, and followed by approximately four spaces, before beginning the paragraph text (e.g., [0071]). If, according to the proposed changes to § 1.121, for example, paragraph [0071] is to be replaced, another paragraph of the same number should be inserted in its place. If several paragraphs are to replace a single deleted paragraph, [0071] should, for example, be replaced by [0071], [0071.1], and [0071.2]. The ability of word processing software to renumber the remaining paragraphs should not be necessary.

Comment: Several comments suggested identifying the replacement paragraphs by page number and line number, or through the use of replacement pages.

Response: The proposed changes to § 1.121 are intended, in part, to serve the Office and its customers during a transition into an EFW environment. Accordingly, paragraph replacement via paragraph numbering will most effectively achieve the desired results. Identification of paragraphs by page and line number does not consistently and uniformly refer to the same section of the specification due to formatting and pagination differences among various word processing programs.

Comment: Several comments received suggested that the Office more aggressively pursue total electronic filing.

Response: A total EFW environment is still several years away. The proposed changes must be workable during a transition into electronic filing, and, at the same time, serve all customers adequately, including those not yet able to adapt to word processing and advanced computer techniques.

Section 1.125: Section 1.125(b)(2) is proposed to be amended to require that

all the changes to the specification (rather than simply all additions and deletions) be shown in a marked-up copy. Section 1.125(b)(2) is also proposed to be amended to provide that numbering the paragraphs of the specification of record is not considered a change that must be shown. Thus, the marked-up copy of the substitute specification need not show the numbering the paragraphs of the specification of record, and no marked-up copy of the substitute specification is required if the only change is numbering of the paragraph of the specification of record. Section 1.125(c) is proposed to be amended to encourage that the paragraphs of any substitute specification be numbered in a manner consistent with § 1.52(b)(6).

Section 1.131: The heading of § 1.131 is proposed to be amended to clarify that it applies to overcoming other activities in addition to cited patents or publication. Section 1.131(a) is proposed to be amended for simplicity.

Section 1.131(a) is specifically proposed to be amended to provide that when any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. Section 1.131(a) as proposed would eliminate the provisions that specify which bases for rejection must be applicable for § 1.131 to apply. Instead, the approach would be that § 1.131 is applicable unless the rejection is based upon a U.S. patent to another or others which claims the same patentable invention as defined in § 1.601(n) or a statutory bar. This avoids the situation in which the basis for rejection is not a statutory bar (under 35 U.S.C. 102(a) based upon prior use by others in the United States) and should be capable of being antedated, but the rejection is not specified as a basis for rejection that must be applicable for § 1.131 to apply.

Section 1.131(a) is also proposed to be amended to provide that the effective date of a U.S. patent is the date that such U.S. patent is effective as a reference under 35 U.S.C. 102(e). MPEP 2136.03 provides a general discussion of the date a U.S. patent is effective as a reference under 35 U.S.C. 102(e). Finally, § 1.131(a) is proposed to be amended to provide that prior invention may not be established under § 1.131 if either: (1) The rejection is based upon a U.S. patent to another or others which

claims the same patentable invention as defined in § 1.601(n); or (2) the rejection is based upon a statutory bar.

Section 1.132: Section 1.132 is proposed to be amended to eliminate the provisions that specify which bases for rejection must be applicable for § 1.132 to apply. Instead, the approach would be that § 1.132 is applicable unless the rejection is based upon a U.S. patent to another or others which claims the same patentable invention as defined in § 1.601(n). Section 1.132 is specifically proposed to be amended to state that: (1) when any claim of an application or a patent under reexamination is rejected or objected to, an oath or declaration may be submitted to traverse the rejection or objection; and (2) an oath or declaration may not be submitted under this section to traverse a rejection if the rejection is based upon a U.S. patent to another or others which claims the same patentable invention as defined in § 1.601(n).

Sections 1.131 and 1.132 are procedural in nature that they provide mechanisms for the submission of evidence to antedate or otherwise traverse a rejection; however, they do not address the substantive effect of the submission of such evidence on the objection or rejection at issue. See, e.g., *In re Zletz*, 893 F.2d 319, 322–33, 13 USPQ2d 1320, 1322–23 (Fed. Cir. 1990) (§ 1.131 provides an *ex parte* mechanism whereby a patent applicant may antedate subject matter in a reference); *Newell Cos. v. Kenney Mfg.*, 864 F.2d 757, 768–69, 9 USPQ2d 1417, 1426–27 (Fed. Cir. 1988) (the mere submission of evidence under § 1.132 does not mandate a conclusion of patentability). An applicant's compliance with §§ 1.131 or 1.132 means that the applicant is entitled to have the evidence considered in determining the patentability of the claim(s) at issue. It does not mean that the applicant is entitled as a matter of right to have the rejection or objection of the claim(s) withdrawn.

Section 1.133: Section 1.133(a) is proposed to be amended to provide that interviews must be conducted on "Office premises" (rather than "in the examiner's rooms"). The purpose of this proposed change is to account for interviews conducted in conference rooms or by video conference.

Section 1.136: Section 1.136(c) is proposed to be added to provide that if an applicant is notified in a "Notice of Allowability" that an application is otherwise in condition for allowance, the following time periods are not extendable if set in the "Notice of Allowability" or in an Office action having a mail date on or after the mail

date of the "Notice of Allowability": (1) The period for submitting an oath or declaration in compliance with § 1.63; (2) the period for submitting formal drawings set under § 1.85(c); and (3) the period for making a deposit set under § 1.809(c). See discussion of the change to § 1.85(c).

Section 1.137: Section 1.137(c) is proposed to be amended to provide that any petition under § 1.137 in either a utility or plant application filed before June 8, 1995, must be accompanied by a terminal disclaimer and fee as set forth in § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the lesser of: (1) The period of abandonment of the application; or (2) the period extending beyond twenty years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application(s) under 35 U.S.C. 120, 121, or 365(c), from the date on which the earliest such application was filed. This proposed change will further harmonize effective treatment under the patent term provisions of 35 U.S.C. 154(b) and (c) of utility and plant applications filed before June 8, 1995, with utility and plant applications filed on or after June 8, 1995. Section 1.137(c) is also proposed to provide that its terminal disclaimer requirement does not apply to applications for which revival is sought solely for purposes of copendency with a utility or plant application filed on or after June 8, 1995, or to lapsed patents.

Section 1.138: Section 1.138 is proposed to be amended to clarify the signature requirement for a letter (or written declaration) of express abandonment. Section 1.138(a) is proposed to provide that: (1) An application may be expressly abandoned by filing in the Patent and Trademark Office a written declaration of abandonment identifying the application; and (2) express abandonment of the application may not be recognized by the Office unless it is actually received by appropriate officials in time to act thereon before the date of issue. Section 1.138(b) is proposed to provide that a written declaration of abandonment must be signed by a party authorized under § 1.33(b)(1), (b)(3), or (b)(4) to sign a paper in the application, except that a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a) when filing a continuing application may expressly abandon the prior application as of the filing date granted to the continuing application.

Section 1.152: Section 1.152 is proposed to be revised to be consistent with the proposed changes to § 1.84 (deletion of the petition requirement for color photographs and color drawings). Section 1.152 was amended in 1997 to clarify Office practice that details disclosed in the drawings or photographs filed with a design application are considered to be an integral part of the disclosed and claimed design, unless disclaimed. See Changes to Patent Practice and Procedure, Final Rule Notice, 62 FR 53131, 53164 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 91 (October 21, 1997). A recent decision by the Federal Circuit, however, has called this practice into question. See *In re Daniels*, 144 F.3d 1452, 46 USPQ2d 1788 (Fed. Cir. 1998), *rev'g*, *Ex parte Daniels*, 40 USPQ2d 1394 (BPAI 1996). Accordingly, the Office is proposing to amend § 1.152 to eliminate these provisions. See Removal of Surface Treatment From Design Drawings Permitted, Notice, 1217 Off. Gaz. Pat. Office 19 (December 1, 1998).

Section 1.154: Section 1.154(a) is proposed to be separated into §§ 1.154(a) and 1.154(b) and the material clarified. The order of the papers in a design patent application, including the proposed application data sheet (see § 1.76), is proposed to be listed in § 1.154(a). The order of the sections in the specification of a design patent application is proposed to be listed in § 1.154(b). New § 1.154(c) corresponds to § 1.77(c) and provides that the section heading should be in uppercase letters without underlining or bold type.

Section 1.155: Current § 1.155 is proposed to be eliminated as being unnecessarily duplicative of the provisions of §§ 1.311(a) and 1.316, which apply to the issuance of all patents, including designs. In its place, proposed § 1.155 is proposed to be redrafted to establish a procedure to create a "rocket docket" for design applications. The procedure will be available to all design applicants who first conduct a preliminary examination search and file a request for expedited treatment accompanied by a fee commensurate with the Office cost of the expedited treatment and handling (§ 1.17(t)). The Office will require a statement that a preexamination search was conducted which must also indicate the field of search and include an information disclosure statement in compliance with § 1.98. Formal drawings in compliance with § 1.84 are required. The applications will be individually examined with priority and the clerical processing will be conducted and/or monitored by

specially designated personnel to achieve expeditious processing through initial application processing and the Design Examining Group. The Office will not examine an application that is not in condition for examination even if the applicant files a request for expedited examination under this section. The requirements announced in the Advance Notice relating to constructive election of the first presented invention have been dropped.

General Comments

Of the comments received in response to the proposal to creating a "Rocket Docket" for design applications, most of the comments generally favored the proposal, by roughly a two-to-one margin.

Comment: One commenter opined that the "ultra expedited" procedure is a much needed avenue for patentees concerned with the design and marketing of seasonal, high volume consumer goods and that the procedure would attract new customers and fulfill a critical need in many industries for patent protection to stop infringement and to deter would-be infringers. Moreover, the commenter opined that recent court interpretations of the marking provisions require patented products to be marked with the patent number no matter what monetary remedy the patentee pursues and that having all of the products marked with the patent number will maximize a patentee's protection by synchronizing protection with the retail market launch.

Response: The Office envisions that these provisions will fulfill a particular need by affording rapid design protection on an expedited basis so that designs may be readily patented and marked with a patent number before marketing. At the same time, a fee will be charged to recoup estimated expected costs incurred by the Office.

Comment: Two comments opposed the idea of giving one applicant priority over others based on a fee, or the opportunity to "buy a place in line," further reasoning that the granting of priority should be based on need.

Response: The applicant is not buying a place in line, but instead is merely compensating for the extra costs for expediting the examination of the design applications. Also, if priority were to be granted based upon need, a petition would be required to determine whether the standards for awarding priority had been met. By eliminating the determination of a petition (which is required to determine need or compliance in Petitions to Make Special), the significant time required to make the determination is eliminated.

Comment: Another comment stated that the fee was unjustified in view of the fact that the current "Petition to Make Special" is available at a reduced fee.

Response: Although the current system of making cases special by petition fulfills the needs of some applicants, an additional expedited process is necessary for a quicker, streamlined filing-to-issuance procedure that does not involve the lengthy process of deciding a petition based upon need or some other type of showing. Moreover, the Petition to Make Special procedure requires a petition to be decided once the application reaches the Design Group, whereas the expedited procedure is instituted once the fee is paid and the application is ready for examination. Further, the "Petition to Make Special" will continue to be made available. Although the § 1.155 expedited examination is more costly, the cost is warranted due to more comprehensive expedited procedures to reduce processing time.

Comment: One commenter also suggested that if the Office procedure for dealing with a petition to make special is too complex, then the answer should be to simplify the Petition to Make Special procedure.

Response: The Petition to Make Special procedures are adopted for treating a variety of types of cases for which a determination must be made as to whether the subject matter qualifies under the procedure; e.g., whether "the invention will materially enhance the quality of the environment." On the other hand, the expedited procedure of § 1.155 is an entirely different rule which is fee-based and which may be readily decided as part of a clerical function, thereby reducing processing time and costs since the application does not need to be reviewed by a high level official.

Comment: Two comments were directed to the amount of time the examiners spend on the searching of design applications. One commenter was alarmed by the belief that design applications were examined in groups of ten or twenty and questioned the fairness of not examining the application in the order of filing and of delaying examination until a group is filled. The same commenter reasoned that design applications are easy to search and therefore hiring additional design applications examiners should allow each design application to be examined in the order of filing. The same commenter postulated that applicants should not have to pay a surcharge and perform their own search in order to obtain the examination for

which they have already paid. Another commenter stated that the examiners will require additional time for searching expedited cases.

Response: Only the search phase of the examination of design applications is conducted in groups. Generally, the remainder of the examination process is done individually, unless the subject matter is so close as to involve double patenting. However, the most time consuming part of the design patent application examination is the search for prior art. Unlike the utility patent examiner, the design examiner is not concerned about claim language, but is focusing on visual characteristics that can be readily evaluated and searched. To employ economies of scale, searching is best done in groups. Generally, the size of group depends on the clustering of filing dates and similarities in subject matter. Cases are not delayed since design examiners are required to work on the "oldest-date" case. Moreover, even though a group search may be conducted, the examination is done in order of filing and the cases are not delayed to fill a group. Typically, the examiner picks the oldest date case for examination and then tries to create a group of design applications with similar subject matter for efficiency in searching. As to the comment directed to increasing the number of examiners, to dramatically increase the number of examiners might result in less efficiency due to overlapping subject matter and is not necessarily an option available based on Office priorities and budget. As to the comment regarding the payment of a "surcharge," this is to cover the costs associated with expediting the search. It is recognized that more time is required to search cases individually than that required if the searching is done in groups. As to the requirement of a search performed by the applicant, this will not only enhance the quality of the search but also ensure that applicant is prudently filing for expedited status and making an informed choice. As to the impact of the processing time for expedited cases on those regularly filed, enough resources are being provided so that the handling of expedited cases will not influence the examination of other cases.

Comment: Two comments suggested that the concept be extended to both utility and design applications.

Response: This suggestion is not being adopted at this time, since due to limited resources, the idea is best limited to design applications where due to the relative ease of copying, there is often a need for rapid patent protection.

Comment: One comment supported the measure but asked for a *quid-pro-quo* short time goal of four months.

Response: The Design Group has indicated that they will set as an objective three months cycle-time for examination and one month cycle-time for printing and guidelines for the program shall be explained to the public in the MPEP.

Comment: One comment stated there was no need for an expedited procedure since design applications "are being examined as of late relatively quickly."

Response: Nonetheless, the proposal is responsive to public need for those applicants who are willing to pay an increased, cost-offsetting fee in view of the benefits arising from further decreases in patent prosecution time.

Comment: A few comments stated in opposition to the proposal that the best solution is to hire more examiners.

Response: Although additional manpower conceivably would reduce cycle time, the Office faces certain constraints on its ability to hire more examiners and it must utilize its resources as best it can in order to meet all of the Office's goals.

Comment: Several comments supportive in concept also had specific recommendations for streamlining the application process, including prepayment or preauthorization of the issue fee, and faxing and/or telephoning all communications.

Response: As to the prepayment or preauthorization of the issue fee, this suggestion is not being adopted for reasons similar to those presented in conjunction with the proposal to eliminate preauthorization of payment of the issue fee (§ 1.311). As to making all communications by facsimile or phone, this will be encouraged where practicable and when the applicant's representative supplies a facsimile number. Multiple references, however, may prove too cumbersome for transmission by facsimile.

Comment: One comment suggested that automatic refunds be given if short time goals were not met and that a "Public Advisory Committee" be established to monitor progress and to be a point of contact for suggestions from the public.

Response: The suggestion as to automatic refunds is not being adopted in view of the unpredictability of unforeseen circumstances which might justify the failure to achieve the goal as well as lack of statutory authority to give a refund because a processing goal is not met in time. As to the "Public Advisory Committee," the Office does not foresee the need for such a committee, and the most practical point

of contact would be with the design group itself, which is always open to suggestions from the public.

Section 1.163: Section 1.163(b) is proposed to be eliminated to delete the requirement for two copies of the specification for consistency with the current Office practice. See Interim Waiver of 37 C.F.R. § 1.163(b) for Two Copies of a Specification of an Application for a Plant Patent, Notice, 1213 Off. Gaz. Pat. Office 109 (August 4, 1998). Section 1.163(c) is proposed to be separated into §§ 1.163(b) and 1.163(c). The order of the papers in a plant patent application, including the proposed application data sheet (see § 1.76) is proposed to be listed in § 1.163(b). The order of the sections in the specification of a plant patent application is proposed to be listed in § 1.163(c). New § 1.163(d) corresponds to § 1.77(c) and provides that the section headings should be in uppercase letters without underlining or bold type.

New sections 1.163(c)(4) and 1.163(c)(5) require the plant patent applicant to state the Latin name and the variety denomination for the plant claimed. The Latin name and the variety denomination of the claimed plant are usually included in the specification of the plant patent application. The Office, pursuant to the "International Convention for the Protection of New Varieties of Plants" (generally known by its French acronym as the UPOV convention), has been asked to compile a database of the plants patented and the database must include the Latin name and the variety denomination of each patented plant. Having this information in separate sections of the plant patent application will make the process of compiling this database more efficient.

Current §§ 1.163(c)(5) through 1.163(c)(10) are proposed to be redesignated §§ 1.163(c)(6) through 1.163(c)(11), respectfully.

Section 1.163(c)(14) and 1.163(d) are proposed to be eliminated to delete the reference to a plant patent color coding sheet. The color codes and the color coding system are generally included in the specification. Repeating the color coding information in a color coding sheet increases the risk of error and inconsistencies.

Section 1.173: The proposed changes to § 1.173 regarding identifying all occurrences of claim broadening in a reissue application, which were published in the Advance Notice (Topic 16), have been dropped in view of comments received. A number of comments were directed to the undue burden which the rule change would place on applicants and the potential for

future issues in litigation re § 1.56 violations.

It is now being proposed that § 1.173 be amended to consolidate the requirements for the filing of reissue applications currently in § 1.173, the requirements for amending reissue applications currently in § 1.121, and the requirements for reissue drawings, currently in § 1.174. It is proposed that § 1.174 be eliminated as the requirements for filing drawings would be moved to § 1.173. The proposed language consolidates many procedural and formal requirements for reissue applications into a single section. Paragraphs for separate items within this section have been proposed, in order to set forth the requirements for the specification, claims and drawings in a format which is clearer and easier to understand.

The title § 1.173 is proposed to be changed to "Reissue specification, drawings, and amendments" to more aptly describe the inclusion of all filing and amendment requirements for the specification, including the claims, and the drawings of reissue applications in a single section.

Section 1.173(a), as proposed, sets forth the current requirements for the contents of a reissue application at filing, and the existing prohibition against new matter in a reissue application.

It is proposed in § 1.173(a)(1) to now require that the specification, including the claims, be furnished in the form of a copy of the printed patent with a single column of the patent appearing on each individual page of the specification of the reissue application. This format for submitting a reissue application is currently set out in MPEP 1411. Paragraph (a)(1) would also provide that amendments made to the specification at filing must be made according to paragraph (b) of this section.

Proposed paragraph (a)(2) of § 1.173 sets forth the requirements for the drawings at the time the reissue application is filed. If clean copies (*i.e.*, good quality photocopies free of any extraneous markings) of the drawings from the original patent are supplied by applicant at the time of filing the application and the copies meet the requirements of § 1.84, no further (formal) drawings would be required. The current provision of § 1.174 requiring temporary drawings would be eliminated in view of this proposed change to § 1.173. The Office will be able to print a reissue patent using clean copies of the patent drawings. How changes to the patent drawings may be made at the time of filing of the reissue

application, or during the prosecution, would now be specifically set forth and must be made in accordance with the requirements of proposed paragraph (b)(3) of this section (which are essentially the requirements of current § 1.121(b)(3)(i) and (ii)). If applicant has failed to provide clean copies of the patent drawings, or if changes are made to the drawings during the reissue prosecution, drawings in compliance with § 1.84 would continue to be required at the time of allowance. It is also proposed to eliminate the practice of transferring drawings from the patent file since clean copies of patent drawings will be acceptable for use in the printing of the reissue patent.

Section 1.173(b), as proposed, now sets out that amendments in a reissue application made at the time of filing may be made either by physically incorporating the amendments within the body of the specification (including the claims) as filed, or by a preliminary amendment (separate paper).

Paragraphs (b)(1) and (b)(2) of § 1.173 incorporate the provisions of current § 1.121(b)(1) and (b)(2) as to the manner of amending the specification and claims, respectively.

Proposed § 1.173(b)(3) would incorporate the provisions currently set forth in § 1.121(b)(3) as to amending reissue drawings.

Paragraph (c) of § 1.173, as proposed, would now require, that whenever an amendment is made to the claims, either at the time of filing or during the prosecution, the amendment must be accompanied by a statement as to the status of all patent claims and all added claims, and an explanation as to the support in the disclosure for any concurrently made changes to the claims.

Paragraph (d), as proposed, would incorporate the provisions currently set forth in § 1.121(b)(1)(iii) and (b)(2)(i)(C) as to how changes in reissue applications are shown in the specification and claims, respectively.

Paragraphs (e), (f) and (g), as proposed, merely reiterate requirements for retaining original claim numbering, amending the disclosure when required, and making amendments relative to the original patent, as are set out currently in § 1.121(b)(2)(B), (b)(4), and (b)(6), respectively.

The current requirement of § 1.121(b)(5) prohibiting enlarging the scope of the claims more than two years after the patent grant has been eliminated from proposed § 1.173 as being redundant to existing statutory language in 35 U.S.C. 251.

Section 1.174: It is proposed that § 1.174 be eliminated (and reserved) in

view of the inclusion of all filing and amendment requirements for reissue drawings into proposed § 1.173. Thus, in addition to the reissue filing requirements of current § 1.173, the reissue amendment requirements of current § 1.121(b) and the reissue drawing requirements of current § 1.174 would all be included in a single rule, proposed § 1.173. The proposed changes consolidating several current rules into a single section should make all reissue filing and amendment requirements quicker to locate and easier to understand.

Section 1.176: Section 1.176 is proposed to be amended to eliminate the prohibition against requiring division in a reissue application. The Federal Circuit has indicated that 35 U.S.C. 251 does not, under certain circumstances, prohibit an applicant in a reissue application from adding claims directed to an invention which is separate and distinct from the invention defined by the original patent claims. See *In re Amos*, 953 F.2d 613, 21 USPQ2d 1271 (Fed. Cir. 1991). Section 1.176, however, presently prohibits the Office from making a restriction requirement in a reissue application. This prohibition in § 1.176, in combination with the Federal Circuit's decision in *Amos*, frequently places an unreasonable burden on the Office in requiring the examination of multiple inventions in a single reissue application.

Section 1.176 as proposed would allow the Office to make a restriction requirement in a reissue application between claims added in a reissue application and the original patent claims, where the added claims are directed to an invention which is separate and distinct from the invention(s) defined by the original patent claims. The criteria for making a restriction requirement in a reissue application between added claims and original claims would be the same as that applied in an original application. See MPEP 806 through 806.05(i). See the discussion of § 1.177 concerning the proposed treatment of multiple reissue applications and procedures following a restriction requirement in a reissue.

The Office would continue to not require restriction among original claims of the patent (*i.e.*, among 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 added claims, the added claims must be directed toward inventions which are separate and distinct from the invention(s) defined by the original patent claims. Restriction between multiple inventions

in the added claims would also be possible provided the added claims are drawn to several separate and distinct inventions.

The changes being considered 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.*, 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). See *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990); *In re Mead*, 581 F.2d 251, 198 USPQ 412 (CCPA 1978); and *In re Orita*, 550 F.2d 1277, 193 USPQ 145 (CCPA 1977).

Section 1.11(b) currently exempts reissue continued prosecution applications (CPAs) under § 1.53(d) from the announcement of reissue filing in the *Official Gazette*. The proposed language of § 1.176(b) further clarifies that the examination of a CPA reissue is not subject to a two-month examination delay following its filing.

Section 1.177: It is proposed that § 1.177 be modified to eliminate current requirements that divisional reissues be limited to separate and distinct parts of the thing patented, and that they be issued simultaneously unless ordered by the Commissioner. It is proposed that the rule be expanded to include continuations of reissues as well as divisionals. As a result of comments received following publication in the Advance Notice (Topic 17), none of which were opposed to the proposed changes to § 1.177, the Office is moving forward with the changes proposed.

The Federal Circuit has indicated that 35 U.S.C. 251, ¶ 2, does not place stricter limitations on the filing of continuation or divisional reissue applications than is placed by 35 U.S.C. 120 and 121 on the filing of continuation or divisional non-reissue applications. See *In re Graff*, 111 F.3d 874, 876, 42 USPQ2d 1471, 1473 (Fed. Cir. 1997). The Federal Circuit specifically stated:

* * * [35 U.S.C. 251, ¶ 3,] provides that the general rules for patent applications apply also to reissue applications, and [35 U.S.C. 251, ¶ 2,] expressly recognizes that there may be more than one reissue patent for distinct and separate parts of the thing patented. [35 U.S.C. 251] does not prohibit divisional or continuation reissue applications, and does not place stricter limitations on such applications when they are presented by reissue, provided of course that the statutory requirements specific to reissue applications are met. See [35 U.S.C. 251, ¶ 3].

* * * [35 U.S.C. 251, ¶ 2,] is plainly intended as enabling, not limiting. [35 U.S.C. 251, ¶ 2,] has the effect of assuring that a different burden is not placed on divisional or continuation reissue applications, compared with divisions and continuations

of original applications, by codifying [*The Corn-Planter Patent*, 90 U.S. 181 (1874),] which recognized that more than one patent can result from a reissue proceeding. Thus, [35 U.S.C. 251, ¶ 2,] places no greater burden on [a] continuation reissue application than upon a continuation of an original application; [35 U.S.C. 251, ¶ 2,] neither overrides, enlarges, nor limits the statement in [35 U.S.C. 251, ¶ 3,] that the provisions of Title 35 apply to reissues.

Graff, 111 F.3d at 876–77, 42 USPQ2d at 1473. Thus, the Federal Circuit has indicated that a continuation or divisional reissue application is not subject to any greater burden other than the burden imposed by 35 U.S.C. 120 and 121 on a continuation or divisional non-reissue application, except that a continuation or divisional reissue application must also comply with the statutory requirements specific to reissue applications (e.g., the “error without any deceptive intention” requirement of 35 U.S.C. 251, ¶ 1).

Following *Graff*, the Office has adopted a policy of treating continuations/divisionals of reissue applications in much the same manner as continuations/divisionals of non-reissue applications. Accordingly, it is proposed that the current requirements of § 1.177 as to petitioning for non-simultaneous issuance of multiple reissues, suspending prosecution in an allowable reissue while the other is prosecuted, and limiting the content of each reissue to separate and distinct parts of the thing patented, all be eliminated. These requirements are considered unique to reissue continuations/divisionals, impose additional burdens on reissue applicants, and are not consistent with the Federal Circuit’s discussion of 35 U.S.C. 251, ¶ 2, in *Graff*.

It is proposed that § 1.177(a) be changed to require that all multiple reissue applications from a single patent include as the first line of the respective specifications a cross reference to the other reissue application(s). The statement would provide the public with notice that more than one reissue application has been filed to correct an error (or errors) in a single patent. If one reissue has already issued without the appropriate cross reference, a certificate of correction would be issued to provide the cross reference in the issued reissue.

In § 1.177(b), it is proposed that all of the claims of the patent be presented in each application as amended, unamended or canceled, and that the same claim not be presented for examination in more than one application in its original unamended version. Any added claims would have to be numbered beginning with the next

highest number following the last patent claim.

If the same or similar claims were presented in more than one of the multiple reissue applications, statutory double patenting (35 U.S.C. 101) or non-statutory (judicially created doctrine) double patenting considerations would be given by the examiner during examination, and appropriate rejections made. If needed to overcome the rejections, terminal disclaimers would be required in order to ensure common ownership of any non-distinct claims throughout each of the patents’ lifetimes.

It is also being proposed concurrently that restriction between the original patent claims and any added claims to separate and distinct subject matter be permitted in reissue applications (see the proposed change to § 1.176). If one or more divisional applications are filed after such a restriction requirement, it is proposed in § 1.177(c) that the resulting multiple reissue applications would be issued alone or together, but each of the reissue applications would be required to include changes which correct an error in the original patent before it can be issued as a reissue patent. If one of the applications resulting from the restriction requirement was found to be allowable without any changes relative to the patent (i.e., it includes only all the original patent claims), further action would be suspended until one other reissue application was allowable; then, the two would be recombined and issued as a single reissue patent. If the several reissue applications resulting from the restriction each included changes correcting some error in the original patent, the reissue applications could be issued separately, with an appropriate cross-reference to the other(s) in each of the respective specifications.

Section 1.178: Section 1.178 is proposed to be amended to no longer require an offer to surrender the original patent at the time of filing as part of the reissue application filing requirements. The inclusion of a sentence regarding the “offer” is frequently overlooked by reissue applicants at the time of filing and results in the Office sending out a Notice to File Missing Parts of Application (Missing Parts Notice). The time spent by the Office in preparing the Missing Parts Notice, the time needed by applicant to reply, and the further time needed by the Office to process applicant’s “offer” reply, can all be saved by the proposed change. The requirement for actual surrender of the original patent (or a “statement” of its loss, as set out below) before the reissue

application is allowed, however, is retained.

It is also proposed that § 1.178 be amended to change “affidavit or declaration” (attesting to the loss or inaccessibility of the original patent) to “statement.” This proposed change would eliminate the verification requirements of the current rule, which are formalities covered by §§ 1.4 and 10.18. This change is in conformance with other similar changes to the patent rules which were effective on December 1, 1997, to ease the verification requirements of applicants. See Changes to Patent Practice and Procedure, 62 FR at 53175–78, 1203 Off. Gaz. Pat. Office at 100–03.

Section 1.193: Section 1.193(b)(1) is proposed to be amended to provide that appellant may file a reply brief to an examiner’s answer “or a supplemental examiner’s answer.” The purpose of this proposed amendment is to clarify the current practice that the appellant may file a (or another) reply brief within two months of a supplemental examiner’s answer (§ 1.193), but the appellant must file any request for an oral hearing within two months of the examiner’s answer (§ 1.194).

Section 1.303: Section 1.303(a) is proposed to be amended to add the phrase “to an interference” between “any party” and “dissatisfied with the decision of the Board of Patent Appeals and Interferences” to correct an inadvertent omission.

Section 1.311: Section 1.311(b) is proposed to be amended to provide that an authorization to charge the issue fee (§ 1.18) to a deposit account may be filed in an individual application only after mailing of the notice of allowance (PTOL–85).

The suggestion of eliminating preauthorization of payment of the issue fee was discussed in Topic 19 of the Advance Notice and received a generally favorable response. Many patent attorneys stated that they considered preauthorization a dangerous practice that they would not use. Others thought that preauthorization was an important safety feature, and that the Office should fix the internal clerical problems which were motivating the change.

After considering all of the comments, the Office has decided to go forward with the proposal to eliminate the ability of applicants to preauthorize payment of the issue fee. Section 1.311(b), as currently written, causes problems for the Office that tend to increase Office processing time. The language used by applicants to authorize that fees be charged to a deposit account often varies from one

application to another. As a result, conflicts arise between the Office and applicants as to the proper interpretation of authorizing language found in their applications. For example, some applicants are not aware that it is current Office policy to interpret broad language to "charge any additional fees which may be required at any time during the prosecution of the application" as authorization to charge the issue fee on applications filed on or after October 1, 1982. See Deposit Account Authorization to Charge Issue Fee, Notice 1095 Off. Gaz. Pat. Office 44 (October 25, 1988), reprinted at 1206 Off. Gaz. Pat. Office 95 (January 6, 1998).

Even when the language preauthorizing payment of the issue fee is clear, the preauthorization can present problems for both the Office and practitioners. One problem is because it may not be clear to the Office whether a preauthorization is still valid after the practitioner withdraws or the practitioner's authority to act as a representative is revoked. If the Office charges the issue fee to the practitioner's deposit account, the practitioner may have difficulty getting reimbursement from the practitioner's former client. Another problem is that when the issue fee is actually charged at the time the notice of allowance is mailed, a notice to that effect is printed on the notice of allowance (PTOL-85) and applicant is given one month to submit/return the PTOL-85B with information to be printed on the patent. Applicants are sometimes confused, however, by the usual three-month time period provided for paying the issue fee and do not, therefore, return the PTOL-85B until the end of the normal three-month period. As the Office does not wait for the PTOL-85B to be returned to begin electronic capture of the data to be printed as a patent, any PTOL-85B received more than a month after the issue fee has been paid may not be matched with the application file in time for the information thereon to be included on the patent.

Clerical problems are not the main reason for proposing to eliminate the practice. The Office would like all of the information necessary for printing a patent to be in the application when the issue fee is paid. Thus, the Office is proposing to eliminate petitions under § 3.81(b), see below, and intends to no longer print any assignee data that is submitted after payment of the issue fee. As explained in the Advance Notice, it is not generally in applicant's best interest to pay the issue fee at the time the notice of allowance is mailed, since it is much easier to have a necessary

amendment or an information disclosure statement considered if filed before the issue fee is paid rather than after the issue fee is paid. See current §§ 1.97 and 1.312(b). Also, once the issue fee has been paid, applicant's window of opportunity for filing a continuing application is reduced and the applicant no longer has the option of filing a continuation or divisional application as a continued prosecution application (CPA) under § 1.53(d). See Patents to Issue More Quickly After Issue Fee Payment, 1220 Off. Gaz. Pat. Office at 42, and Filing of Continuing Applications, Amendments, or Petitions after Payment of Issue Fee, 1221 Off. Gaz. Pat. Office at 14. Many applicants find the time period between the mailing date of the notice of allowance and the due date for paying the issue fee useful for re-evaluating the scope of protection afforded by the allowed claim(s) and for deciding whether to pay the issue fee and/or to file one or more continuing applications.

If prompt issuance of the patent is a high priority, after receipt of the notice of allowance applicant may promptly return the PTOL-85B (supplying any desired assignee and attorney information) and pay the issue fee. In this way, the Office will be able to process the payment of the issue fee and the information on the PTOL-85B as a part of a single processing step. Further, no time would be saved even if the issue fee was preauthorized for payment as the Office would still not have the assignee and attorney data which is taken from the PTOL-85B. Thus, it is not seen that the proposal to eliminate the preauthorization to pay the issue fee would have any adverse effects on our customers.

Section 1.312: Section 1.312(a) is proposed to be amended to change "case" to "application" for clarity. Section 1.312(b) is proposed to be amended to replace the required showing of good and sufficient reason of why the amendment is needed and was not earlier presented, to provide that any amendment pursuant to § 1.312 filed after the date the issue fee is paid must be accompanied by: (1) A petition under § 1.313(c)(1) to withdraw the application from issue; (2) an unequivocal statement that one or more claims are unpatentable; and (3) an explanation as to how the amendment is necessary to render such claim or claims patentable. The proposed change to § 1.312(b) is necessary because the change in the patent printing process (discussed above with respect to § 1.55) will dramatically reduce the period between the date of issue fee payment and the date a patent is issued. In view

of the brief period between the date of issue fee payment and the date a patent is issued, the Office must limit amendments under § 1.312 to those necessary to avoid the issuance of a patent containing an unpatentable claim or claims. Other amendments must be filed prior to payment of the issue fee (preferably within one month of the mailing of a notice of allowance), or be sought in a continuing application (see § 1.313(c)(2)) or by certificate of correction under 35 U.S.C. 255 and § 1.323.

Section 1.313: Section 1.313(a) is proposed to be amended to provide that: (1) Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant; (2) to request that the Office withdraw an application from issue, the applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application is necessary; and (3) if the Office withdraws the application from issue, the Office will issue a new notice of allowance if the Office again allows the application. The changes proposed to separate the language directed to actions by applicants and those actions by the Office are also proposed to increase the clarity of the section.

Section 1.313(b) is proposed to be amended to provide that once the issue fee has been paid, the Office will not withdraw the application from issue at its own initiative for any reason except: (1) a mistake on the part of the Office; (2) a violation of § 1.56 or illegality in the application; (3) unpatentability of one or more claims; or (4) for interference. Section 1.313(c) is proposed to provide that once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except: (1) Unpatentability of one or more claims (see § 1.312(b)); or (2) for express abandonment (which express abandonment may be in favor of a continuing application). As discussed above, changes in the patent printing process will dramatically reduce the period between the date of issue fee payment and the date a patent is issued. The Office must streamline the provisions of current § 1.313(b) or the Office will not be able to render decisions on such petitions before the application is issued as a patent.

It is the Office's experience that petitions under current § 1.313(b) are rarely filed (and even more rarely granted) on the basis of: (1) A mistake on the part of the Office; (2) a violation of § 1.56 or illegality in the application;

(3) unpatentability of one or more claims; or (4) for interference. Therefore, the Office is proposing to provide that the Office may withdraw applications from issue after payment of the issue fee at its own initiative for these bases, but limit petitions under current § 1.313(b) (§ 1.313(c) as proposed) to: (1) unpatentability of one or more claims; or (2) for express abandonment, (which express abandonment may be in favor of a continuing application). If a petition under § 1.313(c) filed on the basis of unpatentability of one or more claims (§ 1.313(c)(1)), that petition must (in addition to meeting the requirements of § 1.313(a)) be accompanied by an amendment (pursuant to § 1.312), an unequivocal statement that one or more claims are unpatentable, and an explanation as to how the amendment is necessary to render such claim or claims patentable. See discussion of § 1.312(b).

Obviously, if an applicant believes that an application should be withdrawn from issue (after payment of the issue fee) on the basis of a mistake on the part of the Office, a violation of § 1.56 or illegality in the application, or for interference, the applicant may contact the examiner and suggest that the examiner request the Group Director to withdraw the application from issue at the initiative of the Office. The applicant, however, cannot insist that the Office withdraw an application from issue (after payment of the issue fee) for these reasons.

Section 1.313(d) is proposed to provide that a petition under § 1.313 will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate officials before the date of issue. Section 1.313(d) is also proposed to advise applicants that withdrawal of an application from issue after payment of the issue fee may not be effective to avoid publication of application information. While the Office takes reasonable steps to stop the publication and dissemination of application information (e.g., the patent document) once an application has been withdrawn from issue, withdrawal from issue after payment of the issue fee often occurs too late in the patent printing process to completely maintain the application in confidence. How much of the application information is actually disseminated depends upon how close to the issue date the application is withdrawn from issue. The change in the patent printing process (discussed above with respect to § 1.55) will make it less likely that the Office can completely stop the publication and dissemination of application information in an application

withdrawn from issue under § 1.313 after payment of the issue fee.

Section 1.314: Section 1.314 is proposed to be amended to change the reference to the fee set forth in “§ 1.17(i)” to the fee set forth in “§ 1.17(h).” This change is for consistency with the changes to § 1.17(h) and § 1.17(i). See discussion of changes to § 1.17(h) and § 1.17(i).

Section 1.322: Section 1.322(a) is proposed to be amended to provide that: (1) The Office may issue a certificate of correction under the conditions specified in 35 U.S.C. 254 at the request of the patentee or the patentee's assignee or at its own initiative; and (2) the Office will not issue such a certificate at its own initiative without first notifying the patentee (including any assignee of record) at the correspondence address of record and affording the patentee an opportunity to be heard. Section 1.322 as proposed would continue to provide that if the request relates to a patent involved in an interference, the request must comply with the requirements of this section and be accompanied by a motion under § 1.635. The current language of § 1.322(a) permits a third party request for a certificate for correction (a party “not owning an interest in the patent”), which has led third parties to conclude that they have standing to demand that the Office issue, or refuse to issue, a certificate of correction. Third parties do not have standing to demand that the Office issue, or refuse to issue, a certificate of correction. See *Hallmark Cards, Inc. v. Lehman*, 959 F. Supp. 539, 543–44, 42 USPQ2d 1134, 1138 (D.D.C. 1997). Since the burden on the Office caused by such third-party requests now outweighs the benefit such information provides to the Office, the Office is proposing to amend § 1.322 such that a certificate of correction will be issued only at the request of the patentee or at the initiative of the Office.

Section 1.323: Section 1.323 is proposed to be amended to provide that the Office may issue a certificate of correction under the conditions specified in 35 U.S.C. 255 at the request of the patentee or the patentee's assignee, upon payment of the fee set forth in § 1.20(a). The language from 35 U.S.C. 255 currently in § 1.323 that provides the specific conditions under which a certificate of correction under § 1.323 will be issued is proposed to be eliminated for consistency with § 1.322 and because it is redundant to repeat the language of the statute in the rule. Section 1.323 as proposed would continue to provide that if the request relates to a patent involved in an interference, the request must comply

with the requirements of this section and be accompanied by a motion under § 1.635.

Section 1.324: Section 1.324 would have the title revised to reference the statutory basis for the rule, 35 U.S.C. 256. It is particularly important to recognize that 35 U.S.C. 256, the statutory basis for corrections of inventorship in patents under § 1.324, is stricter than 35 U.S.C. 116, the statutory basis for corrections of inventorship in applications under § 1.48. 35 U.S.C. 256 requires “on application of all the parties and assignees,” while 35 U.S.C. 116 does not have the same requirement. Thus, the flexibility under 35 U.S.C. 116, and § 1.48, wherein waiver requests under § 1.183 may be submitted (e.g., MPEP 201.03, page 200–6, Statement of Lack of Deceptive Intention), is not possible under 35 U.S.C. 256, and § 1.324.

Section 1.324(b)(1) would be revised to eliminate the requirement for a statement from an inventor being deleted stating that the inventorship error occurred without deceptive intent. The revision would be made to conform Office practice to judicial practice as enunciated in *Stark v. Advanced Magnetics, Inc.*, 119 F.3d 1551, 43 USPQ2d 1321 (Fed. Cir. 1997), which held that 35 U.S.C. 256 only requires an inquiry into the intent of a nonjoined inventor. The clause stating “such error arose without deceptive intent on his part” was interpreted by the court as being applicable only when there is an error where an inventor is not named, and not when there is an error where a person is named as an inventor. While the decision recognized that the Office's additional inquiry as to inventors named in error was appropriate under 35 U.S.C. 256 when read in conjunction with inequitable conduct standards, the Office no longer wishes to conduct an inquiry broader in scope than what would be conducted had the matter been raised in a court proceeding rather than under § 1.324.

Section 1.324(b)(2), which requires a statement from the current named inventors either agreeing to the requested change or stating that they have no disagreement to the requested change, would not be revised. Paragraph (b)(2) in combination with paragraph (b)(1) ensures compliance with the requirement of the statute for application by all the parties, which requirement is separate from the requirement that certain parties address the lack of deceptive intent in the inventorship error.

Section 1.324(c) would be a newly added paragraph to reference §§ 1.48, 1.497 and 1.634 for corrections of

inventorship in national applications, international applications and interferences, respectively.

Section 1.366: Section 1.366(c) is proposed to be amended to continue to provide that a maintenance fee payment must include the patent number and the application number of the United States application for the patent on which the maintenance fee is being paid, but to further provide that if the payment includes identification of only the patent number (*i.e.*, does not identify the application number for the patent on which the maintenance fee is being paid), the Office may apply the payment to the patent identified by patent number in the payment or may return the payment. The Office requires the application number to detect situations in which a maintenance payment is submitted for the incorrect patent (*e.g.*, due to a transposition error in the patent number). Nevertheless, a significant number of maintenance fee payments contain only the patent number and not the application number for the patent on which the maintenance fee is being paid.

The proposed change to § 1.366(c) will permit the Office to streamline processing of maintenance fee payments that lack the application number for the patent on which the maintenance fee is being paid. The Office intends to treat payments that do not contain both a patent number and application number as follows: *First*, a reasonable attempt will be made to contact the person who submitted the payment (patentee or agent) by telephone to confirm the patent number and application number of the patent for which the maintenance fee is being paid. *Second*, if such an attempt is not successful but the payment includes at least a patent number, the payment will be processed as a maintenance fee paid for the patent number provided, and the person who submitted the payment will be sent a letter informing him or her of the patent number and application number of the patent to which the maintenance fee was posted and given a period of time within which to file a petition under § 1.377 (and § 130) if the maintenance fee was not posted to the patent for which the payment was intended. If the payment does not include a patent number (*e.g.*, includes only an application number), the payment will be returned to the person who submitted the payment.

Section 1.446: Section 1.446 is proposed to be amended in such that its refund provisions are consistent with the refund provisions of § 1.26. See discussion of § 1.26.

Section 1.497: Section 1.497(b)(2) has been proposed to be amended in a manner consistent with § 1.64(b). Therefore, § 1.497(b)(2) is proposed to be amended to refer to any supplemental oath or declaration and to provide that if the person making the oath or declaration is the legal representative, the oath or declaration shall state that the person is the legal representative and shall state the citizenship, residence, and mailing address of the legal representative. In addition, § 1.497(b)(2) is proposed to be amended to clarify that facts submitted under §§ 1.42, 1.43, and 1.47 are not required to be in the § 1.497 oath or declaration. Section 1.497(d) is proposed to provide for the situation in which an oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and § 1.497 names an inventive entity different from the inventive entity set forth in the international stage. Section 1.497(d) is proposed to be added to provide that such an oath or declaration must be accompanied by: (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international stage occurred without deceptive intention on his or her part; (2) the processing fee set forth in § 1.17(i); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee (*see* § 3.73(b)). Thus, naming a different inventive entity in an oath or declaration filed to enter the national stage under 35 U.S.C. 371 in an international application is not analogous to the filing of an oath or declaration to complete an application under 35 U.S.C. 111(a) (which operates itself to name the new inventive entity under §§ 1.41(a)(1) and 1.48(f)(1)), but is analogous to correction of inventorship under § 1.48(a).

Section 1.510: Paragraph (b)(4) of § 1.510 is proposed to be revised to correspond to paragraph (a) of § 1.173 as revised by the present notice, *see* the discussion as to the revision of § 1.173. It is considered advantageous for the reexamination and reissue provisions to correspond with each other to the maximum extent possible, in order to eliminate confusion.

Section 1.530: Paragraph (d) of § 1.530 is proposed to be revised, and paragraphs (e)–(i) are proposed to be added, to correspond to paragraph (b) *et seq.* of § 1.173 as revised by the present notice, *see* the discussion as to the revision of § 1.173. It is considered advantageous for the reexamination and reissue provisions to correspond with each other to the maximum extent

possible, in order to eliminate confusion. Paragraphs (d)(3) and (d)(4) of § 1.530 are proposed to be redesignated as paragraphs (j) and (k) of § 1.530.

Section 1.530(l) is proposed to be added to make it clear that where the inventorship of a patent being reexamined is to be corrected, a petition for correction of inventorship which complies with § 1.324 must be submitted during the prosecution of the reexamination proceeding. If the petition under § 1.324 is granted, a certificate of correction indicating the change of inventorship will not be issued, because the reexamination certificate that will ultimately issue will contain the appropriate change-of-inventorship information (*i.e.*, the certificate of correction is in effect merged with the reexamination certificate). In the rare instances where the reexamination proceeding terminates but does not result in a reexamination certificate under § 1.570 (reexamination is vacated or the order for reexamination is denied), patentee may then request that the inventorship be corrected by a certificate of correction indicating the change of inventorship.

Section 1.550: Where an application has become abandoned for failure to timely respond, the application can be revived under 35 U.S.C. 133 upon an appropriate showing of unavoidable delay via petition for revival and a petition fee. Analogously, where a reexamination proceeding becomes terminated for failure to timely respond, the proceeding can be restored to pendency under 35 U.S.C. 133 upon an appropriate showing of unavoidable delay, again via a petition and fee. *See In re Katrapat, AG*, 6 USPQ2d 1863, 1865–66 (Comm'r Pat. 1988).

In a situation where an appropriate showing of unavoidable delay cannot be made, an abandoned application can be revived upon an appropriate showing that the delay was unintentional via a petition and fee. The showing that the delay was unintentional is a lesser standard than that of unavoidable delay; however, the required petition fee for an unintentional delay petition is substantially larger than that of an unavoidable delay petition. This unintentional delay alternative has been found to be highly desirable to deal with situations where the higher standard for revival cannot be met; to eliminate paperwork, time, and effort in making the unavoidable delay showing; and to eliminate the need to request reconsideration if the initial petition for revival is dismissed or denied.

Despite the advantages of relief to petitioners via the unintentional delay alternative, there is no such alternative in reexamination proceedings. See *Katrapat*, 6 USPQ2d at 1866-67. It would be desirable to provide an unintentional delay alternative by rulemaking. Unfortunately, the statute does not provide a basis for unintentional delay relief in reexamination proceedings that is analogous to that for an application. The statutory basis for revival of an application based upon the unintentional delay standard is 35 U.S.C. 41(a)(7). There is no such statutory basis for restoring a reexamination proceeding to pendency based upon the unintentional delay standard.

Section 1.550(c) is proposed to be revised to provide the reexamination patentee with unintentional delay relief for any reply filed within the full statutory time period for submission of the papers that were unintentionally delayed. This relief would be provided in the form of an extension of time under § 1.550(c), which would be granted when unintentional delay is established and the appropriate extension of time fee is paid.

This avenue of unintentional delay relief is expected to deal with the majority of reexamination proceedings terminated for untimely response. The reason for this is as follows. Late responses are most often generated because of one of three reasons: (1) The patentee does not realize that an extension must be requested prior to the response due date and thus, files the response after the due date together with an extension request; (2) the patentee files the extension request shortly prior to the due date but fails to give reasons for the extension, and the time expires before a proper reexamination extension request can subsequently be provided and (3) the patentee is aware of the need for giving reasons and for filing of the request prior to the due date, however, the reminder docket system is not set up for the reexamination type of extension request and the request is not timely or properly made. In all three of these situations, the extension generally reaches the Office prior to the full six-month statutory period for submission of the response, especially given the fact that a one- or two-month shortened statutory period is set for response in reexamination. If there is time remaining in the statutory period, the Office can notify the patentee that an extension in accordance with § 1.550(c)(2) is needed to maintain pendency.

It is understood that the proposed revision will not provide relief to patentees in all cases with an unintentional termination of reexamination proceedings. However, in the absence of a statutory amendment to providing unintentional delay relief analogous to that of 35 U.S.C. 41(a)(7) for an application, the present rule change is believed to be the best avenue available to give patentees unintentional delay relief in reexamination proceedings.

Section 1.666: Section 1.666(b) is proposed to be amended to change the reference to the fee set forth in “§ 1.17(i)” to the fee set forth in “§ 1.17(h).” This change is for consistency with the changes to § 1.17(h) and § 1.17(i). See discussion of changes to § 1.17(h) and § 1.17(i).

Section 1.720: Section 1.720(b) is proposed to be amended to clarify that a patent extended under § 1.701 or § 1.790 would also be eligible for patent term extension. Section 1.720(g) is proposed to be amended to clarify that an application for patent term extension may be timely filed during the period of an interim extension under § 1.790.

Section 1.730: Section 1.730 is proposed to be amended to add new paragraphs (b), (c) and (d) which state who should sign the patent term extension application and what proof of authority may be required of the person signing the application. 35 U.S.C. 156 provides that an application for patent term extension must be filed by the patent owner of record or an agent of the patent owner. The Office interprets an agent of a patent owner to be either a licensee of the patent owner (for example, the party that sought permission from the Food and Drug Administration for permission to commercially use or sell a product, *i.e.*, the marketing applicant), or a registered attorney or agent. Proposed § 1.730(b) explains that, if the application is submitted by the patent owner, the correspondence must be signed by the patent owner or a registered practitioner. Proposed § 1.730(c) states that, if the application is submitted by an agent of the patent owner, the correspondence must be signed by a registered practitioner, and that the Office may require proof that the agent is authorized to act on behalf of the patent owner. Lastly, proposed § 1.730(d) states that the Office may require proof of authority of a registered practitioner who signs the application for patent term extension on behalf of the patent owner or the agent of the patent owner.

Section 1.740: Currently, for each product claim, method of use claim, and

method of manufacturing claim which reads on the approved product, a showing is required demonstrating the manner in which each applicable claim reads on the approved product. Section 1.740(a)(9) is proposed to be amended to provide that the application for patent term extension only needs to explain how *one* product claim claims the approved product, if there is a claim to the product. In addition, the application would only need to explain how one method of use claim claims the method of use of the approved product, if there is a claim to the method of use of the product. Lastly, the application would only need to explain how one claim claims the method of manufacturing the approved product, if there is a claim to the method of manufacturing the approved product. With this proposed change, applicants for patent term extension should be able to reduce the time required to prepare the application since at the most only three claims would have to be addressed rather than all the claims that read on the three categories. Each claim that claims the approved product, the method of use of the approved product, or the method of manufacturing the approved product would still be required to be listed. See 35 U.S.C. 156(d)(1)(B).

Section 1.740(a)(10) is proposed to be amended to separate the text into paragraphs (A), (B) and (C) to aid in comprehension of the text.

Section 1.740(a)(14) is proposed to be amended to add “and” after the semicolon since the paragraph is now the next to last paragraph.

Section 1.740(a)(15) is proposed to be amended to change the semicolon to a period.

Section 1.740(a)(16) is proposed to be moved to § 1.740(b), the number of copies changed from two to three, and to eliminate the express “certification” requirement.

Section 1.740(a)(17) is proposed to be deleted as the requirement for an oath or declaration is being deleted in § 1.740(b).

Section 1.740(b) is proposed to be amended to delete the requirement for an oath or declaration since the averments set forth in § 1.740(b) are implicit in the submission of an application for patent term extension and the signature to the application.

Section 1.740(c) is proposed to be amended to increase the time period for response to a notice of informality for an application for patent term extension from one month to two months, where the notice of informality does not set a time period.

Section 1.741: Section 1.741(a) is proposed to be amended to clarify the

language to reference §§ 1.8 and 1.10 instead of referencing the rules and the titles of the rules. Section 1.741(a)(5) is proposed to be amended to correct the format of the citation of the statute. Section 1.741(b) is proposed to be amended to provide that requests for review of a decision that the application for patent term extension is incomplete, or review of the filing date accorded to the application, must be filed as a petition under § 1.741 accompanied by the fee set forth in § 1.17(h), rather than a petition under § 1.181, and that the petition must be filed within two months of the date of the notice, and that the extension of time provisions of § 1.136 apply.

Section 1.780: Section 1.780, including the title, is proposed to be amended to use terminology consistent with current practice by inserting the term "order."

Section 1.809: Section 1.809(b) is proposed to be amended to change "respond" to "reply" (see § 1.111), and § 1.809(b)(1) is proposed to be amended to eliminate the language discussing payment of the issue fee. Section 1.809(c) is proposed to be amended to provide that if an application for patent is otherwise in condition for allowance except for a needed deposit and the Office has received a written assurance that an acceptable deposit will be made, applicant will be notified and given a period of time within which the deposit must be made in order to avoid abandonment. Section 1.809(c) is also proposed to be amended to provide that this time period is not extendable under § 1.136 (a) or (b) (see § 1.136(c)). Section 1.809(c) is also proposed to be amended to eliminate the language stating that failure to make a needed deposit will result in abandonment for failure to prosecute because abandonment for failure to prosecute occurs by operation of law when an applicant fails to timely comply with such a requirement (see 35 U.S.C. 133).

Section 1.821: The Office indicated in the Advance Notice that the submission of sequence listings on paper is a significant burden on the applicants and the Office, and that it was considering changes to § 1.821 *et seq.* to: (1) Permit a machine-readable submission of the nucleotide and/or amino acid sequence listings to be submitted in an appropriate archival medium; and (2) no longer require the voluminous paper submission of nucleotide and/or amino acid sequence listings. See Changes to Implement the Patent Business Goals, 63 FR at 53510-12, 1215 Off. Gaz. Pat. Office at 99-100.

Unlike a computer program listing appendix under § 1.96(c), a sequence

listing under § 1.821 is part of the disclosure of the application. The Office, however, may accept electronically filed material in a patent application, regardless of whether it is considered "essential" or "nonessential." The patent statute requires that "[a]n application for patent shall be made * * * in writing to the Commissioner." 35 U.S.C. 111(a)(1) (emphasis added). With regard to the meaning of the "in writing" requirement of 35 U.S.C. 111(a)(1), "[i]n determining any Act of Congress, unless the context indicates otherwise * * *, "writing" includes printing and typewriting and reproduction of visual symbols by photographing, multigraphing, mimeographing, manifold, or otherwise." 1 U.S.C. 1 (emphasis added); see also Fed. R. Evid. 1001(1) (writing defined as including magnetic impulse and electronic recording) and title XVII of the Omnibus Consolidated and Emergency Supplemental Appropriations Act, 1999, Pub. L. 105-277, 112 Stat. 2681 (1998) (the Government Paperwork Elimination Act). An electronic document (or an electronic transmission of a document) is a "reproduction of visual symbols," and the "in writing" requirement of 35 U.S.C. 111(a)(1) does not preclude the Office from accepting an electronically filed document. Likewise, there is nothing in the patent statute that precludes the Office from designating an "electronic" record of an application file as the Office's "official" copy of the application.

As discussed with regard to the proposed change to § 1.96, CD-ROM and CD-R are the only practical electronic media of archival quality. The CD-ROM or CD-R sequence listing would serve as the "original" of the sequence listing, yet still offer the conveniences of small size and ease in viewing. Thus, the Office is specifically considering revising § 1.821 *et seq.* to permit applicants to submit the official copy of the sequence listing either on paper or on CD-ROM or CD-R.

Section 1.821(c) is proposed to be amended to provide that a "Sequence Listing" must be submitted either: (1) on paper in compliance with § 1.823(a)(1) and (b); or (2) as a CD-ROM or CD-R in compliance with § 1.823(a)(2) and (b) that will be retained with the paper file. Section 1.821 is also proposed to be amended to provide that applicant may submit a second copy of the CD-ROM or CD-R "Sequence Listing" to satisfy the requirement for a "Sequence Listing" in a computer readable format pursuant to § 1.821(e), provided that the CD-ROM or CD-R "Sequence Listing" meets the requirements of § 1.824(c)(4).

However, in order for a sequence listing to be a part of an international application, it must be filed in paper.

Section 1.821(e) and § 1.821(f) are proposed to be amended for consistency with the provisions in § 1.821(c) that permit the official copy of the "Sequence Listing" required by § 1.821(c) to be a paper or a CD-ROM or CD-R copy. Should these provisions be adopted, conforming changes may be made in the regulations to accommodate international applications in the national stage.

Section 1.823: The heading of § 1.823 is proposed to be amended for consistency with the provisions in § 1.821(c) that permit the official copy of the "Sequence Listing" required by § 1.821(c) to be a paper or a CD-ROM or CD-R copy. Section 1.823(a) is proposed to be amended to be divided into a paragraph (a)(1) that sets forth its current requirement as applying if the "Sequence Listing" submitted pursuant to § 1.821(c) is on paper, and a paragraph (a)(2) setting forth the requirements if the "Sequence Listing" submitted pursuant to § 1.821(c) is on a CD-ROM or CD-R. Section 1.823(a)(2) is proposed to provide that: (1) a "Sequence Listing" submitted on a CD-ROM or CD-R must be a text file in the American Standard Code for Information Interchange (ASCII) in accordance with the standards for that medium set forth in 36 CFR 1228.188(c)(2)(i) (no other format allowed); (2) the CD-ROM or CD-R "Sequence Listing" must be accompanied by documentation on paper that contains the machine format (e.g., IBM-PC, Macintosh (etc.)), the operating system (e.g., MS-DOS, Macintosh, Unix) and any other special information that is necessary to identify, maintain, and interpret the electronic "Sequence Listings"; and (3) a notation that "Sequence Listing" is submitted on a CD-ROM or CD-R must be placed conspicuously in the specification (see § 1.77(b)(11)). Section 1.823(a)(2) is also proposed to provide that the CD-ROM or CD-R "Sequence Listing" must be labeled with the following information: (1) The name of each inventor (if known); (2) title of the invention; (3) the sequence identifiers of the "Sequence Listings" on that CD-ROM or CD-R; and (4) the docket number used by the person filing the application to identify the application (if applicable). Finally, § 1.823(c)(4) is proposed to be amended to refer to CD-R (as well as the CD-ROM currently provided for). Should these provisions be adopted, conforming changes may be made in the regulations to accommodate international applications in the national stage.

Section 1.825: Section 1.825(a) is proposed to be amended to provide that any amendment to the CD-ROM or CD-R copy of the "Sequence Listing" submitted pursuant to § 1.821 must be made by submission of a new CD-ROM or CD-R containing a substitute "Sequence Listing," and that such amendments must be accompanied by a statement that indicates support for the amendment in the application-as-filed, and a statement that the new CD-ROM or CD-R includes no new matter. Section 1.825(b) is proposed to be amended to provide that any amendment to the CD-ROM or CD-R copy of the "Sequence Listing" pursuant to § 1.825(a) must be accompanied by a substitute copy of the computer readable form of the "Sequence Listing" required pursuant to § 1.821(e), including all previously submitted data with the amendment incorporated therein, and accompanied by a statement that the computer readable form copy is the same as the new CD-ROM or CD-R copy of the "Sequence Listing." Should these provisions be adopted, conforming changes may be made in the regulations to accommodate international applications in the national stage.

The comments are addressed above in the discussion of the proposed change to § 1.96. See discussion of § 1.96.

Part 3

Section 3.27: Section 3.27 is proposed to be amended to eliminate the reference to petitions under § 3.81(b) and the reference to a document required by Executive Order 9424 which does not affect title. See discussion of § 3.81(b).

Section 3.71: It is proposed that § 3.71 be revised as discussed immediately below. In conjunction with the proposed revision, the section would be broken into paragraphs (a) through (d), with each paragraph being given a heading, in order to more clearly delineate the topics of the paragraphs.

Proposed paragraph (a) of § 3.71 would clarify that the assignee must be of record in a U.S. national patent application in order to conduct prosecution in place of the inventive entity (the inventors of the application) or any previous assignee that was entitled to conduct prosecution.

Paragraph (b) of § 3.71 has been proposed in order to clarify and define what is meant by the § 3.71(a) assignee which may conduct the prosecution of a U.S. national application for a patent.

A national patent application is owned by the inventor(s), an assignee or assignees of the inventor(s), or some combination of the two. All parties

having a portion of the ownership must act together in order to be entitled to conduct the prosecution.

If there is an assignee of the entire right, title and interest in the patent application, § 3.71(b)(1) (as proposed) states that the single assignee may act alone to conduct the prosecution of an application.

If there is no assignee of the entire right, title and interest of the patent application, then two possibilities exist:

(1) The application has not been assigned; thus, ownership resides solely in the inventor(s) (*i.e.*, the applicant(s)). In this situation, § 3.71 does not apply (since there is no assignee), and the single inventor, or the combination of all the joint inventors, is needed to conduct the prosecution of an application.

(2) The application has been assigned; thus, there is at least one "partial assignee." As pointed out in § 3.71(b)(2), a partial assignee is any assignee of record who has less than the entire right, title and interest in the application. The application will be owned by the combination of all partial assignees and all inventors who have not assigned away their right, title and interest in the application. As proposed, § 3.71(b)(2) points out that where at least one inventor retains an ownership interest together with the partial assignee(s), the combination of all partial assignees and inventors retaining ownership interest is needed to conduct the prosecution of an application. Where no inventor retains an ownership interest, the combination of all partial assignees is needed to conduct the prosecution of an application.

To illustrate this, note as follows. Inventors A and B invent a process and file their application. Inventors A and B together may conduct prosecution. Inventor A then assigns his/her rights in the application to Corporation X. As soon as Corporation X (now a partial assignee) is made of record in the application as a partial assignee (by filing a statement pursuant to § 3.73(b) stating fifty percent ownership), Corporation X and Inventor B together may conduct prosecution. Corporation X and Inventor B then both assign their rights in the application to Corporation Y. As soon as Corporation Y (now an assignee of the entire right, title and interest) is made of record in the application as the assignee (by filing a statement pursuant to § 3.73(b) stating one-hundred percent ownership), Corporation Y may, by itself, conduct prosecution.

This definition of the assignee would apply wherever the assignee is

permitted to take action in the prosecution of an application for patent.

Proposed paragraph (c) of § 3.71 defines the meaning of the term "of record" used in proposed paragraph (b) of § 3.71. An assignee is made of record in an application by filing a statement which is in compliance with § 3.73(b). Note that the assignee being made "of record" in an application is different than the recording of an assignment in the assignment records of the Office pursuant to § 3.11.

Proposed paragraphs (a) through (c) of § 3.71 have been drafted to allow for the situation where an assignee takes action in the prosecution of a reexamination proceeding (in addition to that where a patent application is involved). In a reexamination, the assignee has the entire right, title and interest in the patent upon which reexamination is based.

Proposed paragraph (d) of § 3.71, concerning trademarks, expands the list of actions an assignee may take or request. Specifically, an assignee may also rely on its federal trademark application or registration when filing papers against a third party. This subsection also corrects the inappropriate use of the term "prosecution" when referring to maintaining a registered trademark.

In various places in proposed § 3.71, "national" has been added before "application." Section 3.71 is directed to national applications as defined in § 1.9(a)(1) and not to international (PCT) applications. In an international (PCT) application the assignee is often the applicant for some, or all, of the designated states (except the U.S.) and may control prosecution as the applicant. Section 3.71 would apply to international applications after entry into the U.S. national stage under 35 U.S.C. 371.

Section 3.73: In Paragraph (a) of § 3.73, it is proposed to revise the second sentence to include a trademark registration, in addition to a trademark application which is currently recited. The sentence would read: "The original applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment."

Under the proposal, paragraph (b) of § 3.73 would be revised for clarity and paragraph formatting. Additionally, paragraph (b) of § 3.73 is proposed to be revised to clarify that the statement establishing ownership must explicitly identify the assignee (by adding the language "a signed statement identifying the assignee * * *"). Paragraph (b) of § 3.73 is further proposed to be revised to make it clear

that while the submission establishing ownership is separate from, and in addition to, the specific action taken by the assignee (e.g., appointing a new attorney), the two may be presented together as part of the same paper. This would be done by adding that "The establishment of ownership by the assignee may be combined with the paper that requests or takes the action."

Currently, paragraph (b) of § 3.73 requires that the submission (statement) establishing ownership "must be signed by a party authorized to act on behalf of the assignee." Under the proposal, this language would be expanded upon by newly added paragraph (b)(2) of § 3.73 which would clarify what is acceptable to show that the party signing the submission is authorized to act on behalf of the assignee. (1) The submission could include a statement that the party signing the submission is authorized to act on behalf of the assignee. (2) Alternatively, the submission could be signed by a person having apparent authority to sign on behalf of the assignee, e.g., an officer of the assignee.

In the first case, the statement that the party signing the submission is authorized to act on behalf of the assignee could be an actual statement included in the text of the submission that the signing person "is authorized to act on behalf of the assignee." Alternatively, it could be in the form of a resolution by the organization owning the property (e.g., a corporate resolution, a partnership resolution) included with the submission.

In the second case, the title of the person signing must be given in the submission, and it must be one which empowers the person to act on behalf of the assignee. The president, vice-president, secretary, treasurer, and chairman of the board of directors are presumed to have authority to act on behalf of the organization. Modifications of these basic titles are acceptable, such as vice-president for sales, executive vice-president, assistant treasurer, vice-chairman of the board of directors. A title such as manager, director, administrator, or general counsel does not clearly set forth that the person is an officer of the organization, and as such, does not provide a presumption of authority to sign the statement on behalf of the assignee. A power of attorney from the inventors or the assignee to a practitioner to prosecute an application does not make that practitioner an official of an assignee and does not empower the practitioner to sign the statement on behalf of the assignee.

Proposed new paragraph (c)(1) of § 3.73 would require that the

submission establishing ownership by the assignee must be submitted prior to, or at the same time, that the paper requesting or taking action is submitted. If the submission establishing ownership is not present, the action sought to be taken will not be given effect.

Proposed new paragraph (c)(2) of § 3.73 would point out that for patents, if an assignee of less than the entire right, title and interest (i.e., a partial assignee) fails to indicate in the submission the extent (e.g., by percentage) of its ownership interest, the Office may refuse to accept the submission.

Section 3.81: Section 3.81 is proposed to be amended to eliminate the provisions of § 3.81(b). As discussed above, changes in the patent printing process will dramatically reduce the period between the date of issue fee payment and the date a patent is issued. This change will eliminate the opportunity for providing an assignee name after the date the issue fee is paid.

Part 5

Section 5.1: Section 5.1 is proposed to be amended to locate its current text in § 5.1(a).

Section 5.1 is also proposed to be amended to add a § 5.1(b) to clarify that application as used in Part 5 includes provisional applications filed under 35 U.S.C. 111(b) (§ 1.9(a)(2)), nonprovisional applications filed under 35 U.S.C. 111(a) or entering the national stage from an international application after compliance with 35 U.S.C. 371 (§ 1.9(a)(3)), or international applications filed under the Patent Cooperation Treaty prior to entering the national stage of processing (§ 1.9(b)).

Section 5.1 is also proposed to be amended to add a § 5.1(c) to state current practice that: (1) Patent applications and documents relating thereto that are national security classified (see § 1.9(i)) and contain authorized national security markings (e.g., "Confidential," "Secret" or "Top Secret") are accepted by the Office; and (2) national security classified documents filed in the Office must be either hand-carried to Licensing and Review or mailed to the Office in compliance with § 5.1(a).

Section 5.1 is also proposed to be amended to add a § 5.1(d) to provide that: (1) The applicant in a national security classified patent application must obtain a secrecy order pursuant to § 5.2(a); (2) if a national security classified patent application is filed without a notification pursuant to § 5.2(a), the Office will set a time period within which either the application

must be declassified, or the application must be placed under a secrecy order pursuant to § 5.2(a), or the applicant must submit evidence of a good faith effort to obtain a secrecy order pursuant to § 5.2(a) from the relevant department or agency in order to prevent abandonment of the application; and (3) if evidence of a good faith effort to obtain a secrecy order pursuant to § 5.2(a) from the relevant department or agency is submitted by the applicant within the time period set by the Office, but the application has not been declassified or placed under a secrecy order pursuant to § 5.2(a), the Office will again set a time period within which either the application must be declassified, or the application must be placed under a secrecy order pursuant to § 5.2(a), or the applicant must submit evidence of a good faith effort to again obtain a secrecy order pursuant to § 5.2(a) from the relevant department or agency in order to prevent abandonment of the application. Section 5.1(d) as proposed sets forth the treatment of national security classified applications that is currently set forth in MPEP 130.

Section 5.1 is also proposed to be amended to add a § 5.1(e) to provide that a national security classified patent application will not be allowed pursuant to § 1.311 of this chapter until the application is declassified and any secrecy order pursuant to § 5.2(a) has been rescinded.

Section 5.1 is also proposed to be amended to add a § 5.1(f) to clarify that applications on inventions not made in the United States and on inventions in which a U.S. Government defense agency has a property interest will not be made available to defense agencies.

Section 5.2: Section 5.2(c) is proposed to be added to provide that: (1) An application disclosing any significant part of the subject matter of an application under a secrecy order pursuant to § 5.2(a) also falls within the scope of such secrecy order; (2) any such application that is pending before the Office must be promptly brought to the attention of Licensing and Review, unless such application is itself under a secrecy order pursuant to § 5.2(a); and (3) any subsequently filed application containing any significant part of the subject matter of an application under a secrecy order pursuant to § 5.2(a) must either be hand-carried to Licensing and Review or mailed to the Office in compliance with § 5.1(a).

Section 5.12: Section 5.12(b) is proposed to be amended to require that the fee set forth in § 1.17(h) is required for any petition under § 5.12 for a foreign filing license. As a practical matter, all petitions under § 5.12 are

treated on an expedited basis. Therefore, it is appropriate to require the fee set forth in § 1.17(h) for all petitions under § 5.12.

Part 10

Section 10.23: Section 10.23(c)(11) is proposed to be amended to add the phrase "[e]xcept as permitted by § 1.52(c)" for consistency with the proposed amendment to § 1.52(c).

Review Under the Paperwork Reduction Act of 1995 and Other Considerations

This notice is in conformity with the requirements of the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*), Executive Order 12612 (October 26, 1987), 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 (September 30, 1993).

This notice involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*). The collections of information involved in this notice have been reviewed and previously approved by OMB under the following control numbers: 0651-0016, 0651-0020, 0651-0021, 0651-0022, 0651-0024, 0651-0027, 0651-0031, 0651-0032, 0651-0033, 0651-0034, 0651-0035, and 0651-0037.

As required by the Paperwork Reduction Act of 1995 (44 U.S.C. 3507(d)), the Patent and Trademark Office has submitted an information collection package to OMB for its review and approval of the proposed information collections under OMB control numbers 0651-0031, 0651-0032, and 0651-0035. The Patent and Trademark Office is submitting information collection packages to OMB for its review and approval of these information collections because the following changes proposed in this notice do affect the information collection requirements associated with the information collections under OMB control numbers 0651-0031, 0651-0032, and 0651-0035: (1) The proposed change to §§ 1.27 and 1.28 will permit an applicant to establish small entity status in an application by a simple assertion of entitlement to small entity status (without a statement having a formalistic reference to § 1.9 or a standard form (PTO/SB/09/10/11/12)); (2) the proposed change to §§ 1.55, 1.63 and 1.78 would eliminate the need for an applicant using the application data sheet (§ 1.76) to provide priority claims

in the oath or declaration or specification; (3) the proposed change to § 1.96 would require applicants to submit lengthy computer listings on a CD-ROM or CD-R (rather than microfiche); (4) the proposed change to §§ 1.821, 1.823, and 1.825 would permit applicants to submit sequence listings on a CD-ROM or CD-R (rather than paper); and (5) the proposed change to § 1.155 would allow an applicant to seek expedited examination of a design application by filing a request for expedited examination.

As discussed above, the notice also involves currently approved information collections under OMB control numbers: 0651-0016, 0651-0020, 0651-0021, 0651-0022, 0651-0024, 0651-0027, 0651-0033, 0651-0034, and 0651-0037. The Patent and Trademark Office is not resubmitting information collection packages to OMB for its review and approval of these information collections because the changes proposed in this notice do not affect the information collection requirements associated with the information collections under these OMB control numbers.

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. Included in each estimate is the time for reviewing instructions, gathering and maintaining the data needed, and completing and reviewing the collection of information. Any collections of information whose requirements will be revised as a result of the proposed rule changes discussed in this notice will be submitted to OMB for approval. The principal impact of the changes under consideration in this notice is to raise the efficiency and effectiveness of the Patent and Trademark Office's business processes to make the Patent and Trademark Office a more business-like agency and increase the level of the Patent and Trademark Office's service to the public.

OMB Number: 0651-0016.

Title: Rules for Patent Maintenance Fees.

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

Type of Review: Approved through July of 1999.

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

Estimated Number of Respondents: 273,800.

Estimated Time Per Response: 0.08 hour.

Estimated Total Annual Burden Hours: 22,640 hours.

Needs and Uses: Maintenance fees are required to maintain a patent, except for design or plant patents, in force under 35 U.S.C. 41(b). Payment of maintenance fees are required at 3½, 7½ and 11½ years after the grant of the patent. A patent number and application number of the patent on which maintenance fees are paid are required in order to ensure proper crediting of such payments.

OMB Number: 0651-0020.

Title: Patent Term Extension.

Form Numbers: None.

Type of Review: Approved through September of 2001.

Affected Public: Individuals or households, businesses or other for-profit, not-for-profit institutions, farms, Federal Government, and state, local, or tribal governments.

Estimated Number of Respondents: 57.

Estimated Time Per Response: 22.8 hour.

Estimated Total Annual Burden Hours: 1,302 hours.

Needs and Uses: The information supplied to the PTO by an applicant seeking a patent term extension is used by the Patent and Trademark Office, the Department of Health and Human Services, and the Department of Agriculture to determine the eligibility of a patent for extension and to determine the period of any such extension. The applicant can apply for patent term and interim extensions, petition the Patent and Trademark Office to review final eligibility decisions, and withdraw patent term extensions. If there are multiple patents, the applicant can designate which patents should be extended. An applicant can also declare their eligibility to apply for a patent term extension.

OMB Number: 0651-0021.

Title: Patent Cooperation Treaty.

Form Numbers: PCT/RO/101, ANNEX/134/144, PTO-1382, PCT/IPEA/401, PCT/IB/328.

Type of Review: Approved through May of 2000.

Affected Public: Individuals or Households, Business or Other For-Profit, Federal Agencies or Employees, Not-for-Profit Institutions, Small Businesses or Organizations.

Estimated Number of Respondents: 102,950.

Estimated Time Per Response: 0.9538 hour.

Estimated Total Annual Burden Hours: 98,195 hours.

Needs and Uses: The information collected is required by the Patent Cooperation Treaty (PCT). The general

purpose of the PCT is to simplify the filing of patent applications on the same invention in different countries. It provides for a centralized filing procedure and a standardized application format.

OMB Number: 0651-0022.

Title: Deposit of Biological Materials for Patent Purposes.

Form Numbers: None.

Type of Review: Approved through December of 2000.

Affected Public: Individuals or Households, State or Local Governments, Farms, Business or Other For-Profit, Federal Agencies or Employees, Not-for-Profit Institutions, Small Businesses or Organizations.

Estimated Number of Respondents: 3,300.

Estimated Time Per Response: 1.0 hour.

Estimated Total Annual Burden Hours: 3,300 hours.

Needs and Uses: Information on depositing of biological materials in depositories is required for (1) Office determination of compliance with the patent statute where the invention sought to be patented relies on biological material subject to deposit requirement, which includes notifying interested members of the public where to obtain samples of deposits, and (2) depositories desiring to be recognized as suitable by the Office.

OMB Number: 0651-0024.

Title: Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures.

Form Numbers: None.

Type of Review: Approved through November of 1999.

Affected Public: Individuals or households, business or other for-profit institutions, not-for-profit institutions, and Federal Government.

Estimated Number of Respondents: 4,600.

Estimated Time Per Response: 80 minutes.

Estimated Total Annual Burden Hours: 6,133 hours.

Needs and Uses: This information is used by the Office during the examination process, the public and the patent bar. The Patent and Trademark Office also participates with the EPO and JPO in a Trilateral Sequence Exchange project, to facilitate the international exchange of published sequence data.

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: Approved through May of 2002.

Affected Public: Individuals or Households and Businesses or Other For-Profit.

Estimated Number of Respondents: 209,040.

Estimated Time Per Response: 0.5 hour.

Estimated Total Annual Burden Hours: 104,520 hours.

Needs and Uses: The Office records about 209,040 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.

OMB Number: 0651-0031.

Title: Patent Processing (Updating).

Form Numbers: PTO/SB/08/21-27/31/42/43/61/62/63/64/67/68/91/92/96/97.

Type of Review: Approved through September of 2000.

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

Estimated Number of Respondents: 2,040,630.

Estimated Time Per Response: 0.39 hours.

Estimated Total Annual Burden Hours: 788,421 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 Statements; Terminal Disclaimers; Petitions to Revive; Express Abandonments; Appeal Notices; Petitions for Access; Powers to Inspect; Certificates of Mailing or Transmission; Statements under § 3.73(b); Amendments, Petitions and their Transmittal Letters; and Deposit Account Order Forms.

OMB Number: 0651-0032.

Title: Initial Patent Application.

Form Number: PTO/SB/01-07/13PCT/17-19/29/101-110.

Type of Review: Approved through September of 2000.

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

Estimated Number of Respondents: 344,100.

Estimated Time Per Response: 8.7 hours.

Estimated Total Annual Burden Hours: 2,994,160 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 statute 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, Declaration, and Plant Patent Application Declaration will assist applicants in complying with the requirements of the patent statute and regulations, and will further assist the Office in processing and examination of the application.

OMB Number: 0651-0033.

Title: Post Allowance and Refiling.

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

Type of Review: Approved through September of 2000.

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

Estimated Number of Respondents: 135,250.

Estimated Time Per Response: 0.325 hour.

Estimated Total Annual Burden Hours: 43,893 hours.

Needs and Uses: This collection of information is required to administer the patent laws pursuant to title 35, U.S.C., 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: 0651-0034.

Title: Secrecy/License to Export.

Form Numbers: None.

Type of Review: Approved through January of 2001.

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

Estimated Number of Respondents: 2,187.

Estimated Time Per Response: 0.67 hour.

Estimated Total Annual Burden Hours: 1,476 hours.

Needs and Uses: In the interest of national security, patent laws and regulations place certain limitations on the disclosure of information contained in patents and patent applications and

on the filing of applications for patent in foreign countries.

OMB Number: 0651-0035.

Title: Address-Affecting Provisions.

Form Numbers: PTO/SB/81-84/121-125.

Type of Review: Approved through June of 1999.

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

Estimated Number of Respondents: 263,520.

Estimated Time Per Response: 0.05 hour.

Estimated Total Annual Burden Hours: 13,386 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: 0651-0037.

Title: Provisional Applications.

Form Numbers: PTO/SB/16.

Type of Review: Approved through January of 2001.

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

Estimated Number of Respondents: 25,000.

Estimated Time Per Response: 8.0 hour.

Estimated Total Annual Burden Hours: 200,000 hours.

Needs and Uses: The information included on the provisional application cover sheet is needed by the Office to identify the submission as a provisional application and not some other kind of submission, to promptly and properly process the provisional application, to prepare the provisional application filing receipt which is sent to the applicant, and to identify those provisional applications which must be reviewed by the Office for foreign filing licenses.

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.

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

3507(d)), the Patent and Trademark Office has submitted an information collection package to OMB for its review and approval of the proposed information collections under OMB control numbers 0651-0031, 0651-0032, and 0651-0035. As discussed above, the notice also involves currently approved information collections under OMB control numbers: 0651-0016, 0651-0020, 0651-0021, 0651-0022, 0651-0024, 0651-0027, 0651-0033, 0651-0034, and 0651-0037. The Patent and Trademark Office is not resubmitting information collection packages to OMB for its review and approval of these information collections because the changes proposed in this notice do not materially affect, or change the burden hours associated with, these information collections.

Interested persons are requested to send comments regarding these information collections, including suggestions for reducing this burden, to Robert J. Spar, Director, Special Program Law Office, Patent and Trademark Office, Washington, D.C. 20231, or to the Office of Information and Regulatory Affairs of OMB, New Executive Office Building, 725 17th Street, NW, room 10235, Washington, DC 20503, Attention: Desk Officer for the Patent and Trademark Office.

The Chief Counsel for Regulation of the Department of Commerce certified to the Chief Counsel for Advocacy, Small Business Administration, that the changes proposed in this rule, if adopted, would not have a significant impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)). In furtherance of the Patent Business Goals, the Office is proposing changes to the rules of practice to eliminate unnecessary formal requirements, streamline the patent application process, and simplify and clarify procedures. In streamlining this process, the Office will be able to issue a patent in a shorter time by eliminating formal requirements that must be performed by the applicant, his or her representatives and the Office. All applicants will benefit from a reduced overall cost to them for receiving patent protection and from a faster receipt of their patents. In addition, small entities will benefit from the proposed changes to the requirements for establishing small entity status under § 1.27 for purposes of paying reduced patent fees under 35 U.S.C. 41(h). The currently used small entity statement forms are proposed to be eliminated. Small entity status would be established at any time by a simple assertion of entitlement to small entity status. A simpler procedure to establish small entity status would

reduce processing time with the Office and would be a benefit to small entity applicants as it would eliminate the time-consuming and aggravating processing requirements that are mandated by the current rules.

The Patent and Trademark Office has determined that this notice 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, Courts, Freedom of information, Inventions and patents, Reporting and recordkeeping requirements, Small businesses.

37 CFR Part 3

Administrative practice and procedure, Inventions and patents, Reporting and record keeping requirements.

37 CFR Part 5

Classified information, Foreign relations, Inventions and patents.

37 CFR Part 10

Administrative practice and procedure, Inventions and patents, Lawyers, Reporting and recordkeeping requirements.

For the reasons set forth in the preamble, 37 CFR parts 1, 3, 5, and 10 are proposed to be amended as follows:

PART 1—RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR part 1 is revised to read as follows:

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

2. Section 1.4 is proposed to be amended by revising paragraphs (b) and (c) to read as follows:

§ 1.4 Nature of correspondence and signature requirements.

* * * * *

(b) Since each file must be complete in itself, a separate copy of every paper to be filed in a patent or trademark application, patent file, trademark registration file, or other proceeding must be furnished for each file to which the paper pertains, even though the contents of the papers filed in two or more files may be identical. The filing of duplicate copies of correspondence in the file of an application, patent, trademark registration file, or other proceeding should be avoided, except in situations in which the Office requires the filing of duplicate copies. The Office

may dispose of duplicate copies of correspondence in the file of an application, patent, trademark registration file, or other proceeding.

(c) Since different matters may be considered by different branches or sections of the Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

* * * * *

3. Section 1.6 is proposed to be amended by revising paragraph (d)(9) to read as follows:

§ 1.6 Receipt of correspondence.

* * * * *

(d) * * *

(9) Correspondence to be filed in an interference proceeding which consists of a preliminary statement under § 1.621; a transcript of a deposition under § 1.676 or of interrogatories, or cross-interrogatories; or an evidentiary record and exhibits under § 1.653.

* * * * *

4. Section 1.9 is proposed to be amended by removing and reserving paragraphs (c), (d) and (e), and revising paragraph (f) and adding a new paragraph (i) to read as follows:

§ 1.9 Definitions.

* * * * *

(f) *Small entities.* A small entity as used in this chapter means any party (person, small business concern, or nonprofit organization) under paragraphs (f)(1) through (f)(3) of this section.

(1) *Person:* A person, as used in § 1.27(b), means any inventor or other individual (e.g., an individual to whom an inventor has transferred some rights in the invention), who *has not* assigned, granted, conveyed, or licensed, and is under no obligation under contract or law to assign, grant, convey, or license, any rights in the invention. An inventor or other individual who *has* transferred some rights, or is under an obligation to transfer some rights in the invention to one or more parties, can also qualify for small entity status if all the parties who have had rights in the invention transferred to them also qualify for small entity status either as a person, small business concern, or nonprofit organization under this section.

(2) *Small business concern:* A small business concern, as used in § 1.27(b), means any business concern that:

(i) Has not assigned, granted, conveyed, or licensed, and is under no obligation under contract or law to assign, grant, convey, or license, any rights in the invention to any person,

concern, or organization which would not qualify under this section for small entity status as a person, small business concern, or nonprofit organization.

(ii) Meets the size standards set forth in 13 CFR part 121 to be eligible for reduced patent fees. Questions related to size standards for a small business concern may be directed to: Small Business Administration, Size Standards Staff, 409 Third Street, SW, Washington, DC 20416.

(3) *Nonprofit organization.* A nonprofit organization, as used in § 1.27(b), means any nonprofit organization that:

(i) Has not assigned, granted, conveyed, or licensed, and is under no obligation under contract or law to assign, grant, convey, or license, any rights in the invention to any person who could not qualify for small entity status, or to any concern or organization which would not qualify as a small business concern, or a nonprofit organization under this section, and

(ii) Is either:

(A) A university or other institution of higher education located in any country;

(B) An organization of the type described in section 501(c)(3) of the Internal Revenue Code of 1986 (26 U.S.C. 501(c)(3)) and exempt from taxation under section 501(a) of the Internal Revenue Code (26 U.S.C. 501(a));

(C) Any nonprofit scientific or educational organization qualified under a nonprofit organization statute of a state of this country (35 U.S.C. 201(i)); or

(D) Any nonprofit organization located in a foreign country which would qualify as a nonprofit organization under paragraphs (f)(3)(ii)(B) or (f)(3)(ii)(C) of this section if it were located in this country.

(4) *License to a Federal Agency.* (i) For persons under paragraph (f)(1) of this section, a license to the Government resulting from a rights determination under Executive Order 10096 does not constitute a license so as to prohibit claiming small entity status.

(ii) For small business concerns and nonprofit organizations under paragraphs (f)(2) and (f)(3) of this section, 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.

* * * * *

(i) National security classified as used in this chapter means specifically authorized under criteria established by an Act of Congress or Executive order to be kept secret in the interest of national defense or foreign policy and, in fact,

properly classified pursuant to such Act of Congress or Executive order.

5. Section 1.12 is proposed to be amended by revising paragraph (c)(1) to read as follows:

§ 1.12 Assignment records open to public inspection.

* * * * *

(c) * * *

(1) Be in the form of a petition including the fee set forth in § 1.17(h); or

* * * * *

6. Section 1.14 is proposed to be revised to read as follows:

§ 1.14 Patent applications preserved in confidence.

(a) *Confidentiality of patent application information.* Patent applications are generally preserved in confidence pursuant to 35 U.S.C. 122. Information concerning the filing, pendency, or subject matter of an application for patent, including status information, and access to the application, will only be given to the public as set forth in § 1.11 or in this section.

(1) *Status information is:*
(i) Whether the application is pending, abandoned, or patented; and
(ii) The application "numerical identifier" which may be:

(A) The eight digit application number (the two digit series code plus the six digit serial number); or

(B) The six digit serial number plus any of the filing date of the national application, the international filing date, or date of entry into the national stage.

(2) *Access* is defined as providing the application file for review and copying of any material.

(b) *When status information may be supplied.* Status information of an application may be supplied by the Office to the public if any of the following apply:

(1) Access to the application is available pursuant to paragraph (e) of this section;

(2) The application is referred to by its numerical identifier in a published patent document (e.g., a U.S. patent or a published international application) or in a U.S. application open to public inspection (§ 1.11(b) or paragraph (e)(2)(i) of this section); or

(3) The application is a published international application in which the United States of America has been indicated as a designated state.

(c) *Copy of application-as-filed.* If a pending or abandoned application is incorporated by reference in a U.S. patent, a copy of that application-as-filed may be provided to any person

upon written request including the fee set forth in § 1.19(b)(1).

(d) *Power to inspect a pending or abandoned application may be granted by a party named in the application file.*

Access to an application may be provided to any person if the application file is available, and the application contains written authority (e.g., a power to inspect) in that particular application granting access to such person that is signed by:

- (1) An applicant;
- (2) An attorney or agent of record;
- (3) An authorized official of an assignee of record (made of record pursuant to § 3.71 of this chapter); or

(4) A registered attorney or agent named in papers accompanying the application papers filed under § 1.53 or the national stage documents filed under §§ 1.494 or 1.495, if an executed oath or declaration pursuant to § 1.63 or § 1.497 has not been filed.

(e) *Public access to a pending or abandoned application may be provided.* Access to an application may be provided to any person if a written request for access is submitted, the application file is available, and any of the following apply:

- (1) The application is open to public inspection pursuant to § 1.11(b); or
- (2) The application is abandoned, it is not within the file jacket of a pending application under § 1.53(d), and it is referred to:

- (i) In a U.S. patent; or
- (ii) In another U.S. application which is open to public inspection either pursuant to § 1.11(b) or paragraph (e)(2)(i) of this section.

(f) *Applications that may be destroyed.* Applications that are abandoned or for which proceedings are otherwise terminated may be destroyed, and thus may not be available for access as permitted by paragraphs (d) or (e) of

this section, after twenty years from their filing or deposit date. Exceptions may be made for applications to which particular attention has been called and which have been marked for preservation.

(g) *Applications reported to Department of Energy.* Applications for patents which appear to disclose, purport to disclose or do disclose inventions or discoveries relating to atomic energy are reported to the Department of Energy, which Department will be given access to the applications. Such reporting does not constitute a determination that the subject matter of each application so reported is in fact useful or is an invention or discovery, or that such application in fact discloses subject matter in categories specified by 42 U.S.C. 2181 (c) and (d).

(h) *Decisions by the Commissioner or the Board of Patent Appeals and Interferences.* Any decision by the Commissioner or the Board of Patent Appeals and Interferences which would not otherwise be open to public inspection may be published or made available for public inspection if:

(1) The Commissioner believes the decision involves an interpretation of patent laws or regulations that would be of precedential value; and

(2) The applicant, or a party involved in an interference for which a decision was rendered, is given notice and an opportunity to object in writing within two months on the ground that the decision discloses a trade secret or other confidential information. Any objection must identify the deletions in the text of the decision considered necessary to protect the information, or explain why the entire decision must be withheld from the public to protect such information. An applicant or party will be given time, not less than twenty days,

to request reconsideration and seek court review before any portions of a decision are made public under this paragraph over his or her objection.

(i) *Publication pursuant to § 1.47.* Information as to the filing of an application will be published in the *Official Gazette* in accordance with § 1.47 (a) and (b).

(j) *International applications.* Copies of an application file for which the United States acted as the International Preliminary Examining Authority, or copies of a document in such an application file, will be furnished in accordance with Patent Cooperation Treaty (PCT) Rule 94.2 or 94.3, upon payment of the appropriate fee (§ 1.19(b)(2) or § 1.19(b)(3)).

(k) *Access or copies in other circumstances.* The Office, either *sua sponte* or on petition, may also provide access or copies of an application if necessary to carry out an Act of Congress or if warranted by other special circumstances. Any petition by a member of the public seeking access to, or copies of, any pending or abandoned application preserved in confidence pursuant to paragraph (a) of this section, or any related papers, must include:

- (1) The fee set forth in § 1.17(h); and
- (2) A showing that access to the application is necessary to carry out an Act of Congress or that special circumstances exist which warrant petitioner being granted access to the application.

7. Section 1.17 is proposed to be amended by revising paragraphs (h), (i), (k), (l), (m), and (q) and adding paragraph (t) to read as follows:

§ 1.17 National application processing fees.

* * * * *

(h) For filing a petition to the Commissioner under a section listed below which refers to this paragraph	\$130.00
§ 1.12—for access to an assignment record.	
§ 1.14—for access to an application.	
§ 1.47—for filing by other than all the inventors or a person not the inventor.	
§ 1.53(e)—to accord a filing date.	
§ 1.59—for expungement and return of information.	
§ 1.91—for entry of a model or exhibit.	
§ 1.102—to make an application special.	
§ 1.103(a)—to suspend action in application.	
§ 1.182—for decision on a question not specifically provided for.	
§ 1.183—to suspend the rules.	
§ 1.295—for review of refusal to publish a statutory invention registration.	
§ 1.313—to withdraw an application from issue.	
§ 1.314—to defer issuance of a patent.	
§ 1.377—for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.	
§ 1.378(e)—for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.	
§ 1.550(c)(2)—for a petition for an extension of time to accept an unintentionally delayed response in a reexamination proceeding.	
§ 1.644(e)—for petition in an interference.	
§ 1.644(f)—for request for reconsideration of a decision on petition in an interference.	

§ 1.666(b)—for access to an interference settlement agreement.	
§ 1.666(c)—for late filing of interference settlement agreement.	
§ 1.741(b)—to accord a filing date to an application for extension of a patent term.	
§ 5.12—for expedited handling of a foreign filing license.	
§ 5.15—for changing the scope of a license.	
§ 5.25—for retroactive license.	
(i) Processing fee for taking action under a section listed below which refers to this paragraph	130.00
§ 1.28(c)(3)—for processing a non-itemized fee deficiency based on an error in small entity status.	
§ 1.41—for supplying the name or names of the inventor or inventors after the filing date without an oath or declaration as prescribed by § 1.63, except in provisional applications.	
§ 1.48—for correcting inventorship, except in provisional applications.	
§ 1.52(d)—for processing a nonprovisional application filed with a specification in a language other than English.	
§ 1.55—for entry of late priority papers.	
§ 1.103(b)—for requesting limited suspension of action in continued prosecution application.	
§ 1.497(d)—for filing an oath or declaration pursuant to 35 U.S.C. 371(c)(4) naming an inventive entity different from the inventive entity set forth in the international stage.	
* * * * *	
(k) For accepting color drawings or color photographs (§ 1.84(a))	200.00
(l) For filing a petition for the revival of an unavoidably abandoned application under 35 U.S.C. 111, 133, 364, or 371, or the unavoidably delayed payment of the issue fee under 35 U.S.C. 151 (§ 1.137(a)):	
By a small entity (§ 1.9(f))	55.00
By other than a small entity	110.00
(m) For filing a petition for the revival of an unintentionally abandoned application or the unintentionally delayed payment of the issue fee under 35 U.S.C. 41(a)(7) (§ 1.137(b)):	
By a small entity (§ 1.9(f))	605.00
By other than a small entity	1,210.00
* * * * *	
(q) Processing fee for taking action under a section listed below which refers to this paragraph	50.00
§ 1.41—to supply the name or names of the inventor or inventors after the filing date without a cover sheet as prescribed by § 1.51(c)(1) in a provisional application.	
§ 1.48—for correction of inventorship in a provisional application.	
§ 1.53(c)—to convert a nonprovisional application filed under § 1.53(b) to a provisional application under § 1.53(c).	
* * * * *	
(t) For filing a request for expedited examination under § 1.155(a)	900.00

8. Section 1.19 is proposed to be amended by revising its introductory text and paragraphs (a) and (b) and removing paragraph (h) to read as follows:

§ 1.19 Document supply fees.
The Patent and Trademark Office will supply copies of the following documents upon payment of the fees

indicated. The copies will be in black and white unless the original document is in color, a color copy is requested and the fee for a color copy is paid.

(a) Uncertified copies of patents:	
(1) Printed copy of a patent, including a design patent, statutory invention registration, or defensive publication document:	
(i) Regular service	\$3.00
(ii) Overnight delivery to PTO Box or overnight facsimile	6.00
(iii) Expedited service for copy ordered by expedited mail or facsimile delivery service and delivered to the customer within two workdays	25.00
(2) Printed copy of a plant patent in color	15.00
(3) Color copy of a patent (other than a plant patent) or statutory invention registration containing a color drawing	25.00
(b) Certified and uncertified copies of Office documents:	
(1) Certified or uncertified copy of patent application as filed:	
(i) Regular service	15.00
(ii) Expedited regular service	30.00
(2) Certified or uncertified copy of patent-related file wrapper and contents:	
(i) File wrapper and contents of 400 or fewer pages	250.00
(ii) Additional fee for each additional 100 pages or portion thereof	25.00
(3) Certified or uncertified copy of Office records, per document except as otherwise provided in this section	25.00
(4) For assignment records, abstract of title and certification, per patent	25.00
* * * * *	

9. Section 1.22 is proposed to be amended by revising paragraph (b) and adding paragraph (c) to read as follows:

§ 1.22 Fee payable in advance.

* * * * *

(b) All fees paid to the Patent and Trademark Office must be itemized in each individual application, patent, trademark registration file, or other proceeding in such a manner that it is clear for which purpose the fees are paid. The Office may return fees that are

not itemized as required by this paragraph. The provisions of § 1.5(a) do not apply to the resubmission of fees returned pursuant to this paragraph.

(c)(1) A fee paid by an authorization to charge such fee to a deposit account containing sufficient funds to cover the

applicable fee amount (§ 1.25) is considered paid:

(i) On the date the paper for which the fee is payable is received in the Office (§ 1.6), if the paper including the deposit account charge authorization was filed prior to or concurrently with such paper;

(ii) On the date the paper including the deposit account charge authorization is received in the Office (§ 1.6), if the paper including the deposit account charge authorization is filed after the filing of the paper for which the fee is payable; and

(iii) On the date of the agreement, if the deposit account charge authorization is the result of an agreement between the applicant and an Office employee that is reduced to a writing.

(2) A fee paid other than by an authorization to charge such fee to a deposit account is considered paid on the date the applicable fee amount is received in the Office (§ 1.6).

(3) The applicable fee amount is determined by the fee in effect on the date such fee is paid in full.

10. Section 1.25 is proposed to be amended by revising paragraph (b) to read as follows:

§ 1.25 Deposit accounts.

* * * * *

(b) Filing, issue, appeal, international-type search report, international application processing, petition, and post-issuance fees may be charged against these accounts if sufficient funds are on deposit to cover such fees. A general authorization to charge all fees, or only certain fees, set forth in § 1.16 to § 1.18 to a deposit account containing sufficient funds may be filed in an individual application, either for the entire pendency of the application or with respect to a particular paper filed. An authorization to charge fees under § 1.16 in an application submitted under § 1.494, or § 1.495 will be treated as an authorization to charge fees under § 1.492. An authorization to charge fees set forth in § 1.18 to a deposit account is subject to the provisions of § 1.311(b). An authorization to charge to a deposit account the fee for a request for reexamination pursuant to § 1.510 and any other fees required in a reexamination proceeding in a patent may also be filed with the request for reexamination. An authorization to charge a fee to a deposit account will not be considered payment of the fee on the date the authorization to charge the fee is effective as to the particular fee to be charged unless sufficient funds are present in the account to cover the fee.

11. Section 1.26 is proposed to be amended by revising paragraph (a) and adding paragraph (b) to read as follows:

§ 1.26 Refunds.

(a) The Commissioner may refund a fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, as when a party desires to withdraw a patent or trademark filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify the payor of such amounts. If a party paying a fee or requesting a refund does not instruct the Office that refunds are to be credited to a deposit account, and does not provide the banking information necessary for making refunds by electronic funds transfer, the Commissioner may either require such banking information or use the banking information on the payment instrument to make a refund.

(b) Any request for refund must be filed within two years from the date the fee was paid, except as otherwise provided in this paragraph or in § 1.28(a). If the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization (§ 1.25(b)), any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge, and include a copy of that deposit account statement. The time periods set forth in this paragraph are not extendable.

* * * * *

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

§ 1.27 Establishing status as small entity to permit payment of small entity fees; when a determination of entitlement to small entity status and notification of loss of entitlement to small entity status are required; fraud on the Office.

(a) *Establishment of small entity status permits payment of reduced fees.* A small entity, as defined in § 1.9(f), who has properly asserted entitlement to small entity status pursuant to paragraph (b) of this section will be accorded small entity status by the Office in the particular application or patent in which entitlement to small entity status was asserted. Establishment of small entity status allows the payment of certain reduced patent fees pursuant to 35 U.S.C. 41(h).

(b) *Assertion of small entity status.* Any party (person, small business concern or nonprofit organization) who

has made a determination, pursuant to paragraph (e) of this section, of entitlement to be accorded small entity status pursuant to § 1.9(f) must, in order to establish small entity status for the purpose of paying small entity fees, make an assertion of entitlement to small entity status, pursuant to paragraph (b)(1) or (b)(3) of this section, in the application or patent in which such small entity fees are to be paid.

(1) *Assertion by writing.* Small entity status may be established by a written assertion of entitlement to small entity status. A written assertion must:

(i) Be clearly identifiable;

(ii) Be signed; and

(iii) Convey the concept of entitlement to small entity status, such as by stating that applicant is a small entity, or that small entity status is entitled to be asserted for the application or patent. While no specific words or wording are required to assert small entity status, the intent to assert small entity status must be clearly indicated in order to comply with the assertion requirement.

(2) *Parties who can sign the written assertion.* The written assertion can be signed by:

(i) One of the parties identified in § 1.33(b) (e.g., an attorney or agent registered with the Office), § 3.73(b) of this chapter notwithstanding;

(ii) At least one of the inventors,

§ 1.33(b)(4) notwithstanding; or
(iii) An assignee of an undivided part interest, §§ 1.33(b)(3) and 3.73(b) of this chapter notwithstanding.

(3) *Assertion by payment of the small entity basic filing or national fee.* The payment, by any party, of the exact amount of one of the small entity basic filing fees set forth in § 1.16(a), (f), (g), (h), or (k), or one of the small entity national fees set forth in § 1.492(a)(1), (a)(2), (a)(3), (a)(4), or (a)(5), will be treated as a written assertion of entitlement to small entity status even if the type of basic filing or national fee is inadvertently selected in error.

(i) If the Office accords small entity status based on payment of a small entity fee that is not applicable to that application, any balance of the small entity fee that is applicable to that application will be due.

(ii) The payment of any small entity fee other than those set forth in paragraph (b)(3) (whether in the exact fee amount or not) of this section will not be treated as a written assertion of entitlement to small entity status and will not be sufficient to establish small entity status in an application or a patent.

(4) *Assertion required in related, continuing, and reissue applications.*

Status as a small entity must be specifically established by an assertion in each related, continuing and reissue application in which status is appropriate and desired. Status as a small entity in one application or patent does not affect the status of any other application or patent, regardless of the relationship of the applications or patents. The refiling of an application under § 1.53 as a continuation, divisional, or continuation-in-part application (including a continued prosecution application under § 1.53(d)), or the filing of a reissue application, requires a new assertion as to continued entitlement to small entity status for the continuing or reissue application.

(c) *When small entity fees can be paid.* Any fee, other than the small entity basic filing fees and the small entity national fees of paragraph (b)(3) of this section, can be paid in the small entity amount only if it is submitted with, or subsequent to, the submission of a written assertion of entitlement to small entity status, except when refunds are permitted by § 1.28(a).

(d) *Only one assertion required.* (1) An assertion of small entity status need only be filed once in an application or patent. Small entity status, once established, remains in effect until changed pursuant to § 1.28(b) of this part. Where an assignment of rights or an obligation to assign rights to other parties who are small entities occurs subsequent to an assertion of small entity status, a second assertion is not required.

(2) Once small entity status is withdrawn pursuant to paragraph (f)(2) of this section, a new written assertion is required to again obtain small entity status.

(e) *Assertion requires a determination of entitlement to pay small entity fees.* Prior to submitting an assertion of entitlement to small entity status in an application, including a related, continuing, or reissue application, a determination of such entitlement should be made pursuant to the requirements of § 1.9(f). It should be determined that all parties holding rights in the invention qualify for small entity status. The Office will generally not question any assertion of small entity status that is made in accordance with the requirements of this section, but note paragraph (g) of this section.

(f)(1) *New determination of entitlement to small entity status is needed when issue and maintenance fees are due.* Once status as a small entity has been established in an application or patent, fees as a small entity may thereafter be paid in that

application or patent without regard to a change in status until the issue fee is due or any maintenance fee is due.

(2) *Notification of loss of entitlement to small entity status is required when issue and maintenance fees are due.* Notification of a loss of entitlement to small entity status must be filed in the application or patent prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity as defined in § 1.9(f) is no longer appropriate. The notification that small entity status is no longer appropriate must be signed by a party identified in § 1.33(b). Payment of a fee in other than the small entity amount is not sufficient notification that small entity status is no longer appropriate.

(g) *Fraud attempted or practiced on the Office.* (1) Any attempt to fraudulently establish status as a small entity, or to pay fees as a small entity, shall be considered as a fraud practiced or attempted on the Office.

(2) Improperly, and with intent to deceive, establishing status as a small entity, or paying fees as a small entity, shall be considered as a fraud practiced or attempted on the Office.

13. Section 1.28 is proposed to be revised to read as follows:

§ 1.28 Refunds when small entity status is later established; how errors in small entity status are excused.

(a) *Refunds based on later establishment of small entity status:* 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 an assertion under § 1.27(b) and a request for a refund of the excess amount are filed within three months of the date of the timely payment of the full fee. The three-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 three months of the date of payment of, the full fee.

(b) *Date of payment.* (1) The three-month period for requesting a refund, pursuant to paragraph (a) of this section, starts on the date that a full fee has been paid as defined in § 1.22(c);

(2) The date when a deficiency payment is paid in full determines the amount of deficiency that is due, pursuant to paragraph (c) of this section, and is defined in § 1.22(c).

(c) *How errors in small entity status are excused.* 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 loss of entitlement to small entity status as required by § 1.27(f)(2), the error will be excused upon: compliance with the separate submission and itemization requirements of paragraphs (c)(1) and (c)(2) of this section, and the deficiency payment requirement of paragraph (c)(2) of this section:

(1) *Separate submission required for each application or patent.* Any paper submitted under this paragraph must be limited to the deficiency payment (all fees paid in error), required by paragraph (c)(2) of this section, for one application or one patent. Where more than one application or patent is involved, separate submissions of deficiency payments (e.g., checks) and itemizations are required for each application or patent. See § 1.4(b).

(2) *Payment of deficiency owed.* The deficiency owed, resulting from the previous erroneous payment of small entity fees, must be paid.

(i) *Calculation of the deficiency owed.* The deficiency owed for each previous fee erroneously paid as a small entity is the difference between the current fee amount (for other than a small entity) on the date the deficiency is paid in full and the amount of the previous erroneous (small entity) fee payment. The total deficiency payment owed is the sum of the individual deficiency owed amounts for each fee amount previously erroneously paid as a small entity;

(ii) *Itemization of the deficiency payment.* An itemization of the total deficiency payment is required. The itemization must include the following information:

(A) Each particular type of fee that was erroneously paid as a small entity, (e.g., basic statutory filing fee, two-month extension of time fee) along with the current fee amount for a non-small entity;

(B) The small entity fee actually paid, and when. This will permit the Office to differentiate, for example, between two one-month extension of time fees erroneously paid as a small entity but on different dates;

(C) The deficiency owed amount (for each fee erroneously paid); and

(D) The total deficiency payment owed, which is the sum or total of the individual deficiency owed amounts set forth in paragraph (c)(2)(ii)(C) of this section.

(3) *Failure to comply with requirements.* If the requirements of paragraphs (c)(1) and (c)(2) of this section are not complied with, such

failure will either: be treated as an authorization for the Office to process the deficiency payment and charge the processing fee set forth in § 1.17(i), or result in a requirement for compliance within a one-month non-extendable time period to avoid the return of the fee deficiency paper, at the option of the Office.

(d) *Payment of deficiency operates as notification of loss of status.* Any payment submitted under paragraph (c) of this section will be treated under § 1.27(f)(2) as a notification of a loss of entitlement to small entity status.

14. Section 1.33 is proposed to be amended by revising paragraphs (a) and (b) to read as follows:

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

(a) *Correspondence address and daytime telephone number.* When filing an application, a correspondence address must be set forth in either an application data sheet (§ 1.76), or elsewhere in a clearly identifiable manner in any paper submitted with an application filing. If no correspondence address is specified, the Office may treat the mailing address of the first named inventor (if provided, see § 1.76(b)(1) and § 1.63(c)(2)) as the correspondence address. The Office will direct all notices, official letters, and other communications relating to the application to the correspondence address. The Office will not engage in double correspondence with an applicant and an attorney or agent, or with more than one attorney or agent except as deemed necessary by the Commissioner. If more than one correspondence address is specified, the Office will establish one as the correspondence address. For the party to whom correspondence is to be addressed, a daytime telephone number should be supplied in a clearly identifiable manner and may be changed by any party who may change the correspondence address. The correspondence address may be changed as follows:

(1) *Prior to filing of a § 1.63 oath or declaration by any of the inventors.* If a § 1.63 oath or declaration has not been filed by any of the inventors, the correspondence address may be changed by the party who filed the application. If the application was filed by a registered attorney or agent, any other registered practitioner named in the transmittal papers may also change the correspondence address. Thus, the inventor(s), any registered practitioner named in the transmittal papers accompanying the original application,

or a party that will be the assignee who filed the application, may change the correspondence address in that application under this paragraph.

(2) *Where a § 1.63 oath or declaration has been filed by any of the inventors.*

If a § 1.63 oath or declaration has been filed, or is filed concurrent with the filing of an application, by any of the inventors, the correspondence address may be changed by the parties set forth in paragraph (b) of this section, except for (b)(2).

(b) *Amendments and other papers:* Amendments and other papers filed in the application must be signed by:

(1) An attorney or agent of record appointed in compliance with § 1.34(b);

(2) A registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a);

(3) An assignee as provided for under § 3.71(b) of this chapter; or

(4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

* * * * *

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

§ 1.41 Applicant for patent.

(a) A patent is applied for in the name or names of the actual inventor or inventors.

(1) The inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribed by § 1.63, except as provided for in § 1.53(d)(4) and § 1.63(d). If an oath or declaration as prescribed by § 1.63 is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to § 1.53(b), unless applicant files a paper including the processing fee set forth in § 1.17(i) and supplying or changing the name or names of the inventor or inventors.

(2) The inventorship of a provisional application is that inventorship set forth in the cover sheet as prescribed by § 1.51(c)(1). If a cover sheet as prescribed by § 1.51(c)(1) is not filed during the pendency of a provisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to § 1.53(c), unless applicant files a paper including the processing fee set forth in § 1.17(q) and supplying or changing the name or names of the inventor or inventors.

(3) In a nonprovisional application filed without an oath or declaration as

prescribed by § 1.63 or a provisional application filed without a cover sheet as prescribed by § 1.51(c)(1), the name, residence, and citizenship of each person believed to be an actual inventor should be provided when the application papers pursuant to § 1.53(b) or (c) are filed.

(4) The inventors who submitted an application under §§ 1.494 or 1.495 are the inventors in the international application designating the United States.

* * * * *

§ 1.44 [Removed and reserved]

16. Section 1.44 is proposed to be removed and reserved.

17. 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 nonsigning inventor.

The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application on filing an oath or declaration complying with § 1.63.

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom 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 inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in § 1.17(h), and the last known address of all of the inventors. An inventor may subsequently join in the application on filing an oath or declaration complying with § 1.63.

(c) The Office will send notice of the filing of the application to all inventors who have not joined in the application at the address(es) provided in the petition under this section, and publish notice of the filing of the application in the *Official Gazette*. The Office may dispense with this notice provision in a continuation or divisional application,

if notice regarding the filing of the prior application was given to the nonsigning inventor(s).

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

§ 1.48 Correction of inventorship in a patent application, other than a reissue application, pursuant to 35 U.S.C. 116.

(a) *Nonprovisional application after oath/declaration filed.* If the inventive entity is set forth in error in an executed § 1.63 oath or declaration in a nonprovisional application, 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 inventorship of the nonprovisional application may be amended to name only the actual inventor or inventors. If the nonprovisional application is involved in an interference, the amendment must comply with the requirements of this section and must be accompanied by a motion under § 1.634. Amendment of the inventorship requires:

(1) A request to correct the inventorship that sets forth the desired inventorship change;

(2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;

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

(4) The processing fee set forth in § 1.17(i); and

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

(b) *Nonprovisional application—fewer inventors due to amendment or cancellation of claims.* If the correct inventors are named in a nonprovisional application, and the prosecution of the nonprovisional application results in the amendment or cancellation of claims so that fewer than all of the currently named inventors are the actual inventors of the invention being claimed in the nonprovisional application, an amendment must be filed requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed. If the application is involved in an interference, the amendment must comply with the requirements of this section and must be accompanied by a motion under § 1.634. Amendment of the inventorship requires:

(1) A request, signed by a party set forth in § 1.33(b), to correct the inventorship that identifies the named inventor or inventors being deleted and acknowledges that the inventor's invention is no longer being claimed in the nonprovisional application; and

(2) The processing fee set forth in § 1.17(i).

(c) *Nonprovisional application—inventors added for claims to unclaimed subject matter.* If a nonprovisional application discloses unclaimed subject matter by an inventor or inventors not named in the application, the application may be amended to add claims to the subject matter and name the correct inventors for the application. If the application is involved in an interference, the amendment must comply with the requirements of this section and must be accompanied by a motion under § 1.634. Amendment of the inventorship requires:

(1) A request to correct the inventorship that sets forth the desired inventorship change;

(2) A statement from each person being added as an inventor that the addition is necessitated by amendment of the claims and that the inventorship error occurred without deceptive intention on his or her part;

(3) An oath or declaration by the actual inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or 1.47;

(4) The processing fee set forth in § 1.17(i); and

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

(d) *Provisional application—adding omitted inventors.* If the name or names of an inventor or inventors were omitted in a provisional application through error without any deceptive intention on the part of the omitted inventor or inventors, the provisional application may be amended to add the name or names of the omitted inventor or inventors. Amendment of the inventorship requires:

(1) A request, signed by a party set forth in § 1.33(b), to correct the inventorship that identifies the inventor or inventors being added and states that the inventorship error occurred without deceptive intention on the part of the omitted inventor or inventors; and

(2) The processing fee set forth in § 1.17(q).

(e) *Provisional application—deleting the name or names of the inventor or inventors.* If a person or persons were named as an inventor or inventors in a provisional application through error without any deceptive intention on the part of such person or persons, an

amendment may be filed in the provisional application deleting the name or names of the person or persons who were erroneously named. Amendment of the inventorship requires:

(1) A request to correct the inventorship that sets forth the desired inventorship change;

(2) A statement by the person or persons whose name or names are being deleted that the inventorship error occurred without deceptive intention on the part of such person or persons;

(3) The processing fee set forth in § 1.17(q); 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) of this chapter).

(f)(1) *Nonprovisional application—filing executed oath/declaration corrects inventorship.* If the correct inventor or inventors are not named on filing a nonprovisional application under § 1.53(b) without an executed oath or declaration under § 1.63 by any of the inventors, the first submission of an executed oath or declaration under § 1.63 by any of the inventors during the pendency of the application will act to correct the earlier identification of inventorship. See § 1.497(d) for submission of an executed oath or declaration to enter the national stage under 35 U.S.C. 371 and § 1.494 or § 1.495 naming an inventive entity different from the inventive entity set forth in the international stage.

(2) *Provisional application—filing cover sheet corrects inventorship.* If the correct inventor or inventors are not named on filing a provisional application without a cover sheet under § 1.51(c)(1), the later submission of a cover sheet under § 1.51(c)(1) during the pendency of the application will act to correct the earlier identification of inventorship.

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

(h) *Reissue applications not covered.* The provisions of this section do not apply to reissue applications. See §§ 1.171 and 1.175 for correction of inventorship in a patent via a reissue application.

(i) *Correction of inventorship in patent or interference.* See § 1.324 for correction of inventorship in a patent, and § 1.634 for correction of inventorship in an interference.

19. Section 1.51 is proposed to be amended by revising paragraph (b) to read as follows:

§ 1.51 General requisites of an application.

* * * * *

(b) A complete application filed under § 1.53(b) or § 1.53(d) comprises:

(1) A specification as prescribed by 35 U.S.C. 112, including a claim or claims, see §§ 1.71 to 1.77;

(2) An oath or declaration, see §§ 1.63 and 1.68;

(3) Drawings, when necessary, see §§ 1.81 to 1.85; and

(4) The prescribed filing fee, see § 1.16.

* * * * *

20. Section 1.52 is proposed to be revised to read as follows:

§ 1.52 Language, paper, writing, margins.

(a) *Papers which are to become a part of the permanent Patent and Trademark Office records in the file of a patent application.* (1) All papers, other than drawings, which are to become a part of the permanent Patent and Trademark Office records in the file of a patent application must be on sheets of paper that are:

(i) Flexible, strong, smooth, non-shiny, durable, and white;

(ii) Either 21.0 cm by 29.7 cm (DIN size A4) or 21.6 cm by 27.9 cm (8 1/2 by 11 inches), with each sheet including a top margin of at least 2.0 cm (3/4 inch), a left side margin of at least 2.5 cm (1 inch), a right side margin of at least 2.0 cm (3/4 inch), and a bottom margin of at least 2.0 cm (3/4 inch);

(iii) Written on only one side in portrait orientation;

(iv) Plainly and legibly written either by a typewriter or machine printer in permanent dark ink or its equivalent; and

(v) 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 capture by use of digital imaging and optical character recognition.

(2) All papers which are to become a part of the permanent records of the Patent and Trademark Office should have no holes in the sheets as submitted.

(3) The provisions of this paragraph and paragraph (b) of this section do not apply to the pre-printed information on forms provided by the Office.

(4) See § 1.58 for chemical and mathematical formulae and tables, and § 1.84 for drawings.

(5) If papers are submitted as part of the permanent record, other than the drawings, that do not comply with

paragraph (a)(1) of this section the Office may at its option:

(i) Convert the papers submitted by applicant into papers that do comply with paragraph (a)(1) of this section and charge the applicant the costs incurred by the Office in doing so (§ 1.21(j)); or

(ii) Require that the applicant provide substitute papers that comply with paragraph (a)(1) of this section within a set time period.

(b) *The application (specification, including the claims, drawings, and oath or declaration) and any amendments or corrections to the application.* (1) The application and any amendments or corrections to the application (including any translation submitted pursuant to paragraph (d) of this section), except as provided for in § 1.69 and paragraph (d) of this section, must:

(i) Comply with the requirements of paragraph (a) of this section; and

(ii) Be in the English language or be accompanied by a translation of any corrections or amendments into the English language together with a statement that the translation is accurate.

(2) The specification (including the abstract and claims), and any amendments to the specification, must have:

(i) Lines that are 1 1/2 or double spaced;

(ii) Text written in a block (nonscript) type font or lettering style having capital letters which are at least 0.21 cm (0.08 inch) high; and

(iii) No more than a single column of text.

(3) The claim or claims must commence on a separate sheet (§ 1.75(h)).

(4) The abstract must commence on a separate sheet (§ 1.72(b)).

(5) The pages of the specification including claims and abstract must be numbered consecutively, starting with 1, the numbers being centrally located above or preferably, below, the text.

(6) Paragraphs in the specification, other than in the claims or abstract, should be individually and consecutively numbered using Arabic numerals, so as to unambiguously identify each paragraph. The number should consist of at least four numerals contained in square brackets, including leading zeros (e.g., [0001]). The numbers and enclosing brackets should appear to the right of the left margin as the first item in each paragraph, before the first word of the paragraph, and should be highlighted in bold. A gap, equivalent to approximately four spaces, should follow the number. Nontext elements (e.g., tables, mathematical or chemical

formulas, chemical structures, and sequence data) are considered part of the numbered paragraph around or above the elements, and should not be independently numbered. Even if a nontext element extends to the left margin, it should not be numbered as a separate and independent paragraph. A list is also treated as part of the paragraph around or above the list, and should not be independently numbered. Paragraph or section headers (titles), whether abutting the left margin or centered on the page, are not considered paragraphs and should not be numbered.

(7) If papers are submitted as part of the application that do not comply with paragraphs (b)(1) through (b)(5) of this section, the Office may at its option:

(i) Convert the papers submitted by applicant into papers that do comply with paragraphs (b)(1) through (b)(5) of this section and charge the applicant the costs incurred by the Office in doing so (§ 1.21(j)); or

(ii) Require that the applicant provide substitute papers that comply with paragraphs (b)(1) through (b)(5) of this section within a set time period.

(c)(1) Any interlineation, erasure, cancellation or other alteration of the application papers filed must be made before the signing of any accompanying oath or declaration pursuant to § 1.63 referring to those application papers and should be dated and initialed or signed by the applicant on the same sheet of paper. Application papers containing alterations made after the signing of an oath or declaration referring to those application papers must be supported by a supplemental oath or declaration under § 1.67. In either situation, a substitute specification (§ 1.125) is required if the application papers do not comply with paragraphs (a) and (b) of this section.

(2) After the signing of the oath or declaration referring to the application papers, amendments may only be made in the manner provided by § 1.121.

(3) Notwithstanding the provisions of this paragraph, if an oath or declaration is a copy of the oath or declaration from a prior application, the application for which such copy is submitted may contain alterations that do not introduce matter that would have been new matter in the prior application.

(d) A nonprovisional or provisional application may be filed in a language other than English.

(1) *Nonprovisional application.* If a nonprovisional application is filed in a language other than English, an English language translation of the non-English language application, a statement that the translation is accurate, and the

processing fee set forth in § 1.17(i) are required. If these items are not filed with the application, applicant will be notified and given a period of time within which they must be filed in order to avoid abandonment.

(2) *Provisional application:* If a provisional application is filed in a language other than English, an English language translation of the non-English language provisional application will not be required in the provisional application. If a nonprovisional application claims the benefit of such provisional application, however, an English language translation of the non-English language provisional application and a statement that the translation is accurate must be supplied if the nonprovisional application is involved in an interference (§ 1.630), or when specifically required by the examiner.

21. Section 1.53 is proposed to be amended by revising paragraphs (c)(1), (c)(2), (d)(4), (e)(2), (f) and (g) and adding paragraph (d)(10) to read as follows:

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

* * * * *

(c) * * *

(1) A provisional application must also include the cover sheet required by § 1.51(c)(1), which may be an application data sheet (§ 1.76), or a cover letter identifying the application as a provisional application. Otherwise, the application will be treated as an application filed under paragraph (b) of this section.

(2) An application for patent filed under paragraph (b) of this section may be converted to a provisional application and be accorded the original filing date of the application filed under paragraph (b) of this section. The grant of such a request for conversion will not entitle applicant to a refund of the fees which were properly paid in the application filed under paragraph (b) of this section. Such a request for conversion must be accompanied by the processing fee set forth in § 1.17(q) and be filed prior to the earliest of:

- (i) Abandonment of the application filed under paragraph (b) of this section;
- (ii) Payment of the issue fee on the application filed under paragraph (b) of this section;
- (iii) Expiration of twelve months after the filing date of the application filed under paragraph (b) of this section; or
- (iv) The filing of a request for a statutory invention registration under § 1.293 in the application filed under paragraph (b) of this section.

* * * * *

(d) * * *

(4) An application filed under this paragraph may be filed by fewer than all the inventors named in the prior application, provided that the request for an application under this paragraph when filed is accompanied by a statement requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed in the new application. No person may be named as an inventor in an application filed under this paragraph who was not named as an inventor in the prior application on the date the application under this paragraph was filed, except by way of correction of inventorship under § 1.48.

(10) See § 1.103(b) for requesting a limited suspension of action in an application filed under this paragraph.

(e) * * *

(2) Any request for review of a notification pursuant to paragraph (e)(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 accompanied by the fee set forth in § 1.17(h). 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 (e)(1) of this section will be the date the filing error is corrected.

* * * * *

(f) *Completion of application subsequent to filing—Nonprovisional (including continued prosecution and reissue) application.* (1) If an application which has been accorded a filing date pursuant to paragraph (b) or (d) of this section does not include the basic filing fee, or if an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include an oath or declaration by the applicant pursuant to §§ 1.63, 1.162 or 1.175, and applicant has provided a correspondence address (§ 1.33(a)), applicant will be notified and given a period of time within which to pay the filing fee, file an oath or declaration in an application under paragraph (b) of this section, and pay the surcharge required by § 1.16(e) to avoid abandonment.

(2) If an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include the basic filing fee or an oath or declaration by the applicant pursuant to §§ 1.63, 1.162 or 1.175, and applicant has not provided a correspondence address (§ 1.33(a)), applicant has two

months from the filing date of the application within which to pay the basic filing fee, file an oath or declaration, and pay the surcharge required by § 1.16(e) to avoid abandonment.

(3) This paragraph applies to continuation or divisional applications under paragraphs (b) or (d) of this section and to continuation-in-part applications under paragraph (b) of this section.

(4) See § 1.63(d) concerning the submission of a copy of the oath or declaration from the prior application for a continuation or divisional application under paragraph (b) of this section.

(5) If applicant does not pay one of the basic filing fee or the processing and retention fee set forth in § 1.21(l) during the pendency of the application, the Office may dispose of the application.

(g) *Completion of application subsequent to filing—provisional application.* (1) If a provisional application which has been accorded a filing date pursuant to paragraph (c) of this section does not include the cover sheet required by § 1.51(c)(1) or the basic filing fee (§ 1.16(k)), and applicant has provided a correspondence address (§ 1.33(a)), applicant will be notified and given a period of time within which to pay the basic filing fee, file a cover sheet (§ 1.51(c)(1)), and pay the surcharge required by § 1.16(l) to avoid abandonment.

(2) If a provisional application which has been accorded a filing date pursuant to paragraph (c) of this section does not include the cover sheet required by § 1.51(c)(1) or the basic filing fee (§ 1.16(k)), and applicant has not provided a correspondence address (§ 1.33(a)), applicant has two months from the filing date of the application within which to pay the basic filing fee, file a cover sheet (§ 1.51(c)(1)), and pay the surcharge required by § 1.16(l) to avoid abandonment.

(3) If applicant does not pay the basic filing fee during the pendency of the application, the Office may dispose of the application.

* * * * *

22. Section 1.55 is proposed to be amended by 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), 172, and 365(b).

(1) The claim for priority must identify the foreign application for

which priority is claimed, as well as any foreign application for the same subject having a filing date before that of the application for which priority is claimed, by specifying the application number, country (or intergovernmental organization), day, month, and year of its filing.

(2)(i) In an application filed under 35 U.S.C. 111(a), the claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) must be filed before the patent is granted.

(ii) In an application that entered the national stage from an international application after compliance with 35 U.S.C. 371, the claim for priority must be made within the time limit set forth in the PCT and the Regulations under the PCT. If the certified copy of the foreign application has not been filed in accordance with the PCT and the Regulations under the PCT, it must be filed before the patent is granted.

(iii) When the application becomes involved in an interference (§ 1.630), when necessary to overcome the date of a reference relied upon by the examiner, or when deemed necessary by the examiner, the Office may require that the claim for priority and the certified copy of the foreign application be filed earlier than provided in paragraph (a)(2)(i) or (a)(2)(ii) of this section.

(iv) If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by the processing fee set forth in § 1.17(i) but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323 of this part.

(3) An English-language translation of a non-English-language foreign application is not required except when the application is involved in an interference (§ 1.630), when necessary to overcome the date of a reference relied upon by the examiner, or when specifically required by the examiner. If an English-language translation is required, it must be filed together with a statement that the translation of the certified copy is accurate.

* * * * *

23. Section 1.56 is proposed to be amended by adding a new paragraph (e) to read as follows:

§ 1.56 Duty to disclose information material to patentability.

* * * * *

(e) In any continuation-in-part application, the duty under this section includes the duty to disclose to the Office all information known to the person to be material to patentability, as

defined in paragraph (b) of this section, which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

24. Section 1.59 is proposed to be amended by revising paragraph (b) to read as follows:

§ 1.59 Expungement of information or copy of papers in application file.

* * * * *

(b) An applicant may request that the Office expunge and return information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge and return information from an application must include the fee set forth in § 1.17(h) and establish to the satisfaction of the Commissioner that the return of the information is appropriate.

* * * * *

25. Section 1.63 is proposed to be amended by revising paragraphs (a), (b), (c) and (e) to read as follows:

§ 1.63 Oath or declaration.

(a) An oath or declaration filed under § 1.51(b)(2) as a part of a nonprovisional application must:

(1) Be executed (*i.e.*, signed) in accordance with either § 1.66 or § 1.68;

(2) Identify each inventor and country of citizenship of each inventor; and

(3) State that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

(b) In addition to meeting the requirements of paragraph (a), the oath or declaration must also:

(1) Identify the application to which it is directed;

(2) State that the person making the oath or declaration has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration; and

(3) State that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

(c) Unless such information is supplied on an application data sheet in accordance with § 1.76, the oath or declaration must also identify:

(1) 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;

(2) The mailing address and residence (if different from the mailing address) of each inventor; and

(3) Any foreign application for patent (or inventor's certificate) for which a claim for priority is made pursuant to § 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing.

* * * * *

(e) A newly executed oath or declaration must be filed in any continuation-in-part application, which application may name all, more, or fewer than all of the inventors named in the prior application.

26. Section 1.64 is proposed to be revised to read as follows:

§ 1.64 Person making oath or declaration.

(a) The oath or declaration (§ 1.63), including any supplemental oath or declaration (§ 1.67), must be made by all of the actual inventors except as provided for in §§ 1.42, 1.43, 1.47 or 1.67.

(b) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, 1.47 or 1.67), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor is required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

27. Section 1.67 is proposed to be amended by revising paragraph (a) and removing paragraph (c) to read as follows:

§ 1.67 Supplemental oath or declaration.

(a) The Office may require a supplemental oath or declaration meeting the requirements of § 1.63 or § 1.162 to correct any deficiencies or inaccuracies present in the earlier filed oath or declaration. If the earlier filed oath or declaration complied with § 1.63(a), the Office may permit the supplemental oath or declaration to be made by fewer than all of the inventors or by an applicant other than the inventor.

* * * * *

28. Section 1.72 is proposed to be revised to read as follows:

§ 1.72 Title and abstract.

(a) Unless the title is supplied in an application data sheet (§ 1.76), the title

of the invention, which should be as short and specific as possible, should appear as a heading on the first page of the specification.

(b) A brief abstract of the technical disclosure in the specification must commence on a separate sheet, preferably following the claims, under the heading "Abstract" or "Abstract of the Disclosure." The abstract in an application filed under 35 U.S.C. 111 may not exceed 150 words in length. The purpose of the abstract is to enable the Patent and Trademark Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure. The abstract will not be used for interpreting the scope of the claims.

29. A new § 1.76 is proposed to be added to read as follows:

§ 1.76 Application data sheet.

(a) An application data sheet is a sheet or sheets containing bibliographic data concerning a patent application arranged in a specified format. If an application data sheet is provided, the application data sheet is part of the application.

(b) Bibliographic data as used in paragraph (a) of this section includes:

(1) *Applicant information.* This information includes the name, residence, mailing address, and citizenship of each applicant (§ 1.41(b)). The name of each applicant must include the family name, and at least one given name without abbreviation together with any other given name or initial. If the applicant is not an inventor, this information also includes the applicant's authority (§§ 1.42, 1.43 and 1.47) to apply for the patent on behalf of the inventor. The citizenship of each inventor must be provided in the oath or declaration under § 1.63 even if it is provided in the application data sheet (35 U.S.C. 115).

(2) *Correspondence information.* This information includes the correspondence address, which may be indicated by reference to a customer number, to which correspondence is to be directed (see § 1.33(a)).

(3) *Application information.* This information includes the title of the invention, the total number of drawing sheets, whether the drawings are formal, any docket number assigned to the application, and the type (e.g., utility, plant, design, reissue utility, provisional) of application, and whether the application discloses any significant part of the subject matter of an application under a secrecy order pursuant to § 5.2 of this chapter (see § 5.2(c)).

(4) *Representative information.* This information includes the registration number of each practitioner, or the customer number, having a power of attorney or authorization of agent in the application. Providing this information in the application data sheet does not constitute a power of attorney or authorization of agent in the application (see § 1.34(b)).

(5) *Domestic priority information.* This information includes the application number, the filing date, the status (including patent number if available), and relationship of each application for which a benefit is claimed under 35 U.S.C. 119(e), 120, 121, or 365(c). Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120 and § 1.78(a)(2) or § 1.78(a)(4) of this part.

(6) *Foreign priority information.* This information includes the application number, country, and filing date of each foreign application for which priority is claimed, as well as any foreign application having a filing date before that of the application for which priority is claimed. Providing this information in the application data sheet constitutes the claim for priority as required by 35 U.S.C. 119(b) and § 1.55(a) of this part.

(c) If an application contains an application data sheet, any inconsistency between the information provided in the application data sheet and the oath or declaration under § 1.63 will be resolved in favor of the information provided in the application data sheet. A supplemental application data sheet may be submitted to correct or update information provided in a previous application data sheet.

30. Section 1.77 is proposed to be revised to read as follows:

§ 1.77 Arrangement of application elements.

(a) The elements of the application, if applicable, should appear in the following order:

- (1) Utility application transmittal form.
- (2) Fee transmittal form.
- (3) Application data sheet (see § 1.76).
- (4) Specification.
- (5) Drawings.
- (6) Executed oath or declaration.

(b) The specification should include the following sections in order:

- (1) Title of the invention, which may be accompanied by an introductory portion stating the name, citizenship and residence of the applicant.
- (2) Cross-reference to related applications (unless included in the application data sheet).
- (3) Statement regarding federally sponsored research or development.

(4) Reference to a "computer program listing appendix" (see § 1.96 (c)).

- (5) Background of the invention.
- (6) Brief summary of the invention.
- (7) Brief description of the several views of the drawing.

(8) Detailed description of the invention.

- (9) A claim or claims.
- (10) Abstract of the disclosure.
- (11) Sequence listing (see §§ 1.821 through 1.825).

(c) The text of the specification sections defined in paragraphs (b)(1) through (b)(3) and (b)(5) through (b)(11) of this section, if applicable, should be preceded by a section heading in uppercase and without underlining or bold type.

31. Section 1.78 is proposed to be amended by revising paragraphs (a)(2), (a)(4) and (c) to read as follows:

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

(a) * * *

(2) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application claiming the benefit of one or more prior filed copending nonprovisional applications or international applications designating the United States of America must contain a reference to each such prior application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Unless the reference required by this paragraph is included in an application data sheet (§ 1.76), the specification must contain or be amended to contain such reference in the first sentence following the title. The request for a continued prosecution application under § 1.53(d) is the specific reference required by 35 U.S.C. 120 to the prior application. The identification of an application by application number under this section is the specific reference required by 35 U.S.C. 120 to every application assigned that application number. Cross-references to other related applications may be made when appropriate (see § 1.14).

* * * * *

(4) Any nonprovisional application claiming the benefit of one or more prior filed copending provisional applications must contain a reference to each such prior provisional application, identifying it as a provisional application, and including the provisional application number (consisting of series code and serial number). Unless the reference required by this paragraph is included in an

application data sheet (§ 1.76), the specification must contain or be amended to contain such reference in the first sentence following the title.

* * * * *

(c) If an application or a patent under reexamination and at least one other application naming different inventors are owned by the same party and contain conflicting claims, and there is no statement of record indicating that the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, the Office may require the assignee to state whether the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, and, if not, indicate which named inventor is the prior inventor.

32. Section 1.84 is proposed to be revised to read as follows:

§ 1.84 Standards for drawings.

(a) *Drawings.* There are two acceptable categories for presenting drawings in utility patent applications:

(1) *Black ink.* Black and white drawings are normally required. India ink, or its equivalent that secures solid black lines, must be used for drawings, or

(2) *Color.* On rare occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility patent application or the subject matter of a statutory invention registration. The Patent and Trademark Office will accept color drawings in utility patent applications and statutory invention registrations only if color drawings are necessary for the understanding of the claimed invention and upon payment of the fee set forth in § 1.17(k) and submission of three sets of the color drawings. Color drawings are not permitted in international applications (see PCT Rule 11.13). If the subject matter of the application admits of illustration by a black and white drawing, the examiner may require a black and white drawing in place of the color drawing. The color drawings must be of sufficient quality so that all details in the drawings are reproducible in the printed patent. If color drawings are submitted, the specification must contain or be amended to contain the following language as the first paragraph of the brief description of the drawings:

The file of this patent contains at least one drawing executed in color. Copies of this patent with color drawing(s) will be provided by the Patent and Trademark Office upon request and payment of the necessary fee.

(b)(1) *Photographs.* Photographs are not ordinarily permitted in utility patent applications. The Office will accept photographs in utility patent applications, however, if photographs are the only practicable medium for illustrating the claimed invention. If the subject matter of the application admits of illustration by a drawing, the examiner may require a drawing in place of the photograph. The photographs must be of sufficient quality so that all details in the photographs are reproducible in the printed patent.

(2) *Color photographs.* Color photographs will be accepted in utility patent applications if the conditions for accepting color drawings and photographs have been satisfied. See paragraphs (a)(2) and (b)(1) of this section.

(c) *Identification of drawings.* Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

(d) *Type of paper.* Drawings submitted to the Office must be made on paper which is flexible, strong, white, smooth, non-shiny, and durable. All sheets must be reasonably free from cracks, creases, and folds. Only one side of the sheet may be used for the drawing. Each sheet must be reasonably free from erasures and must be free from alterations, overwritings, and interlineations. Photographs must be developed on paper or be permanently mounted on Bristol board meeting the sheet-size requirements of paragraph (e) of this section and the margin requirements of paragraph (f) of this section. See paragraph (b) of this section for other requirements for photographs.

(e) *Size of paper.* All drawing sheets in an application must be the same size. One of the shorter sides of the sheet is regarded as its top. The size of the sheets on which drawings are made must be:

- (1) 21.0 cm by 29.7 cm (DIN size A4); or
- (2) 21.6 cm by 27.9 cm (8½ by 11 inches).

(f) *Margins.* The sheets must not contain frames around the sight (*i.e.*, the usable surface), but should have scan target points (*i.e.*, cross-hairs) printed on two catercorner margin corners. Each sheet must include a top margin of at least 2.5 cm (1 inch), a left side margin of at least 2.5 cm (1 inch), a right side margin of at least 1.5 cm (¾ inch), and

a bottom margin of at least 1.0 cm (¾ inch), and must leave a sight no greater than 17.0 cm by 26.2 cm on 21.0 cm by 29.7 cm (DIN size A4) drawing sheets, and a sight no greater than 17.0 cm by 24.4 cm (6¾ by 9⅝ inches) on 21.6 cm by 27.9 cm (8½ by 11 inch) drawing sheets.

(g) *Scale.* The scale to which a drawing is made must be large enough to show the mechanism without crowding when the drawing is reduced in size to two-thirds in reproduction. Indications such as "actual size" or "scale ½" on the drawings are not permitted since these lose their meaning with reproduction in a different format.

(h) *Character of lines, numbers, and letters.* All drawings must be made by a process which will give them satisfactory reproduction characteristics. Every line, number, and letter must be durable, clean, black (except for color drawings), sufficiently dense and dark, and uniformly thick and well-defined. The weight of all lines and letters must be heavy enough to permit adequate reproduction. This requirement applies to all lines however fine, to shading, and to lines representing cut surfaces in sectional views. Lines and strokes of different thicknesses may be used in the same drawing where different thicknesses have a different meaning.

(i) *Legends.* Suitable descriptive legends may be used subject to approval by the Office, or may be required by the examiner where necessary for understanding of the drawing. They should contain as few words as possible.

(j) *Numbers, letters, and reference characters.* (1) Reference characters (numerals are preferred), sheet numbers, and view numbers must be plain and legible, and must not be used in association with brackets or inverted commas, or enclosed within outlines, *e.g.*, encircled. They must be oriented in the same direction as the view so as to avoid having to rotate the sheet.

(2) The English alphabet must be used for letters, except where another alphabet is customarily used, such as the Greek alphabet to indicate angles, wavelengths, and mathematical formulas.

(3) Numbers, letters, and reference characters must measure at least 0.32 cm (⅛ inch) in height.

(4) The same part of an invention appearing in more than one view of the drawing must always be designated by the same reference character, and the same reference character must never be used to designate different parts.

(5) Only reference characters mentioned in the description may appear in the drawings. Reference

characters mentioned in the description must appear in the drawings.

(k) *Lead lines.* Lead lines are those lines between the reference characters and the details to which they refer. Such lines may be straight or curved and should be as short as possible. They must originate in the immediate proximity of the reference character and extend to the feature indicated. Lead lines must not cross each other. Lead lines are required for each reference character except for those which indicate the surface or cross section on which they are placed. Such a reference character must be underlined to make it clear that a lead line has not been left out by mistake. Lead lines must be executed in the same way as lines in the drawing. See paragraph (h) of this section.

(l) *Numbering of sheets of drawings.* The sheets of drawings should be numbered in consecutive Arabic numerals, starting with 1, within the sight as defined in paragraph (g) of this section. These numbers, if present, must be placed in the middle of the top of the sheet, but not in the margin. The numbers can be placed on the right-hand side if the drawing extends too close to the middle of the top edge of the usable surface. The drawing sheet numbering must be clear and larger than the numbers used as reference characters to avoid confusion. The number of each sheet may be shown by two Arabic numerals placed on either side of an oblique line, with the first being the sheet number and the second being the total number of sheets of drawings, with no other marking.

(m) *Numbering of views.* (1) The different views must be numbered in consecutive Arabic numerals, starting with 1, independent of the numbering of the sheets and, if possible, in the order in which they appear on the drawing sheet(s). Partial views intended to form one complete view, on one or several sheets, must be identified by the same number followed by a capital letter. View numbers must be preceded by the abbreviation "FIG." Where only a single view is used in an application to illustrate the claimed invention, it must not be numbered and the abbreviation "FIG." must not appear.

(2) Numbers and letters identifying the views must be simple and clear and must not be used in association with brackets, circles, or inverted commas. The view numbers must be larger than the numbers used for reference characters.

(n) *Security markings.* Authorized security markings may be placed on the drawings provided they are outside the

sight, preferably centered in the top margin.

(o) *Corrections.* Any corrections on drawings submitted to the Office must be durable and permanent.

(p) See § 1.152 for design drawings, § 1.165 for plant drawings, and § 1.173 for reissue drawings.

33. Section 1.85 is proposed to be revised to read as follows:

§ 1.85 Corrections to drawings.

(a) If a drawing meets the requirements of § 1.84(d), (e) and (f) and is suitable for reproduction, but is not otherwise in compliance with § 1.84, the drawing may be admitted for examination.

(b) The Office will not release drawings for purposes of correction. If corrections are necessary, new corrected drawings must be submitted within the time set by the Office.

(c) If a corrected drawing is required or if a drawing does not comply with § 1.84 at the time an application is allowed, the Office may notify the applicant and set a three month period of time from the mail date of the notice of allowability within which the applicant must file a corrected or formal drawing in compliance with § 1.84 to avoid abandonment. This time period is not extendable under § 1.136(a) or (b).

34. Section 1.91 is proposed to be amended by revising paragraph (a)(3)(i) to read as follows:

§ 1.91 Models or exhibits not generally admitted as part of application or patent.

(a) * * *

(3) * * *

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

* * * * *

35. Section 1.96 is proposed to be amended by revising paragraphs (b) and (c) to read as follows:

§ 1.96 Submission of computer program listings.

* * * * *

(b) *Material which will be printed in the patent.* If the computer program listing is contained on one sheet, it may be submitted either as a drawing or as part of the specification.

(1) *Drawings.* If the listing is submitted as a drawing, it must be submitted in the manner and complying with the requirements for drawings as provided in § 1.84. At least one figure numeral is required on the sheet of drawing.

(2) *Specification.* (i) If the listing is submitted as part of the specification, it must be submitted in accordance with the provisions of § 1.52, at the end of the description but before the claims.

(ii) Any listing submitted as part of the specification must be a direct

printout (*i.e.*, not a copy) from the computer's printer with dark solid black letters not less than 0.21 cm high, on white, unshaded and unlined paper, and the sheet should be submitted in a protective cover. Any amendments must be made by way of submission of a substitute sheet.

(c) *As an appendix which will not be printed.* Any computer program listing may, and any computer program listing that would be contained on more than one sheet must, be submitted on a Compact Disk-Read Only Memory (CD-ROM) or Compact Disk-Recordable (CD-R), which must be referred to in the specification (see § 1.77(b)(4)). A CD-ROM or CD-R containing such a computer program listing is to be referred to as a "computer program listing appendix." The "computer program listing appendix" will not be part of the printed patent. Reference in the application to the "computer program listing appendix" must be made at the location indicated in § 1.77(b)(4). Any amendment to the "computer program listing appendix" must be by way of a new CD-ROM or CD-R containing a substitute computer program listing.

(1) *Availability of appendix.* Such "computer program listing appendix" will be available to the public for inspection, and copies thereof will be available for purchase with the file wrapper and contents, after a patent based on such application is granted or the application is otherwise made publicly available.

(2) *Submission requirements—(i)* A "computer program listing appendix" must be submitted on a CD-ROM or CD-R in accordance with the standards set forth in 36 CFR 1228.188(c) and (d).

(ii) The computer program listing must be written in American Standard Code for Information Interchange (ASCII) in the form of textual document files on a disk that complies with § 1.824(b). No other format shall be allowed. The CD-ROM or CD-R must be accompanied by documentation on paper in accordance with § 1.52(a) that contains the machine format (*e.g.*, IBM-PC, Macintosh), the operating system (*e.g.*, MS-DOS, Macintosh, Unix) and any other special information that is necessary to identify, maintain, and interpret the "computer program listing appendix."

(iii) Multiple computer program listings for a single application may be placed on a single CD-ROM or CD-R. Multiple CD-ROMs or CD-Rs may be submitted for a single application if necessary. A separate CD-ROM or CD-R is required for each application containing a computer program listing

that must be submitted on a "computer program listing appendix."

(iv) A CD-ROM or CD-R "computer program listing appendix" must be labeled with the following information:

- (A) The name of each inventor (if known);
- (B) Title of the invention;
- (C) The docket number used by the person filing the application to identify the application (if applicable).

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

§ 1.97 Filing of information disclosure statement.

(a) In order for an applicant for a patent or for a reissue of a patent to have an information disclosure statement in compliance with § 1.98 considered by the Office during the pendency of the application, it must satisfy one of paragraphs (b), (c), or (d) of this section.

(b) An information disclosure statement shall be considered by the Office if filed by the applicant within any one of the following time periods:

(1) Within three months of the filing date of a national application other than a continued prosecution application under § 1.53(d);

(2) Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application; or

(3) Before the mailing date of a first Office action on the merits.

(c) An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, provided that the information disclosure statement is filed before the mailing date of any of a final action under § 1.113, a notice of allowance under § 1.311, or an action that otherwise closes prosecution in the application, and it is accompanied by one of:

(1) A statement as specified in paragraph (e) of this section; or

(2) The fee set forth in § 1.17(p).

(d) An information disclosure statement shall be considered by the Office if filed by the applicant after the period specified in paragraph (c) of this section, provided that the information disclosure statement is filed on or before payment of the issue fee and is accompanied by:

(1) A statement as specified in paragraph (e) of this section; and

(2) The fee set forth in § 1.17(p).

(e) A statement under this section must state either:

(1) That each item of information contained in the information disclosure statement was first 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, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in § 1.56(c) more than three months prior to the filing of the information disclosure statement.

* * * * *

37. Section 1.98 is proposed to be revised to read as follows:

§ 1.98 Content of information disclosure statement.

(a) Any information disclosure statement filed under § 1.97 shall include:

(1) A list of all patents, publications or other information submitted for consideration by the Office;

(2) A legible copy of:

(i) Each U.S. and foreign patent;

(ii) Each publication or that portion which caused it to be listed;

(iii) For each cited pending U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and

(iv) All other information or that portion which caused it to be listed; and

(3) A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from the specification or incorporated therein. If a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c), a copy of the translation shall accompany the information disclosure statement.

(b) Each U.S. patent listed in an information disclosure statement shall be identified by patentee, patent number and issue date. Each listed U.S. application shall be identified by the inventor, application number and filing date. Each listed foreign patent or published foreign patent application shall be identified by the country or

patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application. Each listed publication shall be identified by author (if any), title, relevant pages of the publication, date, and place of publication.

(c) When the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications provided that a statement is made that these other patents or publications are cumulative.

(d) A copy of any patent, publication, application, or other information listed in an information disclosure statement is not required to be provided if it was previously cited by or submitted to the Office in a prior application, provided that:

(1) The prior application is properly identified in the statement and relied on for an earlier filing date under 35 U.S.C. 120; and

(2) Where the listed information was not cited by the Office, the information submission made in the prior application complied with paragraphs (a) through (c) of this section, and except for an application filed under § 1.53(d) the submission made in the prior application complied with § 1.97.

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

§ 1.102 Advancement of examination.

* * * * *

(d) A petition to make an application special on grounds other than those referred to in paragraph (c) of this section must be accompanied by the fee set forth in § 1.17(h).

39. Section 1.103 is proposed to be revised to read as follows:

§ 1.103 Suspension of action by the Office.

(a) *Suspension for cause.* On request of the applicant, the Office may grant a suspension of action under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:

(1) A showing of good and sufficient cause for suspension of action; and

(2) The fee set forth in § 1.17(h), unless such cause is the fault of the Office.

(b) *Limited suspension of action in a continued prosecution application (CPA) under § 1.53(d)*. On request of the applicant, the Office may grant a suspension of action under this paragraph in a continued prosecution application under § 1.53(d) for a period not exceeding three months. Any request for suspension of action under this paragraph must be filed with the request for an application under § 1.53(d), specify the period of suspension, and include the processing fee set forth in § 1.17(i).

(c) *Notice of suspension on initiative of the Office*. The Office will notify applicant if the Office suspends action by the Office on an application on its own initiative.

(d) *Suspension of action for public safety or defense*. The Office may suspend action by the Office by order of the Commissioner if the following conditions are met:

(1) The application is owned by the United States;

(2) Publication of the invention may be detrimental to the public safety or defense; and

(3) The appropriate department or agency requests such suspension.

(e) *Statutory invention registration*. The Office will suspend action for the entire pendency of an application if the Office has accepted a request to publish a statutory invention registration in the application, except for purposes relating to patent interference proceedings under subpart E of this part.

40. A new § 1.105 is proposed to be added to read as follows:

§ 1.105 Requirements for information.

(a)(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission of such information as may be reasonably necessary to properly examine or treat the matter.

(2) Any reply that states that the information required to be submitted is unknown and/or is not available will be accepted as a complete reply.

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this rule will be governed by §§ 1.135 and 1.136.

41. Section 1.111 is proposed to be amended by revising the heading and paragraphs (a) and (c) to read as follows:

§ 1.111 Reply by applicant or patent owner to a non-final Office action.

(a) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply thereto and request reconsideration or further examination, with or without amendment. See § 1.135 and § 1.136 for time for reply to avoid abandonment. A second or subsequent supplemental reply will be entered unless disapproved by the Commissioner.

* * * * *

(c) In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.

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

§ 1.112 Reconsideration before final action.

After 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 (§ 1.104). Applicant or patent owner may reply to such Office action in the same manner provided in § 1.111, with or without amendment, unless such Office action indicates that it is made final (§ 1.113) or an appeal (§ 1.191) has been taken.

43. A new § 1.115 is proposed to be added to read as follows:

§ 1.115 Preliminary amendments.

(a) A preliminary amendment is an amendment that is received in the Office (§ 1.6) on or before the mail date of the first Office action under § 1.104.

(b) A preliminary amendment will be entered unless disapproved by the Commissioner. A preliminary amendment will not be disapproved if it is filed no later than:

(1) Three months from the filing date of an application under § 1.53(b);

(2) The filing date of a continued prosecution application under § 1.53(d); or

(3) Three months from the date the national stage is entered as set forth in § 1.491 in an international application.

(c) The time periods specified in paragraph (b) of this section are not extendable.

44. Section 1.121 is proposed to be amended by revising paragraphs (a) and (b) to read as follows:

§ 1.121 Manner of making amendments.

(a) *Amendments in applications, other than 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 the claims—(i) Amendment by instruction to delete, replace or add a paragraph*: If the paragraphs of the specification are numbered as provided in § 1.52(b)(6), amendments to the specification, other than the claims, may be made by submitting an instruction, referencing the paragraph number, to delete one or more paragraphs of the specification, to replace a deleted paragraph with one or more replacement paragraphs, or to add one or more paragraphs, along with the replacement or added paragraph(s). The replacement or added paragraph(s) must not include any markings to indicate the changes that have been made. The amendment must be accompanied by a copy of any replacement paragraph(s), on one or more pages separate from the amendment, marked-up to show all the changes made by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system. If a deleted paragraph is replaced by a single paragraph, the replacement paragraph must retain the same number as the deleted paragraph. If a deleted paragraph is replaced by more than one paragraph, the numbering of the replacement paragraphs must begin with the number of the deleted paragraph with following paragraphs beginning with the number of the deleted paragraph followed by a single decimal and sequential integers (e.g., paragraph 0071 is replaced by 0071, 0071.1, and 0071.2). Any paragraph(s) added between existing paragraphs must have the same number as the paragraph immediately above the added one, followed by a period and a new sequential number series (e.g., 0071.1, 0071.2). When numbered paragraphs are added or deleted by amendment, the numbering of any unaffected paragraphs must remain unchanged. Subsequent amendments which may involve further replacement paragraphs are added in the same manner using existing paragraph numbers along with increasing numbers following a decimal. For clarity, a total renumbering of all previously added

paragraphs or the submission of a substitute specification with totally renumbered paragraphs may be required.

(ii) *Amendment by replacement section.* If the sections of the specification contain section headings as provided in § 1.77(b), § 1.154(b), or § 1.163(c), amendments to the specification, other than the claims, may be made by referring to the section heading along with an instruction to delete that section of the specification and to replace such deleted section with a replacement section. The replacement section must be in clean form and must not include any markings to indicate the changes that have been made. The amendment must be accompanied by a copy of the replacement section, on one or more pages separate from the amendment, marked-up to show all changes made by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system.

(iii) *Amendment by substitute specification.* The specification, other than the claims, may also be amended by submission of a substitute specification in compliance with § 1.125. If the paragraphs of the specification are not numbered as provided in § 1.52(b)(6), and the sections of the specification do not contain section headings as provided in § 1.77(b), § 1.154(b), or § 1.163(c), the specification, other than the claims, may be amended only by submission of a substitute specification in compliance with § 1.125. The paragraphs of the substitute specification, other than the claims, should be individually numbered in Arabic numerals so that any further amendment to the specification may be made by replacement paragraph(s) in accordance with paragraph (a)(1)(i) of this section. The amendment must be accompanied by a copy of the substitute specification marked-up to show all changes made by brackets (for deleted matter), or underlining (for added matter), or by any equivalent marking system.

(iv) Matter deleted by amendment pursuant to paragraph (a)(1) of this section can be reinstated only by a subsequent amendment presenting the previously deleted matter.

(2) *Claims.* Amendments to a claim must be made by rewriting such claim with all changes (e.g., additions, deletions, modifications) included therein, or by directions to cancel or delete such claim. The rewriting of a claim (with the same or a new number) will be construed as directing the deletion of the previous version of that claim. A rewritten or newly added claim

must be in clean form without markings as to the changes from the previous version of the claim or a canceled claim. If a claim is amended by rewriting such claim with the same number, the amendment must be accompanied by a copy of the rewritten claim, on one or more pages separate from the amendment, marked-up to show all the changes made by brackets (for deleted matter) or underlining (for added matter) or by any equivalent marking system, relative to the previous version of that claim. A claim canceled by amendment (deleted in its entirety) can be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

(3) *Drawings.* Application drawings are amended in the following manner: Any change to the patent drawings must be submitted as a sketch on a separate paper showing the proposed changes in red for approval by the examiner. Upon approval by the examiner, new drawings in compliance with § 1.84 including the changes must be filed.

(4) *Disclosure consistency.* The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(5) *No new matter.* No amendment may introduce new matter into the disclosure of an application.

(b) *Amendments in reissue applications.* Any amendment to the description and claims of a reissue application must be made in accordance with § 1.173.

45. Section 1.125 is proposed to be amended by revising paragraphs (b)(2) and (c) to read as follows:

§ 1.125 Substitute specification.

* * * * *

(b) * * *

(2) A marked-up copy of the substitute specification showing all the changes to (including the matter being added to and the matter being deleted from) the specification of record. Numbering the paragraphs of the specification of record is not considered a change that must be shown pursuant to this paragraph.

(c) A substitute specification submitted under this section must be submitted in clean form without markings as to amended material. The paragraphs of any substitute specification, other than the claims, should be individually numbered in Arabic numerals so that any amendment to the specification may be made by

replacement paragraph in accordance with § 1.121(a)(1)(i).

* * * * *

46. Section 1.131 is proposed to be amended by revising its heading and paragraph (a) to read as follows:

§ 1.131 Affidavit or declaration of prior invention.

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent is the date that such U.S. patent is effective as a reference under 35 U.S.C. 102(e). Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. Prior invention may not be established under this section before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a WTO member country other than a NAFTA country. Prior invention may not be established under this section if either:

- (1) The rejection is based upon a U.S. patent to another or others which claims the same patentable invention as defined in § 1.601(n); or
- (2) The rejection is based upon a statutory bar.

* * * * *

47. Section 1.132 is proposed to be revised to read as follows:

§ 1.132 Affidavits or declarations traversing rejections or objections.

When any claim of an application or a patent under reexamination is rejected or objected to, the inventor of the subject matter of the rejected claim, an oath or declaration may be submitted to traverse the rejection or objection. An oath or declaration may not be submitted under this section to traverse a rejection if the rejection is based upon a U.S. patent to another or others which claims the same patentable invention as defined in § 1.601(n).

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

§ 1.133 Interviews.

(a) Interviews with examiners concerning applications and other matters pending before the Office must be conducted on Office premises and within office hours, as the respective

examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Commissioner. Interviews for the discussion of the patentability of pending applications will not occur before the first Office action. The examiner may require that an interview be scheduled in advance.

* * * * *

49. Section 1.136 is proposed to be amended by adding paragraph (c) to read as follows:

§ 1.136 Extensions of time.

* * * * *

(c) If an applicant is notified in a "Notice of Allowability" that an application is otherwise in condition for allowance, the following time periods are not extendable if set in the "Notice of Allowability" or in an Office action having a mail date on or after the mail date of the "Notice of Allowability":

(1) The period for submitting an oath or declaration in compliance with § 1.63;

(2) The period for submitting formal drawings set under § 1.85(c); and

(3) The period for making a deposit set under § 1.809(c).

50. Section 1.137 is proposed to be amended by revising paragraph (c) to read as follows:

§ 1.137 Revival of abandoned application or lapsed patent.

* * * * *

(c)(1) Any petition to revive pursuant to this section in a design application must be accompanied by a terminal disclaimer and fee as set forth in § 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. Any petition to revive pursuant to this section in either a utility or plant application filed before June 8, 1995, must be accompanied by a terminal disclaimer and fee as set forth in § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the lesser of:

(i) The period of abandonment of the application; or

(ii) The period extending beyond twenty years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application(s) under 35 U.S.C. 120, 121, or 365(c), from the date on which the earliest such application was filed.

(2) Any terminal disclaimer pursuant to paragraph (c)(1) of this section must also apply to any patent granted on a continuing utility or plant application

filed after June 8, 1995, or a continuing design application, that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to the application for which revival is sought.

(3) The provisions of paragraph (c)(1) of this section do not apply to applications for which revival is sought solely for purposes of copendency with a utility or plant application filed on or after June 8, 1995, or to lapsed patents.

* * * * *

51. Section 1.138 is proposed to be revised to read as follows:

§ 1.138 Express abandonment.

(a) An application may be expressly abandoned by filing in the Patent and Trademark Office a written declaration of abandonment identifying the application. Express abandonment of the application may not be recognized by the Office unless it is actually received by appropriate officials in time to act thereon before the date of issue.

(b) A written declaration of abandonment must be signed by a party authorized under § 1.33(b)(1), (b)(3) or (b)(4) to sign a paper in the application, except as otherwise provided in this paragraph. A registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a) when filing a continuing application may expressly abandon the prior application as of the filing date granted to the continuing application.

52. 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 design. Appropriate and adequate surface shading 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. Photographs and ink drawings are not permitted to be combined as formal drawings in one application. Photographs submitted in lieu of ink drawings in design patent applications must not disclose environmental

structure but must be limited to the design for the article claimed.

53. Section 1.154 is proposed to be revised to read as follows:

§ 1.154 Arrangement of application elements.

(a) The elements of the design application, if applicable, should appear in the following order:

(1) Design application transmittal form.

(2) Fee transmittal form.

(3) Application data sheet (see § 1.76).

(4) Specification.

(5) Drawings or photographs.

(6) Executed oath or declaration (see § 1.153(b)).

(b) The specification should include the following sections in order:

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

(2) Cross-reference to related applications (unless included in the application data sheet).

(3) Statement regarding federally sponsored research or development.

(4) Description of the figure or figures of the drawing.

(5) Feature description.

(6) A single claim.

(c) The text of the specification sections defined in paragraph (b) of this section, if applicable, should be preceded by a section heading in uppercase and without underlining or bold type.

54. Section 1.155 is proposed to be revised to read as follows:

§ 1.155 Expedited examination of design patents.

(a) The applicant may request that the Office expedite the examination of a design application. To qualify for expedited examination:

(1) The application must include drawings in compliance with § 1.84;

(2) The applicant must have conducted a preexamination search; and

(3) The applicant must file a request for expedited examination including:

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

(ii) A statement that a preexamination search was conducted. The statement must also indicate the field of search and include an information disclosure statement in compliance with § 1.98.

(b) The Office will not examine an application that is not in condition for examination (e.g., missing basic filing fee) even if the applicant files a request for expedited examination under this section.

55. Section 1.163 is proposed to be revised to read as follows:

§ 1.163 Specification and arrangement of application elements.

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. For a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

(b) The elements of the plant application, if applicable, should appear in the following order:

- (1) Plant application transmittal form.
- (2) Fee transmittal form.
- (3) Application data sheet (see § 1.76).
- (4) Specification.
- (5) Drawings (in duplicate).
- (6) Executed oath or declaration

(§ 1.162).

(c) The specification should include the following sections in order:

- (1) Title of the invention, which may include an introductory portion stating the name, citizenship, and residence of the applicant.
- (2) Cross-reference to related applications (unless included in the application data sheet).
- (3) Statement regarding federally sponsored research or development.
- (4) Latin name of the genus and species of the plant claimed.
- (5) Variety denomination.
- (6) Background of the invention.
- (7) Brief summary of the invention.
- (8) Brief description of the drawing.
- (9) Detailed botanical description.
- (10) A single claim.
- (11) Abstract of the disclosure.

(d) The text of the specification or sections defined in paragraph (c) of this section, if applicable, should be preceded by a section heading in upper case, without underlining or bold type.

56. Section 1.173 is proposed to be revised to read as follows:

§ 1.173 Reissue specification, drawings, and amendments.

(a) *Contents of a reissue application.* An application for reissue must contain the entire specification, including the claims, and the drawings of the patent. No new matter shall be introduced into the application.

(1) *Specification, including claims.* The entire specification, including the claims, of the patent for which reissue is requested must be furnished in the form of a copy of the printed patent, but with only a single column of the printed patent securely mounted, or otherwise reproduced in permanent form, on a

single page. If an amendment of the reissue application is to be included, it must be made pursuant to paragraph (b) of this section.

(2) *Drawings.* Applicant must submit a clean copy of each drawing sheet of the printed patent at the time the reissue application is filed. If such copy complies with § 1.84, no further drawings will be required. Where a drawing of the reissue application is to include any changes relative to the patent being reissued, the changes to the drawing must be made in accordance with paragraph (b)(3) of this section. The Office will not transfer the drawings from the patent file to the reissue application.

(b) *Making amendments in a reissue application.* An amendment in a reissue application is made either upon filing, by incorporating the changes physically within the specification, including the claims, using markings pursuant to paragraph (d) of this section, or by filing an amendment paper as a preliminary amendment or during prosecution directing that specified changes be made to the application specification, including the claims, or to the drawings.

(1) *Specification other than the claims.* Changes to the specification, other than to the claims, must be made by submission of the entire text of an added or rewritten paragraph, including markings pursuant to paragraph (d) of this section, except that an entire paragraph may be deleted by a statement deleting the paragraph without presentation of the text of the paragraph. The precise point in the specification must be identified where any added or rewritten paragraph is located.

(2) *Claims.* An amendment paper must include the entire text of each claim being changed by such amendment paper and of each claim being added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," *etc.*, should follow the claim number. Each changed patent claim and each added claim must include markings pursuant to paragraph (d) of this section, except that a patent claim or added claim should be canceled by a statement canceling the claim without presentation of the text of the claim.

(3) *Drawings.* Any change to the patent drawings must be submitted as a sketch on a separate paper showing the proposed changes in red for approval by the examiner. Upon approval by the examiner, new drawings in compliance with § 1.84 including the approved changes must be filed. Amended figures must be identified as "Amended," and

any added figure must be identified as "New." In the event that a figure is canceled, the figure must be surrounded by brackets and identified as "Canceled."

(c) *Status of claims and support for claim changes.* Whenever there is an amendment to the claims pursuant to paragraph (b) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (*i.e.*, pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper.

(d) *Changes shown by markings.* Any changes relative to the patent being reissued which are made to the specification, including the claims, upon filing, or by an amendment paper in the reissue application, must include the following markings:

(1) The matter to be omitted by reissue must be enclosed in brackets; and

(2) The matter to be added by reissue must be underlined.

(e) *Numbering of patent claims preserved.* Patent claims may not be renumbered. The numbering of any claims added in the reissue application must follow the number of the highest numbered patent claim.

(f) *Amendment of disclosure may be required.* The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(g) *Amendments made relative to patent.* All amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing of the reissue application.

§ 1.174 [Removed and Reserved]

57. Section 1.174 is proposed to be removed and reserved.

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

§ 1.176 Examination of reissue.

(a) A reissue application will be examined in the same manner as a non-reissue nonprovisional application, and will be subject to all the requirements of the rules related to non-reissue applications. Restriction between subject matter of the original patent claims and previously unclaimed subject matter may be required.

(b) The examiner will act on applications for reissue in advance of

other nonprovisional applications. An application for reissue, other than a continued prosecution application under § 1.53(d), will not be acted on sooner than two months after the announcement of the filing of the reissue application in the *Official Gazette*.

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

§ 1.177 Issuance of multiple reissue patents.

(a) The Office may reissue a patent as multiple reissue patents. If applicant files more than one application for the reissue of a single patent, each such application must contain or be amended to contain in the first sentence of the specification a notice stating that more than one reissue application has been filed and identifying each of the reissue applications by relationship, application number and filing date. The Office may correct any reissue patent resulting from an application to which this paragraph applies and not containing the required notice by certificate of correction under § 1.322.

(b) If applicant files more than one application for the reissue of a single patent, each claim of the patent being reissued must be presented in each of the reissue applications as an amended, unamended, or canceled (shown in brackets) claim, with each such claim bearing the same number as in the patent being reissued. The same claim of the patent being reissued may not be presented in its original unamended form for examination in more than one of such multiple reissue applications. The numbering of any added claims in any of the multiple reissue applications must follow the number of the highest numbered original patent claim.

(c) If any one of the several reissue applications by itself fails to correct an error in the original patent as required by 35 U.S.C. 251, but is otherwise in condition for allowance, the Office may suspend action in the allowable application until all issues are resolved as to at least one of the remaining reissue applications. The Office may also merge two or more of the multiple reissue applications into a single reissue application. No reissue application containing only unamended patent claims and not correcting an error in the original patent will be passed to issue by itself.

60. Section 1.178 is proposed to be revised to read as follows:

§ 1.178 Original patent.

The application for a reissue should be accompanied by an offer to surrender the original patent. The application

should also be accompanied by the original patent, or if the original is lost or inaccessible, by a statement to that effect. The application may be accepted for examination in the absence of the original patent or the statement, but one or the other must be supplied before the application is allowed. If a reissue is refused, the original patent will be returned to applicant upon request.

61. Section 1.193 is proposed to be amended by revising paragraph (b)(1) to read as follows:

§ 1.193 Examiner's answer and reply brief.

* * * * *

(b)(1) Appellant may file a reply brief to an examiner's answer or a supplemental examiner's answer within two months from the date of such examiner's answer or supplemental examiner's answer. See § 1.136(b) for extensions of time for filing a reply brief in a patent application and § 1.550(c) for extensions of time for filing a reply brief in a reexamination proceeding. The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. A supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose.

* * * * *

62. Section 1.303 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.303 Civil action under 35 U.S.C. 145, 146, 306.

(a) Any applicant or any owner of a patent involved in a reexamination proceeding dissatisfied with the decision of the Board of Patent Appeals and Interferences, and any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences may, instead of appealing to the U.S. Court of Appeals for the Federal Circuit (§ 1.301), have remedy by civil action under 35 U.S.C. 145 or 146, as appropriate. Such civil action must be commenced within the time specified in § 1.304.

* * * * *

63. Section 1.311 is proposed to be amended by revising paragraph (b) to read as follows:

§ 1.311 Notice of allowance.

* * * * *

(b) An authorization to charge the issue fee (§ 1.18) to a deposit account may be filed in an individual application only after mailing of the notice of allowance.

64. Section 1.312 is proposed to be revised to read as follows:

§ 1.312 Amendments after allowance.

(a) No amendment may be made as a matter of right in an application after the mailing of the notice of allowance. Any amendment pursuant to this paragraph filed before the payment of the issue fee may be entered on the recommendation of the primary examiner, approved by the Commissioner, without withdrawing the application from issue.

(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 under § 1.313(c)(1) to withdraw the application from issue, an unequivocal statement that one or more claims are unpatentable, and an explanation as to how the amendment is necessary to render such claim or claims patentable.

65. Section 1.313 is proposed to be revised to read as follows:

§ 1.313 Withdrawal from issue.

(a) Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant. To request that the Office withdraw an application from issue, the applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application is necessary. If the Office withdraws the application from issue, the Office will issue a new notice of allowance if the Office again allows the application.

(b) Once the issue fee has been paid, the Office will not withdraw the application from issue at its own initiative for any reason except:

- (1) A mistake on the part of the Office;
- (2) A violation of § 1.56 or illegality in the application;
- (3) Unpatentability of one or more claims; or
- (4) For interference.

(c) Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:

- (1) Unpatentability of one of more claims, which petition must be accompanied by a statement of such unpatentability and an amendment in compliance with § 1.312(b); or
- (2) Express abandonment of the application. Such express abandonment may be in favor of a continuing application.

(d) A petition under this section will not be effective to withdraw the application from issue unless it is actually received and granted by the

appropriate officials before the date of issue. Withdrawal of an application from issue after payment of the issue fee may not be effective to avoid publication of application information.

66. Section 1.314 is proposed to be revised to read as follows:

§ 1.314 Issuance of patent.

If applicant timely pays the issue fee, the Office will issue the patent in regular course unless the application is withdrawn from issue (§ 1.313), or the Office defers issuance of the patent. To request that the Office defer issuance of a patent, applicant must file petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why it is necessary to defer issuance of the patent.

67. Section 1.322 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.322 Certificate of correction of Office mistake.

(a) The Office may issue a certificate of correction under the conditions specified in 35 U.S.C. 254 at the request of the patentee or the patentee's assignee or on its own initiative. If the request relates to a patent involved in an interference, the request must comply with the requirements of this section and be accompanied by a motion under § 1.635. The Office will not issue such a certificate on its own initiative without first notifying the patentee (including any assignee of record) at the correspondence address of record as specified in § 1.33(a) and affording the patentee an opportunity to be heard.

68. Section 1.323 is proposed to be revised to read as follows:

§ 1.323 Certificate of correction of applicant's mistake.

The Office may issue a certificate of correction under the conditions specified in 35 U.S.C. 255 at the request of the patentee or the patentee's assignee, upon payment of the fee set forth in § 1.20(a). If the request relates to a patent involved in an interference, the request must comply with the requirements of this section and be accompanied by a motion under § 1.635.

69. Section 1.324 is proposed to be amended by revising its heading and paragraph (b)(1) and adding paragraph (c) to read as follows:

§ 1.324 Correction of inventorship in patent, pursuant to 35 U.S.C. 256.

(b) * * *

(1) Where one or more persons are being added, a statement from each

person who is being added as an inventor that the inventorship error occurred without any deceptive intention on his or her part;

(c) For correction of inventorship in an application see §§ 1.48 and 1.497, and in an interference see § 1.634.

70. Section 1.366 is proposed to be amended by revising paragraph (c) to read as follows:

§ 1.366 Submission of maintenance fees.

(c) In submitting maintenance fees and any necessary surcharges, identification of the patents for which maintenance fees are being paid must include the patent number, and the application number of the United States application for the patent on which the maintenance fee is being paid. If the payment includes identification of only the patent number (*i.e.*, does not identify the application number of the United States application for the patent on which the maintenance fee is being paid), the Office may apply the payment to the patent identified by patent number in the payment or may return the payment.

71. Section 1.446 is proposed to be amended by revising paragraphs (a) and (b) to read as follows:

§ 1.446 Refund of international application filing and processing fees.

(a) Money paid for international application fees, where paid by actual mistake or in excess, such as a payment not required by law or Treaty and its Regulations, may be refunded. A mere change of purpose after the payment of a fee will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify the payor of such amounts. If the payor or party requesting a refund does not provide the banking information necessary for making refunds by electronic funds transfer, the Office may use the banking information provided on the payment instrument to make any refund by electronic funds transfer.

(b) Any request for refund under paragraph (a) must be filed within two years from the date the fee was paid. If the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization under § 1.25(b), any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge, and include a copy of that deposit account

statement. The time periods set forth in this paragraph are not extendable.

* * * * *

72. Section 1.497 is proposed to be amended by revising paragraph (b)(2) and adding paragraph (d) to read as follows:

§ 1.497 Oath or declaration under 35 U.S.C. 371(c)(4).

* * * * *

(b) * * *

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

* * * * *

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international stage, the oath or declaration must be accompanied by:

(1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international stage occurred without deceptive intention on his or her part;

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

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

73. Section 1.510 is proposed to be amended by revising paragraph (b)(4) to read as follows:

§ 1.510 Request for reexamination.

* * * * *

(b) * * *

(4) The entire specification, including the claims, of the patent for which reexamination is requested, in the form of a copy of the printed patent, but with only a single column of the printed patent securely mounted, or otherwise reproduced in permanent form, on a single sheet. A clean copy of each drawing sheet of the printed patent must also be furnished. Additionally, a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent must be included.

* * * * *

74. Section 1.530 is proposed to be amended by revising its heading and paragraph (d), and adding paragraphs (e) through (l) to read as follows:

§ 1.530 Statement; amendment by patent owner; inventorship change.

* * * * *

(d) *Making amendments in a reexamination proceeding.* A proposed amendment in a reexamination proceeding is made by filing a paper directing that proposed specified changes be made to the patent specification, including the claims, or to the drawings. An amendment paper directing that proposed specified changes be made in a reexamination proceeding may be submitted as an accompaniment to a request filed by the patent owner in accordance with § 1.510(e), as part of a patent owner statement in accordance with paragraph (b) of this section, or, where permitted, during the conduct of the reexamination proceeding pursuant to § 1.550(a).

(1) *Specification other than the claims.* Changes to the specification, other than to the claims, must be made by submission of the entire text of an added or rewritten paragraph including markings pursuant to paragraph (f) of this section, except that an entire paragraph may be deleted by a statement deleting the paragraph, without presentation of the text of the paragraph. The precise point in the specification must be identified where any added or rewritten paragraph is located.

(2) *Claims.* An amendment paper must include the entire text of each patent claim which is being proposed to be changed by such amendment paper and of each new claim being proposed to be added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," etc., should follow the claim number. Each patent claim proposed to be changed and each proposed added claim must include markings pursuant to paragraph (f) of this section, except that a patent claim or proposed added claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

(3) *Drawings.* Any change to the patent drawings must be submitted as a sketch on a separate paper showing the proposed changes in red for approval by the examiner. Upon approval of the changes by the examiner, only new sheets of drawings including the changes and in compliance with § 1.84 must be filed. Amended figures must be identified as "Amended," and any added figure must be identified as

"New." In the event a figure is canceled, the figure must be surrounded by brackets and identified as "Canceled."

(e) *Status of claims and support for claim changes.* Whenever there is an amendment to the claims pursuant to paragraph (d) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (*i.e.*, pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper.

(f) *Changes shown by markings.* Any changes relative to the patent being reexamined which are made to the specification, including the claims, must include the following markings:

(1) The matter to be omitted by the reexamination proceeding must be enclosed in brackets; and

(2) The matter to be added by the reexamination proceeding must be underlined.

(g) *Numbering of patent claims preserved.* Patent claims may not be renumbered. The numbering of any claims added in the reexamination proceeding must follow the number of the highest numbered patent claim.

(h) *Amendment of disclosure may be required.* The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(i) *Amendments made relative to patent.* All amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination.

(j) *No enlargement of claim scope.* 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, other than the cancellation of claims, will be incorporated into the patent by a certificate issued after the expiration of the patent.

(k) *Amendments not effective until certificate.* Although the Office actions will treat proposed amendments as though they have been entered, the proposed amendments will not be effective until the reexamination certificate is issued.

(l) *Correction of inventorship in reexamination proceedings.* (1) When it appears that the correct inventor or inventors were not named in a patent being reexamined 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, include in the reexamination certificate to be issued under § 1.570 an amendment naming only the actual inventor or inventors. The petition must be submitted as part of the reexamination proceeding, and must satisfy the requirements of § 1.324.

(2) Notwithstanding paragraph (l)(1) of this section, if a petition to correct inventorship satisfying the requirements of § 1.324 is filed in a reexamination proceeding, and the reexamination proceeding is terminated other than in a reexamination certificate under § 1.570, a certificate of correction indicating the change of inventorship stated in the petition will be issued upon request by the patentee.

75. Section 1.550 is proposed to be amended by revising paragraphs (a) through (c) 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 responses thereto, the examination will be conducted in accordance with §§ 1.104, 1.105, 1.110–1.113, 1.115, and 1.116 and will result in the issuance of a reexamination certificate under § 1.570.

(b) The patent owner will be given at least thirty days to respond to any Office action. Such response may include further statements in 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.

(c)(1) On or before the day on which an action by the patent owner is due in a reexamination proceeding, the time for taking action by a patent owner will be extended only for sufficient cause, and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

(2) After the day on which an action by the patent owner is due in a

reexamination proceeding, the time for taking action by a patent owner will be extended only upon the granting of a petition for extension of time to accept late papers on the grounds that submission of the papers was unintentionally delayed. A petition must be:

(i) Accompanied by papers effecting the action by the patent owner required to continue prosecution of the reexamination proceeding;

(ii) Accompanied by the petition fee as set forth in § 1.17(h);

(iii) Accompanied by a statement that the delay was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(iv) Filed as a complete petition within the full statutory time period for submission of the papers that were unintentionally delayed.

* * * * *

76. Section 1.666 is proposed to be amended by revising paragraph (b) to read as follows:

§ 1.666 Filing of interference settlement agreements.

* * * * *

(b) If any party filing the agreement or understanding under paragraph (a) of this section so requests, the copy will be kept separate from the file of the interference, and made available only to Government agencies on written request, or to any person upon petition accompanied by the fee set forth in § 1.17(h) and on a showing of good cause.

* * * * *

77. Section 1.720 is proposed to be amended by revising paragraphs (b) and (g) to read as follows:

§ 1.720 Conditions for extension of patent term.

* * * * *

(b) The term of the patent has never been previously extended, except for extensions issued pursuant to § 1.701, § 1.760, or § 1.790;

* * * * *

(g) The term of the patent, including any interim extension issued pursuant to § 1.790, has not expired before the submission of an application in compliance with § 1.741; and

* * * * *

78. Section 1.730 is proposed to be revised to read as follows:

§ 1.730 Applicant for extension of patent term; signature requirements.

(a) Any application for extension of a patent term must be submitted by the owner of record of the patent or its agent

and must comply with the requirements of § 1.740.

(b) If the application is submitted by the patent owner, the application must be signed either by:

(1) The patent owner in compliance with § 3.73(b) of this chapter; or

(2) A registered practitioner on behalf of the patent owner.

(c) If the application is submitted on behalf of the patent owner by an agent of the patent owner (e.g., a licensee of the patent owner), the application must be signed by a registered practitioner on behalf of the agent. The Office may require proof that the agent is authorized to act on behalf of the patent owner.

(d) If the application is signed by a registered practitioner, the Office may require proof that the practitioner is authorized to act on behalf of the patent owner or agent of the patent owner.

79. Section 1.740 is proposed to be amended by revising its heading, the introductory text of paragraph (a), and paragraphs (a)(9), (a)(10), (a)(14), (a)(15), (b) and (c) to read as follows:

§ 1.740 Formal requirements for application for extension of patent term; correction of informalities.

(a) An application for extension of patent term must be made in writing to the Commissioner. A formal application for the extension of patent term must include:

* * * * *

(9) A statement that the patent claims the approved product or a method of using or manufacturing the approved product, and a showing which lists each applicable patent claim and demonstrates the manner in which at least one such patent claim reads on:

(i) The approved product, if the listed claims include any claim to the approved product;

(ii) The method of using the approved product, if the listed claims include any claim to the method of using the approved product; and

(iii) The method of manufacturing the approved product, if the listed claims include any claim to the method of manufacturing the approved product;

(10) A statement beginning on a new page, of the relevant dates and information pursuant to 35 U.S.C. 156(g) in order to enable the Secretary of Health and Human Services or the Secretary of Agriculture, as appropriate, to determine the applicable regulatory review period as follows:

(i) For a patent claiming a human drug, antibiotic, or human biological product:

(A) The effective date of the investigational new drug (IND) application and the IND number;

(B) The date on which a new drug application (NDA) or a Product License Application (PLA) was initially submitted and the NDA or PLA number; and

(C) The date on which the NDA was approved or the Product License issued; (ii) For a patent claiming a new animal drug:

(A) The date a major health or environmental effects test on the drug was initiated, and any available substantiation of that date, or the date of an exemption under subsection (j) of section 512 of the Federal Food, Drug, and Cosmetic Act became effective for such animal drug;

(B) The date on which a new animal drug application (NADA) was initially submitted and the NADA number; and

(C) The date on which the NADA was approved;

(iii) For a patent claiming a veterinary biological product:

(A) The date the authority to prepare an experimental biological product under the Virus-Serum-Toxin Act became effective;

(B) The date an application for a license was submitted under the Virus-Serum-Toxin Act; and

(C) The date the license issued;

(iv) For a patent claiming a food or color additive:

(A) The date a major health or environmental effects test on the additive was initiated and any available substantiation of that date;

(B) The date on which a petition for product approval under the Federal Food, Drug and Cosmetic Act was initially submitted and the petition number; and

(C) The date on which the FDA published a **Federal Register** notice listing the additive for use;

(v) For a patent claiming a medical device:

(A) The effective date of the investigational device exemption (IDE) and the IDE number, if applicable, or the date on which the applicant began the first clinical investigation involving the device if no IDE was submitted and any available substantiation of that date;

(B) The date on which the application for product approval or notice of completion of a product development protocol under section 515 of the Federal Food, Drug and Cosmetic Act was initially submitted and the number of the application; and

(C) The date on which the application was approved or the protocol declared to be completed;

* * * * *

(14) The prescribed fee for receiving and acting upon the application for extension (see § 1.20(j)); and

(15) The name, address, and telephone number of the person to whom inquiries and correspondence relating to the application for patent term extension are to be directed.

(b) The application under this section must be accompanied by two additional copies of such application.

(c) If an application for extension of patent term is informal under this section, the Office will so notify the applicant. The applicant has two months from the mail date of the notice, or such time as is set in the notice, within which to correct the informality. Unless the notice indicates otherwise, this time period may be extended under the provisions of § 1.136.

80. Section 1.741 is proposed to be amended by revising its heading, the introductory text of paragraph (a) and paragraphs (a)(5) and (b) to read as follows:

§ 1.741 Complete application given a filing date; petition procedure.

(a) The filing date of an application for extension of a patent term is the date on which a complete application is received in the Office or filed pursuant to the procedures set forth in § 1.8 or § 1.10. A complete application must include:

* * * * *

(5) Sufficient information to enable the Commissioner to determine under subsections (a) and (b) of 35 U.S.C. 156 the eligibility of a patent for extension and the rights that will be derived from the extension and information to enable the Commissioner and the Secretary of Health and Human Services or the Secretary of Agriculture to determine the length of the regulatory review period; and

* * * * *

(b) If an application for extension of patent term is incomplete under this section, the Office will so notify the applicant. If applicant requests review of a notice that an application is incomplete, or review of the filing date accorded an application under this section, applicant must file a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(h) within two months of the mail date of the notice that the application is incomplete, or the notice according the filing date complained of. Unless the notice indicates otherwise, this time period may be extended under the provisions of § 1.136.

81. Section 1.780 is proposed to be revised to read as follows:

§ 1.780 Certificate or order of extension of patent term.

If a determination is made pursuant to § 1.750 that a patent is eligible for extension and that the term of the patent is to be extended, a certificate of extension, under seal, or an order granting interim extension under 35 U.S.C. 156(d)(5), will be issued to the applicant for the extension of the patent term. Such certificate or order will be recorded in the official file of the patent and will be considered as part of the original patent. Notification of the issuance of the certificate or order of extension will be published in the *Official Gazette* of the Patent and Trademark Office. Notification of the issuance of the order granting an interim extension under 35 U.S.C. 156(d)(5), including the identity of the product currently under regulatory review, will be published in the *Official Gazette* of the Patent and Trademark Office and in the **Federal Register**. No certificate of, or order granting, an extension will be issued if the term of the patent cannot be extended, even though the patent is otherwise determined to be eligible for extension. In such situations, the final determination made pursuant to § 1.750 will indicate that no certificate or order will issue.

82. Section 1.809 is proposed to be amended by revising paragraphs (b) introductory text, (b)(1) and (c) to read as follows:

§ 1.809 Examination procedures.

* * * * *

(b) The applicant for patent or patent owner shall reply to a rejection under paragraph (a) of this section by—

(1) In the case of an applicant for patent, making an acceptable original or replacement or supplemental deposit or assuring the Office in writing that an acceptable deposit will be made, or, in the case of a patent owner, requesting a certificate of correction of the patent which meets the terms of paragraphs (b) and (c) of § 1.805, or

* * * * *

(c) If an application for patent is otherwise in condition for allowance except for a needed deposit and the Office has received a written assurance that an acceptable deposit will be made, applicant will be notified and given a period of time within which the deposit must be made in order to avoid abandonment. This time period is not extendable under § 1.136(a) or (b) (see § 1.136(c)).

* * * * *

83. Section 1.821 is proposed to be amended by revising paragraphs (c), (e) and (f) to read as follows:

§ 1.821 Nucleotide and/or amino acid sequence disclosures in patent applications.

* * * * *

(c) Patent applications which contain disclosures of nucleotide and/or amino acid sequences must contain such nucleotide and/or amino acid sequences disclosure and associated information as a separate part of the disclosure using the symbols and format in accordance with the requirements of §§ 1.822 and 1.823. This disclosure is hereinafter referred to as the "Sequence Listing." Each sequence disclosed must appear separately in the "Sequence Listing." Each sequence set forth in the "Sequence Listing" shall be assigned a separate sequence identifier. The sequence identifiers shall begin with 1 and increase sequentially by integers. If no sequence is present for a sequence identifier, the code "000" shall be used in place of the sequence. The response for the numeric identifier <160> (see § 1.823(b)) shall include the total number of SEQ ID NOs, whether followed by a sequence or by the code "000." The "Sequence Listing" must be submitted either on:

(1) Paper in compliance with § 1.823; or

(2) A Compact Disk-Read Only Memory (CD-ROM) or Compact Disk-Recordable (CD-R) in compliance with § 1.823. Applicant may submit a second copy of such a CD-ROM or CD-R "Sequence Listing" to satisfy the requirement for a "Sequence Listing" in a computer readable format pursuant to paragraph (e) of this section, provided that the CD-ROM or CD-R "Sequence Listing" meets the requirements of § 1.824(b) and (c)(4).

* * * * *

(e) In addition to the submission of the "Sequence Listing" referred to in paragraph (c) of this section, a copy of this "Sequence Listing" must also be submitted in computer readable form in accordance with the requirements of § 1.824. The computer readable form submitted pursuant to this paragraph must be a copy of the "Sequence Listing" submitted pursuant to paragraph (c) of this section and will not necessarily be retained as a part of the patent application file. If the computer readable form of a new application is to be identical with the computer readable form of another application of the applicant on file in the Patent and Trademark Office, reference may be made to the other application and computer readable form in lieu of filing a duplicate computer readable form in the new application if the computer readable form in the other application was compliant with all of the

requirements of this subpart. The new application shall be accompanied by a letter making such reference to the other application and computer readable form, both of which shall be completely identified. In the new application, applicant must also request the use of the compliant computer readable form (CRF) "Sequence Listing" that is already on file for the other application and must state that the paper or CD-ROM or CD-R copy of the "Sequence Listing" in the new application is identical to the computer readable (CRF) copy filed for the other application.

(f) In addition to the paper or CD-ROM or CD-R copy required by paragraph (c) of this section and the computer readable form required by paragraph (e) of this section, a statement that the content of the paper, CD-ROM, or CD-R submission under paragraph (c) of this section and the computer readable (CRF) copy under paragraph (e) of this section are the same must be submitted with the computer readable form (e.g., a statement that "the information recorded in computer readable form is identical to the paper (or CD-ROM or CD-R) copy of the sequence listing submitted under § 1.821(c)" submitted under § 1.821(c)).

84. Section 1.823 is proposed to be amended by revising its heading and paragraph (a) to read as follows:

§ 1.823 Requirements for nucleotide and/or amino acid sequences as part of the application.

(a)(1) If the "Sequence Listing" required by § 1.821(c) is submitted on paper: The "Sequence Listing," setting forth the nucleotide and/or amino acid sequence and associated information in accordance with paragraph (b) of this section, must begin on a new page and must be titled "Sequence Listing." The "Sequence Listing" preferably should be numbered independently of the numbering of the remainder of the application. Each page of the "Sequence Listing" should contain no more than 66 lines and each line should contain no more than 72 characters. A fixed-width font should be used exclusively throughout the "Sequence Listing."

(2) If the "Sequence Listing" required by § 1.821(c) is submitted on a CD-ROM or CD-R: The "Sequence Listing" must be submitted as a text file in the American Standard Code for Information Interchange (ASCII) in accordance with the standards for that medium set forth in 36 CFR 1228.188(c) and (d). No other format shall be allowed. The CD-ROM or CD-R "Sequence Listing" must also be accompanied by documentation on

paper that is adequate to identify, maintain, and interpret the electronic "Sequence Listing." A notation that a "Sequence Listing" is submitted on a CD-ROM or CD-R must be placed conspicuously in the specification (see § 1.77(b)(11)). The CD-ROM or CD-R "Sequence Listing" also must be labeled with the following information:

- (i) The name of each inventor (if known);
- (ii) The title of the invention;
- (iii) The sequence identifiers of the "Sequence Listings" on that CD-ROM or CD-R; and
- (iv) The docket number used by the person filing the application to identify the application (if applicable).

* * * * *

84a. Section 1.824 is proposed to be amended by revising paragraph (c)(4) to read as follows:

§ 1.824 Form and format for nucleotide and/or amino acid sequence submissions in computer readable form.

* * * * *

- (c) * * *
- (4) CD-ROM or CD-R: Format ISO 9660 or High Sierra Format.

* * * * *

85. Section 1.825 is proposed to be amended by revising paragraphs (a) and (b) to read as follows:

§ 1.825 Amendments to or replacement of sequence listing and computer readable copy thereof.

(a) Any amendment to the paper copy of the "Sequence Listing" submitted pursuant to § 1.821 must be made by submission of substitute sheets. Any amendment to the CD-ROM or CD-R copy of the "Sequence Listing" submitted pursuant to § 1.821 must be made by submission of a new CD-ROM or CD-R containing a substitute "Sequence Listing." Amendments must be accompanied by a statement that indicates support for the amendment in the application-as-filed, and a statement that the substitute sheets or new CD-ROM or CD-R includes no new matter.

(b) Any amendment to the paper, CD-ROM, or CD-R copy of the "Sequence Listing" pursuant to paragraph (a) of this section must be accompanied by a substitute copy of the computer readable form of the "Sequence Listing" required pursuant to § 1.821(e), including all previously submitted data with the amendment incorporated therein, and accompanied by a statement that the computer readable form copy is the same as the substitute paper or new CD-ROM or CD-R copy of the "Sequence Listing."

* * * * *

PART 3—ASSIGNMENT, RECORDING AND RIGHTS OF ASSIGNEE

86. The authority citation for 37 CFR part 3 continues to read as follows:

Authority: 15 U.S.C. 1123; 35 U.S.C. 6.

87. Section 3.27 is proposed to be revised to read as follows:

§ 3.27 Mailing address for submitting documents to be recorded.

Documents and cover sheets to be recorded should be addressed to the Commissioner of Patents and Trademarks, Box Assignment, Washington, D.C. 20231, unless they are filed together with new applications.

88. Section 3.71 is proposed to be revised to read as follows:

§ 3.71 Prosecution by assignee.

(a) *Patents—Conducting of prosecution.* One or more assignees as defined in paragraph (b) of this section may, after becoming of record pursuant to paragraph (c) of this section, conduct prosecution of a national patent application or a reexamination proceeding to the exclusion of either the inventive entity, or the assignee(s) previously entitled to conduct prosecution.

(b) *Patents—Assignee(s) who can prosecute.* The assignee(s) who may conduct either the prosecution of a national application for patent or a reexamination proceeding are:

(1) *A single assignee.* An assignee of the entire right, title and interest in the application or patent being reexamined who is of record, or

(2) *Partial assignee(s) together or with inventor(s).* All partial assignees, or all partial assignees and inventors who have not assigned their right, title and interest in the application or patent being reexamined, who together own the entire right, title and interest in the application or patent being reexamined. A partial assignee is any assignee of record having less than the entire right, title and interest in the application or patent being reexamined.

(c) *Patents—Becoming of record.* An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b).

(d) *Trademarks.* The assignee of a trademark application or registration may prosecute a trademark application; submit documents to maintain a trademark registration; or file papers against a third party in reliance on the assignee's trademark application or registration, to the exclusion of the original applicant or previous assignee. The assignee must establish ownership in compliance with § 3.73(b).

89. Section 3.73 is proposed to be revised to read as follows:

§ 3.73 Establishing right of assignee to take action.

(a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment.

(b)(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property to the satisfaction of the Commissioner. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment). The documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office; or

(ii) A statement specifying where documentary evidence of a chain of title is recorded in the assignment records of the Office (e.g., reel and frame number).

(2) The submission establishing ownership must show that the party signing the submission is a party authorized to act on behalf of the assignee by:

(i) Including a statement that the party signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, e.g., an officer of the assignee.

(c) For patent matters only:

(1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.

(2) If the submission under this section is by an assignee of less than the entire right, title and interest, such assignee must indicate the extent (by percentage) of its ownership interest or the Office may refuse to accept the submission.

90. Section 3.81 is proposed to be revised to read as follows:

§ 3.81 Issue of patent to assignee.

For a patent application, if an assignment of the entire right, title, and

interest is recorded before the issue fee is paid, the patent may issue in the name of the assignee. If the assignee holds an undivided part interest, the patent may issue jointly to the inventor and the assignee. If the patent is to issue solely or jointly to that assignee, the name of the assignee must be provided at the time the issue fee is paid.

PART 5—SECRECY OF CERTAIN INVENTIONS AND LICENSES TO EXPORT AND FILE APPLICATIONS IN FOREIGN COUNTRIES

91. The authority citation for 37 CFR part 5 would continue to read as follows:

Authority: 35 U.S.C. 6, 41, 181–188, as amended by the Patent Law Foreign Filing Amendments Act of 1988, Pub. L. 100–418, 102 Stat. 1567; the Arms Export Control Act, as amended, 22 U.S.C. 2751 *et seq.*; the Atomic Energy Act of 1954, as amended, 42 U.S.C. 2011 *et seq.*; and the Nuclear Non-Proliferation Act of 1978, 22 U.S.C. 3201 *et seq.*; and the delegations in the regulations under these Acts to the Commissioner (15 CFR 370.10(j), 22 CFR 125.04, and 10 CFR 810.7).

92. Section 5.1 is proposed to be revised to read as follows:

§ 5.1 Applications and correspondence involving national security.

(a) All correspondence in connection with this part, including petitions, should be addressed to “Assistant Commissioner for Patents (Attention Licensing and Review), Washington, D.C. 20231.”

(b) Application as used in this part includes provisional applications filed under 35 U.S.C. 111(b) (§ 1.9(a)(2) of this chapter), nonprovisional applications filed under 35 U.S.C. 111(a) or entering the national stage from an international application after compliance with 35 U.S.C. 371 (§ 1.9(a)(3)), or international applications filed under the Patent Cooperation Treaty prior to entering the national stage of processing (§ 1.9(b)).

(c) Patent applications and documents relating thereto that are national security classified (see § 1.9(i) of this chapter) and contain authorized national security markings (e.g., “Confidential,” “Secret” or “Top Secret”) are accepted by the Office. National security classified documents filed in the Office must be either hand-carried to Licensing and Review or mailed to the Office in compliance with paragraph (a) of this section.

(d) The applicant in a national security classified patent application must obtain a secrecy order pursuant to § 5.2(a). If a national security classified patent application is filed without a

notification pursuant to § 5.2(a), the Office will set a time period within which either the application must be declassified, or the application must be placed under a secrecy order pursuant to § 5.2(a), or the applicant must submit evidence of a good faith effort to obtain a secrecy order pursuant to § 5.2(a) from the relevant department or agency in order to prevent abandonment of the application. If evidence of a good faith effort to obtain a secrecy order pursuant to § 5.2(a) from the relevant department or agency is submitted by the applicant within the time period set by the Office, but the application has not been declassified or placed under a secrecy order pursuant to § 5.2(a), the Office will again set a time period within which either the application must be declassified, or the application must be placed under a secrecy order pursuant to § 5.2(a), or the applicant must submit evidence of a good faith effort to obtain a secrecy order pursuant to § 5.2(a) from the relevant department or agency in order to prevent abandonment of the application.

(e) A national security classified patent application will not be allowed pursuant to § 1.311 of this chapter until the application is declassified and any secrecy order pursuant to § 5.2(a) has been rescinded.

(f) Applications on inventions made outside the United States and on inventions in which a U.S. Government defense agency has a property interest will not be made available to defense agencies.

93. Section 5.2 is proposed to be amended by adding a new paragraph (c) to read as follows:

§ 5.2 Secrecy order.

* * * * *

(c) An application disclosing any significant part of the subject matter of an application under a secrecy order pursuant to paragraph (a) of this section also falls within the scope of such secrecy order. Any such application that is pending before the Office must be promptly brought to the attention of Licensing and Review, unless such application is itself under a secrecy order pursuant to paragraph (a) of this section. Any subsequently filed application containing any significant part of the subject matter of an application under a secrecy order pursuant to paragraph (a) of this section must either be hand-carried to Licensing and Review or mailed to the Office in compliance with § 5.1(a).

94. Section 5.12 is amended by revising paragraph (b) to read as follows:

§ 5.12 Petition for license.

* * * * *

(b) A petition for license must include the fee set forth in § 1.17(h), the petitioner's address, and full instructions for delivery of the requested license when it is to be delivered to other than the petitioner. The petition should be presented in letter form.

PART 10—REPRESENTATION OF OTHERS BEFORE THE PATENT AND TRADEMARK OFFICE

95. The authority citation for 37 CFR part 10 would continue to read as follows:

Authority: 5 U.S.C. 500, 15 U.S.C. 1123; 35 U.S.C. 6, 31, 32, 41.

96. Section 10.23 is proposed to be amended by revising paragraph (c)(11) to read as follows:

§ 10.23 Misconduct.

* * * * *

(c) * * *

(11) Except as permitted by § 1.52(c) of this chapter, knowingly filing or causing to be filed an application containing any material alteration made in the application papers after the signing of the accompanying oath or declaration without identifying the

alteration at the time of filing the application papers.

* * * * *

Dated: September 17, 1999.

Q. Todd Dickinson,

Acting Assistant Secretary of Commerce and Acting Commissioner of Patents and Trademarks.

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