

Rule by Rule Summary<sup>1</sup> of Final Rule<sup>2,3</sup> for  
“Changes to Support Implementation of the United States Patent and Trademark Office 21<sup>st</sup>  
Century Strategic Plan,” 69 FR 56481 (September 21, 2004); XX *Off. Gaz. Pat. Office* (October XX,  
2004)<sup>4</sup>

§ 1.4 Signature requirements for correspondence: Correspondence filed in the Office for a patent application, patent, or a reexamination proceeding may now be signed in two additional ways, namely, an S-signature (a signature between forward slash marks), or by an EFS character coded (electronic) signature, in addition to a handwritten (personally signed) signature.

a. Handwritten signature: Handwritten (personally signed) signatures are now specifically provided for in § 1.4(d)(1)<sup>5</sup>, and dark ink or its equivalent must be used for such signatures.

b. S-signature: An S-signature is defined in § 1.4(d)(2) as a signature between forward slash marks but not a handwritten signature as defined in § 1.4(d)(1). An S-signature includes any signature made by electronic or mechanical means not covered by either a handwritten signature of §§ 1.4(d)(1) or (e) or an Office EFS character coded signature of § 1.4(d)(3). An S-signature may be used on correspondence filed: 1) in paper, 2) by fax (§ 1.6(d)), or 3) via EFS as a Tag(ged) Image File Format (TIFF) attachment.

1. The S-signature must consist of only letters (including English and non-English alphabet, script fonts and text characters, such as Hebrew, Kanji, etc.) and/or Arabic numbers, and appropriate spaces and commas, periods, apostrophes, or hyphens for punctuation.

2. The person signing must insert his/her own S-signature with a first single

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<sup>1</sup>The instant summary is directed at identifying the more significant changes and does not attempt to identify each rule being amended or set forth each aspect of the amendment to a rule that is identified and discussed, or to include changes proposed in a previous notice of rule making (see f.n. 2), but not continued in the final rule making. For a more complete identification of the changes made, see the final rule and the accompanying preamble discussion.

<sup>2</sup> The final rule making is based on a Notice of Proposed Rule Making “Changes to Support Implementation of the United States Patent and Trademark Office 21<sup>st</sup> Century Strategic Plan,” 68 FR 53815 (September 12, 2003).

<sup>3</sup>The effective date is 30 days after publication, except that: (1) the changes to 37 CFR 1.4, 1.6, 1.10, 1.27, 1.57(a), 1.78, 1.84, 1.115, 1.137, 1.178 and 1.311 are effective on the date of publication in the Federal Register, and (2) the fee changes, § 1.17, are effective 60 days from the date of publication in the Federal Register.

<sup>4</sup>For a list of contacts, see the attached Appendix A. For an identification of rule changes which support each of the key drivers of the USPTO 21<sup>st</sup> Century Strategic Plan initiatives, see Appendix B.

<sup>5</sup> Handwritten signatures are also provided for in § 1.4(e).

forward slash mark before, and a second single forward slash mark after, the S-signature (e.g., /Dr. James T. Jones, Jr./). § 1.4(d)(2)(i).

3. A registered practitioner, whether signing as a practitioner of record per § 1.33(b)(1), or as a practitioner (not of record but) acting in a representative capacity per § 1.33(b)(2), must supply his/her registration number, either as part of the S-signature, or immediately below or adjacent thereto. A number (#) character may precede the supplied registration number. § 1.4(d)(2)(ii).

4. The signer's name must be:

(i) presented in printed or typed form immediately below or adjacent to the S-signature, § 1.4(d)(2)(iii)(A); and

(ii) reasonably specific so that the identity of the signer can be readily recognized. § 1.4(d)(2)(iii)(B).

Examples: /James Jones/

James T. Jones

/John Attorney, #123456/

John Attorney

c. EFS character coded signature (electronic signature): When correspondence is electronically filed via the Office's EFS, a(n electronic) signature in EFS character coded form is the vehicle provided by the software for signing such submissions. § 1.4(d)(3).

1. The electronic signature must consist of only letters of the English alphabet and/or Arabic numerals with appropriate spaces and commas, periods, apostrophes, or hyphens for punctuation. Note, S-signatures are not restricted to the English alphabet.

2. The person signing the correspondence must personally insert his/her electronic signature with a first single forward slash mark before, and a second single forward slash mark after, his/her signature. Note, making an S-signature has the same requirement.

3. The following correspondence filed via EFS as an Extensible Markup Language (XML) document may include an EFS character coded signature: new applications, assignments, amended biotech listings and e-IDSs.

4. The requirements for the location of the signer's name in printed or typed form and for the registration number of a practitioner are not set by § 1.4 (as for S-signatures), but by the EFS software.

d. Certifications as to a signature, § 1.4(d)(4):

1. A person submitting a document signed by another with an S-signature under § 1.4(d)(2), or an EFS character coded (electronic) signature under § 1.4(d)(3), per § 1.4(d)(4)(ii)(A):

(i) is obligated to have a reasonable basis to believe that the person whose signature is present on the document actually inserted that signature, and

(ii) should retain evidence of authenticity of the signature.

2. The person inserting an S-signature, or an EFS character coded (electronic) signature, per §§ 1.4(d)(2) or (d)(3), respectively, in a document submitted to the Office certifies that the inserted signature appearing in the document is his or her own signature. § 1.4(d)(4)(ii)(B).

3. Violations of the certifications as to the signature of another, or a person's own signature, may result in the imposition of sanctions under §§ 10.18(c) and (d). §§1.4(d)(4)(ii)(A) and (B).

e. Ratification, confirmation, evidence of authenticity, § 1.4(h):

1. The Office may require ratification, confirmation (which includes submission of a duplicate document but with a proper signature), or evidence of authenticity of a (handwritten, S-signature, or EFS character coded (electronic)) signature where the Office has reasonable doubt as to its authenticity, or where the signature and the typed or printed name do not clearly identify the person signing.

2. The failure to follow the format and content of an S-signature will usually be treated as a bona fide attempt at making an S-signature per 37 CFR 1.135(c), but it will cause the paper to be treated as unsigned with differing results depending upon the type of document. The following are examples of non-compliant, and not acceptable, S-signatures:

- i) the S-signature is not enclosed in forward slashes,
- ii) use is made of non-text graphic characters (e.g., smiley face),
- iii) there is no accompanying name adjacent or below the S-signature,
- (iv) the accompanying name adjacent or below the S-signature is

inadequate to enable clear identification of the signer.

Examples of Office treatment under 37 CFR 1.135(c) of papers with such non-compliant, and not acceptable, S-signatures, are as follows:

- i) for amendments, per MPEP 714.01(a), a new one-month time period would be given to ratify the improper S-signature, or
- ii) for § 1.63 declarations, a new two-month time period would be given to supply a properly signed declaration, and a surcharge may be imposed.

f. Name requirement for signature: There is no requirement that the signer's actual, full or legal name be used, in either handwritten signatures, S-signatures, or EFS character coded signatures, but it is strongly suggested that the full name be used. Titles may be included as part of S-signatures and EFS character coded signatures.

g. Some situations when an S-signature can be used:

- 1. After the practitioner creates a document and S-signature signs it on his/her PC, it is facsimile transferred directly from the PC to the Office; or it is printed, and then facsimile transferred, mailed, or hand-carried to the Office.
- 2. After an affidavit under § 1.132 is S-signed by the party making the affidavit, the S-signed affidavit is then electronically sent to the practitioner, e.g., via an e-mail. The practitioner can then facsimile transfer, mail or hand-carry the S-signature signed document to the Office, while retaining the e-mail(s) to and from the party making the affidavit as evidence of the authenticity of the S-signature by the party.

§ 1.6 Facsimile transmission of drawings permitted: Section 1.6(d) provides that black and white drawings in patent applications may be transmitted by facsimile at all times other than original filings and not just at the time of payment of the issue fee, which was permitted under prior practice.

- Note:
- 1. color drawings are not permitted to be sent by facsimile transmission, and
  - 2. photographs or drawings with fine detail should not be sent by facsimile transmission as facsimile transmission may degrade the quality, but the

Office would generally print what is received.

Interruptions in postal service: Section 1.6(e) material is transferred to § 1.10 as a more appropriate place.

§ 1.8 Exclusions to certificate of mailing practice: Section 1.8(a) is clarified to indicate that the list of exclusions in § 1.8(a)(2) is not exhaustive and that other prohibitions to the utilization of certificates of mailing are provided in rules other than § 1.8. For example, the provisions of § 1.8 do not apply to time periods or situations set forth in §§ 1.217(e) and 1.703(f) (which are not reflected in the § 1.8(a)(2) list of exclusions).

When correspondence is sent to, but not received by, the Office: Section 1.8(b) is revised to permit the following: If applicant sends a reply to the Office but the Office does not receive it, applicant may notify the Office of nonreceipt and supply a duplicate copy of the reply without having to wait for a notice of abandonment.

§ 1.10 When emergency affects Express Mail: New paragraphs 1.10(g) and (h) are created to provide for a petition to treat Express Mail that was refused or returned by USPS due to an interruption or emergency in Express Mail Service. Refusal requires that an employee of the USPS not accept correspondence due to an interruption or emergency in “Express Mail” service and not due to other reasons, such as insufficient postage or address. This procedure does not apply where an “Express Mail” drop box is unavailable or a Post Office facility is closed due to other than an interruption of emergency in service. The Office may require evidence, such as in the form of a letter from USPS, as to an interruption or emergency in “Express Mail” service. The refused or returned item would be considered as having been filed on the Express Mail date of deposit notwithstanding its refusal or return.

Petition re Express Mail interruption of service: Interruption of postal service designated by the Director is transferred from § 1.6(e) to new paragraph § 1.10(i) with an explicit provision for a petition.

§ 1.12 Petition to get copy of assignment: Section 1.12(c)(1), relating to requests for copies of any assignment records of any pending or abandoned patent application preserved in confidence under § 1.14, is amended to require a petition fee of \$200 per § 1.17(g).

§ 1.14 Petition for access: Section 1.14(h)(1), relating to the fee for petitions seeking access to, or copies of, a pending or abandoned application, is amended to require a petition fee of \$200 per § 1.17(g).

§ 1.17 Petition fees: A three tier petition fee structure replaces the former \$130 across the board petition fee. The three different fee levels (based on the results of an activity-based-accounting cost analysis of the Office’s cost in treating various types of petitions) are as follows:

1. \$130 prior fee retained (e.g., § 1.102 to make an application special), § 1.17(h),
2. \$200 (e.g., § 1.47 noncooperating inventor, § 1.59 expungement), § 1.17 (g), and
3. \$400 (e.g., § 1.53(e) to accord a filing date, § 1.182 questions not specifically provided for, and § 1.183 waiver), § 1.17(f).

Processing fee: For section 1.17(i), a processing fee of \$130 is added for second or subsequent protests by the same real party in interest per § 1.291(c)(5).

§ 1.19 Document supply fees:

a. Provides the Office with the flexibility to supply copies of files and/or documents in paper or electronic form, and it does not matter if the copies are obtained from an IFW, from original paper, or disc sources. § 1.19(b).

b. Copies of documents can be supplied on paper, or electronically (e.g., physically on disc or other than physically, such as e-mail). §§ 1.19(b)(2)(ii) and (iii).

c. The seven-day requirement for processing copy requests is removed.

d. Reference is made to § 1.21(k) for supplying copies of other patent-related materials, such as documents that cannot be scanned (e.g., oversized or illegible), microfiche, video cassettes, etc., at cost. § 1.19(b).

e. A petition is provided to obtain copies of documents in a form other than provided for in the rules of practice at cost. § 1.19(g)

§ 1.27 Small entity status and security interests: A new paragraph is added to clarify that a security interest in an application or patent held by a large entity (e.g., a large entity bank supplying financing) is not a sufficient interest to bar entitlement to small entity status so long as the security interest is not triggered. § 1.27(a)(5).

Small entity status, SBA requirements and foreign applicants: It is clarified that certain Small Business Administration requirements, relating to location in the U.S., or making a significant contribution to the U.S. economy, do not apply to foreign patent applicants (filing in the U.S.) as those particular requirements violate the Paris Convention for the Protection of Industrial Property. § 1.27(a)(2)(ii).

Small entity status has multiple requirements for small business concerns: Clarifies that the requirements for small business concerns regarding assignment of rights only to a small entity and the meeting of SBA requirements, such as the number of employees, are additive. § 1.27(a)(2)(i).

§ 1.47 Noncooperating inventor: Sections 1.47 (a) and (b), relating to noncooperating inventors, are amended to require a petition fee of \$200 per § 1.17(g).

§ 1.52 Recommended Font size: Recommends that the font size be at least 12, which is approximately 0.166 inches or 0.422 cm high. Section 1.52(b)(2)(ii). See also § 1.58(c).

Tables on CD: If the total number of pages of all the tables in an application exceeds 100 pages in length (or a single table is more than 50 pages in length, which practice is unchanged), the tables can be submitted on compact disc (CD-R or CD-ROM). § 1.52(e)(1)(iii).

Page: What constitutes a page is clarified. § 1.52(e)(1)(iii).

CD's must be finalized: To assure archival nature of discs, a requirement is added that discs be finalized so that they are closed. § 1.52(e)(3)(i).

Landscape orientation should be indicated: It is clarified that landscape orientation of a table is an example of special information needed to interpret a table that is to be provided on a

transmittal letter.

§ 1.52(e)(3)(ii).

§ 1.53 Petition re filing date of an application: Petition fee amount is raised from \$130 to \$400 for petitions relating to according a filing date per § 1.17(f). The Office will continue existing practice that filing date petitions which result solely from the fault of the USPTO (e.g., a lost application) will have the entire petition fee refunded. § 1.53(e)(2).

§ 1.57 Limited auto incorporation by reference of a prior application (new section 1.57(a)): A claim for priority under § 1.55 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 filing date of a U.S. application, is also considered an incorporation by reference of the prior-filed application for material completely contained in the prior-filed application, which material was inadvertently omitted from the U.S. application. Only material in the prior application as filed would be subject to incorporation in the later application. For the national stage of international applications designating the U.S., 35 U.S.C. 371, the incorporation is only effective as to incorporate omitted material from a foreign national application for which priority is claimed in the 35 U.S.C. 371 national stage application.

Timeliness for corrective amendment: Any amendment to include inadvertently omitted material needs to be made within any time period set by the Office (should the omission first be noticed by the Office and the applicant informed thereof), but in no case later than the close of prosecution (§ 1.114) or the abandonment of the application (should applicant be the first to notice the omission), whichever occurs earlier. § 1.57(a)(1). Any amendment to include inadvertently omitted material, submitted in reply to a final Office action or rejection, is subject to § 1.116.

Requirements for corrective amendment: A copy of the prior application (except where the prior application is an application filed under 35 U.S.C. 111) and an English language translation, if the prior application is in a foreign language, are required. Additionally, that portion of the prior application (whether foreign or U.S.) where the omitted portion being added to the later application can be found, must be identified. § 1.57(a)(1).

Affect on international applications: Any amendment to an international application is effective only as to the United States, and shall have no affect on the international filing date of the application.

Incorporation by reference of essential and nonessential material (new sections 1.57(b)-(g)):

Trigger required: Specific language referring to the material to be incorporated must be used to trigger an incorporation by reference, particularly where incorporation is essential to a 35 U.S.C. 112, sixth paragraph evaluation of the means or steps to perform a function. Use must be made of the perfecting words “incorporated by reference” or the root words “incorporate” (e.g., incorporating, incorporated) and “reference” (e.g., referencing). § 1.57(b)(1).

MPEP provisions added to rule: Codification of MPEP material (608.01(p)) on incorporation by reference of essential material is made with two changes:

1. Incorporation of essential material from an allowed application with the issue fee paid, is no longer permitted. § 1.57(c);

2. Incorporation of essential material from an application which has been published, which does not itself incorporate such material, is now permitted. § 1.57(c).

Essential material defined: A definition of essential material based on 35 U.S.C. 112, first, second and sixth paragraphs, sections 1.57(c)(1)-(3), as well as a definition for other (nonessential) material, section 1.57(d), are added. A prohibition against hyperlink or other browser incorporation is set forth. § 1.57(d).

Amendment: An amendment to include the incorporated material must be accompanied by a statement that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter.

Examiner may require a copy: Clarifies that the examiner may require submission of a copy of material incorporated by reference along with a statement that the copy consists of the same material incorporated, even if properly incorporated, e.g., to review background material to better understand the invention. § 1.57(e).

Effect of non-compliant incorporation, and importance of timely correction: An incorporation of material by reference that does not comply with paragraphs (b) or (c) of this section is not effective to incorporate such material unless corrected as set forth herein within any time period set by the Office (should the noncompliant incorporation by reference be first noticed by the Office and applicant informed thereof), but in no case later than the close of prosecution as defined by § 1.114(b) (should applicant be the first to notice the noncompliant incorporation by reference and the Office informed thereof), or abandonment of the application, whichever occurs earlier. § 1.57(g).

§ 1.58 Avoid table duplication: Section 1.58(a) is amended to clarify that a table must not be included in both the drawings and the body of the specification. An exclusion from the prohibition is provided for applications filed under 35 U.S.C. 371.

Integrity when rendering by Office is required: Sections 1.58(b) is clarified that when tables and chemical and mathematical formulas are rendered (opened and viewed using a text viewer program) by the Office, the integrity of the rows and columns of the tables and the proper positioning of the characters in formulas must be maintained. See also § 1.83.

Recommended Font size: A recommended font size of 12 points is set forth. Section 1.58(c). See also § 1.52(b)(2)(ii).

Font type deleted: A reference to elite type (typewriter type) is deleted as inconsistent with the font size being recommended.

§ 1.59 Petition for expungement: Section 1.59(b), relating to expungement of information, is amended to require a petition fee of \$200 per § 1.17(g).

§ 1.63 Oath or declaration: The phrase “(or authorization of agent)” is deleted as a conforming change to the notice of final rule entitled “Clarification of Power of Attorney Practice and Revisions to Assignment Rules,” 69 Fed. Reg. 29865 (May 26, 2004), 1283 *Off. Gaz. Pat Office* 148 (June 22, 2004).

§ 1.69 Foreign language oaths and declarations: Section 1.69(b) is amended by deleting the words “or approved” as unnecessary. Such language led to confusion and the mistaken assumption that the Office had a procedure for the approval of applicant generated forms. An exception is added to permit use of declaration forms under PCT Rule 4.17(iv).

§ 1.76 Application Data Sheet (ADS) requirements: An ADS must contain the title “Application Data Sheet,” and the seven headings listed in § 1.76(b) with all the appropriate data for each heading. § 1.76(a).

Data to include on supplemental ADS: When submitting a supplemental ADS, all appropriate information must be supplied with identification of what is being corrected, added, or deleted as opposed to submitting only the new or corrected information. Also requires that a supplemental ADS contain the title “Supplemental Application Data Sheet,” and the seven headings listed in § 1.76(b). § 1.76(c)(2).

How inconsistencies are treated: Sections 1.76(d)(1) and (2) are amended to clarify that an amendment to the specification and a designation of a correspondence address are examples of documents other than a § 1.63 oath or declaration that may have information inconsistent with information on the ADS, and how such inconsistencies are treated. In such case, the information in the ADS will be used if submitted earlier or at the same time as the other documents, but not for inventorship or citizenship where the § 1.63 declaration will control.

Correction via supplemental ADS not by § 1.63 oath or declaration: Section 1.76(d)(4) is amended to remove the option from the last sentence of requesting correction of captured bibliographic data by use of an oath or declaration under §§ 1.63 or 1.67 (but continuing to permit use of a supplemental ADS).

Supply ADS with inventorship or name changes: When making an inventorship change (§1.48), or changing the name of an inventor (§ 1.182), it is strongly advised that an ADS also be used to ensure the change is picked up for publication. 1281 OG 54 (March 17, 2003).

§ 1.78 Condition for U.S. benefit deleted: Section 1.78(a)(1)(ii) (prior application must be complete for a benefit claim to it) is deleted as unnecessary as any application meeting that condition for claiming benefit (prior application is complete) would also automatically meet the less restrictive condition of § 1.78(a)(1)(iii) (prior application entitled to a filing date and include the basic filing fee for a benefit claim to it).

Double patenting rejections possible: A sentence is added to § 1.78(c) to clearly indicate that the prior art exception under 35 U.S.C. 103(c) (common assignee) does not preclude making double patenting rejections. As stated in the preamble, the impact is that applicants are required to disclose related applications where a double patenting rejection can be made and should disclose any related application where applicant is in doubt as to whether a double patenting rejection can be made.

Multiple sentences permitted: The practice of requiring the benefit claims to be in a single sentence, §§ 1.78(a)(2)(iii) and (a)(5)(iii), is changed for clarity purposes to permit multiple sentences forming a continuous string from the beginning of the specification. For example, where there is a provisional application and multiple intermediate nonprovisional applications,



identification in the latest nonprovisional application as to which intermediate applications claim benefit to the provisional application, can be more clearly set forth by using multiple sentences.

§ 1.83 Avoid duplication in drawings of specification material: Clarifies that subject matter illustrated in the specification, tables and sequence listings, must not also be illustrated in the drawings. § 1.83(a). An exclusion from the prohibition is provided for applications filed under 35 USC 371. See also § 1.58.

§ 1.84 Color drawings and photographs no longer require black and white copies: Codifies previous OG Notice to remove requirement for black and white copies of color drawings and photos. See also § 1.165. Former § 1.84(a)(2)(iv) material is amended to become § 1.84(a)(2)(iii).

Identification labels for drawings: (1) Adds recommendation that drawings include identification labels. Where identification is supplied for the front of a drawing, it must be placed within the top margin. Section 1.84(c). (2) Drawings submitted after the filing date of the application must be identified as either: "Replacement Sheet," or "New Sheet," or "Annotated Sheet" (for a marked-up copy).

§ 1.85 No more "formal" drawings: Deleted the expression "or formal" to characterize a drawing as the expression "formal drawing" is no longer appropriate.

§ 1.91 Photos for models, exhibits, videos and DVDs: Now required that any model or exhibit that cannot be stored in the file, § 1.52, must be accompanied by photographs in conformance with § 1.84 (photos that are legible after being scanned by the Office) to show multiple views. It is explained in the preamble: (1) models, exhibits, or specimens not in compliance with § 1.52 and those in compliance that cannot be scanned into IFW will be stored by the Office in an artifact file until they can be disposed of; (2) that videos and DVDs should be accompanied by photos or some description that can be retained in the file (see § 1.94). § 1.91(c).

§ 1.94 Models, exhibits and specimens may be returned: For models, exhibits, or specimens that do not substantially conform to § 1.52 and therefore cannot be stored in the file (see § 1.91 where photographs thereof are submitted), applicant can be notified and required to arrange for their return (to applicant) at applicant's expense. Sections 1.94(a) and (c). The Office may return the model, exhibit or specimen once it is no longer necessary for the conduct of business. Applicant is responsible for retaining the model, exhibit, or specimen for the enforceable life of any patent. Section 1.94(b). For perishables, it is presumed that the Office has permission to dispose of them without notice to applicant unless applicant notifies the Office at the time of submission of the perishable that a return is desired and arrangements will be promptly made for its return upon notice by the Office. § 1.94(a).

§ 1.98 IDS format requirements: Format requirements for non-Office Information Disclosure forms are set forth.

IDS heading and column for initialing cites: Each page of an IDS list of citations is

required to include: a column providing a space next to each citation for the examiner to initial and a heading clearly identifying the list as an IDS for a particular application number.

§ 1.98(a)(1). Note: (1) Office forms PTO/SB/08a (8/03) and PTO/SB/08b (8/03) are fully compliant so it is recommended that use be made of these Office forms. (2) Any 1449 form that the public has may not be fully compliant. It is not an Office form, and the Office does not update it, nor recommend its usage.

Separate list of US patent documents: Requires applicants to separately list U.S. patents and U.S. patent application publications from other citations. This aids the Office in OCR scanning the U.S. patent and U.S. application publication list and to electronically provide the numerical list and search capability of the documents directly to examiners for IDSs. § 1.98(a)(1).

No copies of U.S. patents or U.S. patent application publications: Eliminates the requirement for applicants to supply copies of U.S. patents or U.S. patent application publications to the Office regardless of the filing date of the application. This change expands on “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 (August 5, 2003).

Note: (1) A large number of citations may trigger an Office requirement for applicant to supply paper copies for all the citations. See preamble discussion of Final Rule notice. (2)

Recommendation: Applicants are encouraged for two main reasons to file an e-IDS for U.S. patents and patent application publications rather than a paper IDS form (1449 or PTO/SB/08) listing the citations. First, an e-IDS is directly processed into the IFW system so it is available to the examiner much faster. Second, cites on a paper IDS form have to be entered into the IFW system via a more complex processing arrangement (OCR scanning, checking and then manually keying to correct scanning errors), which not only takes longer, but may introduce errors. (3) Copies of cited U.S. patent applications are also no longer required to be filed with an IDS. Even if the application is not published as a pre-grant publication, a copy does not have to be supplied if the application is in the Image File Wrapper (IFW) system. The waiver for copies is limited to the specification, claims and drawings. Applications in IFW includes all applications filed on or after June 30, 2003; check PAIR for earlier filed applications which are being continually added to the IFW. *Waiver of the Copy Requirement in 37 CFR 1.98 for Cited Pending U.S. Patent Applications*, \_ *Off. Gaz. Pat. Office* \_ (October 19, 2004).

§ 1.102 Advancement of examination: Establishes a petition without fee to make an application special based on an invention’s ability to counter terrorism. Section 1.102(c). Note: Where the application disclosure is not clear on its face that the claimed invention is materially directed to countering terrorism, an explanatory statement to that effect is required. MPEP 708.02, XI.

§ 1.103 Petition for suspension of actions: Section 1.103(a), relating to suspension of action for cause, is amended to require a petition fee of \$200 per § 1.17(g).

§ 1.105 Requirements for Information have an added example for technical information: Section 1.105 is amended to provide for requiring technical (factual) information (not opinions nor level

of ordinary skill in the art) of applicants. An additional (nonlimiting) example as to what applicant could be questioned about is added to § 1.105 relating to technical information known to applicant concerning facts as to: the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability, or the accuracy of the examiner's stated interpretation of such items. Section 1.105(a)(1)(viii). Examples, as provided in the preamble of the final rule, are applicant's actual knowledge:

- 1) of the common technical features shared among all claims or admission that certain groups of claims do not share any common technical features;
- 2) about the support found in the disclosure for means or step plus function claims (35 U.S.C. 112, para 6);
- 3) of precisely which portion(s) of the disclosure provide the written description and enablement support for specific claim element(s);
- 4) of the intended meaning of claim limitations or terms used in the claims, such as what teachings in the prior art would be covered by particular limitations or terms in a claim and which dictionary definitions would define a particular claim term, particularly where those terms are not used *per se* in the specification;
- 5) of which portions of each claim correspond to any admitted prior art in the specification;
- 6) of the specific utility provided by the claimed subject matter on a claim by claim basis;
- 7) as to whether a dependent claim element is known in the prior art based on the examiner having a reasonable basis for believing so;
- 8) of support for added limitations in an amended claim; and
- 9) of facts related to public use or sale situations.

How requirements for information may be presented in an Office action: Three examples are given as to the manner in which requirements for information may be set forth (§ 1.105(a)(3)):

- 1) a requirement for factual information,
  - 2) interrogatories in the form of specific questions seeking applicant's factual knowledge,
- or
- 3) stipulations as to facts with which the applicant may agree or disagree.

Replies to § 1.105 requirements for information: It is provided that any reply to a requirement for information that states either that the factual information required to be submitted is unknown or is not readily available to the party or parties from which it was requested may be accepted as a complete reply without further specification as to which of the two is relied upon (after a good faith attempt is made to obtain the information based on reasonable inquiry).

§ 1.105(a)(4). The preamble notes that such reply may affect the prosecution of the application, e.g., where inquiry is made in regard to correlation of structure set forth in the specification with a claim under 35 U.S.C. 122, paragraph 6, a reply that the correlation is unknown may cause, e.g., rejections under 35 U.S.C. 112, paragraphs 1 and 2 to be made.

Initial management review of requirements: For an initial break-in period the Office will provide management review of requirements for interrogatories and stipulations.

§ 1.111 Supplemental replies no longer have a right of entry:

- a. Supplemental replies are no longer entered as a matter of right.

b. Supplemental replies submitted before final rejection or allowance may be entered only if:

1) the prior reply is a complete reply,  
 2) the supplemental reply is filed in sufficient time to be entered before the examiner considers the prior reply,  
 and

3) the supplemental reply is limited to meeting conditions similar to those conditions used for entry of § 1.116(b) amendments after final rejection (§ 1.111(a)(2)(i)):

- i) cancellation of a claim(s),
- ii) adoption of an examiner's suggestion(s),
- iii) the application is placed in condition for allowance,
- iv) it is a reply to an Office requirement made after the first reply was filed,
- v) informalities are corrected, or
- vi) issues would be simplified for appeal.

c. The examiner is only required to give a supplemental reply a cursory review to determine compliance.

d. A supplemental reply that is properly not entered due to lack of compliance with the criteria of § 1.111(a)(2)(i) must be resubmitted, e.g., upon filing of an RCE, if entry is still desired.

\_\_\_\_\_ e. Where action by the Office is suspended on an application pursuant to §§ 1.103(a) and (c), supplemental replies filed during the suspension period continue to be entered as a matter of right. § 1.111(a)(2)(ii).

f. IDSs are not considered replies and therefore not subject to the new limitations, except where a second one is submitted in reply to a § 1.105 requirement for information (as explained in the preamble).

§ 1.115 Preliminary amendments may be in PG Pubs: Patent application publications may include preliminary amendments. Section 1.115(a). See also § 1.215(a).

\_\_\_\_\_ Preliminary amendments are part of the original disclosure: All preliminary amendments present on the filing date of an application are treated as part of the original disclosure of the application. § 1.115(a)(1).

\_\_\_\_\_ Added disclosure issues in preliminary amendment: For preliminary amendments present on the filing date of the application, which are not referred to in an accompanying § 1.63 oath or declaration (or a later submitted one), the normal operating procedure of the Office is not to screen to see if such preliminary amendments also include subject matter not otherwise included in the specification or drawings of the application as filed (i.e., subject matter that is “new matter” relative to the specification (including the claims) and drawings of the application). Accordingly, it is applicant's obligation to review preliminary amendments present on the filing date of the application to ensure that they do not contain new matter relative to the originally filed specification and drawings of the application. If the preliminary amendment does contain such new matter, it is applicant's additional obligation to have the inventor(s) via a § 1.63 oath or declaration, review and understand the contents of the application and acknowledge the duty to disclose to the Office all information known to be material to patentability as defined by § 1.56,

relative to any new matter disclosure in the preliminary amendment (i.e., execute a § 1.63 oath or declaration referring to the preliminary amendment).

Preliminary amendments canceling all claims: Codification of prior practice, the Office will disapprove a preliminary amendment (submitted prior to, on, or after the filing date of an application) canceling all claims without presenting any new claims. § 1.115(b)(1).

§ 1.121 Amendments with “New Sheet” of drawings: Clarified that any new sheet of drawing containing an additional figure must be labeled in the header as “New Sheet.”

§ 1.131 Affidavit of prior invention: Clarifies that the lack of original exhibits, drawings or records in support of an affidavit must be satisfactorily explained. § 1.131(b).

§ 1.136 Petition for extension of time for sufficient cause: A \$200 petition fee requirement, § 1.17(g), is added to defray the cost of evaluating the presence of sufficient cause to support an extension of time request under § 1.136(b).

§ 1.137 Terminal disclaimer not required to revive reissue: Clarifies that when reviving a reissue application pursuant to § 1.137, a terminal disclaimer is not required. § 1.137(d)(3).

§ 1.165 Color drawings or photographs for plants no longer require black and white copies: Section 1.165(b) is amended in a manner similar to § 1.84 changes.

§ 1.173 Amendments in reissue applications: Clarifies that paragraphs § 1.173(b)(1)-(3) are to be read with paragraph § 1.173(b) (replaced the period preceding (1)-(3) with a colon).

§ 1.175 Oath or declaration in reissue applications: Clarifies that a continuation reissue must identify an error not being corrected in the earlier reissue where the earlier reissue is not being abandoned. § 1.175(e).

§ 1.178 Original letters patent no longer required by Office: Eliminates the requirement in a reissue application for the actual physical surrender by applicant of the original letters patent (ribboned copy). The surrender of the original patent is automatic upon the grant of the reissue patent. § 1.178(a). Applies retroactively to all pending reissue applications.

The change applies retroactively to all pending applications.

§ 1.179 Notice of reissue application: Section 1.179 is removed and reserved to eliminate requirements on the Office for placement of a paper notice in the original patent file of: the filing of a reissue application, and the grant of a reissue patent or other termination of the reissue proceeding. Public PAIR now provides this information. Notification in the *Official Gazette* of the filing of a reissue application (pursuant to § 1.11) will continue.

§ 1.182 Petition re matters not provided for: The petition fee is \$400 per § 1.17(f).

§ 1.183 Petition re waiver of rule requirements: The petition fee is \$400 per § 1.17(f).

§ 1.215 PG Pubs may include amendments: Patent application publications may be based on (nonEFS) amendments to the:

1. specification (other than the abstract or the claims) that are reflected only in a substitute

specification under § 1.125(b),

2. abstract under § 1.121(b),

\_\_\_\_\_ 3. claims that are reflected in a complete claim listing under section 1.121(c), and

4. drawings under § 1.121(d),

provided that the substitute specification or amendment is submitted in sufficient time to be entered into the Office file wrapper of the application before technical preparations for publication of the application have begun (e.g., generally four months prior to the projected date of publication). § 1.215(a).

\_\_\_\_\_ National stage: The patent application publication of an application that has entered the national stage under 35 U.S.C. 371 may also include amendments made during the international stage.

\_\_\_\_\_ Requests for republications versus corrected publications: Any request for a corrected publication under § 1.221(b) based on the failure to include in the patent application publication a substitute specification or amendment (not submitted in compliance with § 1.215(c)) will not be accepted notwithstanding how timely it was submitted. Resort may be had to republication pursuant to § 1.221(a). To ensure that a patent application publication reflects an amendment, advantage should be taken of § 1.215(c) by use of the Electronic Filing System (EFS).

\_\_\_\_\_ Time for EFS submission of amended application for publication: Codification of OG notice providing a new additional time frame of one month from the mail date of a filing receipt (instead of one month from the actual filing date of the application). “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 (December 26, 2000). The OG notice is expanded to apply the one month mail date to the first Office communication with a confirmation number (and not just the mail date of the filing receipt), for submitting an amended application via EFS for publication. Section 1.215(c).

§ 1.291 Applicant may consent to untimely protest: Creates an explicit provision to accept a protest after the application publication date in § 1.291(g), based on the express written consent of the applicant pursuant to 35 U.S.C. 122(c). Section 1.291(b)(1).

\_\_\_\_\_ First protests: A statement must accompany a protest that it is the first protest submitted in the application by the real party in interest (who does not need to be identified), or compliance must be had with § 1.291(c)(5) relating to second or subsequent protests. This section is not applicable where the protest is in fact the first protest in the application. § 1.291(b)(2).

\_\_\_\_\_ Explanation for second or subsequent protests: For consideration of second or subsequent protests by the same real party in interest, an explanation is required as to why the additional prior

art issues are significantly different, and why the art issues were not earlier presented. A processing fee of \$130 under § 1.17(i) is also required. § 1.291(c)(5).

Cumulative prior art not permitted in subsequent protest: Eliminates the ability of a single protestor to submit cumulative prior art in a subsequent protest by requiring in a subsequent protest an explanation as to how the issue(s) are significantly different and why the different issue(s) were not presented in the earlier protest.

Rule format was revised: The section is substantially reformatted for clarity.

Office may consider despite non-compliance: It has been clarified in the rule and the preamble that the Office retains flexibility as to reviewing the information submitted notwithstanding lack of compliance with the timeliness and content requirements of a protest.

§ 1.295 Statutory invention registration, review of refusal to publish: The petition fee for review of a decision refusing to publish a statutory invention registration is \$200 per § 1.17(g).

§ 1.296 Statutory invention registration, withdrawal of: The petition fee for a request to withdraw a statutory invention registration from publication, where the request is filed on or after the date of a notice of intent to publish, is converted from a petition under § 1.183 to a § 1.17 fee and raised to \$200 per § 1.17(g).

§ 1.311 Notice of allowance: Exceptions are added to permit reliance on a previous authorization to charge allowance and publication fees to a deposit account. The submission of an incorrect publication fee or a completed fee transmittal form (which form applies to both issue and publication fees), for payment of a publication fee, would operate as a valid request to charge the publication fee to any previously identified deposit account (notwithstanding that previously submitted general authorizations to charge a deposit account are generally ineffective to pay issue or publication fees). The prohibition on non-Office issue fee forms is removed and non-Office publication fee forms are permitted. § 1.311(b).

Appropriate fee must be identified: It is clarified that previously filed authorizations to charge a deposit account will be given effect under the exceptions provided by the rule only where the previous authorizations are broad enough to cover the issue and publication fees to be charged, e.g., previous authorizations only to pay §§ 1.16 and 1.17 fees do not effectuate payment of issue fee or publication fees under § 1.18. § 1.311(b).

§ 1.324 Inventorship correction in a patent, all parties required: A specific reference to 35 U.S.C. 256 is added to clarify that a request from all the inventors (whether or not they have assigned away their rights) together with all the existing assignees must be made. The former reference to “petition” is replaced by a “request” to conform to previous changes made in § 1.20(b).  
§ 1.324(a).

§ 1.377 Maintenance fee, review: The petition fee for review of a decision refusing to accept a maintenance fee is \$200 per § 1.17(g).

§ 1.378 Maintenance fee, reconsideration: The petition fee for reconsideration of a decision refusing to accept a maintenance fee is \$400 per § 1.17(f).

§ 1.550 Ex parte reexamination petition fee: Obtaining an extension of time for cause, under § 1.550(c), now requires a petition fee of \$200 per section 1.17(g).

§ 1.741 Application for extension of patent term: The fee for a petition for review of a notice of an incomplete application for extension of patent term is \$400 per § 1.17(f). § 1.741(b).

§ 1.956 Inter partes reexamination: Obtaining an extension of time for cause, under § 1.956, now requires a petition fee of \$200 per § 1.17(g).

§ 5.12 Petition for foreign filing license: The petition fee for a foreign filing license is \$200 per § 1.17(g). § 5.12(b).

§ 5.15 Scope of foreign filing license: The petition fee for changing the scope of a foreign filing license is \$200 per § 1.17(g). § 5.15(c).

§ 5.25 Retroactive foreign filing license: The petition fee for a retroactive foreign filing license is \$200 per § 1.17(g). § 5.25(a)(4).



Appendix A - Contacts

The alternative set of phone numbers are effective September 28, 2004.

Generally: Office of Patent Legal Administration (OPLA) (571) 272-7701

- Robert J. Spar (Director) (703) 308-5107 or (571) 272-7700
- Hiram H. Bernstein (Senior Legal Advisor) (703) 305-8713 or (571) 272-7707

For the more significant rules<sup>6</sup>:

- § 1.4, Michael Lewis (571) 272-7755
- § 1.6, Karin Ferriter (571) 272-7744
- § 1.17, Anton Fetting (571) 272-7717
- § 1.19, Karin Ferriter (571) 272-7744
- § 1.27, Eugenia Jones (571) 272-7727
- § 1.52 (translations) (font size), Karin Ferriter (571) 272-7744
- § 1.52, (compact discs), Michael Lewis (571) 272-7755
- § 1.57, Eugenia Jones (571) 272-7727
- § 1.58, Michael Lewis (571) 272-7755
- § 1.76, Kery Fries (571) 272-7757
- § 1.78, Jeanne Clark (571) 272-7714
- §§ 1.83, 1.84, 1.165, Karin Ferriter (571) 272-7744
- §§ 1.91, 1.94, Joni Chang (571) 272-7720 or Eugenia Jones (571) 272-7727
- § 1.98, Jeanne Clark (571) 272-7714
- § 1.102, James Engel (571) 272-7725
- § 1.105, Anton Fetting (571) 272-7717
- § 1.111, Joni Chang (571) 272-7720
- § 1.115, Fred Silverberg (571) 272-7719
- § 1.136, Hiram Bernstein (571) 272-7707
- §§ 1.137, 1.175, 1.178, 1.179, 1.550, 1.956, Kenneth Schor (571) 272-7710
- §§ 1.213, 1.215, Mark Polutta (571) 272-7709
- § 1.291, James Engel (571) 272-7725
- § 1.311, Cynthia Nessler (571) 272-7724
- § 1.324, Hiram Bernstein (571) 272-7707
- § 1.550, Kenneth Schor (571) 272-7710
- § 1.705, Kery Fries (571) 272-7757

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<sup>6</sup>For a complete list of contacts for all the rules see the Fed Reg publication of the final rule.

Appendix B - Changes in Support of the 21<sup>st</sup> century Strategic Plan Initiatives

The following concepts are the drivers behind the USPTO 21<sup>st</sup> Century Strategic Plan. Identified with each driver are examples of the rules changes that best embody these concepts:

*Quality*: §§ 1.52, 1.78, 1.105, 1.291

*E-government*: §§ 1.4, 1.19, 1.52, 1.58, 1.84(c), 1.91(c), 1.94, 1.98

*Pendency/Timeliness*: §§ 1.6, 1.111, 1.115

*Resource alignment*: §§ 1.17, 1.94, 1.136/1.550/1.956

*Unnecessary formalities removal*: §§ 1.6, 1.27, 1.57(a), 1.137, 1.178, 1.179, 1.215, 1.311