

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

[Docket No.: 2003-P-020]

RIN 0651-AB64

**Changes To Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan****AGENCY:** United States Patent and Trademark Office, Commerce.**ACTION:** Notice of proposed rulemaking.

**SUMMARY:** The United States Patent and Trademark Office (Office) has established a 21st Century Strategic Plan to transform the Office into a quality-focused, highly productive, responsive organization supporting a market-driven intellectual property system. The Office is proposing to revise the rules of practice to support the implementation of the 21st Century Strategic Plan, which involves improving the patent application and examination process by promoting quality enhancement, reducing patent pendency, and using information technology to simplify the patent application process. The more notable changes being proposed in this document involve permitting electronic signatures on a number of submissions, streamlining the requirements for incorporation by reference of prior-filed applications, and clarifying the qualifications for claiming small entity status for purposes of paying reduced patent fees. These changes to the patent application and examination process are necessary for the Office to be able to process the long-term trend of increasing numbers of applications within a reasonable time frame.

**COMMENT DEADLINE DATE:** To be ensured of consideration, written comments must be received on or before November 12, 2003. No public hearing will be held.

**ADDRESSES:** Comments should be sent by electronic mail message over the Internet addressed to [ab64.comments@uspto.gov](mailto:ab64.comments@uspto.gov). Comments may also be submitted by mail addressed to: Mail Stop Comments—Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 or by facsimile to (703) 305-1013, marked to the attention of Hiram Bernstein. Although comments may be submitted by mail or facsimile, the Office prefers to receive comments via the Internet.

The comments will be available for public inspection at the Office of Patent

Legal Administration, 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: <http://www.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, Senior Legal Advisor, by telephone at (703) 305-8713 or Robert J. Spar, Director, Office of Patent Legal Administration (OPLA), at (703) 308-5107, or by facsimile to (703) 305-1013, marked to the attention of Mr. Bernstein, or by mail addressed to: Mail Stop Comments—Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

**SUPPLEMENTARY INFORMATION:** The Office has conducted a “top to bottom” review of the patent application and examination process (among other processes) as part of the 21st Century Strategic Plan. The 21st Century Strategic Plan is available on the Office’s Internet Web site ([www.uspto.gov](http://www.uspto.gov)). While many of the changes to the patent application and examination process necessary to support the 21st Century Strategic Plan require enabling legislation (and implementing rule changes), the Office has determined that a number of initiatives can be implemented under the Office’s current rule making and patent examination authority set forth in 35 U.S.C. 2(b)(2), 131, and 132. This document proposes changes to the rules of practice in title 37 of the Code of Federal Regulations (CFR) to improve the patent application and examination process by promoting quality enhancement, reducing patent pendency, and using information technology to simplify the patent application process.

This document specifically proposes changes to the following sections of title 37 CFR: 1.4, 1.6, 1.8, 1.10, 1.14, 1.17, 1.19, 1.27, 1.47, 1.52, 1.53, 1.55, 1.58, 1.59, 1.69, 1.76, 1.78, 1.83, 1.84, 1.91, 1.94, 1.98, 1.102, 1.103, 1.105, 1.111, 1.115, 1.116, 1.131, 1.136, 1.137, 1.165, 1.173, 1.175, 1.178, 1.182, 1.183, 1.213, 1.215, 1.291, 1.295, 1.296, 1.311, 1.324, 1.377, 1.378, 1.502, 1.530, 1.550, 1.570, 1.644, 1.666, 1.704, 1.705, 1.741, 1.902, 1.953, 1.956, 1.957, 1.958, 1.979, 1.997, 5.12, 5.15, and 5.25. Additionally, this document proposes to amend title 37 CFR by adding new § 1.57 and removing § 1.179.

The following members of the Office of Patent Legal Administration may be contacted directly for the matters indicated:

Joni Chang ((703) 308-3858): §§ 1.8, 1.10, 1.98, 1.111, and 1.311  
 Jeanne Clark ((703) 306-5603): § 1.98  
 James Engel ((703) 308-5106): §§ 1.14, 1.17, 1.53, 1.59, 1.103, 1.131, 1.182, 1.183, 1.295, 1.296, 1.377, 1.378, 1.644, 1.666, 1.741, 5.12, 5.15, and 5.25  
 Karin Ferriter ((703) 306-3159): §§ 1.6, 1.47, 1.52 (other than (e)(1)(iii) and (e)(3)), 1.58, 1.83, 1.84, and 1.165  
 Anton Fetting ((703) 305-8449): §§ 1.17, 1.53, 1.59, 1.103, 1.105, 1.182, 1.183, 1.295, 1.296, 1.377, 1.378, 1.644, 1.666, 1.741, 5.12, 5.15, and 5.25  
 Kery Fries ((703) 308-0687): §§ 1.76, 1.704, and 1.705  
 Hiram Bernstein ((703) 305-8713): §§ 1.91 and 1.94  
 Eugenia Jones ((703) 306-5586): §§ 1.8, 1.10, 1.27, 1.55, 1.57(a), and 1.78  
 Michael Lewis ((703) 306-5585): §§ 1.4, 1.19, 1.52(e)(1)(iii) and (e)(3), 1.57, and 1.58(b)  
 Joe Narcavage ((703) 305-1795): §§ 1.173, 1.175, 1.178, 1.179, 1.291, and 1.324  
 Mark Polutta ((703) 308-8122): §§ 1.213, and 1.215  
 Kenneth Schor ((703) 308-6710): §§ 1.98, 1.116, 1.136, 1.137, 1.291, 1.502, 1.550, 1.570, 1.902, 1.953, 1.956, 1.957, 1.958, 1.979, and 1.997  
 Fred Silverberg ((703) 305-8986): § 1.115

The Office will post a copy of this notice on its Internet Web site ([www.uspto.gov](http://www.uspto.gov)). Additionally, individuals or organizations, that need a copy for the purpose of providing comments, may send a request by phone or e-mail to Elizabeth Polley at ((703) 308-6202, or [elizabeth.polley@uspto.gov](mailto:elizabeth.polley@uspto.gov)) or Terry Dey at ((703) 308-1201 or [terry.dey@uspto.gov](mailto:terry.dey@uspto.gov)) to receive an e-mail copy of the notice. When making a request for an e-mail copy, it is requested that persons please specify whether they wish to receive the document in MS-Word, WordPerfect, or HTML format.

**Discussion of Specific Rules**

**Section 1.4:** Section 1.4(d) is proposed to be amended to provide for filing correspondence with electronic signatures on electronically created correspondence documents that are filed by facsimile transmission, or hand-carried or mailed to the Office, for entry in a patent application, patent file, or

reexamination proceeding. The electronic signature must be the signer's actual name or have the actual name additionally presented in printed or typed form. The electronic signature may be any combination of numbers and/or letters and may include a title. Appropriate punctuation and spaces may be used with the letters and numbers. The signer must present his or her family name entirely in capital letters in the signature if the actual name is used. Where the actual name is not used in the signature, the family name must be presented entirely in capital letters in the printed or typed form of the name. When the actual name of the signer is being provided as a printed or typed name, it must be clearly identified as the actual name of the signer. A practitioner signing pursuant to §§ 1.33(b)(1) or 1.33(b)(2) must place the signer's registration number, either within or after the electronic signature. A number character (#) may only be used in a signature if it is prior to a practitioner's registration number that is part of the electronic signature. New paragraph (h) sets forth the procedure for resolving questions as to the veracity of the (electronic) signature, such as when there are variations in signatures, or where the signature and the printed or typed name does not clearly identify the person signing the document, or where more than one person has used the same signature.

The Office considered proposing a requirement that the order of the name in a signature be identified with the language such as follows: given name, middle name or initial, family name if the name is supplied in that order. Capitalizing only the family name without identifying the order is considered a simpler and less burdensome procedure for signing a document. Comments in favor of or opposed to this alternative are invited.

Section 1.4(d)(1)(iv)(A) sets forth the specific requirements of an electronic signature (e-signature), and when the Office will accept an electronic signature in patent-related documents. The phrase "electronically signed" documents includes documents that are created and signed in a word processor program and electronically fillable forms, such as declarations generated using the program Adobe Acrobat that have pre-printed standard language with an ability to add specific information such as a signature (e.g., similar to those provided on the Office's Internet Web site that can be completed and signed electronically). The proposed rule change is intended to facilitate movement of documents between

practitioners, applicants, and the Office. The proposed rule change does not permit the filing of Official correspondence by electronic mail (e.g., e-mail) messages over the Internet to the Office, but does permit submissions transmitted by facsimile. Pilot programs, such as the program at the Board of Patent Appeals and Interferences (BPAI) are not affected by this rule change (see standing orders at the URL: <http://www.uspto.gov/web/offices/dcom/bpai/standing2003May.pdf>). Electronically created documents that contain an electronic signature e-mailed from applicants to a practitioner, however, may be transmitted to the Office from a practitioner by facsimile transfer, or as a paper document. While it is not now permitted, the Office is considering expanding the means by which electronically created documents can be transmitted to the Office, such as by an e-mail attachment using the proposed signature requirements.

Paragraph 1.4(d)(1)(iv)(A) recites that electronic signatures may be utilized when the electronically signed document is: (1) Facsimile transmitted from a computer in its electronic form; (2) printed and then facsimile transmitted; or (3) printed on paper and hand or mail delivered to the Office. This paragraph also permits electronic signatures for documents submitted via the Office's Electronic Filing System (EFS). The EFS is not an e-mail system. This paragraph does not authorize delivery of documents to the Office by e-mail over the Internet.

Practitioners must take care when submitting a document intended to be unsigned by ensuring that there are no markings in a signature space or this could be determined to be indicia of a signature (either as a permanent ink signature or electronic signature).

The documents submitted under this provision may become records submitted in interference and other legal proceedings where authentication is required. Applicants and practitioners must recognize the differences in electronically created documents and paper documents for authentication purposes and take appropriate steps to be able to authenticate documents, if required. An issue with electronically created documents is that they may have embedded comments and track changes in the electronic document that are not always visible when a document is rendered using a different computer system or a different software version, or when printed to paper. Variations in how much of the embedded comments and track changes are rendered on a given computer may cause the document signer to see different

document content than the contents of the document that is submitted to the Office. Additionally, establishing a chain of custody may involve proving that a document viewed by the Office is, in fact, the same document executed by the signer.

The Office can only authenticate a document to the extent of what is contained in Office records. Office records will not contain any of the electronic communications between the applicant or practitioner filing a document and a third party. For example, the Office cannot authenticate from its records a document (e.g., a § 1.132 affidavit) prepared by a third party and including a third party signature that was submitted to an applicant or practitioner electronically for resubmission to the Office. Under these circumstances, the applicant or practitioner would need to be concerned about both establishing a chain of custody to address alteration and any attempted repudiation by a third party of his or her electronic signature. In establishing the authenticity of a document, the applicant or practitioner would be attempting to show that the date of execution of the document is earlier than the date of submission to the Office, and the document was unaltered from that earlier date until its submission to the Office. A chain of custody would need to be shown and proven. Therefore, electronically created documents may require additional procedures over what may be required for a document signed with an ink signature to address chain of custody and alteration issues. In addition, there must be procedures in place to address the issue that the particular document preparation software may have undergone frequent changes. Different versions of the same software program may store and display the document, as well as comments and changes to the document, differently, which gives rise to issues concerning alteration of the document. Accordingly, applicants and practitioners must be cognizant of these issues of changed document appearance and content and take appropriate steps to ensure that their records, if in electronic form, can be rendered and authenticated at some later time as being the unaltered electronically signed original document.

Paragraph 1.4(d)(1)(iv)(A) defines who can insert an electronic signature into an electronically created document. The proposed rule change requires that the signer "personally insert" his or her electronic signature by use of numbers and/or letters, with punctuation and spaces. To make the identity of the signer self-evident, the same electronic

signature should be utilized each time, with variations of the signature being avoided. The signer should review any indicia of identity of the signer in the body of the document including any printed or typed name and registration number, to ensure that the indicia of identity is consistent with how the document is signed. Knowingly adopting an electronic signature of another is not permitted. The "personally insert" requirement is met by the signer directly typing his or her electronic signature on a keyboard. This requirement is not met when a first person types the electronic signature of a second person, upon receiving only a general instruction from the second person to insert the second person's signature. A person physically unable to use a keyboard, however, may, while simultaneously reviewing the document for signature, direct another person to press the appropriate keys to form the signature.

Paragraph 1.4(d)(1)(iv)(A) defines the content of an electronic signature. The Office proposes to adopt a standard of numbers and/or letters, with punctuation and spaces as the electronic signature, which must be placed between two forward slashes to be consistent with the international standard and to build upon the experience gained with this standard in the Trademarks section of the office. See PCT Annex F, section 3.3.2. The electronic signature between two forward slashes cannot contain any additional forward slashes. This standard can be met with any standard personal computer (PC) and keyboard. The Office also recognizes that many practitioners sign their name with the number character (#) as part of his or her registration number. The use of the number character (#) as part of the registration number would be permitted but not otherwise, such as utilization of a customer number as the signature. Other non-text characters would not be permitted, as a typed symbol in one font may vary when viewed in a different font (e.g., the code for the euro currency symbol in one font produces a different currency symbol when viewed in another font).

The Office recognizes that periods, commas, and hyphens are often found in names and will therefore be found in many signatures. Appropriate punctuation and spaces may be used with numbers and letters, not in place of numbers and letters in a signature. Hence, the use of appropriate punctuation and spaces with letters and numbers would be permitted (e.g., periods, commas and hyphens). A signature of only punctuation marks

ordinarily does not identify any person, and would be improper. Also, punctuation marks, such as question marks (e.g., /???/), are often utilized to represent the intent not to sign a document and would be improper.

To avoid processing delays, the Office needs to readily determine whether a document has been signed. The filing of a document does not imply that the document has been signed. The Office does not want to investigate as to whether a mark (e.g., extraneous marks or a non-permanent ink presentation of a name) comprises a signature. Therefore, the Office will only interpret the data presented between forward slashes as an electronic signature. Hence, documents intended to be unsigned should be very clear that any data presented between forward slashes is not intended to be a signature.

Similarly, presentation of just numbers and letters in an electronically produced document without forward slashes will be treated under this part as an unsigned document. Script fonts are not permitted for any portion of a document, which would include a name typed in a signature area. See § 1.52(b)(2)(ii). Accordingly, presentation of a typed name without the required slashes even in a script font does not present the proper indicia manifesting an intent to sign and will not be accepted as an electronic signature.

Paragraph (d)(1)(iv)(A) requires the signer's actual name be used except as provided in paragraph (d)(1)(iv)(B), where an electronic signature is used that differs from the actual name of the signer. Where an electronic signature is not the signer's actual name, the actual name must be printed or typed and clearly indicated as the signer's actual name. The use of lower case and capital letters is permitted except that the family name must be entirely capitalized with no other names entirely capitalized. A middle initial if capitalized and presented with a period to identify it as an abbreviation is permitted. A person with an electronic signature that includes both a single character family name and at least one other single character name must provide an electronic signature with all single character names other than the family name in non-capital letters. Titles may be used with the signer's name and can be placed within or after the slash marks. When the last name is given first it will be presumed to be followed by a first name before any middle name. Similarly, when a last name is given last it will be presumed that the first name will precede a middle name. Where two or more

multiple character names are capitalized, the Office will need to inquire as to which is the last name.

To accommodate as many varieties of names as possible a signer may select any combination of letters and/or numbers for his or her signature under § 1.4(d)(1)(iv)(A). A signature that is the actual name of the signer need not be accompanied by a typed or printed name. Accordingly, the absence of a printed or typed name clearly identified as the actual name of the signer is a representation that the signature is the signer's actual name.

The Office considered accepting an actual name as a signature without requiring that the order of names be identified. A signature of an actual name has been found by the Office insufficient to identify the signer. For example, some people routinely sign with his or her last (or family) name first. Similarly, for people with first and last names that are commonly interchanged as first and last names, it may not be self-evident which is the given name and which is the family name. A printed or typed copy of the signer's name immediately below the signature often will have the same problem of which is the family name and which is the given name.

The Office considered proposing a standard signature format such as family name first, followed by given name. A standard signature format was rejected because it would not aid the Office in identifying the signer of a document, particularly where the format is not adhered to by the signer. The Office is receiving applications and correspondence for other patent-related matters in which it cannot be determined who signed the document and/or what the actual name of the signer is because either the order of the family name and given name are unclear, or more than one signer has the same name. Adopting a standard signature format would not make it any easier for the Office to detect in many cases when the order of family name, given name, and middle name are in a non-standard order.

In the following discussion, family name is intended to be synonymous with the terms "surname" or "last name" in the customary format for European-American names. Similarly, given name is intended to be synonymous with the term "first name" in the customary format for European-American names. Format and content of a signature are both critical because people from different countries throughout the world have different customs for signing a name, e.g., reversing the order of family (*i.e.*, last)

name and given (*i.e.*, first) name. Current rules and procedures for most communications do not require applicants and practitioners to utilize any format for the signature. A person may currently use a signature with his or her family name as the first name or the last name of the signature. Further, it is common for a person to abbreviate his or her given name (*e.g.*, William Jefferson Louis, as W. Jefferson Louis), which, if signed with the last name first, would appear as a middle initial (*i.e.*, Louis W. Jefferson). The Office is receiving communications from people all over the world with different signature formats and the Office cannot readily identify the family name and given name of the signer.

This lack of consistency in signing order is exacerbated in many patent applications because a person's name may appear in several places in the record of an application in a different format (*e.g.*, first name and last name reversed) in each occurrence. In addition, the Office has found at least two applicants and/or practitioners in the same firm with the given and family names in reverse order (*e.g.*, first practitioner is Mitchell Louis, and the second practitioner is Louis Mitchell). Signatures have been found with the printed or typed name under the signature appearing as the reverse of the signature (*e.g.*, /Louis Mitchell/ with Mitchell Louis typed immediately underneath). In view of the differing customs for the order of signing names, the Office is frequently unable to ascertain the identity of the signer (*e.g.*, in the example given, is Louis Mitchell or Mitchell Louis the signer). The identity of the signer is not self-evident in applications with applicants and/or practitioners that have reversed versions of the same names, and when the order of names in a signature is the reverse order in the adjacent printed/typed version of the signer's name. This often results in confusion in the Office, and later in the public when reviewing Office records, as to the actual name and identity of the signer of a document or a patentee when an application is issued.

To avoid confusion as to whether a registered practitioner is relying on his or her registration for signing a document, § 1.4(d)(1)(iv)(A) recites that a practitioner signing pursuant to §§ 1.33(b)(1) or 1.33(b)(2) of this part must place his or her complete name, as registered, and his or her registration number, with or immediately adjacent his or her electronic signature. A number character (#) may only be used in a signature if it is prior to a practitioner's registration number that is

part of the electronic signature. When a practitioner is signing as an assignee, or as an applicant (inventor) pursuant to §§ 1.33(b)(3) or 1.33(b)(4), a registration number is not required but may be supplied.

The requirement that an electronic signature for practitioners be accompanied by an identification of the family name, and registration number, is consistent with Article 9(1) of the Patent Law Treaty (June 1, 2000) (PLT).

Paragraph 1.4(d)(1)(iv)(B) recites the requirements for when a signer uses an electronic signature that is not the person's actual name. The Office expects that where persons do not sign with their actual name it is because they are using an e-signature that is the normal e-signature for that person and not something that is employed to obfuscate or misidentify the signer. Where the e-signature is not the actual name because the signer is using the signer's normal e-signature, the actual name must be presented in printed or typed form with the last name in capitals. The printed or typed name must be clearly identified as the actual name. To accommodate as many signatures as possible, a signer may select any combination of letters and/or numbers for his or her signature. The flexibility in selecting combinations of letters and/or numbers for signatures means that the identity of the signer may not be clear from the signature if it is not an actual name. For example, a collection of letters/numbers when presented for the first time without a full printed or typed name that does not appear to be a person's name (*e.g.*, /123456XYZ/) does not identify any person as the signer. This is so even where the signer has submitted a previous document with such signature and an additional identification of the actual name of the signer. Similarly, where the signature, because it is not the signer's actual name, appears to represent an identifiable person with a name different in some respects from those persons authorized to sign and who are of record in an application, the name of the signer in the signature alone would not be sufficient to identify the signer.

Paragraph 1.4(d)(1)(iv)(B) requires that where the signer's usual electronic signature is not the signer's actual name, the signer must provide his or her actual name by printing or typing the actual name and clearly identifying it as such. The signer must further identify in the printed or typed actual name the signer's family name by entirely capitalizing only the family name. These requirements are consistent with PLT Rule 9. Registered practitioners

signing pursuant to §§ 1.33(b)(1) or 1.33(b)(2) of this part, or where the signer otherwise (*e.g.*, to distinguish two practitioners with the same name) includes a registration number when it is not required by rule, should provide the registration number after the signature, or the printed or typed name immediately below the signature.

A typed or printed name in the body of the text is not usually self-identifying as to whether it is the signer's actual name, or even the name of some other person. A clear indication that it is the signer's actual name is necessary to distinguish it from the other possibilities where the signature is not the actual name and a printed or typed name has not been supplied with the signature. Similarly, the order of the names, family name, given name, middle name or initial, unless supplied is not self-evident from the printed or typed name alone so the order must be indicated by entirely capitalizing only the family name.

The Office strongly suggests that each signer use a signature (electronic or otherwise) that has his or her full name including full middle name. The Office recommends that registered practitioners use their full name under which they are registered and always include their registration number with the signature or with the hand-written or typed name that accompanies a signature. Examples of proper and improper signatures will be posted on the Office's Internet Web site.

Paragraph 1.4(h) proposes requiring a ratification or confirmation of a signature, such as where the Office has reasonable doubt as to the authenticity (veracity) of the signature. The Office may additionally inquire in regard to a signature simply to identify the signer and clarify the record where the identity of the signer is unclear. The inquiries concerning the authenticity (veracity) of a signature are consistent with PLT Article 8(4)(c) and Rules 7(4), 15(4), 16(6), 17(6), and 18(4). An example of when ratification or confirmation of a signature may be required is when there are variations in a signature or whenever a name in an e-signature is not exactly the same as the name indicated as an inventor, or a practitioner of record. Hence, whatever signature is adopted by a signer, that signature should be consistently used on all documents. Also addressed is the treatment of variations in a signature when a printed or typed name accompanies the e-signature but the identity of the signer is unclear. In such cases, the Office may require ratification or confirmation of a signature. Ratification or confirmation alone does

not provide a means for changing the name of a signer. For example, when an inventor changes her/his name and the inventor desires to change her/his name in the application, such change must be accompanied by a petition under § 1.182. See *Manual of Patent Examining Procedure* § 605.04(c) (8th. ed. 2001) (Rev. 1, Feb. 2003) (MPEP).

The Office is proposing to treat failure to follow the format and content of a standard signature as an unsigned document. Treating the documents as being unsigned could have varying results dependent on the nature of the document. For example, in new applications, treating an oath or declaration as an unsigned oath or declaration could result in the imposition of a surcharge. See § 1.53(f)(1). Other correspondence could be treated under the procedures for unsigned amendment documents set forth in MPEP §§ 714.01 and 714.01(a).

As previously indicated, the Office is requesting comments on the alternative of requiring labeling the order of names in a signature in place of the proposed rule requiring capitalization of the entire family name.

**Section 1.6:** Section 1.6(d)(4) is proposed to be amended to provide that black and white drawings in patent applications may be transmitted to the Office by facsimile in order to provide more flexibility to applicants for filing individual papers in applications that contain drawings. Drawings are now permitted to be transmitted to the Office by facsimile when accompanied by payment of the issue fee, and drawings received by facsimile have been of an acceptable quality. See *Payment of the Issue Fee and Filing Related Correspondence by Facsimile*, 1254 Off. Gaz. Pat. Office 91 (Jan. 15, 2002). Although the rules of practice will now permit the submission of black and white drawings by facsimile, photographs or drawings with detail should not be transmitted by facsimile. Furthermore, color drawings must continue to be hand-carried or mailed to the Office instead of being transmitted by facsimile. In addition, the Office will publish drawings that are received as long as they can be scanned, and will not, in general require replacement drawings to replace drawings transmitted by facsimile, even if the facsimile transmission process results in the drawings being less sharp than the original drawings.

Section 1.6(e) is proposed to be removed and reserved because the provisions of § 1.6(e) are deemed more appropriately placed in § 1.10. This is because the "Express Mail" provisions of § 1.10 are the only means by which

correspondence can be accorded a filing date other than the actual date of receipt in the Office. Thus, the provisions of § 1.6(e) are proposed to be transferred to § 1.10 along with some changes.

Proposed § 1.10(g) and (h) specifically address situations in which "Express Mail" is returned or refused by the United States Postal Service (USPS). Proposed § 1.10(i) is similar to § 1.6(e) and addresses situations where there is a designated interruption or emergency in "Express Mail" service.

**Section 1.8:** Section 1.8(a) is proposed to be amended to clarify that the provisions of this section do not apply to time periods or situations set forth in sections that have been expressly excluded from § 1.8 as well as situations enumerated in § 1.8(a)(2).

Section 1.8(b) is also proposed to be amended to permit notifying the Office of a previous mailing, or transmitting, of correspondence, when "a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence."

Section 1.8(b) is also proposed to be amended to make it clear that it is not the reexamination proceeding which is concluded under §§ 1.550(d) or 1.957(b), but rather the prosecution of the reexamination. See the discussion as to the amendment of § 1.550 for the rationale for this change.

It is further proposed that § 1.8(b) be revised to more appropriately set forth the § 1.957(c) consequences of a failure to respond in an *inter partes* reexamination.

The proposed amendment to § 1.8(a) is to clarify that the list enumerated in § 1.8(a)(2) is not exhaustive. Provisions of § 1.8 also do not apply to the time periods or situations set forth in sections that have been explicitly excluded from § 1.8. For example, provisions of § 1.8(a) do not apply to time periods and situations set forth in §§ 1.217(e) and 1.703(f) because the exceptions are provided explicitly in § 1.217(e), "[t]he provisions of § 1.8 do not apply to the time periods set forth in this section" and § 1.703(f), "[t]he date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in [a patent term adjustment] calculation."

Recently, many applicants had experienced substantial delays in delivery of their correspondence by the USPS to the Office. These applicants did not wish to wait until the application is held to be abandoned before notifying the Office of the previous mailing, or transmitting, of the correspondence and supplying a duplicate copy of the correspondence

and requisite statement in accordance with § 1.8(b)(3).

Under the proposed amendment to § 1.8(b), in the event that correspondence is considered timely filed by being mailed or transmitted in accordance with § 1.8(a), but not received in the Office after a reasonable amount of time has elapsed (e.g., more than one month from the time the correspondence was mailed), the applicants would not be required to wait until the end of the maximum extendable period for reply set in a prior Office action (for the Office to hold the application to be abandoned) before informing the Office of the previous submitted correspondence and supplying a duplicate copy and requisite statement. Thus, filing a petition to withdraw the holding of abandonment would not be necessary in such circumstance. The proposed amendment to § 1.8(b) would provide applicants an expedited procedure in resolving substantial delayed mail problems.

Before notifying the Office of a previously submitted correspondence that is not received by the Office, applicants are encouraged to check the Patent Application Information Retrieval (PAIR) System (which can be accessed over the Office's Internet Web site at <http://pair.uspto.gov>) to see if the correspondence has been entered into the application file. The PAIR system is a system which enables applicants to access the Office's electronic records for a patent application or patent. Private PAIR is available to applicants who have a customer number associated with the correspondence address for an application and who have acquired the access software (Entrust Direct Software and a PKI certificate). Applicants may contact the Electronic Business Center (EBC) at (703) 305-3028 for more information on PAIR.

The proposal that § 1.8(b) be revised to more appropriately set forth the § 1.957(c) consequences of a failure to respond in an *inter partes* reexamination is necessary to clarify that the *inter partes* reexamination prosecution is neither terminated nor concluded where the patent owner fails to timely respond to an Office action, and claims in the proceeding remain patentable. Rather, an Office action is issued to thereby permit the third party requester to challenge the claims found patentable. As set forth in § 1.957(c), "[i]f claims are found patentable and the patent owner fails to file a timely and appropriate response to any Office action in an *inter partes* reexamination proceeding, further prosecution will be limited to the claims found patentable at

the time of the failure to respond, and to any claims added thereafter which do not expand the scope of the claims which were found patentable at that time" (emphasis added). The proposed revision accordingly would apply the § 1.8(b) remedy to an *inter partes* reexamination prosecution which has been limited as to further prosecution under § 1.957(c). In addition, the amendment is intended to apply to the § 1.957(a) situation where the third party requester files an untimely comment, notice of appeal or brief in an *inter partes* reexamination, and the paper would thus be refused consideration (to thereby limit the requester's prosecution) if not for the operation of the § 1.8(b) remedy.

**Section 1.10:** Section 1.10 is proposed to be amended to add paragraphs (g), (h), and (i) to address the effects of interruptions or emergencies in USPS "Express Mail" service. For example, Friday, November 16, 2001, the USPS issued a memorandum temporarily and immediately suspending "Express Mail" service to Washington DC zip codes 202xx through 205xx. The suspension included service to the zip code for certain correspondence mailed to the Office (20231).

Applicants frequently rely on the benefits under § 1.10 to obtain a particular filing date for a new application. The filing date accorded to an application is often critical. For example, applicants who do not file their applications in the United States within one year from when their invention was first described in a printed publication or in public use or on sale in this country are not entitled to a patent. (See 35 U.S.C. 102(b)). Furthermore, to be able to claim the benefit of a provisional application or to claim priority to a foreign application, the nonprovisional application claiming benefit or priority must be filed within one year from the filing of the provisional application or foreign application, respectively. Therefore, the means by which applicants may remedy the effects of an interruption or emergency in USPS Express Mail service which has been so designated by the Director should be specifically addressed in the rules of practice.

The Office published a notice on October 9, 2001, that provides guidance in the situations in which a post office refuses to accept the deposit of mail for delivery by "Express Mail" Service and situations in which "Express Mail" is deposited into an "Express Mail" drop box and given an incorrect "date-in." See *United States Postal Service Interruption and Emergency*, 1251 *Off. Gaz. Pat. Office* 55 (Oct. 9, 2001). The

procedure for where the USPS refuses to accept the deposit of mail for delivery by "Express Mail" as contained in the notice, however, has not been incorporated into the rules of practice.

The Office's existing framework to address postal emergencies is detailed in § 1.6(e), "Interruptions in U.S. Postal Service." Section 1.6(e) provides that if interruptions or emergencies in the USPS which have been so designated by the Director occur, the Office will consider as filed on a particular date in the Office any correspondence which is: (1) Promptly filed after the ending of the interruption or emergency; and (2) accompanied by a statement indicating that the correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the USPS.

The provisions of § 1.6(e) are more appropriate in § 1.10 since "Express Mail" is the only means by which correspondence can be accorded a filing date other than the actual date of receipt in the Office. Thus, the provisions of § 1.6(e) are proposed to be transferred to § 1.10 along with some changes. Proposed § 1.10(g) and (h) specifically address situations in which "Express Mail" is returned or refused by the USPS. Proposed § 1.10(i) is similar to § 1.6(e) and addresses situations where there is a designated interruption or emergency in "Express Mail" service.

Section § 1.10(g) is proposed to be added to provide that any person who attempts to file correspondence by "Express Mail" that was returned by the USPS may petition the Director to consider the correspondence as filed on a particular date in the Office. The petition must be filed promptly after the person becomes aware of the return of the correspondence and the number of the "Express Mail" mailing label must have been placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail." The petition must also include the original correspondence or a copy of the original correspondence showing the number of the "Express Mail" mailing label thereon and a copy of the "Express Mail" mailing label showing the "date-in." Furthermore, the petition must include a statement, which establishes to the satisfaction of the Director, the original deposit of the correspondence and that the correspondence or the copy is the original correspondence or a true copy of the correspondence originally deposited with the USPS on the requested filing date.

Section 1.10(h) is proposed to be added to provide that any person who attempts to file correspondence by

"Express Mail" that was not accepted by the USPS may petition the Director to consider the correspondence as filed on a particular date in the Office. The petition must be filed promptly after the person becomes aware of the refusal of the correspondence and the number of the "Express Mail" mailing label must have been placed on the paper(s) or fee(s) that constitute the correspondence prior to the attempted mailing by "Express Mail." The petition must also include the original correspondence or a copy of the original correspondence showing the number of the "Express Mail" mailing label thereon. In addition, the petition must include a statement by the person who originally attempted to deposit the correspondence with the USPS which establishes, to the satisfaction of the Director, the original attempt to deposit the correspondence and that the correspondence or the copy is the original correspondence or a true copy of the correspondence originally attempted to be deposited with the USPS on the requested filing date.

Section 1.10(i) is proposed to be added to provide that any person attempting to file correspondence by "Express Mail" who was unable to deposit the correspondence with the USPS due to an interruption or emergency in "Express Mail" service which has been so designated by the Director, may petition the Director to consider such correspondence as filed on a particular date in the Office. This material is proposed to be transferred from § 1.6. The petition must be filed in a manner designated by the Director promptly after the person becomes aware of the designated interruption or emergency in "Express Mail" service. The petition must also include the original correspondence or a copy of the original correspondence, and a statement which establishes, to the satisfaction of the Director, that the correspondence would have been deposited with the USPS but for the designated interruption or emergency in "Express Mail" service, and that the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally attempted to be deposited with the USPS on the requested filing date.

Proposed § 1.10(i) requires the Director to designate an interruption or emergency in "Express Mail" service. It is envisioned that in the notice designating the interruption or emergency the Director would provide guidance on the manner in which petitions under proposed § 1.10(i) should be filed. This is similar to what occurred when "Express Mail" was

suspended in November of 2001, when applicants were advised that if the USPS refused to accept correspondence for delivery to the Office by "Express Mail" they should mail the correspondence by registered or first class mail with a statement by the person who originally attempted to deposit the correspondence with the USPS by "Express Mail."

**Section 1.14:** Section 1.14(h)(1) is proposed to be amended to refer to the petition fee set forth in § 1.17(g) for consistency with the change to § 1.17. See discussion of § 1.17.

**Section 1.17:** Section 1.17 is proposed to be amended to adjust petition fees to more accurately reflect the Office's cost of treating petitions. The petitions whose fees are currently provided for in § 1.17(h) are outside the scope of the usual processing of patent applications provided for in 35 U.S.C. 41(a) and (b). The Office is directed by 35 U.S.C. 41(d) to set fees for services not set under 35 U.S.C. 41(a) or (b) so as to recover the average costs of performing the processing or service.

The Office has conducted an activity-based-accounting cost (ABC) analysis of the Office's cost of treating the various petitions enumerated under § 1.17(h) based on current practices and staffing costs. The Office has determined that the petition fee set forth in § 1.17(h) does not recover the Office's costs of treating petitions for a number of the types of petitions enumerated under § 1.17(h). The Office has also determined that there is a significant difference in the Office's costs for treating the various types of petitions enumerated under § 1.17(h). Therefore, the Office is proposing to separate the petitions enumerated under § 1.17(h) into three groups, and to charge separate petition fees for each of these three groups of petitions, which petition fees will more accurately reflect the cost of treating petitions in these three groups.

The first group of petitions will be covered by a new § 1.17(f), which will specify a petition fee of \$400. The petitions in this group are: (1) Petitions under § 1.53(e) to accord a filing date; (2) petitions under § 1.57(a) to accord a filing date; (3) petitions under § 1.182 for decision on a question not specifically provided for; (4) petitions under § 1.183 to suspend the rules; (5) petitions under § 1.378(e) for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent; (6) petitions under § 1.644(e) in an interference; (7) petitions under § 1.644(f) for requesting reconsideration of a decision on petition in an interference; (8) petitions under

§ 1.666(b) for access to an interference settlement agreement; (9) petitions under § 1.666(c) for late filing of an interference settlement agreement; and (10) petitions under § 1.741(b) to accord a filing date to an application under § 1.740 for extension of a patent term. Petitions in this first group require analysis of complex and unique factual situations and evidentiary showings. Often a petition in this group will involve an issue of first impression requiring review and approval of a course of action by senior Office officials.

The second group of petitions will be covered by a new § 1.17(g), which will specify a petition fee of \$200. The petitions in this group are: (1) Petitions under § 1.12 for access to an assignment record; (2) petitions under § 1.14 for access to an application; (3) petitions under § 1.47 for filing by other than all the inventors or a person not the inventor; (4) petitions under § 1.59 for expungement of information; (5) petitions under § 1.103(a) to suspend action in an application; (6) petitions under § 1.136(b) to review requests for extension of time when the provisions of section 1.136(a) are not available; (7) petitions under § 1.138(c) to expressly abandon an application to avoid publication; (8) petitions under § 1.295 for review of refusal to publish a statutory invention registration; (9) petitions under § 1.296 to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued; (10) petitions under § 1.377 for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent; (11) petitions under § 1.550(c) for patent owner requests for extension of time in *ex parte* reexamination proceedings; (12) petitions under § 1.956 for patent owner requests for extension of time in *inter partes* reexamination proceedings; (13) petitions under § 5.12 for expedited handling of a foreign filing license; (14) petitions under § 5.15 for changing the scope of a license; and (15) petitions under § 5.25 for a retroactive license. Petitions in this second group also require analysis of factual situations and evidentiary showings; however, the factual situations and evidentiary showings for this second group of petitions often fall into recognizable patterns. On occasion, however, a petition in this second group will involve an issue of first impression requiring review and approval of a course of action by senior Office officials.

The third group of petitions will be covered by § 1.17(h), which will

continue to specify a petition fee of \$130. The petitions in this group are: (1) Petitions under § 1.19(h) to request documents in a form other than that provided in this part; (2) petitions under § 1.84 for accepting color drawings or photographs; (3) petitions under § 1.91 for entry of a model or exhibit; (4) petitions under § 1.102(d) to make an application special; (5) § 1.313 to withdraw an application from issue; and (6) petitions under § 1.314 to defer issuance of a patent. Petitions in this third group require review for compliance with the applicable procedural requirements, but do not often require analysis of varied factual situations or evidentiary showings.

Section 1.17(i) is proposed to be amended to provide a processing fee so that replacement drawings submitted within the period set forth in § 1.215(a) can be included in any patent application publication. This will replace the current requirement for a petition fee under § 1.17(h) for the petition under § 1.182 which is required for such replacement drawings to be accepted for inclusion in any patent application publication. See *Drawings in Patent Application Publications and Patents*, 1242 Off. Gaz. Pat. Office 114 (Jan. 16, 2001). See also a conforming amendment to § 1.215(a).

Sections 1.17(l) and (m) are proposed to be revised to make it clear that the reexamination proceeding is not terminated under §§ 1.550(d) or 1.957(b), but rather the prosecution of the reexamination is concluded under §§ 1.550(d) or 1.957(b). See the discussion below as to the amendment of § 1.550 for the rationale for this change.

**Section 1.19:** Section 1.19 is proposed to be amended to clarify that copies of documents may be provided in whole, or in part, in electronic image form at the Office's option. Additionally, § 1.19(b) is proposed to be amended to provide how copies of Image File Wrapper (IFW) contents are to be charged. Further, it is proposed to eliminate the seven-day requirement of § 1.19(b)(1) for processing copy requests, and to eliminate the phrase "that were submitted in electronic form on a physical media" from § 1.19(b)(3). Paragraphs (g) and (h) would be added to provide for supplying copies of unscanned documents and to provide for a petition to obtain copies of documents in a form other than provided for in the rules of practice.

In view of the ever-increasing (paper) submissions, many of the Office official records need to be, and are going to be, stored and maintained in electronic form. As a result of the Office's



migration to electronic storage of documents, especially for voluminous documents, the Office proposes amending § 1.19 to reflect that the Office may, at its option, provide copies of documents where the copy is in electronic form on compact disc. Requests for voluminous documents can be economically provided in an expedited time frame without degrading service to other users if copies are furnished on compact disc. Requests for documents in other forms that would impair service to other users would be decided on a case-by-case basis as provided in new § 1.19(h).

Section 1.19(b) is proposed to be amended in view of the current migration of Office records from paper file wrappers to their electronic image equivalent with the image file wrapper (IFW) system as the repository of official Office records. See *USPTO Announces Prototype of Image Processing*, 1265 *Off. Gaz. Pat. Office* 87 (Dec. 17, 2002), and *See Changes To Implement Electronic Maintenance of Official Patent Application Records*, 68 FR 38611 (June 30, 2003). The instant proposed rule change clarifies how copies of IFW contents are to be charged, as the current rule would otherwise not provide a way for the public to obtain copies given the absence of a paper file wrapper for the Office to copy when IFW replaces the paper file wrapper as the source of copies.

Sections 1.19(b)(1) and (2) are proposed to be amended to reflect the change to IFW from paper file wrappers. Currently when documents are submitted to the Office in paper or on compact disc, copies of a file wrapper and documents contained therein may be made from the original paper or compact disc submission. If a scanned image is used to make copies of an application as originally filed, the scanned image corresponds to a paper file wrapper. In the future, there will be no paper file wrapper corresponding to scanned image files in the IFW System. As the Office uploads its records to the IFW system, the instant proposed change will permit the Office to supply to the public copies of Office documents directly from the IFW system regardless of format and media of the initial submission (e.g., paper, electronic, or compact disc). After uploading into IFW, the original submission may not be retained or be in an easily retrievable form for copying.

The existing §§ 1.19(b)(1) and (2) do not provide for supplying copies of the non-paper portion of a file wrapper (e.g., compact discs). Under the current practice, for example, copies of compact discs associated with a file wrapper

must be ordered under existing § 1.19(b)(3) and are not provided with an order under existing §§ 1.19(b)(1) or 1.19(b)(2). Nothing in these proposed rule changes will change this practice. Similarly, any materials not in the IFW portion of a file wrapper (e.g., blueprints, microfiche, and video cassettes) are not included in these current sections or as proposed to be amended. To the extent, however, that documents may be uploaded from compact discs to be part of an IFW, those documents will be included with the IFW copy. In the event the Office cannot fill an order solely from the IFW, and must complete an order in part by copying paper files or compact discs, the fees of § 1.19(b)(2)(i) for pages over 400 will apply to any copies made from paper files, except those provided for under § 1.19(g) (e.g., blueprints), in which case the fee of § 1.19(g) will apply, and the fee for compact disc copies under § 1.19(b)(3) will apply to the copies of compact discs.

Patent applications and patents will normally reference any compact discs that are a part of the application specification. The public should therefore review the specification to determine if an order for compact discs should be included with an order to obtain the contents of an application or file wrapper. Other materials associated with a file wrapper (e.g., blueprints, video cassettes, compact discs exhibits not part of the specification) are not referenced in the specification of an application or patent. The Office does not maintain an index of other materials associated with any specific file wrapper.

Accordingly, the public should carefully review the contents of a file wrapper to determine if other materials associated with a file wrapper need to be separately ordered.

Customers will not be able to select the source for documents under §§ 1.19(b)(1) and (2) for filling an order.

The Office's experience with providing copies from an image system is that it is faster than providing copies from paper and it allows the Office to provide copies for regular orders with the same speed as expedited service. The service is also cheaper for the public so that excess page fees can be eliminated in most cases. The Office is considering charging a single fee for copies made from the IFW to recover an average cost and limiting the additional fee of § 1.19(b)(2)(ii) to paper copy non-IFW documents rather than actual cost depending on size, if public comment is favorable. The Office believes public comment should be favorable because it will result in lower overall costs to the

public and faster service. Lowered costs to the public and the Office occur because there will not need to be separate analysis and billing of the number of pages and excess pages copied. Faster service will occur because the Office will not have to delay orders while additional charges for excess pages are processed. Also, since the Office can provide the copies within a short period of time which would be faster than a seven-day service, at the same fee, it is proposed to remove the references to the slower non-expedited service, i.e., "seven-day."

Section 1.19(b)(3) is proposed to be amended by revising "on compact disc" to "in electronic form on a physical media" so that documents submitted on electronic forms other than compact discs may be made available on compact disc for the same fee as documents submitted on compact disc.

Section 1.19(g) is proposed to be added to provide for copying material that is not image scanned. Materials such as large blueprints, microfiche, and video cassettes cannot be scanned as electronic image equivalents, and an average cost for pricing cannot be computed in advance, because the demand for such copies is so infrequent. The Office proposes to charge the actual cost of copying of these materials.

Section 1.19(h) is proposed to provide for a mechanism for requesting copies of documents in a form other than that normally provided by the Office. The copies would be provided at cost. For example, a copy of an application so voluminous that it required many boxes of compact discs might be requested under this part on some other media such as DVD media instead of compact discs. Petitions would be decided under this section based upon the ability of the Office to provide the requested service and the adverse impact to the Office and the public from diverting resources to fulfilling the order.

*Section 1.27:* Section 1.27 is proposed to be amended to make certain clarifying changes. The proposed changes would clarify that: (1) A security interest held by a large entity would not be a sufficient interest to bar entitlement to small entity status; (2) the requirements for small business concerns regarding transfer of rights and the size standards of the Small Business Administration are additive; and (3) business concerns are not precluded from claiming small entity status merely because they are located in or operate primarily in a foreign country.

Section 1.27 is proposed to be amended to revise paragraphs (a)(1), (a)(2)(i), and (a)(3)(i) to change "obligation" to "currently enforceable



obligation.” Questions have arisen as to whether a security interest in an application or patent held by a large entity is a sufficient interest to prohibit claiming small entity status. For example, an applicant or patentee may take out a loan from a banking institution and the loan may be secured with rights in a patent application or patent of the applicant or patentee, respectively. The granting of such a security interest to the banking institution is not a currently enforceable obligation to assign, grant, convey, or license any rights in the invention to the banking institution. Only if the loan is defaulted upon will the security interest cause a transfer of rights in the application or patent to the banking institution. Thus, where the banking institution is a large entity, the applicant or patentee would not be prohibited from claiming small entity status merely because the banking institution has been granted a security interest, but if the loan is defaulted upon, there would be a loss of entitlement to small entity status. Pursuant to § 1.27(g), notification of the loss of entitlement would need to 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 small entity status is no longer appropriate. The proposed change to paragraphs (a)(1), (a)(2)(i), and (a)(3)(i) is intended to clarify that the obligation to assign, grant, convey, or license any rights in the invention must be a currently enforceable obligation and thus a security interest in an application or patent held by a large entity would not be a sufficient interest to bar entitlement to small entity status. The proposed change would not result in any change to the standards for determining entitlement to small entity status.

A few additional examples will further clarify when small entity status is or is not appropriate.

*Example 1:* On January 2, 2002, an application is filed with a written assertion of small entity status and the small entity filing fee is paid. Applicant is entitled to claim small entity status when the application is filed. Thereafter, the application is allowed and the small entity issue fee is timely paid on October 1, 2002. On October 2, 2002, applicant signs a license agreement licensing rights in the invention to a large entity. On October 1, 2002, applicant had not transferred any rights in the invention, and was under no obligation to transfer any rights in the invention, to any other party who would not qualify for small entity status. The payment of the small entity issue fee would be proper as long as the applicant was under no obligation on

October 1, 2002, to sign the license agreement with the large entity.

*Example 2:* An applicant, who would otherwise qualify for small entity status, executes an agreement with a large entity. The agreement requires the applicant to assign a patent application to the large entity sixty days after the application is filed. Thereafter, the application is filed. Since the applicant is under an existing obligation to assign the application to a large entity, applicant would not be entitled to claim small entity status. Applicant would need to pay the large entity filing fee even though the actual assignment of the application to the large entity may not occur until after the date of payment of the filing fee.

Furthermore, § 1.27 is proposed to be amended to change the period at the end of paragraph (a)(2)(i) to “; and” to clarify that paragraphs (a)(2)(i) and (a)(2)(ii) are additive requirements and a party seeking to qualify as a small business must meet both requirements as to transfer of rights and Small Business Administration requirements.

Section 1.27(a)(2)(ii) is proposed to be amended to change “[m]eets the standards set forth in 13 CFR part 121” to “[m]eets the size standards set forth in 13 CFR 121.801 through 121.805 to be eligible for reduced patent fees.”

Questions have also arisen as to whether a small business concern must have a place of business located in the United States, and operate primarily within the United States or make a significant contribution to the United States economy through the payment of taxes or use of American products, materials or labor (13 CFR 121.105) to be eligible to pay reduced patent fees under 35 U.S.C. 41(h). When the provisions of 35 U.S.C. 41(h) (Public Law 97-247, 96 Stat. 317 (1982)) were implemented in 1982, a suggestion that foreign concerns not be eligible to pay reduced patent fees under 35 U.S.C. 41(h) was considered and rejected because excluding foreign concerns would violate United States treaties in the patent area. *See Definition of Small Business for Paying Reduced Patent Fees Under Title 35, United States Code*, 47 FR 43272 (Sept. 30, 1982), 1023 *Off. Gaz. Pat. Office* 27 (Oct. 19, 1982) (final rule). Specifically, a provision that foreign concerns are not eligible to pay reduced patent fees under 35 U.S.C. 41(h) would violate Article 2 of the Paris Convention for the Protection of Industrial Property, which provides that nationals of any Paris Convention country shall, as regards the protection of industrial property, enjoy in all the other Paris Convention countries the advantages that their respective laws grant to nationals of that country. Therefore, a business concern which meets the small business requirements

set forth in 13 CFR 121.801 through 121.805 and complies with applicable Office procedures is and continues to be eligible to pay reduced patent fees under 35 U.S.C. 41(h), even if the business concern is located in or operates primarily in a foreign country.

*Section 1.47:* Section 1.47(a) and (b) are proposed to be amended to refer to the petition fee set forth in § 1.17(g) for consistency with the change to § 1.17. See discussion of § 1.17.

*Section 1.52:* Section 1.52, paragraphs (b)(1)(ii), (b)(2)(ii), (d)(1) and (e), are proposed to be amended.

Section 1.52, paragraphs (b)(1)(ii) and (d)(1) are proposed to be amended to require that the statement that the translation is accurate be signed by the individual who made the translation. The Office has received a number of inquiries as to who may sign the statement, and has decided that it is appropriate to include the requirement that the signature required is that of the translator into the rules of practice. See also the proposed amendments to §§ 1.55(a)(4), 1.69(b) and 1.78(a)(5)(iv). The requirement that the person who made the translation sign the statement that the translation is accurate is consistent with current § 3.26.

Currently, anyone, including practitioners, who would have sufficient knowledge concerning the accuracy of the translation to comply with the averments of §§ 1.4(d)(2) and 10.18 may sign the accuracy statement regarding the translation. As a result, translations are being received by the Office accompanied by statements signed by practitioners stating that the translations are believed to be accurate “based on information and belief.” Such type of qualification by a party unrelated and several parties removed from the one doing the translation does not lend itself to confidence by the Office that care has been taken with the translation.

Accordingly, the Office believes it to be appropriate to require the party doing the actual translation to make the statement of accuracy, particularly to ensure that the translator is covered by §§ 1.4(d)(2) and 10.18.

Section 1.52(b)(2)(ii) is proposed to be revised to recommend that the font size of text be at least a font size of 12, which is approximately 0.166 inches or 0.422 cm. high. Section 1.52(b)(2)(ii) currently requires that the text be in a lettering style that is at least 0.08 inches high, which is the font size set forth in Patent Cooperation Treaty (PCT) Rule 11.9. A font size of only 0.08 inches leads to difficulty in capturing text with optical character recognition technology and may not be reproducible as required by § 1.52(a)(1)(v) (and PCT Rule 11.2(a)). A

font size of 12 (0.422 cm. or 0.166 inch high) is significantly more reproducible. Accordingly, § 1.52(b)(2)(ii) is proposed to be amended to indicate a preference for a larger font size. See § 1.58(c) for a similar change.

Further, § 1.52 is proposed to be amended to allow greater flexibility in filing tables on compact disc, so that compact disc files may be used instead of paper where the total number of pages collectively occupied by all the tables in an application exceeds 100. Also, § 1.52 is proposed to be clarified to be consistent with tables submitted on paper as to what constitutes a page. Section 1.52 is proposed to be amended to recite that CD-R discs should be finalized so that they are closed to further writing.

Section 1.52(e)(1)(iii) is proposed to be amended to allow tables of any size on compact disc if the total number of pages of tables exceeds 100 pages. Since permitting the filing of tables on compact disc, the Office has received voluminous applications having large numbers of tables that were under 50 pages in length. Applicants have indicated that it would be less burdensome filing these small tables on compact disc. Accordingly, the rule is being liberalized while balancing the convenience of the Office and the public to view the document with the least burden imposed by dual media.

Section 1.52(e)(1)(iii) is also proposed to be amended to clarify what constitutes an electronic page so as to determine compliance with the 50- and 100-page requirement for submission of tables on compact disc.

Further clarification is proposed to be provided in § 1.52(e)(3)(i) as to what is a permanent compact disc. Recordable compact discs can be made for recording in a single recording session or in multiple recording sessions. To further assure the archival nature of the discs, the requirement that recordable discs be finalized so that they are closed to further recording is proposed to be added to § 1.52. Further, many older CD-ROM drives and audio CD players have compatibility problems with unfinalized CDs. This proposed change will ensure that the public and the Office will be able to use identical copies of any CDs filed with older CD-ROM drives.

The Office is actively investigating allowing the submission of other file formats, such as the Continuous Acquisition and Life Cycle Support (CALS) XML format, in addition to the current ASCII format. Before allowing the use of a file format, the Office must verify that applicants will have the tools to create files easily that are archivable

and can be rendered to be viewable both by the Office users and later by the public when the application is published. Problems involving file size limitations, software display, and availability of adequate table creation software are delaying implementation at this time. The Office intends to broaden § 1.52 to allow at least CALS format tables when these problems are resolved. Technical specifications and a discussion of operability issues for the CALS table format may be found at the OASIS, *i.e.*, Organization for the Advancement of Structured Information Standards, Web site pages <http://www.oasis-open.org/cover/tr9502.html> and <http://www.oasis-open.org/specs/a501.htm>.

The Office is also reviewing the acceptability of DVD media. At present, there are several different types of recordable DVD media and it is unclear which if any will become a standard archivable format. Also, the Office is upgrading its capabilities to include the ability to read at least some types of DVD media. However, it does not appear that any DVD readers can be procured that will be able to read all of the different types of DVD media that are now in the marketplace. The Office is considering allowing submissions on at least some types of DVD media when it becomes clear which types of DVD media are recognized as of archivable quality and are compatible with Office hardware and software.

**Section 1.53:** Section 1.53(e)(2) is proposed to be amended to refer to the petition fee set forth in § 1.17(f) for consistency with the change to § 1.17. See discussion of § 1.17.

**Section 1.55:** Section 1.55(a)(1)(ii) is proposed to be amended to replace "an application that entered the national stage from an international application after compliance with 35 U.S.C. 371" with "an international application designating the United States" (any application that enters the national stage from an international application after compliance with 35 U.S.C. 371 is also an "international application designating the United States"). While section 4508 of the American Inventors Protection Act of 1999 (AIPA) as originally enacted did not make the eighteen-month publication amendments to 35 U.S.C. 119 and 120 applicable to an international application unless and until it enters the national stage under 35 U.S.C. 371 (see Public Law 106–113, 113 Stat. 1501, 1501A–566 through 1501A–567 (1999)), section 13205 of Public Law 107–273 amended section 4508 of the AIPA to make the eighteen-month publication amendments to 35 U.S.C. 119 and 120

in the AIPA also applicable during the international stage of an international application. See 116 Stat. 1758, 1903 (2002).

Section 1.55(a)(1) is also proposed to be amended to add a paragraph (a)(1)(iii) to provide that if an application claiming the benefit of a prior foreign application meets the twelve-month filing period requirement in 35 U.S.C. 119(a) only through one or more prior-filed nonprovisional applications or international applications designating the United States for which a benefit is claimed under 35 U.S.C. 120, 121, or 365(c) and § 1.78(a), each such prior-filed application must also contain a claim for priority in compliance with § 1.55 to the prior foreign application. 35 U.S.C. 119(b)(1) provides that an application for patent is not entitled to priority under 35 U.S.C. 119(a)–(d) unless a claim is filed in the Office at such time during the pendency of the application as required by the Director. 35 U.S.C. 119(b)(2) also provides that the Director may consider the failure of the applicant to file a timely claim for priority as a waiver of any such claim, and that the Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed claim under 35 U.S.C. 119(a)–(d). This time period requirement is to ensure that priority claims under 35 U.S.C. 119(a)–(d) are presented in sufficient time to permit publication of the application at eighteen months from the earliest claimed priority date under 35 U.S.C. 119(a)–(d). See 145 Cong. Rec. S14,708, S14,719 (1999) (daily ed. Nov. 17, 1999) (the Conference Report for H.R. 3194, 106th Cong., 1st Sess. (1999), which resulted in Public Law 106–113, does not contain any discussion (other than the incorporated language) of S. 1948; however, a section-by-section analysis of S. 1948 was printed in the Congressional Record at the request of Senator Lott). In addition, priority claims must be presented in a timely manner in a PCT international application filed under 35 U.S.C. 363 to determine (among other things) the time limit for national stage entry. Therefore, the Office is proposing to amend § 1.55(a) to add a paragraph (a)(1)(iii) to make clear that the first-filed application in a chain of applications (as well as all intermediate applications) must contain a claim for priority in compliance with § 1.55 to a prior foreign application for a subsequent application to claim the benefit of the prior foreign application through the first-filed application (and all intermediate applications).

In *In re Tangsrud*, 184 USPQ 746 (Comm'r Pat. 1973), the Office held that a certified copy of a foreign priority document may be filed in a continuation application under § 1.60, rather than in its abandoned parent application, to meet the requirements in 35 U.S.C. 119 for the continuation application to claim the benefit of the foreign priority application (through its abandoned parent application). The language of *Tangsrud*, however, is broad enough to imply that neither the claim for priority nor the certified copy of the foreign priority document must be filed in the first-filed application for a subsequent application to claim the benefit of the foreign priority application through the first-filed application. This proposed change to § 1.55(a) would not affect the holding in *Tangsrud* that the certified copy of the foreign priority document may be filed in a continuing application, rather than in an abandoned first-filed application, provided that a claim for priority in compliance with § 1.55 to a prior foreign application is presented in the first-filed application.

Section 1.55(a)(4) is proposed to be amended to require that the statement that the translation is accurate be signed by the individual who made the translation. The Office has received a number of inquiries as to who may sign the statement, and has decided that it is appropriate to include the requirement that the signature required is that of the translator into the rules of practice. See also the proposed amendments to §§ 1.52(b)(1)(ii), 1.52(d)(1), 1.69(b) and 1.78(a)(5)(iv). The requirement that the person who made the translation sign the statement that the translation is accurate is consistent with current § 3.26.

Section 1.55(c) is proposed to be amended to change "365(a)" to "365(a)-(b)" such that the procedures for acceptance of delayed priority claims under § 1.55(c) also apply to delayed priority claims under 35 U.S.C. 365(b) in international applications.

**Section 1.57:** Section 1.57 is proposed to be added to provide for incorporation by reference. Section 1.57(a) as proposed provides that, if all or a portion of the specification or drawings is inadvertently omitted from an application, but the application contains a claim under § 1.55 for priority of a prior-filed foreign application, or § 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application, that was present on the date of receipt of the application, and the omitted portion of the specification or drawings is completely contained in the prior-filed

application, the claim would be considered an incorporation by reference of the prior-filed application. Sections 1.57(b) through (f) as proposed treat incorporation by reference into an application of essential and nonessential material by: (1) Providing a definition of essential and nonessential material; (2) defining specific language that must be used to trigger an incorporation by reference; (3) codifying current practice as set forth in MPEP § 608.01(p) (Incorporation by Reference), updated to reflect the publication of applications; and (4) codifying treatment of improper incorporation by reference.

Currently, the mere reference to another application is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure under 35 U.S.C. 112, ¶ 1. See MPEP §§ 201.06(c) and 608.01(p), and *In re de Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). The proposed rule would allow all or a portion of the specification or drawings that is inadvertently omitted from an application containing a priority claim for a prior-filed foreign application, or a benefit claim for a prior-filed provisional, nonprovisional, or international application, to be added to the application by way of an amendment if the omitted portion of the specification or drawings is completely contained in the prior-filed application even though there is no explicit incorporation by reference of the prior-filed application. The phrase "completely contained" in § 1.57(a) requires that the material to be added to the application under § 1.57(a) must be expressly (as opposed to implicitly) disclosed in the prior application. Cf. PLT Rule 2(4)(iv). The claim for priority or benefit would have to be present on the date of receipt of the application in order for it to be considered an incorporation by reference of the prior-filed application. The nonprovisional application claiming benefit could be a continuation, divisional, or continuation-in-part of the prior application for which benefit is claimed. The purpose of the proposed rule is to provide a safeguard for applicants when a page(s) of the specification, or a portion thereof, or a sheet(s) of the drawings, or a portion thereof, is inadvertently omitted from an application.

If all or a portion of the specification or drawings is inadvertently omitted from an application and applicant wants to rely on the incorporation by reference provided by the proposed rule, the application would need to be amended

to include the omitted portion of the specification or drawings within the time period set by the Office, but in no case later than the close of prosecution as defined by § 1.114. In order for the omitted material to be included in the application, the application must be amended to include it. The incorporation by reference provided by the proposed rule requires an applicant to timely amend the application to include the omitted material in order for this material to be considered part of the disclosure. The proposed rule gives the examiner the authority to require the applicant to supply a copy of the prior-filed application, to supply an English-language translation of any prior-filed application that is in a language other than English, and to identify where the omitted portion of the specification or drawings can be found in the prior-filed application.

Any amendment to an international application pursuant to the proposed rule would be effective only as to the United States. See proposed § 1.57(a)(2). In addition, no request to add the missing part of the description or the missing drawing in an international application designating the United States will be acted upon by the Office prior to the expiration of the applicable time limit under PCT Article 22(1) or (2), or Article 39(a).

If an application is not entitled to a filing date under § 1.53(b) or under PCT Article 11, the amendment must be by way of a petition accompanied by the fee set forth in § 1.17(f). See proposed § 1.57(a)(3).

The proposed rule is similar to the current practice under MPEP § 201.06(c) where there is an explicit incorporation by reference of the prior U.S. application contained in the specification or in the application transmittal letter of a continuation or divisional application filed under § 1.53(b). See MPEP § 201.06(c) (Incorporation by Reference). The proposed rule is also consistent with the PLT Article 5(6)(b) and Rule 2(3) and (4).

Of course, whether the proposed rule is adopted or not, applicants may continue to explicitly incorporate by reference a prior application or applications by including, in the body of the specification as filed, a statement that the prior application or applications is "hereby incorporated by reference." Such an explicit incorporation by reference would not be limited to inadvertent omissions as in the proposed rule. Accordingly, applicants are encouraged to explicitly incorporate by reference a prior application or applications by including

such a statement in the body of the specification, if appropriate.

Sometimes applicants intentionally omit material from a prior-filed application when filing an application claiming priority to, or benefit of, a prior-filed application. As discussed, the incorporation by reference would only permit material that was inadvertently omitted from the application to be added to the application if the omitted material is completely contained in the prior-filed application. Therefore, if the proposed rule were adopted, applicants would still be able to intentionally omit material contained in the prior-filed application from the application containing the priority or benefit claim without the material coming back in by virtue of the incorporation by reference. Applicants would be able to maintain their intent by simply not amending the application to include the intentionally omitted material. Thus, there should be no impact from the proposed rule in continuing applications where material from the prior application has been intentionally omitted. Therefore, the proposed rule has been drafted such that the application claiming benefit of a prior U.S. application could be a continuation-in-part application (as well as a continuation or divisional).

The proposed rule would not apply to any applications filed before the effective date of the rule. The proposed rule would be prospective only since to apply the rule retroactively would result in changing the expectations regarding incorporation by reference by applicants when the applications were filed.

The Office is interested in comments from the public regarding proposed § 1.57(a), whether there is support or opposition for the proposed rule, and whether there is any desire to limit the proposed rule to continuation or divisional applications and not have it apply to continuation-in-part applications.

Section 1.57(b) clarifies what is acceptable language that identifies an incorporation by reference for essential and non-essential matter as opposed to incorporation by reference of material in a prior application as is proposed in § 1.57(a). Applicants sometimes refer to other applications, patents, and publications, including patent application publications using language which does not clearly indicate whether what is being referred to is incorporated by reference or is just an informational reference. The Office is proposing to limit incorporation by reference (except as provided in § 1.57(a)) to instances only where the words "incorporated by reference" appear. The Office is

attempting to bring greater clarity to the record and provide a bright line test as to where something being referred to is an incorporation by reference. The Office considered the alternative of making any mention of a document an automatic incorporation by reference of the document. Patent applications frequently contain a discussion of prior art documents when discussing the background of the invention, which prior art documents are not intended to be incorporated by reference. The necessity for § 1.57(b) is that applicants who fail to clearly link certain disclosures to means-plus-function language risk having their claims interpreted too narrowly or held unenforceable. Clarifying when material is incorporated by reference during examination by use of specific trigger language is considered an aid to applicants when they invoke 35 U.S.C. 112, ¶ 6. Applicants would be aided by avoiding narrowed claim construction as a result of a number of court decisions which would not look for equivalents outside of the application. See *Atmel Corp. v. Info. Storage Devices Inc.*, 198 F.3d 1374, 53 USPQ2d 1225 (Fed. Cir. 1999), and *B. Braun Medical Inc. v. Abbott Lab*, 124 F.2d 1419, 43 USPQ2d 1896 (Fed. Cir. 1997). Treating these documents as automatically incorporated might result in unintended consequences such as when a means-plus-function claim is presented under 35 U.S.C. 112, ¶ 6.

Similarly, applicants would be aided by not having their claims found unpatentable by a mere reference to outside material unintentionally incorporating material that contained equivalents that would broaden their claims to encompass the prior art. Automatic incorporation by reference would create a trap for applicants and practitioners by creating unintentional equivalents for 35 U.S.C. 112, ¶ 6, language broadening claims to be unpatentable. Additionally, as claims are generally read in light of the specification, what is actually incorporated into the specification can affect the scope of the claims independent of 35 U.S.C. 112, ¶ 6.

Accordingly, comments are desired identifying alternative language to that proposed in paragraph (b) or why requiring this specific language would be a problem.

A patent application incorporating by reference other material must, as described in paragraph (b), include an identification of the referenced patent, application, or publication pursuant to § 1.98(b)(1) through (b)(5). The Office recommends that particular attention be directed to specific portions of

referenced documents where the subject matter incorporated may be found if large amounts of material are incorporated. Guidelines for situations where applicant is permitted to fill in a number for Application No. \_\_\_\_ left blank in the application as filed can be found in *In re Fouché*, 439 F.2d 1237, 169 USPQ 429 (CCPA 1971). Commonly assigned abandoned applications less than 20 years old can be incorporated by reference to the same extent as copending applications; both types are open to the public upon the referencing application issuing as a patent. See MPEP § 103.

Section 1.57(c) codifies current practice in MPEP § 608.01(p) (Incorporation by Reference), except that § 1.57(c) as proposed is limited to U.S. patent or U.S. patent application publications (*i.e.*, the Office proposes to eliminate the practice of incorporating by reference essential material in unpublished patents in which the issue fee for an application has been paid but the application has not yet issued as a patent). Delays in issuance or the withdrawal from issue of an allowed application put in doubt that an application incorporated by reference will be available to the public when a patent incorporating the other application issues. Similarly, this provision permitting only the incorporation of the publication document of an application is intended to preclude incorporation by reference of material found only in the redacted portion of a published patent application.

Section 1.57(c) updates current practice to reflect publication of applications in two areas. Current practice permits holding in abeyance correction of material incorporated by reference from unpublished U.S. applications that have not issued as patents until allowance of the application making the incorporation by reference. Publication of the applications which contain an incorporation by reference means that the public will need access to the material incorporated by reference prior to an application being issued as a patent. Where the incorporation is to an unpublished application that has not issued as a patent, such application is not readily available. Therefore, holding the correction of an incorporation by reference in abeyance in this situation will materially impair the public's access to the invention that is disclosed by the published application that incorporates an unpublished application.

The Office considered but rejected including unpublished abandoned

applications (which are otherwise open to the public under § 1.14(a)(iv)) as acceptable documents for incorporation by reference since the text of abandoned applications is not published after abandonment on the Internet at this time. The Office is considering how to make previously unpublished material to which the public is currently permitted access pursuant to § 1.14(a)(iv) (e.g., unpublished incorporated by reference applications) available on the Internet. The Office may reconsider this position when its electronic file wrapper permits access to the text of unpublished abandoned applications on the Internet.

Section 1.57(c)(1) through (c)(3) defines essential material as those items required by 35 U.S.C. 112, ¶¶ 1, 2, and 6.

Section 1.57(d) defines the scope of incorporation by reference practice for nonessential subject matter. As discussed with respect to § 1.57(c), the Director has considerable discretion in determining what may or may not be incorporated by reference in a patent application. Through the Office's incorporation by reference policy, the Office ensures that reasonably complete disclosures are published as U.S. patents and U.S. application publications.

Section 1.57(e) is added so that it is clear that a copy of the incorporated by reference material may be required to be submitted to the Office even if the material is properly incorporated by reference. The examiner may require a copy of the incorporated material simply to review it and understand what is being incorporated or to put the description of the material in its proper context. Another instance where a copy of the reference may be required is where the material is being inserted by amendment into the body of the application to replace the incorporation by reference statement.

Section 1.57(f) addresses corrections of incorporation by reference. Section 1.57(f) provides that improper incorporation by reference statements may be corrected with a timely filed amendment. Nothing in § 1.57(f) authorizes the insertion of new matter into an application. The Office is concerned that improper incorporation by reference statements and late corrections thereof require the expenditure of unnecessary examination resources and slow the prosecution process. By treating improper incorporation by reference statements as not incorporating any material (until the incorporation by reference is corrected), the Office and applicants will avoid expending unnecessary resources and

delays in prosecution occasioned by the many references to extraneous material that are often found in patent applications. Applicants know whether they want material incorporated by reference, and must timely correct any incorporation by reference errors.

*Section 1.58:* Section 1.58(a) is proposed to be amended to provide that a table not be included in both the drawings and in the body of the specification of an application. Section 1.58(b) is also proposed to be amended to clarify that correct visual alignment of rows and columns of chemical and mathematical formulae and tables is retained when the electronic file is rendered by opening and displaying the electronic file at the Office using a text viewer program. Section 1.58(c) is additionally proposed to be amended to recommend that the font size of text be at least 0.166 inches or 0.422 cm. and to eliminate a reference to elite type font.

Section 1.58(a) is proposed to be amended because applicants have been making voluminous applications even larger by including the same table as both a drawing figure and as text in the body of an application. Filing duplicate tables requires additional review by the Office to determine if the drawing table and the text table are duplicates and to identify differences if any differences exist. Moreover, the number of pages is effectively increased, causing increased scanning, storage and reproduction costs. In addition, the burden on the public to copy and review a published application or patent is also increased. *See* § 1.83 for a similar proposed change involving tables and sequence listings.

Section 1.58(b) is proposed to be amended adding "visually" so that it is clear that the data in the electronic file are appropriately formatted so that the alignment of rows and columns is maintained in the table when the file is opened to view at the Office. The Office has found that some filers have only been providing markers to identify rows and columns in table data. When the table is viewed at the Office the markers do not cause the rows and columns of data to be visually aligned. Unless each entry in a table is surrounded with an appropriate number of spaces the visual spatial alignment of the table is not maintained: i.e., the rows and cells are mis-aligned. A way to provide the proper alignment is to insert space characters in each cell so that the overall number of characters in each cell is the same, and to maintain a constant font width for all characters.

Many programs that are used to generate tables allow the user to provide additional spaces manually when typing

data. Many of these programs also provide an automated way to pad the cells with space characters, and create an ASCII file with spatially aligned data. This feature is generally invoked by a command that is often called printing to a "formatted text" format or "prn" file. The program formats the table as it would appear on paper padding the cells with spaces to provide proper alignment of the cell entries.

A review of different versions of the same software product and of different software products showed no consistency in the menu language used for the formatting command noted above. With the constant change in software versions, the Office is not able to provide a list of all the menu variations. However, a person knowledgeable with the software used to create tabular data should be able to find the commands to invoke this feature in the software.

Section 1.58(c) is proposed to be amended for the same reason that § 1.52(b)(2)(ii) is proposed to be amended. Section 1.58(c) currently requires that the text be in a lettering style that is at least 0.08 inches high, which is the minimum font size set forth in Patent Cooperation Treaty (PCT) Rule 11.9. Text having a font size only 0.08 inches high is difficult to capture with optical character recognition technology and may not be reproducible as required by § 1.52(a)(1)(v) (and PCT Rule 11.2(a)). A font size of 12 (12/72 inch or 0.166 inch (0.422 cm.) high) is significantly more reproducible than a font size of 6 (6/72 inch or 0.08 inch (0.211 cm.) high). Accordingly, § 1.58(c) is proposed to be amended to indicate a preference for a larger font size. In addition, the reference to elite type is proposed to be deleted as it was inconsistent with the size given. Elite type is a typewriter type that runs 12 characters to the inch. Instead of referencing elite type, the rule is proposed to reference a font size of 6 which should be more meaningful to most patent applicants (most word processing software programs have an option to choose a font and a font size).

*Section 1.59:* Section 1.59 is proposed to be amended to refer to the petition fee set forth in § 1.17(g) for consistency with the change to § 1.17. *See* discussion of § 1.17.

*Section 1.69:* Section 1.69(b) is proposed to be amended by deleting the words "or approved" as unnecessary, and possibly leading to confusion and the mistaken assumption that the Office has a procedure for the approval of applicant generated forms, where no such procedure exists. *See Changes to Implement the Patent Business Goals,*

64 FR 53771, 53777 (Oct. 4, 1999), 1228 *Off. Gaz. Pat. Office* 15, 20 (Nov. 2, 1999) (proposed rule) (declining to adopt a review service for applicant-created forms). In addition, paragraph (b) of § 1.69 is proposed to be amended to require that the statement that the translation is accurate be signed by the individual who made the translation. The Office has received a number of inquiries as to who may sign the statement required by the current rule and how the statement must be signed. The Office has decided to clarify that the signature required is that of the translator. See also the proposed amendments to §§ 1.52(b)(1)(ii), 1.52(d)(1), 1.55(a)(4) and 1.78(a)(5)(iv). The requirement that the person who made the translation sign the statement that the translation is accurate is consistent with current § 3.26.

**Section 1.76:** Section 1.76(a) is proposed to be amended to require that any application data sheet (ADS) contain the seven headings listed in § 1.76(b) and all of the appropriate data for each section heading. The proposed amendment would also require that the ADS be titled "Application Data Sheet." Any label (*e.g.*, the label "Given Name" in the "Applicant Information" heading) that does not contain any corresponding data will be interpreted by the Office to mean that there is no corresponding data for that label anywhere in the application. By requiring an ADS to contain all seven section headings, and any appropriate data for the sections, the accuracy of bibliographic data in patent applications will be enhanced and the need for corrected filing receipts related to Office errors will be reduced.

Section 1.76(c)(2) is proposed to be amended to require a supplemental application data sheet to be labeled "Supplemental Application Data Sheet" and to also contain all of the headings listed in § 1.76(b) with any appropriate data for each heading, rather than only identifying the information that is being changed (added, deleted, or modified) in the supplemental ADS. Requiring a supplemental ADS to contain all of the information from the ADS with the changes indicated is consistent with the ADS guide posted on the Office's Internet Web site at: <http://www.uspto.gov/web/offices/pac/dapp/sir/doc/patappde.html>. A supplemental ADS containing only new or changed information is likely to confuse the record, create unnecessary work for the Office, and would not comply with § 1.76 if amended as proposed. When submitting an ADS after the initial filing of the application to correct, modify, or augment the original application data included in an ADS, the following

applies: (1) The supplemental application data sheet must be labeled "Supplemental Application Data Sheet"; (2) the "Supplemental Application Data Sheet" is a full replacement copy of the original application data sheet, with each of the seven section headings, and with any appropriate data for the section headings; and (3) the "Supplemental Application Data Sheet" must be submitted with any changes or additions underlined (for deletions without replacement data, use strike-through or brackets).

When submitting an ADS to correct, modify, or augment application data (*see* § 1.76(d)), when an ADS has not been previously filed, the first-filed ADS is not considered a supplemental ADS even if such is filed subsequent to the initial filing of the oath or declaration. When submitting such an ADS: (1) The application data sheet must be labeled "Application Data Sheet"; and (2) a complete application data sheet including all appropriate information for each heading must be submitted.

**Section 1.78:** Section 1.78(a)(1) is proposed to be amended to delete an unnecessary alternate condition to permit a claim for the benefit of a prior-filed application. Sections 1.78(a)(2) and (a)(5) are proposed to be amended to permit the required reference to the prior application(s) to be in multiple sentences at the beginning of the specification, rather than being limited to the first sentence of the specification.

Section 1.78(a)(1) sets forth the conditions under which a nonprovisional application may claim the benefit of one or more prior-filed copending U.S. nonprovisional applications or international applications designating the United States of America. Where the prior-filed application is a nonprovisional application (filed under 35 U.S.C. 111(a)), one of the conditions under § 1.78(a)(1) is met when the prior-filed application satisfied any one of paragraphs (ii), (iii) or (iv) of § 1.78(a)(1). To satisfy paragraph (ii), the prior-filed application must be "[c]omplete as set forth in § 1.51(b)." To satisfy paragraph (iii), the prior-filed application must be "[e]ntitled to a filing date as set forth in § 1.53(b) or § 1.53(d) and include the basic filing fee set forth in § 1.16." Considering that paragraph (iii) is less restrictive than paragraph (ii), it is proposed to delete paragraph (ii) (and redesignate paragraphs (iii) and (iv) as paragraphs (ii) and (iii), respectively) as it is unnecessary because any prior-filed application that would satisfy paragraph (ii) would also satisfy paragraph (iii).

Sections 1.78(a)(2)(iii) and (a)(5)(iii) are proposed to be amended to change the word "sentence" to "sentence(s)". The proposed change would permit the required reference to the prior application(s) to be in more than one sentence at the beginning of the specification. In some situations, it would be easier and clearer to set forth the relationship between prior applications if more than one sentence were permitted. For example, where there is a provisional application and multiple intermediate nonprovisional applications, the required identification in the latest nonprovisional application as to which intermediate nonprovisional application(s) claims benefit to the provisional application (*i.e.*, is within one year of the provisional application's filing date), could be set forth in a clearer manner using multiple sentences.

Section 1.78(a)(5)(iv) is proposed to be amended to require that the statement that the translation is accurate be signed by the individual who made the translation. The Office has received a number of inquiries as to who may sign the statement, and has decided that it is appropriate to include the requirement that the signature required is that of the translator into the rules of practice. See also the proposed amendments to §§ 1.52(b)(1)(ii) and (d)(1), 1.55(a)(4) and 1.69(b). The requirement that the person who made the translation sign the statement that the translation is accurate is consistent with current § 3.26.

Section 1.78(c) is proposed to be amended to clarify that the prior art exception under 35 U.S.C. 103(c) does not apply to double patenting rejections by the addition of the last sentence, which states "Even if 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 conflicting claims may be rejected under the doctrine of double patenting in view of such commonly owned or assigned applications or patents under reexamination." Therefore, § 1.78(c) emphasizes that double patenting rejections should still be made, when appropriate, even if a reference is disqualified from being used in a rejection under 35 U.S.C. 103(a) via the prior art exclusion under 35 U.S.C. 103(c). This clarification codifies patent policy regarding double patenting rejections and the prior art exclusion under 35 U.S.C. 103(c) as set forth in the notice *Guidelines Concerning the Implementation of Changes to 35 U.S.C. 102(g) and 103(c) and the Interpretation of the Term "Original Application" in*

the American Inventors Protection Act of 1999, 1233 Off. Gaz. Pat. Office 54 (Apr. 11, 2000)) and MPEP § 706.02(l)(1). Additionally, the first sentence of § 1.78(c) is proposed to be amended by changing the word "party" to "person" in order to use terminology consistent with 35 U.S.C. 103(c).

**Section 1.83:** Section 1.83(a) is proposed to be amended to provide that tables and sequence listings that are in the specification are not permitted to also be included in the drawings. Applicants should not be obliged to include tables or the sequence listing in the drawings due to the current requirement of § 1.83(a) that all claimed features must be shown in the drawings. Under the proposed amendment, if the specification includes a sequence listing or a table, such a sequence listing or table would not be permitted to be repeated in the drawings.

See § 1.58(a) for a similar proposed change to require that tables be included in only one of the drawings and the specification.

**Section 1.84:** Section 1.84 is proposed to be amended by revising § 1.84(a)(2)(iii) to remove the requirement for submission of a black and white copy of any color drawings or photographs. Section 1.84(a)(2)(iv) is proposed to be amended to become (a)(2)(iii). Section 1.84(c) is proposed to be amended to clarify that identification (labeling) of the drawings is recommended, but not required, and to change the recommended location of any identification of the drawings.

Section 1.84(a)(2) is proposed to be amended to remove the requirement for a black and white copy of a color drawing or photograph. This requirement has already been waived. See *Interim Waiver of Parts of 37 CFR 1.84 and 1.165, and Delay in the Enforcement of the Change in 37 CFR 1.84(e) to No Longer Permit Mounting of Photographs*, 1246 Off. Gaz. Pat. Office 106 (May 22, 2001).

Section 1.84(c) is proposed to be amended to remove the requirement that the identification of drawings must be placed on the front of each sheet of drawing, if the information is provided. The Office prefers that the identification of drawings be placed on the front of each sheet of drawing so that photocopies and scanned images of the drawings will be properly identified with the application. The Office has new scanners that will endorse in the top margin starting 3.5 inch from the right edge and ending 1 inch from the right edge of the paper. Therefore, applicants are strongly encouraged to place the information on the front of each sheet, to the left of the center on

the top margin so that the identification does not overlap the endorsement, and so that the identification will be included in any photocopies of the drawings. The Office, however, recognizes that some applications have long titles or identification that could not be placed completely on the front within the top margin. In such a situation, the identification of drawings may be placed on the back of each sheet (understanding that the backs of drawing sheets will not be scanned), but placing part of the identification (e.g., the application number and the first inventor's name) on the front is recommended. If the identification of drawings is placed on the front of each sheet, the identification must be placed to the left of center within the top margin.

**Section 1.91:** Section 1.91 is proposed to be amended to add a paragraph (c), which provides that a model or exhibit must be accompanied by photographs that show multiple views of the material features of the model or exhibit and that substantially conform to the requirements of § 1.84. Material features are considered to be those features which represent that portion(s) of the model or exhibit forming the basis for which the model or exhibit has been submitted. Since the Office generally returns or otherwise disposes of models or exhibits when they are no longer necessary for the conduct of business before the Office (§ 1.94), such photographs are necessary for the file of the application or proceeding to contain an adequate record of the model or exhibit submitted to the Office. Section 1.91(c) would also provide that this requirement does not apply if the model or exhibit substantially conforms to the requirements of § 1.52 or § 1.84, since a model or exhibit that substantially conforms to the requirements of § 1.52 or § 1.84 can itself be retained in the file wrapper of the application or proceeding.

In applications where the exhibit is not intended to display the medium of submission (e.g., video tapes, DVDs, and compact discs) but the content of the submission, the requirement that the photographs be of the substantive content is included in this paragraph. Video tapes, DVDs, and compact discs are usually submitted with movies or multimedia images. The requirement that the photographs submitted should show the material features that were being exhibited is intended to require that the photograph be that of the content of the material, not a photograph of the medium of submission. Hence, if video or multimedia submission is contained on

a tape or disc, the corresponding photograph should be a still image single frame of a movie, and not a submission of a photograph of a video cassette, DVD disc or compact disc.

A video or DVD is not the type of model or exhibit that would substantially conform to the requirements of §§ 1.52 or 1.84. The Office does not intend to store bulky items, such as videos, particularly as the Office is moving toward an Image File Wrapper. See *Changes To Implement Electronic Maintenance of Official Patent Application Records*, 68 FR 38611 (June 30, 2003). Accordingly, where a video or DVD or similar item is submitted as a model or exhibit, the requirement of § 1.91(c) for supplying photographs of what is depicted in the video or DVD, pursuant to § 1.84, would need to be met.

The Office is interested in comments as to whether the requirement for supplying photographs, particularly for a video or DVD, is overly broad and an adequate description could be presented by some other type of description, such as a written statement.

**Section 1.94:** Section 1.94 is proposed to be amended to be divided into paragraphs (a) through (c). Paragraph (a) provides that once notification is sent to applicant, arrangements must be made by applicant for the return of the model, exhibit, or specimen at applicant's expense, in response to such notification. Where the model, exhibit or specimen is a perishable, it will be presumed that the Office has permission to dispose of the item without notice to applicant, unless applicant notifies the Office upon submission of the item that a return is desired and arrangements are promptly made for its return upon notification by the Office.

Paragraph (b) provides that applicant is responsible for retaining the actual model, exhibit, or specimen for the enforceable life of any patent resulting from the application. Section 1.94 would also provide that its provisions do not apply: (1) If the model or exhibit substantially conforms to the requirements of § 1.52 or § 1.84, since a model or exhibit that substantially conforms to the requirements of § 1.52 or § 1.84 can itself be retained in the file wrapper of the application or proceeding; (2) where a model, exhibit, or specimen has been described by photographs that conform to § 1.84, or (3) where the model, exhibit, or specimen is a perishable.

Paragraph (c) provides that the notification to applicant will set a period of time within which applicant must make arrangements for a return of a model, exhibit, or specimen, with



extensions of time available under § 1.136, except in the case of perishables. The Office intends to set a one-month period of time from the mailing date of the notification for applicant to make arrangements for a return, unless the item is a perishable, in which case the time period will be shorter. Failure by applicant to establish that arrangements for the return of a model, exhibit or specimen have been made within the time period set in the notice, will result in the item being discarded by the Office.

**Section 1.98:** Section 1.98(a) is proposed to be amended by revising paragraph (a)(1) to require a specified format/identification for each page of an IDS, and that U.S. patents and U.S. patent application publications be listed in a section separately from citations of other documents. Section 1.98(a)(1) is specifically proposed to be amended to require that U.S. patents and U.S. patent application publications must be listed separately from the citations of other documents. This will permit the Office to optical character recognition (OCR) scan the U.S. patent numbers and the U.S. patent application publication numbers such that the document could be made available electronically to the examiner to facilitate searching and retrieval of U.S. patents and U.S. patent application publications on the Office's search databases. Applicants will comply with this proposed requirement if they use forms PTO/SB/08A and 08B (or the more commonly used PTO-1449), which provide a separate section for listing U.S. patents and U.S. patent application publications. Applicants who do not use these forms for submitting an IDS must make sure that the U.S. patents and U.S. patent application publications are listed in a separate section from citations of other documents.

Current § 1.98(a)(1) does not require the use of a form such as the PTO/SB/08A and 08B because the Office wishes to provide applicants the flexibility to use other types of lists. The Office, however, experiences problems associated with lists that do not properly identify the application in which the IDS is being submitted: *e.g.*, when applicants submit a list that includes copies of PTO-1449 or PTO-892 forms from other applications. Even though the IDS transmittal letter has the proper application number, each page of the list does not include the proper application number, but instead has the application numbers of the other applications. Should the pages of the list become separated, the Office cannot associate the pages with the proper application. Therefore, the rule is

proposed to be amended to require that each page of the list must clearly identify the application number of the application in which the IDS is being submitted.

Section 1.98(a)(1) is also proposed to be amended to require that a list must include a column that provides a space next to each document listed in order to permit the examiner to enter his or her initials next to the citations of the documents that have been considered by the examiner. This provides a notification to the applicant and a clear record in the application to indicate which documents have been considered by the examiner for the application. Applicants are strongly discouraged from submitting a list that includes copies of PTO/SB/08 (PTO-1449) or PTO-892 forms from other applications. A completed PTO/SB/08 or PTO-1449 form from another application may already have initials of another examiner and the application number of another application. The burden is then on the Office to correct the incorrect information. Furthermore, when the spaces provided on the form have initials of another examiner, there are no spaces available next to the documents listed for the examiner of the subsequent application to provide his or her initials.

Section 1.98(a)(1) is also proposed to be amended to require that each page of the list includes a heading that clearly indicates that the list is an information disclosure statement. Since the Office treats an IDS submitted by the applicant differently than information submitted by a third-party (*e.g.*, the Office may discard any non-compliant third-party submission under § 1.99), a heading on each page of the list to indicate that the list is an IDS would promote proper treatment of the IDS submitted by the applicant and reduce handling errors.

Section 1.98(e) is proposed to be amended to provide that the requirement in § 1.98(a)(2) for a copy of the U.S. patents or U.S. patent application publications listed in an information disclosure statement does not apply: (1) In any national patent application filed after June 30, 2003; (2) in any international application that has entered the national stage under 35 U.S.C. 371 and § 1.495 after June 30, 2003; or (3) in any information disclosure statement submitted in compliance with the Office's electronic filing system. *See Information Disclosure Statements May Be Filed Without Copies of U.S. Patents and Published Applications in Patent Applications filed after June 30, 2003*, 1273 *Off. Gaz. Pat. Office* 55 (Aug. 5, 2003).

**Section 1.102:** Section 1.102(c) would be amended to provide by rule for a petition to make an application special without a fee when the application relates to a counter-terrorism invention. The Office currently accords "special" status to patent applications relating to counter-terrorism technology so long as the fee under § 1.17(h) is included with the petition. Amending § 1.102(c) to cover applications relating to counter-terrorism inventions will eliminate the requirement for a fee.

Under current § 1.102(c), there are two types of inventions that qualify as a basis for making an application special without a fee (other than on the basis of an applicant's age or health), namely: (1) Inventions that will materially enhance the quality of the environment; and (2) inventions that will materially contribute to the development or conservation of energy resources. It is proposed that inventions that will materially contribute to countering terrorism be added as a third type of invention for making an application special without a fee under § 1.102(c). As set forth in MPEP § 708.02, XI (Inventions For Countering Terrorism), the types of technology for countering terrorism include, but are not limited to, systems for detecting/identifying explosives, aircraft sensors/security systems, and vehicular barricades/disabling systems. This is appropriate considering that such inventions may help maintain homeland security. In view of this proposed amendment, the basis for making applications relating to counter-terrorism technology special would be transferred from § 1.102(d) to § 1.102(c).

Pursuant to the proposed amendment, § 1.102(c) sets forth two bases for making an application special: (1) Applicant's age or health; or (2) that the invention is one of the three qualifying types of inventions (*i.e.*, the invention is one that will materially enhance the quality of the environment, materially contribute to the development or conservation of energy resources, or materially contribute to countering terrorism). In view of the divergent subject matter covered by § 1.102(c)(1) and (c)(2), a petition under § 1.102(c)(1) or (c)(2) must identify the particular basis under which applicant is petitioning for special status so that the Office can determine how to evaluate an application's entitlement to special status. In addition, MPEP § 708.02 indicates that a "petition for special status should be accompanied by a statement explaining how the invention contributes to countering terrorism" as defined in MPEP § 708.02, XI, Inventions For Countering Terrorism.

Applicants are reminded that any identification of a basis for requesting special status and a statement of compliance with the technology specific requirement for special status must be based upon a good faith belief that the invention in fact qualifies for special status. See §§ 1.56 and 10.18.

*Section 1.103:* Section 1.103(a) is proposed to be amended to refer to the petition fee set forth in § 1.17(g) for consistency with the change to § 1.17. See discussion of § 1.17.

*Section 1.105:* Section 1.105(a) is proposed to be amended to redesignate paragraph (a)(3) as paragraph (a)(4) and add new paragraphs (a)(1)(viii) and (a)(3). Sections 1.105(a)(1)(viii) and (a)(3) contain additional examples of information requirements and set forth exemplary formats to portray the use of § 1.105 to seek stipulations, for example, as to the knowledge of those of ordinary skill in the art, and to require responses to interrogatories, for example, as to applicant's understanding of the knowledge of persons of ordinary skill in the relevant art.

This proposal sets forth a practice for soliciting applicant's knowledge, such as stipulations to clarify the record by removing uncontroverted assertions from further consideration, or for soliciting the applicant's response to specific questions based on the applicant's knowledge to resolve outstanding issues. The requirement for information provisions of § 1.105(a)(1) contain several examples, not by any means exhaustive, of the types of information that may be required from applicants under § 1.105. The Office is proposing to add the following examples to § 1.105(a)(1): Technical information known to applicant concerning the interpretation of the related art, the disclosure, the claimed subject matter, other information pertinent to patentability, or the accuracy of the examiner's stated interpretation of such items. The format of such a requirement would differ markedly from the format of the existing examples, which generally require specific documents. New paragraph (a)(3) provides examples of formats for requirements for information: (1) a requirement for documents; (2) interrogatories in the form of specific questions seeking applicant's knowledge; or (3) stipulations in the form of statements with which the applicant may agree or disagree. The existing provisions of paragraph (a)(3) would be included in paragraph (a)(4), which would also recognize that information in the form of opinion might not be held, and permit a reply to a requirement for opinion to be

considered complete where it is stated that an opinion is not held.

35 U.S.C. 101, 102, 103 and 112 require that claimed subject matter be among those eligible for patentability, provide utility that is substantial, credible and specific, be supported by a written disclosure that teaches how to make and use the invention and be definite in characterization, and be novel and non-obvious to a person of ordinary skill in the art. Evidentiary issues surrounding these patentability conditions frequently arise that require applicant reply for resolution.

In particular, the knowledge and skill of a person of ordinary skill in the art is highly pertinent to the resultant utility, to the degree of disclosure required, and to the degree to which prior art reads on claimed subject matter in view of inherent aspects and standard practices and knowledge in the art. However, evidence of what the indicia would be for that knowledge and skill may be highly burdensome to collect, and may be particularly wasteful of examiner resources for certain elementary issues, such as in common matters of scientific and engineering practice.

The Office is considering the use of stipulations and interrogatories relating to elements of the prior art, recognitions of problems to be solved, and rationales for combinations.

Applicant and the examiner may agree on the knowledge exhibited by persons of ordinary skill in the art, and this may be documented by formal stipulation. Alternatively, the examiner may articulate specific questions for applicant response in the form of an interrogatory designed to elicit the aspects of the knowledge of persons of ordinary skill in the art pertinent to analyzing patentability arising from the art of record.

Additional instances where stipulations and interrogatories may be used to elicit information reasonably necessary to examination include eliciting: (1) Applicant's interpretation of the distinctions among claims; (2) applicant's interpretation of the common technical features shared among all claims, or admission that certain groups of claims do not share any common technical features; (3) applicant's intention for the scope of structural and procedural support found in the disclosure for means or step plus function claims; (4) applicant's interpretation for precisely which portions of the disclosure provide the written description and enablement support for each claim element; (5) applicant's interpretation for the intended breadth of claim terms,

particularly where those terms are not used per se in the specification; (6) applicant's interpretation of which portions of each claim correspond to the admitted prior art in the specification; (7) applicant's interpretation of the specific utility provided by the claimed subject matter; and (8) applicant's identification of new subject matter in a continuation-in-part.

All requirements for information under § 1.105 must be reasonably necessary to treating a matter in an application. As such, requirements for information must be specific in the articulation of what is required and must exhibit a reasonable likelihood of being readily fulfilled by the applicant. The Office's policy of compact prosecution requires that both examiners and applicants provide the information necessary to raise and resolve the issues related to patentability expeditiously. Where information highly pertinent to patentability determination may be required in a form that is readily responded to, such as with solicitations of stipulations or interrogatories directly related to the issues on the record, such a requirement is consistent with the policies of compact prosecution and reasonable necessity for making requirements.

*Section 1.111:* Section 1.111(a)(2) is proposed to be amended to provide that a supplemental reply to a non-final Office action will not be entered as a matter of right, with the exception that a supplemental reply will be entered if it is filed within the period when action by the Office is suspended under § 1.103(a) through (c) (suspensions requested by the applicant). The proposed amendment to § 1.111(a)(2) would also provide that the Office may enter a supplemental reply that is filed before the expiration of the statutory period (*i.e.*, within six months from the mailing date of the non-final Office action) if the supplemental reply is clearly limited to: (1) Cancellation of a claim(s); (2) adoption of an examiner suggestion(s); or (3) placement of the application in condition for allowance. The proposed amendment to § 1.111(a)(2) would replace the current procedures for disapproving a second or subsequent supplemental reply set forth in § 1.111(a)(2).

The proposed amendment to § 1.111(a)(2) would encourage applicants to utilize the Office's resources more efficiently, by filing a complete first reply to a non-final Office action, thus assisting the Office in reducing pendency. Supplemental replies cause significant material delays in the examination and processing of

applications, and place a significant burden on the Office's resources. An examiner's workload is increased by a supplemental reply received after the examiner has already conducted an updated prior art search and drafted the next Office action in response to the first reply. Beyond the additional time to read and consider the supplemental reply, the examiner may need to redraft the next Office action and frequently may need to conduct a further search. Pendency of the application is also increased when a first complete reply is filed to toll the period for reply and then a supplemental reply is filed beyond the statutory period set forth in the non-final Office action. Applicants are therefore strongly encouraged to file a reply to an Office action that represents a thorough consideration of all pending claims, the art of record, and the preceding Office action, and as well represents the full communication between applicants, any assignees and any legal representative mailing the reply. This would greatly reduce the need to file a supplemental reply. A single reply, absent supplements, would save examiners' time on rework. Cross-mailings between a new Office action and any supplemental reply would be significantly reduced. Applicant's patent term adjustment reductions (under § 1.704(c)(8)) would also be minimized, and the Office would save processing time and resources on patent term adjustment calculations. The changes to § 1.111(a)(2) would affect a very small percentage of applicants because only about 5.6% of all applications have one or more supplemental amendments. These supplemental amendments do, however, represent a significant burden on the Office from a small group of applicants. The burden would be effectively reduced by the instant proposed change.

After filing a reply to a non-final Office action, applicants would not be able in a supplemental reply, as a matter of right, to: (1) Further amend any claims; (2) add new claims; (3) reinstate previously canceled claims; (4) present evidence; or (5) submit arguments. The Office may enter any supplemental reply that is filed before the expiration of the statutory period (*i.e.*, within six months from the mailing date of the non-final Office action) if the supplemental reply is limited to: (1) Cancellation of a claim(s); (2) adoption of an examiner suggestion(s); or (3) placement of the application in condition for allowance. Any supplemental reply filed after the expiration of the statutory period would not be entered even if the supplemental

reply meets one of the conditions since such reply would not be evaluated for entry. IDSs, or supplemental IDSs are not considered replies except when they are submitted pursuant to a requirement under § 1.105. IDSs filed with a non-compliant supplemental reply would be considered separately according to the requirements of §§ 1.97 and 1.98.

The proposed amendment to § 1.111(a)(2) would replace the procedures currently set forth in § 1.111(a)(2). The current disapproval procedures were meant to provide the Office with latitude to refuse entry of supplemental replies that unduly interfere with the preparation of an Office action. *See Changes to Implement the Patent Business Goals*, 65 FR 54604 (Sept. 8, 2000), 1238 *Off. Gaz. Pat. Office* 77 (Sept. 19, 2000). The disapproval procedures, however, did not address the pendency problems associated with first supplemental replies. The Office receives a significantly larger number of first supplemental replies than second (or subsequent) supplemental replies. Furthermore, the procedures for disapproving a second (or subsequent) supplemental reply are too time consuming for examiners and Office technical support staff. The proposed amendment to § 1.111(a)(2) would provide a single simplified procedure for handling all supplemental replies, which would reduce processing delays and save Office resources.

If a supplemental reply is denied entry, such reply would be assigned a paper number and placed in the application file, with no further action taken. To have any of the arguments or amendments contained in an unentered supplemental reply considered by the examiner, applicants may request the entry of the supplemental reply, or resubmit the contents of supplemental reply, in a proper reply to the next Office action, if the next Office action is a non-final action. If the next Office action is a final rejection or a notice of allowance, applicants may file a request for continued examination (RCE) in compliance with § 1.114 (*i.e.*, a request accompanied by a submission and a fee) and request the entry of the supplemental reply, or resubmit the contents of such reply, in the RCE submission, to have such reply considered by the examiner. If an RCE is filed after a final Office action, to have a previously filed supplemental reply considered, the RCE must be accompanied by a reply to the outstanding Office action. *See* § 1.114(c).

If an applicant cannot file a first reply to a non-final Office action that is to his

or her satisfaction (*e.g.*, an affidavit is being prepared under § 1.131), applicant may consider filing a continuing application, such as a continuation application under § 1.53(b) (as an RCE would not be permitted because the Office action is non-final, see § 1.114(b)).

A supplemental reply would be entered if it is filed within the period during which action by the Office is suspended under § 1.103(a) through (c). If a supplemental reply is filed during a suspension of action that was granted by the Office for a petition, with a showing of good and sufficient cause for suspension, the supplemental reply would be entered. For example, if test data is required to overcome a rejection under 35 U.S.C. 103(a) and the applicant needs more time to conduct an experiment and collect the test data, the applicant may file a first reply to the Office action (as the Office will not grant a suspension of action if there is an outstanding Office action awaiting a reply by the applicant) and a petition for suspension of action with a showing of good cause under § 1.103(a). If the suspension is granted by the Office, applicant may submit the test data in a supplemental reply during the suspension period. In addition, if an applicant is filing an RCE after a final rejection accompanied by a reply to the final Office action and needs more time to prepare a supplemental reply (*e.g.*, an affidavit), applicant may consider filing a request for suspension of action under § 1.103(c) with the RCE. The proposed § 1.111(a)(2)(ii) would permit the affidavit (which is supplemental to the reply to the final Office action) to be entered. A supplemental reply, however, would not be entered if it is filed during a suspension of action initiated by the Office under § 1.103(e).

The proposed amendment to § 1.111(a)(2) would not change the impact of the submission of a supplemental reply on patent term adjustment, in that the submission of any supplemental reply will cause a reduction of any accumulated patent term adjustment under § 1.704(c)(8).

**Section 1.115:** Section 1.115 is proposed to be amended by adding a new paragraph (b) to treat all preliminary amendments filed on or prior to (where a filing date being accorded application papers is later than the original receipt date of the application papers) the application filing date as being part of the original disclosure. Current paragraphs (b) and (c) of § 1.115 would be redesignated (c) and (d), respectively. If a preliminary amendment is determined to contain matter not otherwise included in the

contents of the originally filed specification, including claims, and drawings, and the preliminary amendment is not specifically referred to in the oath or declaration under § 1.63, a new oath or declaration in compliance with § 1.63 and referencing such preliminary amendment(s) will be required. Further, the Office proposes to amend current section 1.115(b)(1), as proposed new paragraph (c)(1)(i), to allow the Office to disapprove entry of any amendment, whether submitted prior to, on or after the filing date of an application, which seeks cancellation of all claims without presenting any new or substitute claims, except that the Office would treat a preliminary amendment canceling all of the claims and presenting no new or substitute claims procedurally as preserving a claim (the first independent claim) for filing and fee calculation purposes only.

*Preliminary Amendment Submitted on or Prior to the Filing Date as Part of the Original Disclosure:* It has long been the practice that a preliminary amendment filed on or prior to the filing date of an application may be considered a part of the original disclosure if it is referred to in a first filed oath or declaration in compliance with § 1.63. The first filed oath or declaration may have been filed prior to, on or after the application filing date. If the preliminary amendment is not referred to in the oath or declaration, any request to treat the preliminary amendment as a part of the original disclosure is by way of petition under § 1.182 requesting that the original oath or declaration be disregarded and that the application be treated as an application filed without an executed oath or declaration under § 1.53(f). Any such petition must be accompanied by the \$130.00 petition fee, a newly executed oath or declaration (which identifies the application and refers to the preliminary amendment), and the requisite surcharge under § 1.16(e).

All application papers, including preliminary amendments, located in the application file on the application filing date are currently scanned by the Office of Initial Patent Examination (OIPE) into an electronic image format. Therefore, the treatment of a preliminary amendment as being part of the original disclosure by the newly proposed practice of automatically treating all preliminary amendments filed on or prior to the filing date of an application as being part of the original disclosure would add no additional scanning work to OIPE. The proposed practice, however, would provide a consistent way of treating preliminary amendments and eliminate the need for

filing a petition. As a result, valuable processing time would be saved. No change in practice is contemplated regarding inclusion of preliminary amendments in a published application, as only preliminary amendments submitted by EFS (electronic system for submitting patent applications) will be included in a published application. See § 1.215(c).

A preliminary amendment seeking cancellation of all claims, but not presenting any new or substitute claims, would be part of the original disclosure, but would be entered only in part in conformance with the practice set forth below.

All preliminary amendments filed on or prior to the filing date of an application are proposed to be treated as part of the original disclosure. These preliminary amendments would be entered into the application. Thereafter, the application, including the preliminary amendments, would be forwarded to an examiner for examination in due course. During examination, the examiner would make a determination as to whether the preliminary amendments contain matter not in the originally filed specification, including claims and any drawings. If the examiner determines that the preliminary amendments filed on or prior to the filing date of an application contains only subject matter disclosed in the contents of the originally filed specification, including claims and any drawings, no reference to the preliminary amendments in the oath or declaration would be necessary and, thus, would not be required. If, however, it is determined by the examiner that the amendments filed on or prior to the filing date of an application do contain matter not in the originally filed specification, including claims and any drawings, and the preliminary amendments are not referred to in a first filed oath or declaration (or a later submitted one), then a new oath or declaration in compliance with § 1.63 and referencing such preliminary amendment(s) would be necessary and, thus, would be required by the examiner. The oath or declaration filed in such an application must identify the preliminary amendment adding matter not in the originally filed specification, including claims and any drawings as one of the papers which the inventor(s) has "reviewed and understands" in order to comply with § 1.63(b)(2) (the surcharge under § 1.16(e) would not be required).

Preliminary amendments filed after the filing date of an application are not considered as part of the original disclosure and are not subject to a

determination of whether the preliminary amendments must be referred to in an oath or declaration (if they contain subject matter not disclosed in the contents of the originally filed specification, including claims and any drawings) but will be reviewed by the examiner for new matter. Preliminary amendments filed prior to or on the filing date of the application by definition cannot contain new matter whether or not they are referred to in a first filed oath or declaration because they would be considered part of the application as originally filed.

The appropriate provisions of the MPEP will be modified accordingly, if the proposed amendment to § 1.115 is adopted.

It is recognized that the requirement for a new oath or declaration when the originally filed application papers include preliminary amendments which have been determined by an examiner to contain matter not in the originally filed specification, including claims and any drawings and are not referred to in the originally filed oath or declaration (or a later submitted one) may present a hardship in acquiring the requisite signatures of all the inventors. The treatment, however, of such a preliminary amendment as being part of the original disclosure and the elimination of the current petition practice are believed to outweigh such hardship.

A good practice to follow, when at all possible, is to refer to all preliminary amendments filed on or prior to the filing date of an application, in an oath or declaration filed under § 1.63 whenever the oath or declaration is first filed. Following this practice will avoid the necessity for filing a new oath or declaration referencing the preliminary amendments.

It should be noted that no oath or declaration filed under § 1.63 would be determined to be defective under this section if it makes reference to a preliminary amendment filed on or prior to the filing date of an application, which is determined by the Office to contain only subject matter disclosed in the contents of the originally filed specification, including claims and any drawings.

#### *Preliminary Amendment Filed Prior to the Filing Date of an Application*

*Example A:* An example of a preliminary amendment filed prior to the filing date of an application is a preliminary amendment filed with the original application papers, wherein the original application papers did not include a specification in compliance

with 35 U.S.C. 112. Accordingly, the application papers, as filed, were not entitled to a filing date under 35 U.S.C. 111(a)(2)(A). Thereafter, a specification in compliance with 35 U.S.C. 112 was filed in the application, and the application was entitled to a filing date as of the date of submission of the specification in compliance with 35 U.S.C. 112.

#### Preliminary Amendment Not Desired To Be Part of the Original Disclosure

*Example B1:* If a preliminary amendment is not desired to be a part of the original disclosure, then such preliminary amendment must be filed in the application on a date later than the application filing date. Such a situation could occur if a practitioner drafts a preliminary amendment, which he believes contains only subject matter disclosed in the contents of the originally filed specification, including claims and any drawings, after a declaration was signed by all the inventors executing the application papers without the preliminary amendment being before them and it would be very difficult to obtain a new oath or declaration in compliance with § 1.63 executed by all the inventors referring to the preliminary amendment.

*Example B2:* Where it is determined by an examiner that a preliminary amendment filed on or prior to the filing date of an application (including an executed declaration) contains additional subject matter not disclosed in the contents of the originally filed specification, including claims and any drawings, a practitioner may determine that the preliminary amendment does not need to be a part of the original disclosure (e.g., to support the particular invention being claimed) and therefore it would be easier to cancel the preliminary amendment rather than obtain a new oath or declaration in compliance with § 1.63 executed by all the inventors referring to the preliminary amendment.

#### Preliminary Amendment Adding a Benefit Claim to a Prior Application

*Example C1:* An application was filed under § 1.53(b) as a continuation application of a prior filed (parent) application including a specification (including claims) and drawings updated with all desired amendments (without adding any new matter (§ 1.63(d)(1)(iii))) from a prior filed (parent) application, a copy of a signed declaration used in the prior application (§ 1.63(d)(1)(iv)), and a preliminary amendment adding a benefit claim. The preliminary amendment adds only a specific reference to the prior filed (e.g.,

parent) application to the first line of the specification. As the preliminary amendment was submitted on filing, it is part of the original disclosure.

*Question:* Does the oath or declaration need to refer to this preliminary amendment? *Answer:* No. As the application submitted on filing is an updated version of the specification of the prior application (without adding new matter) including the benefit claim, the oath or declaration does not need to include a reference to the preliminary amendment. Thus, the preliminary amendment is not adding additional subject matter not disclosed in the contents of the originally filed specification of the continuation application, including claims and drawings.

*Example C2:* In addition to the facts set forth in Example C(1), the specification submitted on filing inadvertently omitted a copy of page 5 of the specification, however, the transmittal letter (PTO/SB/05) submitted on filing stated the following:

For CONTINUATION OR DIVISIONAL APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

Thereafter, the omitted page 5 from the prior application, that was intended to be submitted with the new application on filing but was not, is then submitted. *Question:* Is a new oath or declaration required? *Answer:* No. While the continuation application did not include all the subject matter of the prior application which was intended to be submitted on filing, the application did include a limited incorporation by reference. See MPEP § 201.06(c). As the material of page 5 of the prior application was inadvertently omitted on filing, the incorporation by reference would permit the entry of the subject matter of page 5 of the prior application into the continuation application. See also proposed § 1.57(a).

#### Preliminary Amendment Adding New Matter to a Continuation Application

*Example D:* An application was filed under § 1.53(b) as a continuation application of a prior filed (parent) application including an updated specification (including claims) and drawings from a prior filed (parent) application, a copy of the signed declaration from the prior application,

and a preliminary amendment. The preliminary amendment included a benefit claim and also a new matter amendment of the specification, which new matter was not disclosed in the contents of the originally filed specification, including claims and drawings. As the preliminary amendment was submitted on filing, it is part of the original disclosure.

*Question:* Does the oath or declaration need to refer to this preliminary amendment? *Answer:* Yes. As the application includes new matter, the application cannot be a continuation application. The application is a continuation-in-part application. An examiner would require that the application be redesignated as a continuation-in-part application, and require a new oath or declaration in compliance with § 1.63 and referencing the preliminary amendment(s).

The Office is particularly interested in comments from our customers regarding whether the benefits of the proposed change in Office policy (elimination of the current petition practice and treatment of preliminary amendments filed on or prior to the filing date of an application as part of the original disclosure) outweighs the attendant hardship (reexecution of the oath or declaration).

This change to § 1.115 would not be retroactive to any applications filed before the effective date of the rule change. The proposed change would be prospective only since to apply the change retroactively would result in changing the expectations regarding treatment of preliminary amendments filed on or prior to the filing date of an application by the Office.

*Preliminary Amendment Cancelling All Claims:* Current paragraph (b) of § 1.115 is proposed to be redesignated as paragraph (c) based on the above new proposed paragraph (b) and would be reformatted to accommodate the addition of new paragraph (c)(1)(i) as is being proposed to treat a preliminary amendment seeking to cancel all claims.

Before June of 1998, it was the practice of the Office to treat an application filed with an amendment (preliminary amendment) canceling all of the claims and presenting no new or substitute claims by denying entry of the amendment. See MPEP §§ 711.01 and 714.19. In *Baxter Int'l Inc. v. McGaw Inc.*, 149 F.3d 1321, 47 USPQ2d 1225 (Fed. Cir. 1998), the Federal Circuit held that a divisional application that included instructions to cancel all of the claims in the specification, without presenting any new claims, and did not contain at least one claim as required by 35 U.S.C. 112,

¶ 2, was not entitled to a filing date under 35 U.S.C. 111(a) until the date an amendment including at least one claim was filed in the application. Following *Baxter*, the Office changed its practice and no longer accorded a filing date to any application that was accompanied by a preliminary amendment which canceled all claims and failed to simultaneously submit any new claims. See *Any Application Filed With Instructions to Cancel All of the Claims in the Application is Not Entitled to a Filing Date*, 1216 Off. Gaz. Pat. Office 46 (Nov. 10, 1998).

Subsequently, in *Exxon Corp. v. Phillips Petroleum Co.*, 265 F.3d 1249, 60 USPQ2d 1368 (Fed. Cir. 2001), the Federal Circuit affirmed that the Office may refuse to enter an improper amendment that would cancel all of the claims in an application to avert harm (loss of a filing date) to an applicant. The Federal Circuit distinguished its decision in *Baxter* since in *Baxter* the Office did enter the amendment that canceled all of the claims in the application, thus resulting in the application not being entitled to a filing date. In contrast, in *Exxon* the Office refused to enter the amendment cancelling all the claims. The Office did, however, cancel all the dependent claims and preserve one claim for filing purposes only. Thus, all the claims were never canceled.

Consistent with *Exxon Corp. v. Phillips Petroleum Co.* and MPEP §§ 711.01 and 714.19, paragraph (H), (8th ed. 2001), the Office would disapprove entry of any amendment (whether submitted prior to, on or after the filing date of the application) that seeks cancellation of all claims but does not present any new or substitute claims. For filing purposes, that is, fee calculation purposes, the Office would treat such an application as containing a single claim, which would be the first independent claim, claim 1, wherein such claim would be the only claim that would be considered part of the original disclosure. See *Example A* above for an illustration of a preliminary amendment filed prior to the filing date of an application.

The proposed amendment to § 1.115(c)(1) would be a codification of the Office's current practice as set forth in MPEP §§ 711.01 and 714.19, paragraph (H). In addition, the provision in MPEP § 601.01(e) concerning the treatment of a nonprovisional application accompanied by a preliminary amendment which cancels all claims and fails to simultaneously submit any new claim(s) would be revised to be in conformance with current practice. See *Treatment of*

*Amendments that if Entered Would Cancel All of the Claims in an Application*, 1255 Off. Gaz. Pat. Office 827 (Feb. 5, 2002).

This change to § 1.115 (if adopted) would apply to any applications filed before the effective date of the rule change, as it is a codification of current Office practice.

*Section 1.116:* Section 1.116(b) is proposed to be revised to make it clear that the reexamination proceeding is not terminated under §§ 1.550(d) or 1.957(b), but rather the prosecution of the reexamination is concluded under §§ 1.550(d) or 1.957(b). See the discussion below as to the amendment of § 1.550 for the rationale for this change. See also §§ 1.502, 1.570, 1.902, 1.953, 1.957, 1.958, 1.979, and 1.997.

It is further proposed that § 1.116(b) be revised to more appropriately set forth the § 1.957(c) consequences of a failure to respond in an *inter partes* reexamination. The *inter partes* reexamination prosecution is neither terminated nor concluded where the patent owner fails to timely respond to an Office action, and claims in the proceeding remain patentable. Rather, an Office action is issued to thereby permit the third party requester to challenge the claims found patentable.

*Section 1.131:* Section 1.131(b) is proposed to be amended for correction of a typographical error that was inadvertently introduced in the final rule *Miscellaneous Amendments of Patent Rules*, 53 FR 23728 (June 23, 1988) (final rule). The typographical error to be corrected is contained in the text at the end of the second (and last) sentence of § 1.131(b), which pertains to exhibits or records needed to substantiate an oath or declaration of prior invention swearing behind a reference applied in a rejection of a claim. Specifically, the text "of their absence satisfactorily explained" should read "*or* their absence satisfactorily explained" (emphasis added). Thus, § 1.131(b) would be amended to clarify that for any oath or declaration under § 1.131 lacking original exhibits of drawings or records in support thereof, the absence of such original exhibits of drawings or records must be satisfactorily explained.

*Section 1.136:* Section 1.136(b) is proposed to be amended to add a petition fee requirement. Paragraph 1.136(a)(2), for example, specifically refers to § 1.136(b) for extensions of time to file replies under §§ 1.193(b), 1.194, 1.196 or 1.197 after a notice of appeal is filed. For such replies on appeal § 1.136(a) is not available for extending the time period for reply, and applicants may be able to make the § 1.136(b)

"sufficient cause" showing. To evaluate whether a showing of "sufficient cause" exists, decisions on § 1.136(b) requests require a thorough evaluation of facts and circumstances on a case-by-case basis. Furthermore, requests under § 1.136(b) are generally treated expeditiously by the deciding official. At MPEP § 710.02(e), it is recommended that requests under § 1.136(b) be filed in duplicate with a stamped return-address envelope to assist the Office in processing these requests with special dispatch. To reflect the Office's cost of deciding requests under § 1.136(b), it is proposed that a requirement for a petition fee be added to § 1.136(b). Evaluation of a request for an extension of time under § 1.136(b) for sufficient cause is analogous to evaluation of a request for the Office to suspend action for sufficient cause pursuant to § 1.103(a). See discussion of § 1.17.

*Section 1.137:* Sections 1.137(a), (b) and (e) are proposed to be amended to clarify that the reexamination proceedings under § 1.957(c) referred to in §§ 1.137(b) and (c) are "limited as to further prosecution." Section 1.137(d) is also proposed to be amended to clarify that when reviving a reissue application pursuant to § 1.137 a terminal disclaimer is not required.

Sections 1.137(a), (b) and (e) are proposed to be amended to more appropriately set forth the consequences of a failure to respond when governed by § 1.957(c). An *inter partes* reexamination prosecution is neither terminated nor concluded where the patent owner fails to timely respond to an Office action and claims in the proceeding remain patentable. An Office action is issued instead to thereby permit the third party requester to challenge the claims found patentable. As set forth in § 1.957(c), "[i]f claims are found patentable and the patent owner fails to file a timely and appropriate response to any Office action in an *inter partes* reexamination proceeding, further prosecution will be limited to the claims found patentable at the time of the failure to respond, and to any claims added thereafter which do not expand the scope of the claims which were found patentable at that time." The proposed revision refers accordingly to "revival" of an *inter partes* reexamination prosecution which has been "limited" under § 1.957(c).

Section 1.137(d)(3) is proposed to be amended to clarify that the terminal disclaimer requirements of paragraph (d)(1) do not apply to reissue applications.

Pursuant to 35 U.S.C. 251, a patent is reissued "for the unexpired part of the term of the original patent." Hence, any

period of abandonment of a reissue application, should the reissue application become revived and serve to reissue the patent, will result in a loss of patent term for the period that the reissue application was abandoned. Accordingly, there is no need to impose an additional penalty on patentee to terminally disclaim the entire period of abandonment of a reissue application. This rationale accords with the exclusion of the terminal disclaimer requirement when petitioning for revival of nonprovisional applications filed on or after June 8, 1995, pursuant to § 1.137(d)(1).

Current Office practice does not require a terminal disclaimer as a condition precedent for revival of an abandoned reissue application, no matter when the application was filed, where revival is otherwise appropriate.

In order to codify current practice, § 1.137(d)(3) is proposed to be amended by inserting "to reissue applications" to provide a blanket exception for reissue applications. Regardless of when the reissue application was filed, applicant is not required to file an accompanying terminal disclaimer with a petition to revive under § 1.137.

*Section 1.165:* Section 1.165(b) is proposed to be amended to remove the requirement for a black and white copy of a color drawing or photograph. This requirement has already been waived. See *Interim Waiver of Parts of 37 CFR 1.84 and 1.165, and Delay in the Enforcement of the Change in 37 CFR 1.84(e) to No Longer Permit Mounting of Photographs*, 1246 *Off. Gaz. Pat. Office* 106 (May 22, 2001).

*Section 1.173:* Section 1.173(b) is amended to clarify that paragraphs (b)(1), (b)(2) and (b)(3) are directly related to, and should be read with, paragraph (b).

*Section 1.175:* Section 1.175 is proposed to be amended by adding a new paragraph (e) requiring a new oath or declaration for continuing reissue applications, which must identify an error not corrected in an earlier reissue application.

Section 1.175 is currently interpreted to require any continuing reissue application whose parent application has not been abandoned to include an oath or declaration identifying at least one error being corrected, which error is different from the error(s) being corrected in the parent reissue (or an earlier reissue). Ordinarily, a single reissue application is filed to replace a single original patent and corrects all of the errors recognized by the applicant at the time of filing of the (single) reissue. If, during the prosecution of the reissue application, applicant (patentee)

recognizes additional errors needing correcting, such corrections could, and should, be made in the same application. If, however, after the close of prosecution and up until the time that the first reissue issues, applicant recognizes a further error which needs correction and files a continuing reissue application, § 1.175(e) would now explicitly require applicant to include an oath or declaration which identifies an error which was not corrected in the parent reissue application or in an earlier reissue application, e.g., a grandparent reissue application.

*Section 1.178:* Section 1.178 is proposed to be amended to eliminate the requirement for physical surrender of the original letters patent (i.e., the "ribbon copy" of the original patent) in a reissue application, and to make surrender of the original patent automatic upon the grant of the reissue patent. The reissue statute provides in part that:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent.

See 35 U.S.C. 251, ¶ 1 (emphasis added).

While the statutory language requires a "surrender" of the original patent, it does not require a physical surrender of the actual letters patent, nor even a statement that the patent owner surrenders the patent. Physical surrender by submission of the letters patent (i.e., the copy of the original patent grant) is currently required by rule via § 1.178; however, such submission is only symbolic, since the patent right exists independently of physical possession of the letters patent.

It is the right to the original patent that must be surrendered upon grant of the reissue patent, rather than any physical document. Thus, where the letters patent is not submitted during the prosecution of the reissue application because it is stated in the reissue that the letters patent copy of the patent is lost or inaccessible, there is no evidence that any stigma is attached to the reissue patent by the public. Further, there is no case law treating such a reissue patent adversely due to the failure to submit the letters patent. In fact, there is no legal reason to retain the requirement for physical surrender

of the letters patent. On the other hand, there is much benefit for eliminating the requirement for physical surrender of the letters patent.

It would be beneficial to both the Office and the public to recognize and provide that the surrender of the original patent is automatic upon the grant of the reissue patent to thereby eliminate the requirement for a physical submission of the letters patent, and to eliminate even the need for filing a paper offering to physically surrender the letters patent (§ 1.178(a)).

The current requirement for submission of the patent document requires the patent owner (seeking reissue) to try to obtain the letters patent copy of the patent. If the document was lost or misplaced, the patent owner must search for it. If it is in the hands of a former employee, the patentee must make an effort to secure it from that employee (who might not be on friendly terms with the patentee). If the letters patent can be obtained, it must then be physically submitted without losing or destroying it. If the letters patent cannot be obtained, the patent owner must make a statement of loss (Form PTO/SB/55) or explain that it cannot be obtained from the party having physical possession of it. The proposed revision of § 1.178 would eliminate these burdens, and the requirement for use of form PTO/SB/55 or its equivalent.

At present, the requirement for submission of the letters patent copy of the patent provides an unnecessary drain on Office processing and storage resources in dealing with the submitted letters patent document. Further, in the event the reissue is not granted, the Office must return the letters patent to the applicant where such is requested. The proposed revision would do away with the burden on the Office of processing, storing, and returning letters patent.

The current requirement for submission of the original patent (the letters patent), or a statement as to its loss, results in a "built in" delay in the prosecution while the Office awaits submission of the letters patent or the statement of loss, which is often submitted only after an indication of allowance of claims. The proposed revision would reduce reissue application pendency, since the Office would no longer need to delay prosecution while waiting for the letters patent or the statement of loss.

As a final point, the complete elimination of the requirement for an affirmative act (of surrender) by the patent owner would put reissue in step with other post patent proceedings for change of patent which have no



requirement for even a statement of surrender (e.g., reexamination certificate, certificate of correction).

**Section 1.179:** Section 1.179 would be removed and reserved as no longer being necessary. The information provided by this rule, i.e., notification to the public in the patent file that a reissue application has been filed for a particular patent, is now available through other means, such as public PAIR on the Office's Internet home page. This source of information can be entered through the Office's Internet Web site at <http://pair.uspto.gov/cgi-bin/final/home.pl> wherein the user can enter the original patent number, click on "Search," and then click on "Continuity Data." Any post-issuance filings (e.g., reissues, reexamination proceedings) will be identified by scrolling to "Child Continuity Data." To identify an application under "Child Continuity Data" as a reissue, the user simply clicks on the desired application number and searches through the file contents screen for "Notice of Reissue Published in Official Gazette." The Patent Assistance Center (PAC) Helpdesk (telephone number: 800-786-9199) can also provide information to the public on reissue filings. Removal of the provision that the Office place a separate paper in the patent file stating that a reissue has been filed would therefore eliminate several processing steps within the Office and contribute to overall efficiency. Similarly, public PAIR will indicate termination of the reissue examination, and placing a second separate paper notice to that effect in the patent file would be unnecessary.

The Office, through recent rule changes, has removed other language directed solely to internal instructions or directions to itself, and which do not directly impact patent applicants or the public. See, e.g., *Changes to Implement the Patent Business Goals*, 65 FR 54603, 54644, 54676 (Sept. 8, 2000), 1238 *Off. Gaz. Pat. Office* 77 (Sept. 19, 2000) (revised § 1.176 to eliminate instructions providing for a two-month delay of examination following the notice of reissue filing in the *Official Gazette*). Additionally, Office personnel can internally through the PALM database access information regarding reissue filings and do not rely on the presence or absence of the notice in the patent file as determinative of reissue status.

**Section 1.182:** Section 1.182 is proposed to be amended to refer to the petition fee set forth in § 1.17(f) for consistency with the change to § 1.17. See discussion of § 1.17.

**Section 1.183:** Section 1.183 is proposed to be amended to refer to the petition fee set forth in § 1.17(f) for consistency with the change to § 1.17. See discussion of § 1.17.

**Section 1.213:** Section 1.213(a) is proposed to be amended to add a provision that the certification under § 1.213(a)(3) is not appropriate unless the person signing the request has made an actual inquiry consistent with the requirements of § 10.18(b) of this chapter with respect to the application to which the request and certification pertains to determine that: (1) The application has not been the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications at eighteen months after filing; and (2) the applicant's intent at the time the nonpublication request is being filed is that the application will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications at eighteen months after filing. The Office has received inquiries which make it apparent that a number of practitioners consider a certification under 35 U.S.C. 122(b)(2)(B)(i) and § 1.213(a) appropriate so long as the applicant has not filed, and has not yet made a decision whether to file, a counterpart application in a foreign country, or under a multilateral international agreement, that requires publication of applications at eighteen months after filing ("a counterpart application subject to eighteen-month publication"). Thus, § 1.213(a) is proposed to be amended to more clearly place persons signing nonpublication requests under § 1.213(a) on notice as to what a certification under 35 U.S.C. 122(b)(2)(B)(i) and § 1.213(a) entails.

A nonpublication request must contain a certification that "the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing" (emphasis added). See 35 U.S.C. 122(b)(2)(B)(i). A certification under 35 U.S.C. 122(b)(2)(B)(i) and § 1.213(a) is not appropriate unless the applicant's intent at the time the nonpublication request is being filed is not to file a counterpart application that would be subject to eighteen-month publication for the particular application with which the nonpublication request is filed. That is, the applicant must have an affirmative intent not to file a counterpart application that would be subject to eighteen-month publication,

and not just the absence of any intent or plan concerning the filing of any counterpart application that would be subject to eighteen-month publication. In addition, a certification on the basis of a lack of knowledge of the applicant's plans concerning the filing of any counterpart application that would be subject to eighteen-month publication or the applicant's past practices or tendencies with respect to the filing of foreign counterpart applications would not meet the requirement that the person signing the request make an "actual inquiry" "with respect to the application to which the request and certification pertains." Obviously, that a particular applicant has a tendency to file counterpart applications for fewer than fifty percent of its U.S. applications is not alone an adequate basis for filing all or any of the U.S. applications with a nonpublication request under § 1.213(a).

Section 1.213(b) (and § 1.213(c)) is proposed to be amended to incorporate into the rules of practice the Office's interpretation of the interplay between the provision in 35 U.S.C.

122(b)(2)(B)(ii) for rescission of a previously filed nonpublication request and the notice requirement of 35 U.S.C. 122(b)(2)(B)(iii). The Office published a notice advising practitioners that the requirement in 35 U.S.C.

122(b)(2)(B)(iii) (and § 1.213(c)) for a notice of the foreign filing is in addition to any rescission of the nonpublication request under 35 U.S.C. 122(b)(2)(B)(ii) (and § 1.213(b)). See *Reminder that Rescission of a Nonpublication Request is Not Itself a Notice of Foreign Filing*, 1270 *Off. Gaz. Pat. Office* 20 (May 6, 2003). The inquiries in response to that notice revealed that many practitioners were unaware of this information. These inquiries also revealed that many practitioners who filed a counterpart application subject to eighteen-month publication after filing a nonpublication request in a U.S. application rescinded the nonpublication request by filing a nonpublication request rescission form that did not also contain a foreign filing notice (in many situations because the foreign filing notice included on the Office pre-printed form was removed). In view of these inquiries, the Office published a notice further clarifying the Office's interpretation of the provisions of 35 U.S.C. 122(b)(2)(B)(ii)-(iv). See *Clarification of the United States Patent and Trademark Office's Interpretation of the Provisions of 35 U.S.C.*

122(b)(2)(B)(ii)-(iv), 1272 *Off. Gaz. Pat. Office* 22 (July 1, 2003). Section 1.213(b) is specifically proposed to be amended to indicate that the mere filing of a

request under § 1.213(b) to rescind a previously filed nonpublication request does not comply with the notice requirement of 35 U.S.C.

122(b)(2)(B)(iii) and § 1.213(c) (for applicants who submitted a nonpublication request under § 1.213(a), but before filing the request under § 1.213(b) to rescind the previously filed nonpublication request, also filed an application directed to the invention disclosed in the application in which the nonpublication request was submitted in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing). *See Clarification of the United States Patent and Trademark Office's Interpretation of the Provisions of 35 U.S.C. 122(b)(2)(B)(ii)-(iv)*, 1272 *Off. Gaz. Pat. Office* at 23. Section 1.213(b) is also proposed to be amended to indicate that the provisions of § 1.8 do not apply in determining whether such an application has been filed before filing a request under § 1.213(b) to rescind a previously filed nonpublication request. *See Clarification of the United States Patent and Trademark Office's Interpretation of the Provisions of 35 U.S.C. § 122(b)(2)(B)(ii)-(iv)*, 1272 *Off. Gaz. Pat. Office* at 23–24.

Section 1.213(b) is also proposed to be amended to provide that a request under § 1.213(b) to rescind a nonpublication request is not appropriate unless the person signing the request has made an inquiry consistent with the requirements of § 10.18(b) of this chapter and determined that a nonpublication request under § 1.213(a) was previously filed in the application in which the request to rescind a nonpublication request is directed. A number of practitioners have developed the practice of filing a request under § 1.213(b) to rescind a nonpublication request in all applications for which a counterpart application subject to eighteen-month publication is filed, regardless of whether a nonpublication request was filed in the application. Processing a request under § 1.213(b) to rescind a nonpublication request in an application in which a nonpublication request was not previously filed in the application is burdensome on the Office. This is because the filing of a nonpublication request in an application for which a nonpublication request is not entered in the Office's computer system generally results in a search of the application file to determine whether the Office failed to record a nonpublication request in the Office's computer system. The filing of a request under § 1.213(b) to rescind a

nonpublication request in an application in which a nonpublication request was not previously filed is unwarranted and results in an unnecessary delay and a needless increase in the cost of processing the application. Thus, the Office considers this course of conduct to be in violation of § 10.18(b). Therefore, the Office is proposing to amend § 1.213(b) to place persons signing a request under § 1.213(b) to rescind a nonpublication request on notice that such a request is not appropriate unless the person signing the request has made an inquiry consistent with the requirements of § 10.18(b) of this chapter and determined that a nonpublication request under § 1.213(a) was previously filed in the application in which the request to rescind a nonpublication request is directed. Practitioners who continue to engage in the practice of filing a request under § 1.213(b) to rescind a nonpublication request in applications for which a nonpublication request was never filed may be subject to sanctions, disciplinary action, or both (*see* §§ 10.18(c) and (d)).

Section 1.213(c) is (as discussed above with respect to § 1.213(b)) proposed to be amended to incorporate into the rules of practice the Office's interpretation of the interplay between the provision in 35 U.S.C.

122(b)(2)(B)(ii) for rescission of a previously filed nonpublication request and the notice requirement of 35 U.S.C. 122(b)(2)(B)(iii). Section 1.213(c) is specifically proposed to be amended to provide that an applicant who has submitted a nonpublication request under § 1.213(a), but before filing a request under § 1.213(b) to rescind the previously filed nonpublication request, files an application directed to the invention disclosed in the application in which the nonpublication request was submitted in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing, must notify the Office of such filing within forty-five days after the date of the filing in another country, or under a multilateral international agreement. Section 1.213(c) is also proposed to be amended to provide that the provisions of § 1.8 do not apply in determining whether such an application has been filed before filing a request under § 1.213(b) to rescind a previously filed nonpublication request. Section 1.213(c) is also proposed to be amended to provide that the mere filing of a request under § 1.213(b) to rescind a previously filed nonpublication request does not comply with the notice

requirement of 35 U.S.C.

122(b)(2)(B)(iii) and § 1.213(c). Section 1.213(c) is also proposed to be amended to recite “of the filing in another country, or under a multilateral international agreement,” rather than “of the filing of such foreign or international application” to more accurately track the language of 35 U.S.C. 122(b)(2)(B)(iii).

Section 1.213(d) is proposed to be added to provide that if an applicant who has submitted a nonpublication request under § 1.213(a), subsequently files a request under § 1.213(b) to rescind a nonpublication request or files a notice of a filing in another country, or under a multilateral international agreement, under § 1.213(c), the application shall be published as soon as is practical after the expiration of a period of eighteen months from the earliest filing date for which a benefit is sought under title 35, United States Code. 35 U.S.C. 122(b)(2)(B)(iv) provides that if an applicant rescinds a request made under 35 U.S.C. 122(b)(2)(B)(i) or notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in 35 U.S.C. 122(b)(2)(B)(i), the application shall be published in accordance with the provisions of 35 U.S.C. 122(b)(1) on or as soon as is practical after the date that is specified in 35 U.S.C. 122(b)(2)(B)(i). Notwithstanding this provision in 35 U.S.C. 122(b)(2)(B), the Office has also received inquiries as to whether an application will be published if a request under § 1.213(b) to rescind a nonpublication request or a notice of foreign or international filing under § 1.213(c) is filed.

*Section 1.215:* Section 1.215(a) is proposed to be amended to permit submission of paper replacement drawings with a processing fee pursuant to § 1.17(i) (to replace the requirement for a petition) within the same time frame as is being proposed in § 1.215(c). Additionally, § 1.215(c) is proposed to be amended to provide a time frame of one month from the mailing date of the first Office communication that includes a confirmation number for the application for the submission of an amended version of an application through EFS (as well as providing the same time frame for replacement drawings submitted pursuant to § 1.215(a)).

Section 1.215(a) is proposed to be amended to refer to the processing fee set forth in § 1.17(i), and to provide that paper replacement drawings received before the Office has begun to process the patent application publication will be included in any patent application

publication. Replacement paper drawings may currently be included in any patent application publication, so long as the drawings are accompanied by a petition under § 1.182 and a petition fee set forth in § 1.17(h) and are timely received. Deletion of the requirement for a petition and replacement of the petition fee set forth in § 1.17(h) with a processing fee set forth in § 1.17(i) will reduce burdens upon applicants, while retaining the ability of the Office to recover the costs associated with processing the replacement drawings that have not been required by the Office. See *Drawings in Patent Application Publications and Patents*, 1242 *Off. Gaz. Pat. Office* 114 (Jan. 16, 2001).

Section 1.215(c) is proposed to be amended to provide that applicant has until the later of: (1) A month after the mailing date of the first Office communication that includes a confirmation number for the application; or (2) fourteen months after the earliest filing date claimed under title 35, United States Code, to file an amended version of an application through EFS, for publication purposes. This new time frame is also being applied to submission of replacement paper drawings pursuant to § 1.215(a). This change has already been implemented. See *Assignment of Confirmation Number and Time Period for Filing a Copy of an Application by EFS for Eighteen-Month Publication Purposes*, 1241 *Off. Gaz. Pat. Office* 97 (Dec. 26, 2000).

**Section 1.291:** Section 1.291 is proposed to be amended to require that when a protest under § 1.291 is filed in an application, the real party in interest that files the protest must be named; *i.e.*, the naming of the real party in interest would be a requirement of the filing of a proper protest. An exception to this requirement would be provided in that a protester desiring anonymity could submit a statement (together with a processing fee under § 1.17(i)) that the protest being submitted is the first protest submitted in the application by the real party in interest on behalf of whom the protest is being submitted. Additionally, § 1.291, as it is proposed to be amended, is reformatted for clarity.

Currently, a protest may be submitted without identification of the real party in interest on behalf of whom the protest is being submitted. Further, there is no explicit bar in the rule against multiple piecemeal protest submissions (raising a slightly different issue in each of multiple protest submissions) other than that they should be submitted before prosecution

closes in an application. Thus, § 1.291, as it currently exists, is subject to abuse by, for example, the filing of multiple protests in a single application by practitioners of the same firm, with a different practitioner signing each protest, and additionally, by any of the inventors and/or assignees, where essentially the same grounds of protest are presented in each of the protests. In order to eliminate such potential for harassment of the prosecution process via multiple filings of protests in an application by persons serving the same interest, it is proposed that § 1.291 be amended to require the naming of the real party in interest, or privy thereof, when a protest is filed.

The party on whose behalf the protest is being filed is required to be identified by either: (1) The name of the business or other organizational entity (*e.g.*, name of corporation) and its principal address, its place of formation (*e.g.*, incorporation) and any other name under which the business or other organizational entity is doing business (d/b/a) or conducting operations; or (2) the name and residence of the individual who is directing the submission of the protest.

The concept of identifying the “real party in interest” is not new to the Office; it is required by statute (35 U.S.C. 311) and by rule (§ 1.915) in *inter partes* reexamination practice with respect to identifying the *inter partes* third party reexamination requester. It is to be noted that the term “privy” is construed to include any party related to the real party in interest (filing the protest) as employer, employee, co-employee of the same employer, assignee, legal representative, licensee or hired contractor of the assignee or employer.

Where a genuine reason for not identifying the real party in interest exists (such as concern by an employee as to retaliation by his/her employer which is the assignee of the application), § 1.291(b)(3) would permit a statement in substitution for identifying the real party in interest. The § 1.291(b)(3) substitute statement must aver that the protest being submitted is, to the best of the knowledge of the submitting party, the first protest submitted by the real party in interest. A processing fee under § 1.17(i) must be included with the § 1.291(b)(3) substitute statement.

While an examiner is always free to look at or consider any documents submitted in an application, under § 1.291 as it is proposed to be amended, there would be no requirement that an examiner consider a second protest filed on behalf of the same real party in

interest, unless: (1) The second protest submission (a) includes additional art directed to the patentability of the claims, or (b) otherwise raises new issues substantially different from issues earlier presented and affecting the patentability of the claims, which could not have been earlier presented; and (2) the second protest submission includes an explanation of what is added by the additional art or new issue(s) raised, and why such could not have been earlier presented.

Finally, once a protest has been matched with an application, the examiner is always free to look at, or consider, any document(s) or other information submitted in that protest whether or not the protest complies with § 1.291. This is true both for § 1.291 as it presently exists, and § 1.291 as it would be revised via the present proposal. Section 1.291 exists as a matter of administrative convenience for the Office, and a third party's failure to comply with any of the requirements of § 1.291 does not vest the applicant with any “right” to preclude consideration of information in a non-compliant protest by the examiner.

Section 1.291(a): In order for a protest submission to be matched with an application, it must include sufficient information to adequately identify the application for which the submission is being made.

Where possible, the protest should specifically identify the application to which the protest is directed by application number and filing date. If, however, the protestor is unable to specifically identify the application to which the protest is directed by application number and filing date, but, nevertheless, believes such an application to be pending, the protest should be directed to the attention of the Office of Petitions, along with as much identifying data for the application as is possible. If sufficient information is provided in the protest to match it to an application, it will be matched. If not, the protest submission will be returned to the party that submitted it.

Section 1.291(b): Section 1.291(b) is proposed to be amended to provide that a protest may be filed “[a]t any time if it is accompanied by the written consent of the applicant to the filing of the protest being submitted.” 35 U.S.C. 122(c) prohibits the filing of a protest in an application after the application has been published without the express written consent of the applicant. In order to provide for the filing of protests after publication of patent applications, § 1.291(b)(2) requires that a filing of a protest after publication (of an

application) be accompanied by a written statement of consent of the applicant to the filing of the protest. The written statement must indicate that applicant is consenting to the specific protest being submitted. A blanket consent upon publication of an application would not be sufficient to permit admission of the subsequently filed individual protests; applicant's consent must be specifically directed to the protest being filed. It should be noted, however, that applicant's consent need not be directed to a document that applicant has already looked at or reviewed, but rather may be directed to the "protest that party Smith has informed me that he will be submitting during the week of November 26th."

Where the protest can be "matched" with an application, it will be "entered" into the file (*i.e.*, it has an entry right), if the protest: (1) Is timely filed; (2) indicates that it has been served on the applicant, and (3) properly identifies the real party in interest, or contains the statement pursuant to paragraph (b)(3) of the section. If the protest is not entered, it will be so marked, and it may be returned to the protestor.

Section 1.291(c): Where the protest is "entered" into the application, the items of information submitted with the protest, and the argument directed to the items of information, will be "considered" by the examiner, if the protest includes: (1) A listing of patents, publications, or other information relied upon; (2) a concise explanation of the relevance of each listed patent, publication and other item of information; (3) a copy of each listed patent, publication, or other item of information in written form, or at least pertinent portions thereof; (4) an English language translation of all the necessary and pertinent parts of any non-English language patent, publication, or other item of information relied upon; and (5) if a second or subsequent protest in the case, an explanation why the additional art or other item(s) of information presented are significantly different, and why they were not earlier presented. Any item of information for which § 1.291(c)(1) through (c)(5) is not complied with would not be entitled to "consideration."

Section 1.291(e): This paragraph is proposed to be added to reiterate and confirm the Office's long-standing practice to enter protests raising inequitable conduct issues without comment on such issues. *See* MPEP § 1901.02.

Section 1.295: Section 1.295(a) is proposed to be amended to refer to the petition fee set forth in § 1.17(g) for

consistency with the change to § 1.17. *See* discussion of § 1.17.

Section 1.296: Section 1.296 is proposed to be amended to refer to the petition fee set forth in § 1.17(g) for consistency with the change to § 1.17. *See* discussion of § 1.17.

Section 1.311: Section 1.311(b) is proposed to be amended to provide that the submission after the mailing of a notice of allowance of either: (1) An incorrect issue fee or publication fee; or (2) a fee transmittal form (or letter) for payment of issue fee or publication fee, will operate as a valid request to charge the correct issue fee, or any publication fee due, to any deposit account identified in a previously filed authorization to charge such fees. Additionally, non-Office provided issue and publication fee forms would now be permitted. It is proposed to be clarified that for previous authorizations to be effective under the exceptions provided for, the previous authorizations must cover the issue and publication fees to be charged.

Current § 1.311(b) sets forth that an authorization to charge the issue fee or other post-allowance fees (such as any publication fee due) to a deposit account may be filed only after the mailing of a notice of allowance in part to encourage the use (return) of the PTOL-85B form as that form contains important information, such as the name of the assignee. The last sentence of § 1.311(b), however, provides an exception for charging the issue fee to a deposit account identified in a previously filed authorization if the applicant submits either an incorrect issue fee or an Office-provided fee transmittal form (*i.e.*, Part B—Fee(s) Transmittal of a Notice of Allowance and Fee(s) Due, form PTOL-85). The proposed amendment to § 1.311(b) would extend the exception to any publication fee due and expand the exception to apply where an applicant's own fee transmittal form or letter for submitting issue fee or publication fee is submitted. Further, the term "such" is proposed to be added before "fees" in the last line of section 1.311(b) to clarify that the previously filed authorization must be an authorization to charge the appropriate fee due to an identified deposit account. For example, if the previously filed fee authorization only authorizes the Office to charge the issue fee, the Office would *not* be able to charge any publication fee due to the identified deposit account in the previously filed authorization even when the applicant submitted an issue fee transmittal form. For such authorization, the Office could only

charge the correct issue fee to the identified deposit account.

The phrase "A completed Office-provided issue fee transmittal form (where no issue fee has been submitted)" in the last sentence of § 1.311(b) is proposed to be changed to "A fee transmittal form (or letter) for payment of issue fee or publication fee" to provide that a submission of an Office-provided fee transmittal form (*i.e.*, Part B of the form PTOL-85), or applicant's own fee transmittal form or letter for submitting issue fee or publication fee, (incomplete as well as a complete, but for a fee authorization) would operate as a request to charge the correct issue fee due, or any publication fee due, to any deposit account identified in a previously filed authorization to charge such fees, even if the issue fee has been previously submitted.

Where an issue fee has been previously submitted, and the application is withdrawn from issue and is allowed again, since November 13, 2001, the Notice of Allowance has indicated the current amount due as the difference between the previously paid issue fee and the current amount for an issue fee. In such situation, a payment of only the difference, or a response to the notice where there is no issue fee due (or only the return of the Part B—Fee(s) Transmittal of form PTOL-85 as the current issue fee is the same amount as previously paid), will be treated as a ratification of the Office's decision to apply the previously paid issue fee. If the fee was paid in a different application (*e.g.*, the parent application of a continued prosecution application under § 1.53(d) (CPA)), the fee indicated in the notice as due is the current issue fee. The issue fee paid in the parent application cannot be refunded, or applied, to the notice of allowance mailed in the CPA.

Section 1.324: Section 1.324(a) and (b) would be amended to provide an informational reference to 35 U.S.C. 256 and to replace "petition" with "request." Section 1.324(b) would be amended to alert patentees to the availability of reissue to correct inventorship in a patent where § 1.324 is not available.

Section 1.324(a) is proposed to be amended by adding an explicit reference to 35 U.S.C. 256 and its requirement in order to clarify that the inventorship of a patent may be changed only by way of request from *all* of the inventors together with assignees of the entire interest, or on order of a court, and the Office will then issue a certificate naming the correct inventors. 35 U.S.C. 256 requires that there be

agreement among all parties (inventors and existing assignees), or that a court has issued an order so directing the inventorship change. The current reference in § 1.324 to a petition is being eliminated in order to conform the rule language to earlier changes made to § 1.20(a).

*Section 1.377:* Section 1.377 is proposed to be amended to refer to the petition fee set forth in § 1.17(g) for consistency with the change to § 1.17. See discussion of § 1.17. Section 1.377 will retain the provision that the petition fee may be refunded if an Office error created the need for the petition.

*Section 1.378:* Section 1.378(e) is proposed to be amended to refer to the petition fee set forth in § 1.17(f) for consistency with the change to § 1.17. See discussion of § 1.17.

*Section 1.502:* Section 1.502 is proposed to be amended to make it clear that it is the issuance and publication of the *ex parte* reexamination certificate that terminates the reexamination proceeding. The failure to timely respond, or the issuance of a Notice of Intent to Issue Reexamination Certificate (NIRC), does not terminate the reexamination proceeding. See the discussion below as to the amendment of § 1.550. See also §§ 1.116, 1.570, 1.902, 1.953, 1.957, 1.958, 1.979, and 1.997.

*Section 1.530:* Section 1.530 is proposed to be amended to state that proposed amendments in *ex parte* or *inter partes* reexamination are not effective until the reexamination certificate is both “issued and published” (emphasis added) to conform § 1.530 for consistency with the language of 35 U.S.C. 307 and 316.

*Section 1.550:* Section 1.550(c) is proposed to be amended to add a \$200 fee requirement pursuant to § 1.17(g) in *ex parte* reexamination proceedings for requests for extensions of time, which requests are based upon sufficient cause. Extensions of time under § 1.136(a) are not permitted in *ex parte* reexamination proceedings because the provisions of 35 U.S.C. 41(a)(8) and § 1.136(a) apply only to an “application” and not to a reexamination proceeding (*ex parte* or *inter partes*). Additionally, 35 U.S.C. 305 requires that *ex parte* reexamination proceedings “will be conducted with special dispatch.” Accordingly, extensions of time in *inter partes* reexamination proceedings are provided for in § 1.550(c) only “for sufficient cause and for a reasonable time specified.” To evaluate whether a showing of “sufficient cause” exists and whether a “reasonable time” is specified, decisions on § 1.550(c)

requests require a thorough evaluation of facts and circumstances on a case-by-case basis. Furthermore, requests under § 1.550(c) are generally treated expeditiously by the deciding official, especially so in reexamination since the statute requires “special dispatch.” To reflect the Office’s cost of deciding requests under § 1.550(c), *i.e.*, the cost of evaluating whether a showing of “sufficient cause” exists and whether a “reasonable time” is specified, it is proposed that a requirement for a fee be added to § 1.550(c).

The present proposal tracks the above discussed proposals to require a fee for the decision on § 1.136(b) and § 1.956 extension of time requests, and the criteria for granting of an extension of time under § 1.550(c) is analogous to that for § 1.136(b) and § 1.956.

Section 1.550(d) is proposed to be amended to state that patent owner’s failure to file a timely response will result in the concluding of prosecution of the reexamination proceeding, but will not conclude or terminate the reexamination proceeding.

The patent owner’s failure to file a timely response, and the issuance of the Notice of intent to Issue Reexamination Certificate (NIRC) concludes the prosecution in the reexamination proceeding. On the other hand, the issuance and publication of a certificate terminates the reexamination proceeding itself. This distinction is important because prosecution which is concluded may be reopened at the option of the Office where appropriate, and a rejection that was withdrawn during the proceeding may be reinstated where the propriety of that rejection has been reconsidered. In contrast, a reexamination proceeding which has been terminated is not subject to being reopened. After the reexamination proceeding has been terminated, it is not permitted to reinstate the same ground of rejection in a reexamination proceeding in accordance with *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) (holding that a “substantial new question of patentability” is not raised by prior art presented in a reexamination request, if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications.). But see Pub. L. 107–273, § 13105, 116 Stat. 1758, 1900 (2002) (overruling *In re Portola Packaging, Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997), by amending 35 U.S.C. 303(a) and 312(a) to provide that “[t]he existence of a

substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office, or considered by the Office”).

This distinction between concluding the prosecution of the reexamination proceeding, and termination of the reexamination proceeding was highlighted by the Federal Circuit decision of *In re Bass*, 314 F.3d 575, 65 USPQ2d 1156 (Fed. Cir. 2003), wherein the Court opined that:

Until a matter has been completed, however, the PTO may reconsider an earlier action. See *In re Borkowski*, 505 F.2d 713, 718, 184 USPQ 29, 32–33 (CCPA 1974). A reexamination is complete upon the statutorily mandated issuance of a reexamination certificate, 35 U.S.C. 307(a); the NIRC merely notifies the applicant of the PTO’s intent to issue a certificate. A NIRC does not wrest jurisdiction from the PTO precluding further review of the matter.

It is to be noted that both NIRC cover sheet forms, *ex parte* Form PTOL 469 and *inter partes* Form PTOL 2068, specifically state (in their opening sentences) that “[p]rosecution on the merits is (or remains) closed in this \* \* \* reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office, or upon petition.” This statement addresses the point that the NIRC concludes the prosecution in the reexamination proceeding, but does not conclude or terminate the reexamination proceeding itself. In this notice of proposed rule making, it is proposed to amend the rules of practice to also address the point. See also §§ 1.116, 1.502, 1.570, 1.902, 1.953, 1.957, 1.958, 1.979, and 1.997.

*Section 1.570:* The heading of § 1.570, and § 1.570(a), are proposed to be amended to make it clear that the grant of the *ex parte* reexamination certificate terminates the reexamination proceeding. The failure to timely respond, or the issuance of the NIRC does not terminate the reexamination proceeding. See the discussion as to the amendment of § 1.550. See also §§ 1.116, 1.502, 1.902, 1.953, 1.957, 1.958, 1.979, and 1.997.

Section 1.570 is also proposed to be amended in its heading and paragraphs (b) and (d) to recite that the reexamination certificate is both issued and published for consistency with the language of 35 U.S.C. 307.

*Section 1.644:* Section 1.644, paragraphs (e) and (f), are proposed to be amended to refer to the petition fee set forth in § 1.17(f) for consistency with the change to § 1.17. See discussion of § 1.17.

*Section 1.666:* Section 1.666(b) and (c) are proposed to be amended to refer to the petition fee set forth in § 1.17(f) for consistency with the change to § 1.17. See discussion of § 1.17.

*Section 1.704(d):* Section 1.704(d) is proposed to be amended to change “cited in a communication” to “first cited in any communication” in order to clarify that the item must have been first cited in any communication from a foreign patent office in a counterpart application instead of merely being cited in such a communication.

An applicant who fails to cite an item, within thirty days of receipt by an individual designated in § 1.56(c) of a first communication from a foreign patent office in a counterpart application citing the item, and instead files an information disclosure statement, within thirty days of a subsequent communication citing the item, cannot be considered to have acted with reasonable efforts to conclude prosecution of the application. The provisions of § 1.704(d) do not apply if the applicant does not submit the IDS within the thirty-day window of a first communication including a citation of an item to a party designated in § 1.56(c). The proposed change to require the thirty-day time frame to run from a first communication parallels the requirement in § 1.97(e)(1).

*Section 1.705:* Section 1.705(d) is proposed to be amended to provide that a patentee may request reconsideration of the patent term adjustment within thirty days of the date the patent issued if the patent indicates a revised patent term adjustment. Currently, any request for reconsideration of the patent term adjustment indicated in the patent is limited to the situation where the patent issues on a date other than the projected date of issue. If the patent indicates a revised patent term adjustment due to the patent being issued on a date other than the projected date of issue, applicant must file a request for reconsideration within thirty days of the date the patent issued. Section 1.705(d) as proposed would allow a patentee to file the request for reconsideration for an event which occurs after the mailing of the notice of allowance so long as the patentee files the request for reconsideration within thirty days of the date the patent issues.

Events occurring after the mailing of the notice of allowance which may result in a reduction of any patent term adjustment include submissions of additional papers such as: (1) Request for refunds; (2) status letter, (3) amendments under § 1.312; (4) late priority claims; (5) a certified copy of a priority document; (6) drawings; (7)

letters related to biological deposits; and (8) oaths or declarations. See § 1.704(c)(10). An additional event which may trigger the revision of the patent term adjustment is receipt of the payment of the issue fee more than 3 months after mailing of the notice of allowance. See § 1.704(b). Events occurring after the mailing of the notice of allowance which may trigger an increase in the amount of patent term adjustment include administrative delays caused by the Office's failure to issue the application within four months after the date the issue fee was paid under 35 U.S.C. 151 and all outstanding requirements were satisfied. See § 1.702(a)(4).

Section 1.705(d) is also proposed to be amended to provide that any request for reconsideration under § 1.705(d) that raises issues that were raised, or could have been raised, in an application for patent term adjustment under § 1.704(b) may be dismissed as untimely. The purpose of § 1.705(d) is to provide patentees with an avenue to obtain reconsideration of the patent term adjustment indicated in the patent when the patent term adjustment indicated in the patent differs from the patent term adjustment indicated in the notice of allowance due to events occurring after the mailing of the notice of allowance. Section 1.705(d) is not intended as an avenue for patentees to seek review of issues that were raised, or could have been raised, in an application for patent term adjustment under § 1.704(b). Any request for reconsideration of the patent term adjustment indicated in the patent on the basis of issues that were raised, or could have been raised, in an application for patent term adjustment under § 1.704(b) is considered untimely if not filed within the period specified in § 1.705(b).

*Section 1.741:* Section 1.741(b) is proposed to be amended to refer to the petition fee set forth in section 1.17(f) for consistency with the change to § 1.17. See discussion of § 1.17.

*Section 1.902:* Section 1.902 is proposed to be amended to make it clear that it is the issuance and publication of the inter partes reexamination certificate that terminates the reexamination proceeding. The failure to timely respond, or the issuance of the NIRC does not terminate the reexamination proceeding. See the discussion as to the amendment of § 1.550. See also §§ 1.116, 1.502, 1.570, 1.953, 1.957, 1.958, 1.979, and 1.997.

*Section 1.953:* Section 1.953(c) is proposed to be amended to state that patent owner's failure to file a timely response will result in the concluding of the prosecution of the reexamination

proceeding, but will not terminate the reexamination proceeding. See the discussion as to the amendment of § 1.550 for the rationale for this change. See also §§ 1.116, 1.502, 1.570, 1.902, 1.957, 1.958, 1.979, and 1.997.

The subheading preceding § 1.956 is proposed to be amended to refer to concluding of prosecution of the reexamination proceeding, rather than conclusion or termination of the reexamination proceeding, since that is what the sections which follow deal with. It is § 1.997, Issuance of *Inter Partes* Reexamination Certificate, that deals with termination of the reexamination proceeding. See the discussion above as to the amendment of § 1.550 for the rationale for this change.

*Section 1.956:* Section 1.956 is proposed to be amended to add a \$200 fee requirement pursuant to § 1.17(g) in *inter partes* reexamination proceedings for requests for extensions of time, which requests are based upon sufficient cause. Extensions of time under § 1.136(a) are not permitted in *inter partes* reexamination proceedings because the provisions of 35 U.S.C. 41(a)(8) and § 1.136(a) apply only to an “application” and not to a reexamination proceeding (*ex parte* or *inter partes*). Additionally, 35 U.S.C. 314 requires that inter partes reexamination proceedings “will be conducted with special dispatch.” Accordingly, extensions of time in *inter partes* reexamination proceedings are provided for in § 1.956 only “for sufficient cause and for a reasonable time specified.” To evaluate whether a showing of “sufficient cause” exists and whether a “reasonable time” is specified, decisions on § 1.956 requests require a thorough evaluation of facts and circumstances on a case-by-case basis. Furthermore, requests under § 1.956 are generally treated expeditiously by the deciding official, especially so in reexamination since the statute requires “special dispatch.” To reflect the Office's cost of deciding requests under § 1.956, *i.e.*, the cost of evaluating whether a showing of “sufficient cause” exists and whether a “reasonable time” is specified, it is proposed that a requirement for a fee be added to § 1.956.

The present proposal tracks the above-discussed proposals to require a fee for the decision on § 1.136(b) and § 1.550(c) extension of time requests, and the criteria for granting of an extension of time under § 1.956 is analogous to that for § 1.136(b) and § 1.550(c).

*Section 1.957:* Section 1.957(b) is proposed to be amended to state that

patent owner's failure to file a timely response will result in the concluding of prosecution of the *inter partes* reexamination proceeding, but will not conclude or terminate the reexamination proceeding. See the discussion as to the amendment of § 1.550 for the rationale for this change. See also §§ 1.116, 1.502, 1.570, 1.902, 1.953, 1.958, 1.979, and 1.997.

**Section 1.958:** The heading of § 1.958 is proposed to be amended to state the concluding of prosecution of the reexamination proceeding, rather than conclusion or termination of the reexamination proceeding, since that is what the materials which follow deal with. See the discussion above as to the amendment of § 1.550 for the rationale for this change. Note that both § 1.957(b) and (c) result in the concluding of reexamination prosecution. Under § 1.957(b), prosecution is concluded *in toto*; under § 1.957(c), prosecution is concluded as to the non-patentable claims. See also §§ 1.116, 1.502, 1.570, 1.902, 1.953, 1.957, 1.979, and 1.997.

**Section 1.979:** Section 1.979(f) is proposed to be amended to state that patent owner's failure to file a timely response will result in a concluding of prosecution of the reexamination proceeding, but will not conclude or terminate the reexamination proceeding, and that it is the reexamination certificate under § 1.997 that terminates the reexamination proceeding. See the discussion as to the amendment of § 1.550 for the rationale for this change. See also §§ 1.116, 1.502, 1.570, 1.902, 1.953, 1.957, 1.958, and 1.997.

**Section 1.997:** The heading of § 1.997 is proposed to be amended to refer to the issuance and publication of *inter partes* reexamination certificates. The heading of § 1.997 and § 1.997(a) are proposed to be amended to make it clear that the issuance and publication of the *inter partes* reexamination certificate terminates the reexamination proceeding. The failure to timely respond, or the issuance of the NIRC does not terminate the reexamination proceeding. See the discussion as to the amendment of § 1.550. See also §§ 1.116, 1.502, 1.570, 1.902, 1.953, 1.957, 1.958, and 1.979. Section 1.997(a) is also proposed to be revised to make its language consistent with that of § 1.570(a).

Section 1.997, paragraphs (b) and (d), are proposed to be amended to recite that the reexamination certificate is both issued and published for consistency with the language of 35 U.S.C. 316.

**Section 5.12:** Section 5.12(b) is proposed to be amended to refer to the petition fee set forth in § 1.17(g) for

consistency with the change to § 1.17. See discussion of § 1.17.

**Section 5.15:** Section 5.15(c) is proposed to be amended to refer to the petition fee set forth in § 1.17(g) for consistency with the change to § 1.17. See discussion of § 1.17.

**Section 5.25:** Section 5.25 is proposed to be amended to refer to the petition fee set forth in § 1.17(g) for consistency with the change to § 1.17. See discussion of § 1.17.

## Rule Making Considerations

### Regulatory Flexibility Act

The Deputy General Counsel for General Law, United States Patent and Trademark Office certified to the Chief Counsel for Advocacy, Small Business Administration, that the changes proposed in this notice (if adopted) would not have a significant impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)). The primary impact of the changes proposed in this notice are to: (1) Permit electronic signatures on a number of patent-related submissions; (2) streamline the requirements for incorporation by reference of prior-filed applications; and (3) clarify the qualifications for claiming small entity status for purposes of paying reduced patent fees. These changes to the rules of practice (if adopted) will simplify the patent application, and as such, will benefit all patent applicants (including small entities).

The Office is also proposing to adjust certain petition fees that are set under the Office's authority under 35 U.S.C. 41(d) to adjust these petition fees to be in alignment with the actual average costs of deciding such petitions. There are approximately 7,500 petitions filed each year of the type that would be affected by the proposed patent fee changes. Since the Office received over 400,000 applications (provisional and nonprovisional) in fiscal year 2002, this proposed change would impact relatively few (less than 2% of) patent applicants. In addition, the petition fee amounts proposed by the Office for petitions whose fees are set under the authority in 35 U.S.C. 41(d) are comparable or lower than the petition fee amounts for petitions whose fees are set by statute in 35 U.S.C. 41(a) (\$110.00 to \$1,970.00 for extension of time petitions (35 U.S.C. 41(a)(8)), or \$1,300.00 to revive an unintentionally abandoned application (35 U.S.C. 41(a)(7)).

### Executive Order 13132

This rule making does not contain policies with federalism implications

sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

### Executive Order 12866

This rule making has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

### Paperwork Reduction Act

This rule making 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 final rule have been reviewed and previously approved by OMB under the following control numbers: 0651-0016, 0651-0020, 0651-0031, 0651-0032, 0651-0033, 0651-0034 and 0651-0036.

The title, description and respondent description of each of the information collections is shown below with an estimate of the annual reporting burdens. Included in the estimate is the time for reviewing instructions, gathering and maintaining the data needed, and completing and reviewing the collection of information. The principal impacts of the changes in this proposed rule are to (1) expressly provide for the electronic submission of an information disclosure statement; (2) provide for a slight change in the format of an application being filed in order to accommodate for the scanning and indexing of different sections of the application file; and (3) provide for a change in the manner of making amendments to an application consistent with the Office's efforts to establish a patent electronic image management system.

**OMB Number:** 0651-0016.

**Title:** Rules for Patent Maintenance Fees.

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

**Type of Review:** Approved through May of 2006.

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

**Estimated Number of Respondents:** 348,110.

**Estimated Time Per Response:** Between 20 seconds and 8 hours.

**Estimated Total Annual Burden Hours:** 30,495 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 October of 2004.

*Affected Public:* Individuals or Households, Business or Other For-Profit Institutions, Not-for-Profit Institutions, Farms, Federal Government and State, Local and Tribal Governments.

*Estimated Number of Respondents:* 26,858.

*Estimated Time Per Response:* Between 1 and 25 hours.

*Estimated Total Annual Burden Hours:* 30,903 hours.

*Needs and Uses:* The information supplied to the United States Patent and Trademark Office by an applicant requesting reconsideration of a patent term adjustment determination under 35 U.S.C. 154(b) (§ 1.702 *et seq.*) is used by the United States Patent and Trademark Office to determine whether its determination of patent term adjustment under 35 U.S.C. 154(b) is correct, and whether the applicant is entitled to reinstatement of reduced patent term adjustment. The information supplied to the United States Patent and Trademark Office by an applicant seeking a patent term extension under 35 U.S.C. 156 (§ 1.710 *et seq.*) is used by the United States 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 Office to review final eligibility decisions, withdraw patent term applications, and declare his or her eligibility to apply for a patent term extension.

*OMB Number:* 0651-0031.

*Title:* Patent Processing (Updating).

*Form Numbers:* PTO/SB/08A, PTO/SB/08B, PTO/SB/21-27, PTO/SB/30-32, PTO/SB/35-37, PTO/SB/42-43, PTO/SB/61-64, PTO/SB/67-68, PTO/SB/91-92, PTO/SB/96-97, PTO-2053-A/B, PTO-2054-A/B, PTO-2055-A/B, PTOL-413A.

*Type of Review:* Approved through July of 2006.

*Affected Public:* Individuals or Households, Business or Other For-Profit Institutions, Not-for-Profit Institutions, Farms Federal Government and State, Local and Tribal Governments.

*Estimated Number of Respondents:* 2,208,339.

*Estimated Time Per Response:* 1 minute and 48 seconds to 8 hours.

*Estimated Total Annual Burden Hours:* 830,629 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 United States Patent and Trademark Office concerning the examination of a specific application. The specific information required or which may be submitted includes: Information Disclosure Statements; Submission of priority documents and Amendments.

*OMB Number:* 0651-0032.

*Title:* Initial Patent Application.

*Form Number:* PTO/SB/01-07, PTO/SB/13PCT, PTO/SB/16-19, PTO/SB/29 and 29A, PTO/SB/101-110.

*Type of Review:* Approved through July of 2006.

*Affected Public:* Individuals or Households, Business or Other For-Profit Institutions, Not-For-Profit Institutions, Farms, Federal Government, and State, Local, or Tribal Governments.

*Estimated Number of Respondents:* 454,287.

*Estimated Time Per Response:* 22 minutes to 10 hours and 45 minutes.

*Estimated Total Annual Burden Hours:* 4,171,568 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, Provisional Application Cover Sheet, 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/44, PTO/SB/50-51, PTO/SB/51S, PTO/SB/52-53, PTO/SB/55-58, PTOL-85B.

*Type of Review:* Approved through January of 2004.

*Affected Public:* Individuals or Households, Business or Other For-Profit Institutions, Not-For-Profit Institutions, Farms, State, Local and Tribal Governments, and Federal Government.

*Estimated Number of Respondents:* 205,480.

*Estimated Time Per Response:* 1.8 minutes to 2 hours.

*Estimated Total Annual Burden Hours:* 63,640 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 and License to Export.

*Form Numbers:* None.

*Type of Review:* Approved through March 2004.

*Affected Public:* Individuals or Households, Business or Other For-Profit Institutions, Not-For-Profit Institutions, Farms, Federal Government, and State, Local, or Tribal Governments.

*Number of Respondents:* 2,194.

*Estimated Time Per Response:* Between 30 minutes and 4 hours.

*Estimated Total Annual Burden Hours:* 1,523 hours.

*Needs and Uses:* When disclosure of an invention may be detrimental to national security, the Director of the USPTO must issue a secrecy order and withhold the publication of the application or grant of a patent for such period as the national interest requires. The USPTO is also required to grant foreign filing licenses in certain circumstances to applicants filing patent applications in foreign countries. This collection is used by the public to petition the USPTO to allow disclosure, modification, or rescission of a secrecy order, or to obtain a general or group permit. Applicants may also petition the USPTO for a foreign filing license or a retroactive license.

*OMB Number:* 0651-0036.

*Title:* Statutory Invention Registration.

*Form Numbers:* PTO/SB/94.

*Type of Review:* Approved through April of 2006.

*Affected Public:* Individuals or Households, Business or Other For-Profit Institutions, Not-For-Profit Institutions, Farms, Federal Government, and State, Local or Tribal Governments.

*Estimated Number of Respondents:* 73.

*Estimated Time Per Response:* 24 minutes.

*Estimated Total Annual Burden Hours:* 29 hours.

**Needs and Uses:** This collection of information is necessary to ensure that the requirements of 35 U.S.C. 157 and 37 CFR 1.293 through 1.297 are met. The public uses form PTO/SB/94, Request for Statutory Invention Registration, to request and authorize publication of a regularly filed patent application as a statutory invention registration, to waive the right to receive a United States patent on the same invention claimed in the identified patent application, and to agree that the waiver will be effective upon publication of the statutory invention registration. The Office uses form PTO/SB/94, Request for a Statutory Invention Registration, to review, grant, or deny a request for a statutory invention registration. No forms are associated with the petition to review final refusal to publish a statutory invention registration or the petition to withdraw a publication request. The petition to review final refusal to publish a statutory invention registration is used by the public to petition the Office's rejection of a request for a statutory invention registration. The Office uses the petition to withdraw a publication request to review requests to stop publication of a statutory invention registration.

Comments are invited on: (1) Whether the collection of information is necessary for proper performance of the functions of the agency; (2) the accuracy of the agency's estimate of the burden; (3) ways to enhance the quality, utility, and clarity of the information to be collected; and (4) ways to minimize the burden of the collection of information to respondents.

Interested persons are requested to send comments regarding these information collections, including suggestions for reducing this burden, to Robert J. Spar, Director, Office of Patent Legal Administration, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or to the Office of Information and Regulatory Affairs, OMB, 725 17th Street, NW., Washington, DC 20503, (Attn: PTO Desk Officer).

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.

## List of Subjects

### 37 CFR Part 1

Administrative practice and procedure, Courts, Freedom of Information, Inventions and patents, Reporting and record keeping requirements, Small businesses.

### 37 CFR Part 5

Classified information, foreign relations, inventions and patents.

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

## PART 1—RULES OF PRACTICE IN PATENT CASES

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

**Authority:** 35 U.S.C. 2(b)(2).

2. Section 1.4 is amended by adding paragraphs (d)(1)(iv) and (h) to read as follows:

### § 1.4 Nature of correspondence and signature requirements.

\* \* \* \* \*

(d)(1) \* \* \*

(iv)(A) Where correspondence for a patent application, patent file, or a reexamination proceeding is printed on paper for hand or mail delivery, or is submitted via the Office's Electronic Filing System, or facsimile transmission (pursuant to § 1.6(d) of this part), it may be electronically signed. The electronic signature must consist only of numbers and/or letters, with punctuation and spaces (e.g., Jane DOE-JONES, James JONES, Jr., and Dr. James JONES). The person signing the correspondence must personally insert the electronic signature between two forward slash marks. The signature must be the signer's actual name, except as provided by paragraph (d)(1)(iv)(B) of this section, including the given name, middle name or initial, and family name and, optionally, a title. The actual name must be presented with only the family name being entirely in capital letters. A practitioner, signing pursuant to §§ 1.33(b)(1) or 1.33(b)(2) of this part, must use his/her complete name as registered as his or her electronic signature, and the signer's registration number must be supplied, either as part of the electronic signature, or adjacent the electronic signature. If part of the electronic signature, the number (#) character may be used when appearing before a practitioner's registration number; otherwise the number character may not be used in an electronic signature.

(B) Where a person's electronic signature as set forth in paragraph

(d)(1)(iv)(A) of this section is not the person's actual name, the correspondence must include the person's actual name in printed or typed form immediately below the electronic signature, and clearly indicate that it is the signer's actual name, with only the family name being presented entirely in capital letters.

\* \* \* \* \*

(h) The Office may require ratification or confirmation of a signature, or a resubmission of a document, such as when the Office has reasonable doubt as to the authenticity (veracity) of the signature, e.g., where there are variations of a signature, or where the signature and the complete typed or printed name, if any, does not clearly identify the person signing, or where more than one person has used the same signature (with a different typed or printed name below the signature).

3. Section 1.6 is amended by removing and reserving paragraph (e) and revising paragraph (d)(4) to read as follows:

### § 1.6 Receipt of correspondence.

\* \* \* \* \*

(d) \* \* \*

(4) Drawings submitted under §§ 2.51, 2.52, or 2.72, and color drawings submitted under §§ 1.81, 1.83 through 1.85, 1.152, 1.165, 1.173, or 1.437;

\* \* \* \* \*

(e) [Reserved]

\* \* \* \* \*

4. Section 1.8 is amended by revising the introductory text of paragraph (a) and the introductory text of paragraph (b) to read as follows:

### § 1.8 Certificate of mailing or transmission.

(a) Except in the situations enumerated in paragraph (a)(2) of this section or as otherwise expressly excluded in this chapter, correspondence required to be filed in the Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

\* \* \* \* \*

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed or decided with prejudice, or

the prosecution of a reexamination proceeding is concluded (§§ 1.550(d), 1.957(b)) or limited (§§ 1.957(a), 1.957(c)), the correspondence will be considered timely if the party who forwarded such correspondence:

\* \* \* \* \*

5. Section 1.10 is amended by adding new paragraphs (g), (h), and (i) to read as follows:

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

\* \* \* \* \*

(g) Any person attempting to file correspondence under this section that was returned by the USPS may petition the Director to consider such correspondence as filed on a particular date in the Office, provided that:

(1) The petition is filed promptly after the person becomes aware of the return of the correspondence;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail";

(3) The petition includes the original correspondence or a copy of the original correspondence showing the number of the "Express Mail" mailing label thereon and a copy of the "Express Mail" mailing label showing the "date-in" and

(4) The petition includes a statement which establishes, to the satisfaction of the Director, the original deposit of the correspondence and that the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally deposited with the USPS on the requested filing date.

(h) Any person attempting to file correspondence under this section that was refused by the USPS may petition the Director to consider such correspondence as filed on a particular date in the Office, provided that:

(1) The petition is filed promptly after the person becomes aware of the refusal of the correspondence;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the attempted mailing by "Express Mail";

(3) The petition includes the original correspondence or a copy of the original correspondence showing the number of the "Express Mail" mailing label thereon; and

(4) The petition includes a statement by the person who originally attempted to deposit the correspondence with the USPS which establishes, to the satisfaction of the Director, the original

attempt to deposit the correspondence and that the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally attempted to be deposited with the USPS on the requested filing date.

(i) Any person attempting to file correspondence under this section that was unable to be deposited with the USPS due to an interruption or emergency in "Express Mail" service which has been so designated by the Director, may petition the Director to consider such correspondence as filed on a particular date in the Office, provided that:

(1) The petition is filed in a manner designated by the Director promptly after the person becomes aware of the designated interruption or emergency in "Express Mail" service;

(2) The petition includes the original correspondence or a copy of the original correspondence; and

(3) The petition includes a statement which establishes, to the satisfaction of the Director, that the correspondence would have been deposited with the USPS but for the designated interruption or emergency in "Express Mail" service, and that the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally attempted to be deposited with the USPS on the requested filing date.

6. Section 1.14 is amended by revising paragraph (h)(1) as follows:

**§ 1.14 Patent applications preserved in confidence.**

\* \* \* \* \*

(h) \* \* \*

(1) The fee set forth in § 1.17(g); and

\* \* \* \* \*

7. Section 1.17 is amended by adding paragraphs (f) and (g) and revising (h), (i), (l), and (m) to read as follows:

**§ 1.17 Patent application and reexamination processing fees.**

\* \* \* \* \*

(f) For filing a petition under one of the following sections which refers to this paragraph—\$400.00

§ 1.53(e)—to accord a filing date.

§ 1.57(a)—to accord a filing date.

§ 1.182—for decision on a question not specifically provided for.

§ 1.183—to suspend the rules.

§ 1.378(e)—for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.

§ 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 under § 1.740 for extension of a patent term.

(g) For filing a petition under one of the following sections which refers to this paragraph—\$200.00

§ 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.

§ 1.59—for expungement of information.

§ 1.103(a)—to suspend action in an application.

§ 1.136(b)—for review of a request for extension of time when the provisions of section 1.136(a) are not available.

§ 1.138(c)—to expressly abandon an application to avoid publication.

§ 1.295—for review of refusal to publish a statutory invention registration.

§ 1.296—to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.

§ 1.377—for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.

§ 1.550(c)—for patent owner requests for extension of time in *ex parte* reexamination proceedings.

§ 1.956—for patent owner requests for extension of time in *inter partes* reexamination proceedings.

§ 5.12—for expedited handling of a foreign filing license.

§ 5.15—for changing the scope of a license.

§ 5.25—for retroactive license.

(h) For filing a petition under one of the following sections which refers to this paragraph—\$130.00

§ 1.19(h)—to request documents in a form other than that provided in this part.

§ 1.84—for accepting color drawings or photographs.

§ 1.91—for entry of a model or exhibit.

§ 1.102(d)—to make an application special.

§ 1.313—to withdraw an application from issue.

§ 1.314—to defer issuance of a patent.

§ 104.3—for a waiver of a rule in part 104 of this title.

(i) Processing fee for taking action under one of the following sections 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.

§ 1.53(b)(3)—to convert a provisional application filed under § 1.53(c) into a nonprovisional application under § 1.53(b).

§ 1.55—for entry of late priority papers.

§ 1.99(e)—for processing a belated submission under § 1.99.

§ 1.103(b)—for requesting limited suspension of action, continued prosecution application (§ 1.53(d)).

§ 1.103(c)—for requesting limited suspension of action, request for continued examination (§ 1.114).

§ 1.103(d)—for requesting deferred examination of an application.

§ 1.215(a)—for processing of replacement drawings to include the drawings in any patent application publication.

§ 1.217—for processing a redacted copy of a paper submitted in the file of an application in which a redacted copy was submitted for the patent application publication.

§ 1.221—for requesting voluntary publication or republication of an application.

§ 1.291(b)(3)—for processing a substitute statement under § 1.291(b)(3).

§ 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.

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

\* \* \* \* \*

(l) For filing a petition for the revival of an unavoidably abandoned application under 35 U.S.C. 111, 133, 364, or 371 for the unavoidably delayed payment of the issue fee under 35 U.S.C. 151 or for the revival of an unavoidably concluded or limited reexamination prosecution under 35 U.S.C. 133 (§ 1.137(a)):

By a small entity (§ 1.27(a))—\$55.00

By other than a small entity—\$110.00

(m) For filing a petition for the revival of an unintentionally abandoned application, for the unintentionally delayed payment of the fee for issuing

a patent, or for the revival of an unintentionally concluded or limited reexamination prosecution under 35 U.S.C. 41(a)(7) (§ 1.137(b)):

By a small entity (§ 1.27(a))—\$665.00

By other than a small entity—  
\$1,330.00

\* \* \* \* \*

8. Section 1.19 is amended by revising paragraphs (b), (g), and (h) to read as follows:

#### § 1.19 Document supply fees.

\* \* \* \* \*

(b) Certified and uncertified copies of Office documents:

(1) Certified or uncertified copy of the paper portion or the electronic image equivalent to a paper portion of a patent application as filed—\$20.00

(2) Certified or uncertified copy on paper of the paper portion or the electronic image equivalent of a patent-related file wrapper and contents:

(i) Paper file wrapper with paper file wrapper contents of 400 or fewer pages, or the entire electronic image contents portion, of a patent application—\$200.00

(ii) Additional fee for each additional 100 pages or portion thereof of the paper contents of a paper file wrapper—\$40.00

(iii) Additional fee for certification—\$25.00

(3) Certified or uncertified copy on compact disc of patent-related file wrapper contents:

(i) First compact disc in a single order—\$55.00

(ii) Each additional compact disc in the single order of paragraph (b)(3)(i) of this section—\$15.00

(4) Certified or uncertified copy of Office records, per document except as otherwise provided in this section—\$25.00

(5) For assignment records, abstract of title and certification, per patent—\$25.00

\* \* \* \* \*

(g) Copies of unscanned documents and documents on media not permitted by § 1.52(a) or (e) will be provided at cost.

(h) Requests for documents in a form other than that provided by this part must be in writing in the form of a petition with the fee set forth in § 1.17(h) and will be provided at cost.

9. Section 1.27 is amended by revising paragraph (a) to read as follows:

#### § 1.27 Definition of small entities and establishing status as a 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) *Definition of small entities.* A small entity as used in this chapter means any party (person, small business concern, or nonprofit organization) under paragraphs (a)(1) through (a)(3) of this section.

(1) *Person.* A person, as used in paragraph (c) of this section, 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 currently enforceable 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 a currently enforceable 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 paragraph (c) of this section, means any business concern that:

(i) Has not assigned, granted, conveyed, or licensed, and is under no currently enforceable 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 for small entity status as a person, small business concern, or nonprofit organization; and

(ii) Meets the size standards set forth in 13 CFR 121.801 through 121.805 to be eligible for reduced patent fees. Questions related to 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 paragraph (c) of this section, means any nonprofit organization that:

(i) Has not assigned, granted, conveyed, or licensed, and is under no currently enforceable 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 as a person, small business concern, or a nonprofit organization; 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 (a)(3)(ii)(B) of this section or (a)(3)(ii)(C) of this section if it were located in this country.

\* \* \* \* \*

10. Section 1.47 is amended by revising paragraphs (a) and (b) 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(g), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by 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(g), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

\* \* \* \* \*

11. Section 1.52 is amended by revising the heading and paragraphs

(b)(1), (b)(2)(ii), (d)(1), (e)(1) and (e)(3)(i) to read as follows:

**§ 1.52 Language, paper, writing, margins, compact disc specifications.**

\* \* \* \* \*

(b) \* \* \*

(1) The application or proceeding and any amendments or corrections to the application (including any translation submitted pursuant to paragraph (d) of this section) or proceeding, 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 the application and a translation of any corrections or amendments into the English language together with a statement that the translation is accurate that is signed by the individual who made the translation.

(2) \* \* \*

(i) Text written in a nonscript type font (e.g., Arial, Times Roman, or Courier, preferably a font size of 12) lettering style having capital letters which should be at least 0.422 cm.

(0.166 inch) high, but may be no smaller than 0.21 cm. (0.08 inch) high; and

\* \* \* \* \*

(d) \* \* \*

(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 that is signed by the individual who made the translation, 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.

\* \* \* \* \*

(e) \* \* \*

(1) The following documents may be submitted to the Office on a compact disc in compliance with this paragraph:

(i) A computer program listing (*see* § 1.96);

(ii) A "Sequence Listing" (submitted under § 1.821(c)); or

(iii) Any individual table (*see* § 1.58) if the table is more than 50 pages in length, or if the total number of pages of all of the tables in an application exceeds 100 pages in length, where a table page is a page printed on paper in conformance with paragraph (b) of this section and § 1.58(c).

(2) \* \* \*

(3)(i) Each compact disc must conform to the International Standards Organization (ISO) 9660 standard, and the contents of each compact disc must

be in compliance with the American Standard Code for Information Interchange (ASCII). CD-R discs must be finalized so that they are closed to further writing to the CD-R.

\* \* \* \* \*

12. Section 1.53 is amended by revising paragraph (e)(2) to read as follows:

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

\* \* \* \* \*

(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(f). 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.

\* \* \* \* \*

13. Section 1.55 is amended by revising paragraphs (a)(1)(ii), (a)(4), and (c) and adding paragraph (a)(1)(iii) to read as follows:

**§ 1.55 Claim for foreign priority.**

(a) \* \* \*

(1) \* \* \*

(ii) In an international application designating the United States, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT.

(iii) If an application claiming the benefit of a prior foreign application meets the twelve-month filing period requirement in 35 U.S.C. 119(a) only through one or more prior-filed nonprovisional applications or international applications designating the United States for which a benefit is claimed under 35 U.S.C. 120, 121, or 365(c) and 37 CFR 1.78(a), each such prior-filed application must also contain a claim for priority in compliance with this section or the Regulations under the PCT to the prior foreign application.

\* \* \* \* \*

(4) 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 that is signed by the individual who made the translation.

\* \* \* \* \*

(c) Unless such claim is accepted in accordance with the provisions of this paragraph, any claim for priority under 35 U.S.C. 119(a)–(d), 365(a)–(b) not presented within the time period provided by paragraph (a) of this section is considered to have been waived. If a claim for priority under 35 U.S.C. 119(a)–(d), 365(a)–(b) is presented after the time period provided by paragraph (a) of this section, the claim may be accepted if the claim identifying the prior foreign application by specifying its application number, country (or intellectual property authority), and the day, month, and year of its filing was unintentionally delayed. A petition to accept a delayed claim for priority under 35 U.S.C. 119(a)–(d), 365(a)–(b) must be accompanied by:

(1) The claim under 35 U.S.C. 119(a)–(d), or 365(a)–(b) and this section to the prior foreign application, unless previously submitted;

(2) The surcharge set forth in § 1.17(t); and

(3) A statement that the entire delay between the date the claim was due under paragraph (a)(1) of this section and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

14. A new § 1.57 is added to read as follows:

#### **§ 1.57 Incorporation by reference.**

(a) Subject to the conditions and requirements of this paragraph, if all or a portion of the specification or drawings is inadvertently omitted from an application, but the application contains a claim under § 1.55 for priority of a prior-filed foreign application, or a claim under § 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application, that was present on the date of receipt of the application, and the omitted portion of the specification or drawings is completely contained in the prior-filed application, the claim under §§ 1.55 or 1.78 shall also be considered an incorporation by reference of the prior-filed application.

(1) The application must be amended to include the omitted portion of the specification or drawings within the time period set by the Office, but in no case later than the close of prosecution as defined by § 1.114. The examiner may require the applicant to supply a copy of the prior-filed application, to

supply an English language translation of any prior-filed application that is in a language other than English, and to identify where the omitted portion of the specification or drawings can be found in the prior-filed application.

(2) Any amendment to an international application pursuant to this paragraph shall be effective only as to the United States. In addition, no request to add the missing part of the description or the missing drawing in an international application designating the United States will be acted upon by the Office prior to the expiration of the applicable time limit under PCT Article 22(1) or (2), or Article 39(a).

(3) If an application is not otherwise entitled to a filing date under § 1.53(b) or PCT Article 11, the amendment must be by way of a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(f).

(b) Except as provided in paragraph (a) of this section, an incorporation by reference must be identified by using the language “incorporated by reference” and must identify the referenced patent, application, or publication in the manner set forth in § 1.98(b)(1) through (b)(5).

(c) “Essential material” may be incorporated by reference, but only by way of an incorporation by reference to a U.S. patent or U.S. patent application publication, which patent or patent application publication does not itself incorporate such essential material by reference. “Essential material” is material that is necessary to:

(1) Provide a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and set forth the best mode contemplated by the inventor of carrying out the invention as required by the first paragraph of 35 U.S.C. 112;

(2) Describe the claimed invention in terms that particularly point out and distinctly claim the invention as required by the second paragraph of 35 U.S.C. 112; or

(3) Describe the structure, material, or acts that correspond to a means or step for performing a specified function as required by the sixth paragraph of 35 U.S.C. 112.

(d) Other material (“Nonessential material”) may be incorporated by reference to domestic or foreign patents or published applications, prior-filed commonly owned U.S. applications, or non-patent publications. An incorporation by reference by hyperlink

or other form of browser executable code is not permitted.

(e) The examiner may require the applicant to supply a copy of the material incorporated by reference. If the Office requires the applicant to supply a copy of material incorporated by reference, the material must be accompanied by a statement that the copy consists of the same material incorporated by reference in the referencing application.

(f) A purported incorporation of material by reference that does not comply with the requirements of paragraphs (b) though (e) of this section is not effective to incorporate such material by reference unless corrected by the applicant in a timely manner.

15. Section 1.58 is revised to read as follows:

#### **§ 1.58 Chemical and mathematical formulae and tables.**

(a) The specification, including the claims, may contain chemical and mathematical formulae, but shall not contain drawings or flow diagrams. The description portion of the specification may contain tables, if the tables are not also included in the drawings; claims may contain tables either if necessary to conform to 35 U.S.C. 112 or if otherwise found to be desirable.

(b) Tables that are submitted in electronic form (§§ 1.96(c) and 1.821(c)) must maintain the spatial relationships (e.g., alignment of columns and rows) of the table elements when displayed so as to visually preserve the relational information they convey. Chemical and mathematical formulae must be encoded to maintain the proper positioning of their characters when displayed in order to preserve their intended meaning.

(c) Chemical and mathematical formulae and tables must be presented in compliance with § 1.52(a) and (b), except that chemical and mathematical formulae or tables may be placed in a landscape orientation if they cannot be presented satisfactorily in a portrait orientation. Typewritten characters used in such formulae and tables must be chosen from a block (nonscript) type font or lettering style having capital letters which should be at least 0.422 cm. (0.166 inch) (e.g., preferably Arial, Times Roman, or Courier with a font size of 12) high, but may be no smaller than 0.21 cm. (0.08 inch) high (e.g., a font size of 6). A space at least 0.64 cm. (1/4 inch) high should be provided between complex formulae and tables and the text. Tables should have the lines and columns of data closely spaced to conserve space, consistent with a high degree of legibility.

16. Section 1.59 is 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 information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

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

**§ 1.69 Foreign language oaths and declarations.**

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

18. Section 1.76 is amended by revising paragraphs (a) and (c)(2) to read as follows:

**§ 1.76 Application data sheet.**

(a) *Application data sheet.* An application data sheet is a sheet or sheets, that may be voluntarily submitted in either provisional or nonprovisional applications, which contains bibliographic data, arranged in a format specified by the Office. An application data sheet must be titled "Application Data Sheet" and must contain all of the section headings listed in paragraph (b) of this section, with any appropriate data for each section heading. If an application data sheet is provided, the application data sheet is part of the provisional or nonprovisional application for which it has been submitted.

(2) Must be titled "Supplemental Application Data Sheet," include all of the section headings listed in paragraph (b) of this section, include all appropriate data for each section heading, and identify the information

that is being changed (added, deleted, or modified).

19. Section 1.78 is amended by revising paragraph (a)(1), (a)(2)(iii), (a)(5)(iii), (a)(5)(iv), and (c) to read as follows:

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

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

(i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America; or

(ii) Entitled to a filing date as set forth in § 1.53(b) or § 1.53(d) and include the basic filing fee set forth in § 1.16; or

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

(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76), or the specification must contain or be amended to contain such reference in the first sentence(s) following the title.

(iii) If the later-filed application is a non-provisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76), or the specification must contain or be amended to contain such reference in the first sentence(s) following the title.

(iv) If the prior-filed provisional application was filed in a language other than English and an English-language translation of the prior-filed provisional application and a statement that the translation is accurate that is signed by the individual who made the translation

were not previously filed in the prior-filed provisional application or the later-filed nonprovisional application, applicant will be notified and given a period of time within which to file an English-language translation of the non-English-language prior-filed provisional application and a statement that the translation is accurate. In a pending nonprovisional application, failure to timely reply to such a notice will result in abandonment of the application.

(c) If an application or a patent under reexamination and at least one other application naming different inventors are owned by the same person 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. Even if 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 conflicting claims may be rejected under the doctrine of double patenting in view of such commonly owned or assigned applications or patents under reexamination.

20. Section 1.83 is amended by revising paragraph (a) to read as follows.

**§ 1.83 Content of drawing.**

(a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box). In addition, tables and sequence listings that are included in the specification are not permitted to be included in the drawings.

21. Section 1.84 is amended by revising paragraphs (a)(2) and (c) to read as follows:

**§ 1.84 Standards for drawings.**

(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 or design patent application or the subject matter of a statutory invention registration. The color drawings must be of sufficient quality such that all details in the drawings are reproducible in black and white in the printed patent. Color drawings are not permitted in international applications (see PCT Rule 11.13), or in an application, or copy thereof, submitted under the Office electronic filing system. The Office will accept color drawings in utility or design patent applications and statutory invention registrations only after granting a petition filed under this paragraph explaining why the color drawings are necessary. Any such petition must include the following:

- (i) The fee set forth in § 1.17(h);
- (ii) Three (3) sets of color drawings; and
- (iii) An amendment to the specification to insert (unless the specification contains or has been previously amended to contain) the following language as the first paragraph of the brief description of the drawings:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

\* \* \* \* \*

(c) *Identification of drawings.* Identifying indicia should be provided, and 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 on the front of each sheet, it must be placed to the left of the center within the top margin.

\* \* \* \* \*

22. Section 1.91 is amended by adding paragraph (c) to read as follows:

**§ 1.91 Models or exhibits not generally admitted as part of application or patent.**

\* \* \* \* \*

(c) Unless the model or exhibit substantially conforms to the requirements of § 1.52 or § 1.84 under paragraph (a)(1) of this section, it must be accompanied by photographs that show multiple views of the material features of the model or exhibit and that substantially conform to the requirements of § 1.84.

23. Section 1.94 is revised to read as follows:

**§ 1.94 Return of models, exhibits or specimens.**

(a) Models, exhibits, or specimens may be returned to the applicant if no

longer necessary for the conduct of business before the Office. When applicant is notified that a model, exhibit, or specimen is no longer necessary for the conduct of business before the Office and will be returned, applicant must arrange for the return of the model, exhibit, or specimen at the applicant's expense. The Office will dispose of perishables without notice to applicant unless applicant notifies the Office upon submission of a perishable model, exhibit or specimen that a return is desired and makes arrangements for its return promptly upon notification by the Office that the perishable model, exhibit or specimen is no longer necessary for the conduct of business before the Office.

(b) Applicant is responsible for retaining the actual model, exhibit, or specimen for the enforceable life of any patent resulting from the application. The provisions of this paragraph do not apply to a model or exhibit that substantially conforms to the requirements of § 1.52 or § 1.84, where the model, exhibit or specimen has been described by photographs that substantially conform to § 1.84, or where the model, exhibit or specimen is perishable.

(c) Where applicant is notified, pursuant to paragraph (a) of this section, of the need to arrange for return of a model, exhibit or specimen, applicant must arrange for the return within the period set in such notice, to avoid disposal of the model, exhibit or specimen by the Office. Extensions of time are available under § 1.136, except in the case of perishables. Failure to establish that the return of the item has been arranged for within the period set or failure to have the item removed from Office storage within a reasonable amount of time notwithstanding any arrangement for return, will permit the Office to dispose of the model, exhibit or specimen.

24. Section 1.98 is amended by revising paragraphs (a)(1), (a)(2), and (e) to read as follows:

**§ 1.98 Content of information disclosure statement.**

(a) \* \* \*

(1) A list of all patents, publications, applications, or other information submitted for consideration by the Office. U.S. patents and U.S. patent application publications must be listed in a section separately from citations of other documents. Each page of the list must include:

(i) The application number of the application in which the information disclosure statement is being submitted;

(ii) A column that provides a space next to each document to be considered for the examiner's initials; and

(iii) A heading that clearly indicates that the list is an information disclosure statement.

(2) A legible copy of:

(i) Each patent;

(ii) Each publication or that portion which caused it to be listed;

(iii) For each cited pending unpublished 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

\* \* \* \* \*

(e) The requirement in paragraph (a)(2) of this section for a copy of the U.S. patents or U.S. patent application publications listed in an information disclosure statement does not apply:

(1) In any national patent application filed after June 30, 2003;

(2) In any international application that has entered the national stage under 35 U.S.C. 371 after June 30, 2003; or

(3) In any information disclosure statement submitted in compliance with the Office's electronic filing system.

25. Section 1.102 is amended by revising paragraph (c) to read as follows:

**§ 1.102 Advancement of examination.**

\* \* \* \* \*

(c) A petition to make an application special may be filed without a fee if the basis for the petition is:

(1) The applicant's age or health; or

(2) That the invention will materially:

(i) Enhance the quality of the environment;

(ii) Contribute to the development or conservation of energy resources; or

(iii) Contribute to countering terrorism.

\* \* \* \* \*

26. Section 1.103 is amended by revising paragraph (a)(2) to read as follows:

**§ 1.103 Suspension of action by the Office.**

(a) \* \* \*

(2) The fee set forth in § 1.17(g), unless such cause is the fault of the Office.

\* \* \* \* \*

27. Section 1.105 is amended by redesignating paragraph (a)(3) as (a)(4) and revising it, and adding new paragraphs (a)(1)(viii) and (a)(3) to read as follows:

**§ 1.105 Requirements for information.**

(a)(1) \* \* \*

(viii) *Technical information known to applicant.* Technical information known to applicant concerning the interpretation of the related art, the disclosure, the claimed subject matter, other information pertinent to patentability, or the accuracy of the examiner's stated interpretation of such items.

\* \* \* \* \*

(3) Requirements for information may be presented in any appropriate form, for example:

(i) A requirement for documents;  
(ii) Interrogatories in the form of specific questions seeking applicant's knowledge; or

(iii) Stipulations in the form of statements with which the applicant may agree or disagree.

(4) Any reply to a requirement for information, apart from requirements for answers based on applicant's opinion, that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply. Any reply to a requirement for answers based on applicant's opinion that states that an opinion is not held by the party or parties from which it was requested will be accepted as a complete reply.

\* \* \* \* \*

28. Section 1.111 is amended by revising paragraph (a)(2) to read as follows:

**§ 1.111 Reply by applicant or patent owner to a non-final Office action.**

(a) \* \* \*

(2) *Supplemental replies.* (i) A supplemental reply will not be entered as matter of right except as provided in paragraph (a)(2)(ii) of this section. The Office may enter a supplemental reply that is filed before the expiration of the statutory period (*i.e.*, within six months from the mailing date of the non-final Office action) if the supplemental reply is clearly limited to:

(A) Cancellation of a claim(s);  
(B) Adoption of an examiner suggestion(s); or  
(C) Placement of the application in condition for allowance.

(ii) A supplemental reply will be entered if the supplemental reply is filed within the period during which action by the Office is suspended under § 1.103(a) through (c).

\* \* \* \* \*

29. Section 1.115 is revised to read as follows:

**§ 1.115 Preliminary amendments.**

(a) A preliminary amendment is an amendment that is received in the Office (*see* § 1.6) on or before the mail

date of the first Office action under § 1.104.

(b) A preliminary amendment submitted on or prior to the filing date of an application is part of the original disclosure of the application. If a preliminary amendment is determined to contain matter not otherwise included in the contents of the originally filed specification, including claims, and drawings, and the preliminary amendment is not specifically referred to in the oath or declaration under § 1.63, a new oath or declaration in compliance with § 1.63 will be required.

(c)(1) A preliminary amendment will be entered unless disapproved by the Director.

(i) A preliminary amendment seeking cancellation of all the claims without presenting any new or substitute claims will be disapproved. However, for filing and fee calculation purposes, such an amendment will cause the application to be treated as containing a single claim, which would be the first independent claim.

(ii) A preliminary amendment may be disapproved if the preliminary amendment unduly interferes with the preparation of a first Office action in an application. Factors that will be considered in disapproving a preliminary amendment include:

(A) The state of preparation of a first Office action as of the date of receipt (*see* § 1.6) of the preliminary amendment by the Office; and

(B) The nature of any changes to the specification or claims that would result from entry of the preliminary amendment.

(2) A preliminary amendment will not be disapproved under (c)(1)(ii) of this section if it is filed no later than:

(i) Three months from the filing date of an application under § 1.53(b);

(ii) The filing date of a continued prosecution application under § 1.53(d); or

(iii) Three months from the date the national stage is entered as set forth in § 1.491 in an international application.

(d) The time periods specified in paragraph (c)(2) of this section are not extendable.

30. Section 1.116 is amended by revising paragraph (b) to read as follows:

**§ 1.116 Amendments after final action or appeal.**

\* \* \* \* \*

(b) After a final rejection or other final action (*see* § 1.113) in an application or in an *ex parte* reexamination filed under § 1.510, or an action closing prosecution (*see* § 1.949) in an *inter partes* reexamination filed under § 1.913,

amendments may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or reexamination proceeding from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination prosecution from concluding under § 1.550(d) or § 1.957(b) or limitation of further prosecution under § 1.957(c). No amendment can be made in an *inter partes* reexamination proceeding after the right of appeal notice under § 1.953 except as provided for in paragraph (d) of this section.

\* \* \* \* \*

31. Section 1.131 is amended by revising paragraph (b) to read as follows:

**§ 1.131 Affidavit or declaration of prior invention.**

\* \* \* \* \*

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

32. Section 1.136 is amended by revising paragraph (b) to read as follows:

**§ 1.136 Extensions of time.**

\* \* \* \* \*

(b) When a reply cannot be filed within the time period set for such reply and the provisions of paragraph (a) of this section are not available, the period for reply will be extended only for sufficient cause and for a reasonable time specified. Any request for an extension of time under this paragraph must be filed on or before the day on which such reply is due, but the mere filing of such a request will not affect any extension under this paragraph. In no situation can any extension carry the date on which reply is due beyond the maximum time period set by statute. *See* § 1.304 for extensions of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a

civil action; § 1.645 for extensions of time in interference proceedings; § 1.550(c) for extensions of time in *ex parte* reexamination proceedings; and § 1.956 for extensions of time in *inter partes* reexamination proceedings. Any request under this section must be accompanied by the petition fee set forth in § 1.17(g).

\* \* \* \*

33. Section 1.137 is amended by revising its heading, the introductory text of paragraph (a), the introductory text of paragraph (b), paragraphs (d)(3) and (e) to read as follows:

**§ 1.137 Revival of abandoned application, concluded reexamination prosecution, or lapsed patent.**

(a) *Unavoidable*. If the delay in reply by applicant or patent owner was unavoidable, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination prosecution concluded under § 1.550(d) or § 1.957(b) or limited as to further prosecution under § 1.957(c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

\* \* \* \*

(b) *Unintentional*. If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination prosecution concluded under § 1.550(d) or § 1.957(b) or limited as to further prosecution under § 1.957(c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

\* \* \* \*

(d) \* \* \*

(3) The provisions of paragraph (d)(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, to lapsed patents, to reissue applications, or to reexamination proceedings.

(e) *Request for reconsideration*. Any request for reconsideration or review of a decision refusing to revive an abandoned application, a concluded reexamination prosecution, or lapsed patent upon petition filed pursuant to this section, to be considered timely, must be filed within two months of the decision refusing to revive or within such time as set in the decision. Unless a decision indicates otherwise, this time period may be extended under:

(1) The provisions of § 1.136 for an abandoned application or lapsed patent;

(2) The provisions of § 1.550(c) for a concluded *ex parte* reexamination prosecution filed under § 1.510; or

(3) The provisions of § 1.956 for a concluded *inter partes* reexamination

prosecution or an *inter partes* reexamination limited as to further prosecution filed under § 1.913.

\* \* \* \*

34. Section 1.165 is amended by revising paragraph (b) to read as follows:

**§ 1.165 Plant drawings.**

\* \* \* \*

(b) The drawings may be in color. The drawing must be in color if color is a distinguishing characteristic of the new variety. Two copies of color drawings or photographs must be submitted.

35. Section 1.173 is amended by revising paragraph (b) introductory text to read as follows:

**§ 1.173 Reissue specification, drawings, and amendments.**

\* \* \* \*

(b) *Making amendments in a reissue application*. An amendment in a reissue application is made either by physically incorporating the changes into the specification when the application is filed, or by a separate amendment paper. If amendment is made by incorporation, markings pursuant to paragraph (d) of this section must be used. If amendment is made by an amendment paper, the paper must direct that specified changes be made, as follows:

\* \* \* \*

36. Section 1.175 is amended by adding a new paragraph (e) to read as follows:

**§ 1.175 Reissue oath or declaration.**

\* \* \* \*

(e) The filing of any continuing reissue application which does not replace its parent reissue application must include an oath or declaration which, pursuant to paragraph (a)(1) of this section, identifies at least one error in the original patent which has not been corrected by the parent reissue application or an earlier reissue application. All other requirements relating to an oath or declaration must also be met.

37. Section 1.178 is amended by revising paragraph (a) to read as follows:

**§ 1.178 Original patent; continuing duty of applicant.**

(a) The application for reissue of a patent shall constitute an offer to surrender that patent, and the surrender shall take effect upon reissue of the patent. Until a reissue application is granted, the original patent shall remain in effect.

\* \* \* \*

**§ 1.179 [Removed and Reserved].**

38. Section 1.179 is removed and reserved.

39. Section 1.182 is revised to read as follows:

**§ 1.182 Questions not specifically provided for.**

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

40. Section 1.183 is revised to read as follows:

**§ 1.183 Suspension of rules.**

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

41. Section 1.213 is revised to read as follows:

**§ 1.213 Nonpublication request; rescission of a nonpublication request; notice of subsequent foreign filing.**

(a) *Nonpublication request and certification*. If the invention disclosed in an application has not been and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing, the application will not be published under 35 U.S.C. 122(b) and § 1.211 provided that:

(1) A request (nonpublication request) is submitted with the application upon filing;

(2) The request states in a conspicuous manner that the application is not to be published under 35 U.S.C. 122(b);

(3) The request contains a certification that the invention disclosed in the application has not been and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications at eighteen months after filing; and

(4) The request is signed in compliance with § 1.33(b). The certification under 35 U.S.C. 122(b)(2)(B)(i) and paragraph (a)(3) of this section is not appropriate unless the person signing the request has made an

actual inquiry consistent with the requirements of § 10.18(b) of this chapter with respect to the application to which the request and certification pertains to determine that:

(i) The application has not been the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications at eighteen months after filing; and

(ii) The applicant's intent at the time the nonpublication request is being filed is that the application will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications at eighteen months after filing.

(b) *Rescission of a nonpublication request.* The applicant may rescind a previously filed nonpublication request at any time. The mere filing of a request under 35 U.S.C. 122(b)(2)(B)(ii) and this paragraph to rescind a previously filed nonpublication request does not comply with the notice requirement of 35 U.S.C. 122(b)(2)(B)(iii) and paragraph (c) of this section. The provisions of § 1.8 do not apply in determining whether such an application has been filed before filing a request under this paragraph to rescind a previously filed nonpublication request. A request to rescind a nonpublication request under paragraph (a) of this section must:

(1) Identify the application to which it is directed;

(2) State in a conspicuous manner that the request that the application is not to be published under 35 U.S.C. 122(b) is rescinded; and

(3) Be signed in compliance with § 1.33(b). A request under paragraph (b) of this section to rescind a nonpublication request is not appropriate unless the person signing the request has made an inquiry consistent with the requirements of § 10.18(b) of this chapter and determined that a nonpublication request under paragraph (a) of this section was previously filed in the application in which the request to rescind a nonpublication request is directed.

(c) *Notification of subsequent foreign filing.* An applicant who has submitted a nonpublication request under 35 U.S.C. 122(b)(2)(B)(i) and paragraph (a) of this section, but before filing a request under 35 U.S.C. 122(b)(2)(B)(ii) and paragraph (b) of this section to rescind the previously filed nonpublication request, files an application directed to the invention disclosed in the application in which the nonpublication request was submitted in another country, or under

a multilateral international agreement, that requires publication of applications eighteen months after filing, must notify the Office of such filing within forty-five days after the date of the filing in another country, or under a multilateral international agreement. The provisions of § 1.8 do not apply in determining whether such an application has been filed before filing a request under paragraph (b) of this section to rescind a previously filed nonpublication request. The mere filing of a request under 35 U.S.C. 122(b)(2)(B)(ii) and paragraph (b) of this section to rescind a previously filed nonpublication request does not comply with the notice requirement of 35 U.S.C. 122(b)(2)(B)(iii) and this paragraph. The failure to timely notify the Office of the filing in another country, or under a multilateral international agreement, shall result in abandonment of the application in which the nonpublication request was submitted (35 U.S.C. 122(b)(2)(B)(iii)).

(d) *Publication after rescission or notice of foreign filing.* If an applicant who has submitted a nonpublication request under 35 U.S.C. 122(b)(2)(B)(i) and paragraph (a) of this section, subsequently files a request under 35 U.S.C. 122(b)(2)(B)(ii) and paragraph (b) of this section to rescind the nonpublication request or files a notice of a filing in another country, or under a multilateral international agreement, under 35 U.S.C. 122(b)(2)(B)(iii) and paragraph (c) of this section, the application shall be published as soon as is practical after the expiration of a period of eighteen months from the earliest filing date for which a benefit is sought under title 35, United States Code (35 U.S.C. 122(b)(2)(B)(iv)).

42. Section 1.215 is amended by revising paragraphs (a) and (c) to read as follows:

**§ 1.215 Patent application publication.**

(a) The publication of an application under 35 U.S.C. 122(b) shall include a patent application publication. The date of publication shall be indicated on the patent application publication. The patent application publication will be based upon the application papers deposited on the filing date of the application, as well as the executed oath or declaration submitted to complete the application, any application papers or drawings submitted in reply to a preexamination notice requiring a title and abstract in compliance with § 1.72, application papers in compliance with § 1.52, drawings in compliance with § 1.84, or a sequence listing in compliance with §§ 1.821 through 1.825, and any replacement drawings

received with the processing fee set forth in § 1.17(i) within the period set forth in paragraph (c) of this section, except as otherwise provided in this section. The patent application publication will not include any amendments, including preliminary amendments, unless applicant supplies a copy of the application containing the amendment pursuant to paragraph (c) of this section.

\* \* \* \* \*

(c) At applicant's option, the patent application publication will be based upon the copy of the application (specification, drawings, and oath or declaration) as amended during examination, provided that applicant supplies such a copy in compliance with the Office electronic filing system requirements within one month of the mailing date of the first Office communication that includes a confirmation number for the application, or within fourteen months of the earliest filing date for which a benefit is sought under title 35, United States Code, whichever is later.

\* \* \* \* \*

43. Section 1.291 is revised to read as follows:

**§ 1.291 Protests by the public against pending applications.**

(a) A protest may be filed by a member of the public against a pending application, and will be matched with the application file if it adequately identifies the patent application to the extent that the Office can timely match it. A protest which does not adequately identify a pending patent application will not be considered by the Office other than to return it to the protestor.

(b) Where the protest adequately identifies the patent application to the extent that the Office can timely match it with an application, the protest will be entered into the record of the application if it:

(1) Is submitted:

(i) Prior to the date the application was published under § 1.211, or the notice of allowance under § 1.311 was mailed, whichever occurs first; or

(ii) At any time if it is accompanied by the written consent of the applicant to the filing of the protest being submitted;

(2) Is served upon the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible; and

(3) Includes a statement identifying the real party in interest on whose behalf the protest is being filed to the extent necessary for determination of whether a party who may file a subsequent protest is in privity with the

identified real party in interest. Where anonymity of the real party in interest is desired, the protestor may provide, in place of the statement identifying the real party in interest, a substitute statement that the protest is, to the best of the knowledge of the submitting party, the first protest being submitted by the real party in interest. The substitute statement must be accompanied by a processing fee under § 1.17(i).

(c) Where the protest is entered into the record of the application, the items of information submitted with the protest, and the argument directed toward such items, will be considered by the examiner, if the protest includes:

(1) A listing of the patents, publications, or other information relied upon;

(2) A concise explanation of the relevance of each item listed pursuant to paragraph (c)(1);

(3) A copy of each listed patent, publication, or other item of information in written form, or at least the pertinent portions thereof;

(4) An English language translation of all the necessary and pertinent parts of any non-English language patent, publication, or other item of information relied upon; and

(5) If a second or subsequent protest by the same party, an explanation why the additional art issues are significantly different and why they were not earlier presented.

(d) A member of the public filing a protest in an application under this section will not receive any communication from the Office relating to the protest, other than the return of a self-addressed postcard which the member of the public may include with the protest in order to receive an acknowledgment by the Office that the protest has been received. The limited involvement of the member of the public filing a protest pursuant to this section ends with the filing of the protest, and no further submission on behalf of the protestor will be considered, unless the submission is accompanied by an explanation pursuant to paragraph (c)(5) of this section.

(e) Where a protest raising inequitable conduct issues satisfies the provisions of this section for entry, it will be entered into the application file, generally without comment on the inequitable conduct issues raised in it.

(f) In the absence of a request by the Office, an applicant has no duty to, and need not, reply to a protest.

(g) In order for a protest submitted after the application publication date to be accepted, the protest must be

accompanied by the written consent of the applicant to the filing of the protest being submitted.

44. Section 1.295 is amended by revising paragraph (a) to read as follows:

**§ 1.295 Review of decision finally refusing to publish a statutory invention registration.**

(a) Any requester who is dissatisfied with the final refusal to publish a statutory invention registration for reasons other than compliance with 35 U.S.C. 112 may obtain review of the refusal to publish the statutory invention registration by filing a petition to the Director accompanied by the fee set forth in § 1.17(g) within one month or such other time as is set in the decision refusing publication. Any such petition should comply with the requirements of § 1.181(b). The petition may include a request that the petition fee be refunded if the final refusal to publish a statutory invention registration for reasons other than compliance with 35 U.S.C. 112 is determined to result from an error by the Patent and Trademark Office.

\* \* \* \* \*

45. Section 1.296 is revised to read as follows:

**§ 1.296 Withdrawal of request for publication of statutory invention registration.**

A request for a statutory invention registration, which has been filed, may be withdrawn prior to the date on which the notice of the intent to publish a statutory invention registration issued pursuant to § 1.294(c) by filing a request to withdraw the request for publication of a statutory invention registration. The request to withdraw may also include a request for a refund of any amount paid in excess of the application filing fee and a handling fee of \$130.00 which will be retained. Any request to withdraw the request for publication of a statutory invention registration filed on or after the date on which the notice of intent to publish issued pursuant to § 1.294(c) must be in the form of a petition accompanied by the fee set forth in § 1.17(g).

46. Section 1.311 is amended by revising paragraph (b) to read as follows:

**§ 1.311 Notice of allowance.**

\* \* \* \* \*

(b) An authorization to charge the issue fee or other post-allowance fees set forth in § 1.18 to a deposit account may be filed in an individual application only after mailing of the notice of allowance. The submission of either of the following after the mailing of a notice of allowance will operate as a request to charge the correct issue fee or

any publication fee due to any deposit account identified in a previously filed authorization to charge such fees:

(1) An incorrect issue fee or publication fee; or

(2) A fee transmittal form (or letter) for payment of issue fee or publication fee.

47. Section 1.324 is amended by revising paragraph (a) and the introductory text of paragraph (b) to read as follows:

**§ 1.324 Correction of inventorship in patent, pursuant to 35 U.S.C. 256.**

(a) Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his or her part, the Director, pursuant to 35 U.S.C. 256, may, on application of all the parties and assignees, or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors. A request to correct inventorship of a patent involved in an interference must comply with the requirements of this section and must be accompanied by a motion under § 1.634.

(b) Any request to correct inventorship of a patent pursuant to paragraph (a) of this section must be accompanied by:

\* \* \* \* \*

48. Section 1.377 is amended by revising paragraph (b) to read as follows:

**§ 1.377 Review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of patent.**

\* \* \* \* \*

(b) Any petition under this section must be filed within 2 months of the action complained of, or within such other time as may be set in the action complained of, and must be accompanied by the fee set forth in § 1.17(g). The petition may include a request that the petition fee be refunded if the refusal to accept and record the maintenance fee is determined to result from an error by the Patent and Trademark Office.

\* \* \* \* \*

49. Section 1.378 is amended by revising paragraph (e) to read as follows:

**§ 1.378 Acceptance of delayed payment of maintenance fee in expired patent to reinstate patent.**

\* \* \* \* \*

(e) Reconsideration of a decision refusing to accept a maintenance fee upon petition filed pursuant to paragraph (a) of this section may be

obtained by filing a petition for reconsideration within two months of, or such other time as set in, the decision refusing to accept the delayed payment of the maintenance fee. Any such petition for reconsideration must be accompanied by the petition fee set forth in § 1.17(f). After decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director. If the delayed payment of the maintenance fee is not accepted, the maintenance fee and the surcharge set forth in § 1.20(i) will be refunded following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed. Any petition fee under this section will not be refunded unless the refusal to accept and record the maintenance fee is determined to result from an error by the Patent and Trademark Office.

50. Section 1.502 is revised to read as follows:

**§ 1.502 Processing of prior art citations during an *ex parte* reexamination proceeding.**

Citations by the patent owner under § 1.555 and by an *ex parte* reexamination requester under either § 1.510 or § 1.535 will be entered in the reexamination file during a reexamination proceeding. The entry in the patent file of citations submitted after the date of an order to reexamine pursuant to § 1.525 by persons other than the patent owner, or an *ex parte* reexamination requester under either § 1.510 or § 1.535, will be delayed until the reexamination proceeding has been terminated by the issuance and publication of a reexamination certificate. *See* § 1.902 for processing of prior art citations in patent and reexamination files during an *inter partes* reexamination proceeding filed under § 1.913.

51. Section 1.530 is amended by revising paragraph (k) to read as follows:

**§ 1.530 Statement by patent owner in *ex parte* reexamination; amendment by patent owner in *ex parte* or *inter partes* reexamination; inventorship change in *ex parte* or *inter partes* reexamination.**

(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 and published.

52. Section 1.550 is amended by revising paragraphs (c) and (d) to read as follows:

**§ 1.550 Conduct of *ex parte* reexamination proceedings.**

(c) The time for taking any action by a patent owner in an *ex parte* reexamination proceeding 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. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). *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.

(d) If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the prosecution in the *ex parte* reexamination proceeding will be concluded, and the Director will proceed to issue and publish a certificate terminating the reexamination proceeding under § 1.570 in accordance with the last action of the Office.

53. Section 1.570 is amended by revising its heading and paragraphs (a), (b) and (d) to read as follows:

**§ 1.570 Issuance and publication of *ex parte* reexamination certificate terminates *ex parte* reexamination proceeding.**

(a) To terminate an *ex parte* reexamination proceeding, the Director will issue and publish an *ex parte* reexamination certificate in accordance with 35 U.S.C. 307 setting forth the results of the *ex parte* reexamination proceeding and the content of the patent following the *ex parte* reexamination proceeding.

(b) An *ex parte* reexamination certificate will be issued and published in each patent in which an *ex parte* reexamination proceeding has been ordered under § 1.525 and has not been merged with any *inter partes* reexamination proceeding pursuant to § 1.989(a). Any statutory disclaimer filed by the patent owner will be made part of the *ex parte* reexamination certificate.

(d) If an *ex parte* reexamination certificate has been issued and published which cancels all of the claims of the patent, no further Office proceedings will be conducted with that patent or any reissue applications or any reexamination requests relating thereto.

54. Section 1.644 is amended by revising paragraphs (e) and (f) to read as follows:

**§ 1.644 Petitions in interferences.**

(e) Any petition under paragraph (a) of this section shall be accompanied by the petition fee set forth in § 1.17(f).

(f) Any request for reconsideration of a decision by the Director shall be filed within 14 days of the decision of the Director and must be accompanied by the fee set forth in § 1.17(f). No opposition to a request for reconsideration shall be filed unless requested by the Director. The decision will not ordinarily be modified unless such an opposition has been requested by the Director.

55. Section 1.666 is amended by revising paragraphs (b) and (c) 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(f) and on a showing of good cause.

(c) Failure to file the copy of the agreement or understanding under paragraph (a) of this section will render permanently unenforceable such agreement or understanding and any patent of the parties involved in the interference or any patent subsequently issued on any application of the parties so involved. The Director may, however, upon petition accompanied by the fee set forth in § 1.17(f) and on a showing of good cause for failure to file within the time prescribed, permit the filing of the agreement or understanding during the six-month period subsequent to the termination of the interference as between the parties to the agreement or understanding.

56. Section 1.704 is amended by revising paragraph (d) to read as follows:

**§ 1.704 Reduction of period of adjustment of patent term.**

(d) A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination)

of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

\* \* \* \* \*

57. Section 1.705 is amended by revising paragraph (d) to read as follows:

**§ 1.705 Patent term adjustment determination.**

\* \* \* \* \*

(d) If there is a revision to the patent term adjustment indicated in the notice of allowance, the patent will indicate the revised patent term adjustment. If the patent indicates a revised patent term adjustment, any request for reconsideration of the patent term adjustment indicated in the patent must be filed within thirty days of the date the patent issued and must comply with the requirements of paragraphs (b)(1) and (b)(2) of this section. Any request for reconsideration under this section that raises issues that were raised, or could have been raised, in an application for patent term adjustment under paragraph (b) of this section may be dismissed as untimely.

\* \* \* \* \*

58. Section 1.741 is amended by revising paragraph (b) to read as follows:

**§ 1.741 Complete application given a filing date; petition procedure.**

\* \* \* \* \*

(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(f) 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.

59. Section 1.902 is revised to read as follows:

**§ 1.902 Processing of prior art citations during an *inter partes* reexamination proceeding.**

Citations by the patent owner in accordance with § 1.933 and by an *inter partes* reexamination third party requester under § 1.915 or § 1.948 will be entered in the *inter partes* reexamination file. The entry in the patent file of other citations submitted after the date of an order for reexamination pursuant to § 1.931 by persons other than the patent owner, or the third party requester under either § 1.915 or § 1.948, will be delayed until the *inter partes* reexamination proceeding has been terminated by the issuance and publication of a reexamination certificate. See § 1.502 for processing of prior art citations in patent and reexamination files during an *ex parte* reexamination proceeding filed under § 1.510.

60. Section 1.953 is amended by revising paragraph (c) to read as follows:

**§ 1.953 Examiner's Right of Appeal Notice in *inter partes* reexamination.**

\* \* \* \* \*

(c) The Right of Appeal Notice shall be a final action, which comprises a final rejection setting forth each ground of rejection and/or final decision favorable to patentability including each determination not to make a proposed rejection, an identification of the status of each claim, and the reasons for decisions favorable to patentability and/or the grounds of rejection for each claim. No amendment can be made in response to the Right of Appeal Notice. The Right of Appeal Notice shall set a one-month time period for either party to appeal. If no notice of appeal is filed, prosecution in the *inter partes* reexamination proceeding will be concluded, and the Director will proceed to issue and publish a certificate under § 1.997 in accordance with the Right of Appeal Notice.

61. The subheading immediately preceding § 1.956 is revised to read as follows:

**EXTENSIONS OF TIME, CONCLUDING OF REEXAMINATION PROSECUTION, AND PETITIONS TO REVIVE IN *INTER PARTES* REEXAMINATION**

62. Section 1.956 is revised to read as follows:

**§ 1.956 Patent owner extensions of time in *inter partes* reexamination.**

The time for taking any action by a patent owner in an *inter partes* reexamination proceeding 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. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). 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.

63. Section 1.957 is amended by revising paragraph (b) to read as follows:

**§ 1.957 Failure to file a timely, appropriate or complete response or comment in *inter partes* reexamination.**

\* \* \* \* \*

(b) If no claims are found patentable, and the patent owner fails to file a timely and appropriate response in an *inter partes* reexamination proceeding, the prosecution in the reexamination proceeding will be concluded and the Director will proceed to issue and publish a certificate terminating the reexamination proceeding under § 1.997 in accordance with the last action of the Office.

\* \* \* \* \*

64. Section 1.958 is amended by revising its heading to read as follows:

**§ 1.958 Petition to revive *inter partes* reexamination prosecution concluded for lack of patent owner response.**

\* \* \* \* \*

65. Section 1.979 is amended by revising paragraph (f) to read as follows:

**§ 1.979 Action following decision by the Board of Patent Appeals and Interferences or dismissal of appeal in *inter partes* reexamination.**

\* \* \* \* \*

(f) An appeal by a third party requester is considered terminated by the dismissal of the third party requester's appeal, the failure of the third party requester to timely request rehearing under § 1.979(a) or (c), or a final decision under § 1.979(e). The date of such termination is the date on which the appeal is dismissed, the date on which the time for rehearing expires, or the date on which the decision of the Board of Patent Appeals and Interferences is final. An appeal by the patent owner is considered terminated by the dismissal of the patent owner's appeal, the failure of the patent owner to timely request rehearing under § 1.979(a) or (c), or the failure of the patent owner to timely file an appeal to the U.S. Court of Appeals for the Federal Circuit under § 1.983. The date of such termination is the date on which the appeal is dismissed, the date on which the time for rehearing expires, or the date on which the time for the patent owner's appeal to the U.S. Court of Appeals for the Federal Circuit



expires. If an appeal to the U.S. Court of Appeals for the Federal Circuit has been filed, the patent owner's appeal is considered terminated when the mandate is issued by the Court. Upon termination of an appeal, if no other appeal is present, the prosecution in the reexamination proceeding will be concluded and the Director will issue and publish a certificate under § 1.997 terminating the reexamination proceeding.

\* \* \* \* \*

66. Section 1.997 is amended by revising its heading and paragraphs (a), (b), and (d) to read as follows:

**§ 1.997 Issuance and publication of *inter partes* reexamination certificate terminates *inter partes* reexamination proceeding.**

(a) To terminate an *inter partes* reexamination proceeding, the Director will issue and publish an *inter partes* reexamination certificate in accordance with 35 U.S.C. 316 setting forth the results of the *inter partes* reexamination proceeding and the content of the patent following the *inter partes* reexamination proceeding.

(b) A certificate will be issued and published in each patent in which an *inter partes* reexamination proceeding has been ordered under § 1.931. Any statutory disclaimer filed by the patent owner will be made part of the certificate.

\* \* \* \* \*

(d) If a certificate has been issued and published which cancels all of the claims of the patent, no further Office proceedings will be conducted with that patent or any reissue applications or any reexamination requests relating thereto.

\* \* \* \* \*

**PART 5—SECRECY OF CERTAIN INVENTIONS AND LICENSES TO EXPORT AND FILE APPLICATIONS IN FOREIGN COUNTRIES**

67. The authority citation for 37 CFR part 5 continues to read as follows:

**Authority:** 35 U.S.C. 2(b)(2), 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.*; 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 Director (15 CFR 370.10(j), 22 CFR 125.04, and 10 CFR 810.7).

68. 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(g) of this chapter, 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.

69. Section 5.15 is amended by revising paragraph (c) to read as follows:

**§ 5.15 Scope of license.**

\* \* \* \* \*

(c) A license granted under § 5.12(b) pursuant to § 5.13 or § 5.14 shall have the scope indicated in paragraph (a) of this section, if it is so specified in the license. A petition, accompanied by the required fee (§ 1.17(g)), may also be filed to change a license having the scope indicated in paragraph (b) of this section to a license having the scope indicated

in paragraph (a) of this section. No such petition will be granted if the copy of the material filed pursuant to § 5.13 or any corresponding United States application was required to be made available for inspection under 35 U.S.C. 181. The change in the scope of a license will be effective as of the date of the grant of the petition.

\* \* \* \* \*

70. Section 5.25 is amended by revising paragraph (a)(4) to read as follows:

**§ 5.25 Petition for retroactive license.**

(a) \* \* \*

(4) The required fee (*see* § 1.17(g)). The explanation in paragraph (a)(3)(iii) must include a showing of facts rather than a mere allegation of action through error and without deceptive intent. The showing of facts as to the nature of the error should include statements by those persons having personal knowledge of the acts regarding filing in a foreign country and should be accompanied by copies of any necessary supporting documents such as letters of transmittal or instructions for filing. The acts which are alleged to constitute error without deceptive intent should cover the period leading up to and including each of the proscribed foreign filings.

\* \* \* \* \*

Dated: September 4, 2003.

**Jon W. Dudas,**

*Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office.*

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