DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Parts 1 and 5

RIN 0651–AB05

Changes to Implement Eighteen-Month Publication of Patent Applications

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Final rule.

SUMMARY: The United States Patent and Trademark Office (Office) is revising the rules of practice in patent cases to implement certain provisions of the American Inventors Protection Act of 1999. These provisions of the American Inventors Protection Act of 1999 provide, with certain exceptions, for the publication of pending patent applications (other than design applications) at eighteen months from the earliest claimed priority date.

DATES: *Effective Date:* November 29, 2000.

Applicability Date: Sections 1.103(d), 1.211, 1.213, 1.215, 1.217, 1.219, and 1.221, and the changes to §§ 1.14, 1.55, 1.72, 1.78, 1.85, 1.99, 1.137, 1.138, and 1.311, apply to any patent application filed on or after November 29, 2000, and to any patent application in which applicant requests voluntary publication.

FOR FURTHER INFORMATION CONTACT: *Concerning this final rule:* Robert W. Bahr, Karin L. Tyson, or Robert A. Clarke by telephone at (703) 308–6906, or by mail addressed to: Box Comments—Patents, Assistant Commissioner for Patents, Washington, D.C. 20231, or by facsimile to (703) 872–9411, marked to the attention of Robert W. Bahr.

Concerning the electronic filing system (EFS): Jay Lucas or Michael Lewis by electronic mail message via the Internet addressed to jay.lucas@uspto.gov.

SUPPLEMENTARY INFORMATION: The American Inventors Protection Act of 1999 (Title IV of the Intellectual Property and Communications Omnibus Reform Act of 1999 (S. 1948) as introduced in the 106th Congress on November 17, 1999) was incorporated and enacted into law on November 29, 1999, by section 1000(a)(9), Division B, of Public Law 106–113, 113 Stat. 1501 (1999). The American Inventors Protection Act of 1999 contains a number of changes to title 35, United States Code. This notice revises the rules of practice to implement the provisions of sections 4501 through 4508 (Subtitle E, Domestic Publication of Patent Applications Published Abroad) of the American Inventors Protection Act of 1999. These provisions of the American Inventors Protection Act of 1999 provide that, with certain exceptions, applications for patent shall be published promptly 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 (''eighteen-month publication'').

Section 4502 of the American Inventors Protection Act of 1999 amends 35 U.S.C. 122 (35 U.S.C. 122(b)) to provide that applications for patent shall be published promptly 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, and that an application may be published earlier than the end of such eighteen-month period at the request of the applicant. Section 4502 of the American Inventors Protection Act of 1999 (35 U.S.C. 122(b)) also contains a number of exceptions to eighteen-month publication of patent applications.

First: An application shall not be published if it is: (1) No longer pending; (2) subject to a secrecy order under 35 U.S.C. 181 or an application for which publication or disclosure would be detrimental to national security; (3) a provisional application under 35 U.S.C. 111(b); or (4) an application for a design patent under 35 U.S.C. chapter 16. *See* 35 U.S.C. 122(b)(2)(A) and (d).

Second: An application shall not be published if an applicant makes a request upon filing, certifying 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 eighteen-month publication. An applicant may rescind such a request at any time. In addition, an applicant who has made such a request but who subsequently files an application directed to the invention disclosed in the application filed in the Office in a foreign country, or under a multilateral international agreement, that requires eighteen-month publication, must notify the Office of such filing within forty-five days after the date of the filing of such foreign or international application. An applicant's failure to timely provide such a notice to the Office will result in abandonment of the application (subject to revival if it is shown that the delay in submitting the notice was unintentional). If an applicant rescinds such a request or notifies the Office that an application was filed in a foreign country, or under a multilateral international agreement, that requires eighteen-month publication, the application is subject to eighteen-month publication. *See* 35 U.S.C. 122(b)(2)(B)(i)–(iv).

Third: If an applicant has filed applications in one or more foreign countries, directly or through a multilateral international agreement, and such foreign-filed applications or the description of the invention in such foreign-filed applications is less extensive than the application or description of the invention in the application filed in the Office, the applicant may submit a redacted copy of the application filed in the Office eliminating any part or description of the invention in such application that is not also contained in any of the corresponding applications filed in a foreign country. If the redacted copy of the application is received within sixteen months after the earliest filing date for which a benefit is sought under title 35, United States Code, the Office may publish only the redacted copy of the application. *See* 35 U.S.C. 122(b)(2)(B)(v).

Section 4503(a) of the American Inventors Protection Act of 1999 amends 35 U.S.C. 119(b) to provide that no application for patent shall be entitled to a right of priority under 35 U.S.C. 119(a)–(d) unless a claim is filed in the Office, identifying the foreign application by specifying the application number of that foreign application, the intellectual property authority or country in or for which the application was filed, and the date of filing the application, at such time during the pendency of the application as required by the Office. Section 4503(a) of the American Inventors Protection Act of 1999 also amends 35 U.S.C. 119(b) to provide that the Office may consider the failure of the applicant to timely file a claim for priority as a waiver of any such claim, and may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed claim under 35 U.S.C. 119(b)–(d). Section 4503(a) of the American Inventors Protection Act of 1999 also amends 35 U.S.C. 119(b) to authorize the Office to determine whether to require a certified copy of the original foreign application.

Section 4503(b)(1) of the American Inventors Protection Act of 1999 amends 35 U.S.C. 120 to provide that no application shall be entitled to the benefit of an earlier filed application under 35 U.S.C. 120 unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the

pendency of the application as required by the Office. Section 4503(b)(1) of the American Inventors Protection Act of 1999 also amends 35 U.S.C. 120 to provide that the Office may consider the failure to submit such an amendment within that time period as a waiver of any benefit under 35 U.S.C. 120, and may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under 35 U.S.C. 120.

Section 4503(b)(2) of the American Inventors Protection Act of 1999 amends 35 U.S.C. 119(e) to provide that no application shall be entitled to the benefit of an earlier filed provisional application under 35 U.S.C. 119(e) unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Office. Section 4503(b)(2) of the American Inventors Protection Act of 1999 also amends 35 U.S.C. 119(e) to provide that the Office may consider the failure to submit such an amendment within that time period as a waiver of any benefit under 35 U.S.C. 119(e), and the Office may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under 35 U.S.C. 119(e) during the pendency of the application.

Case law has indicated that, in certain instances, priority claims may be perfected after issuance. The U.S. Court of Appeals for the District of Columbia has held that the equitable or remedial provisions of 35 U.S.C. 251 authorize patentees to correct or perfect a claim for priority under 35 U.S.C. 119 in an issued patent by reissue. *See Brenner* v. *State of Israel*, 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968). The U.S. District Court for the District of Columbia applied this rationale to permit a patentee to amend an intermediate abandoned application in a chain of applications for which a benefit was claimed under 35 U.S.C. 120 to include the specific reference required by 35 U.S.C. 120. *See Sampson* v. *Commissioner*, 195 USPQ 136 (D.D.C. 1976). In appropriate circumstances, the Office has permitted patentees to perfect claims under 35 U.S.C. 119, 120, or 121 in an issued patent by certificate of correction under 35 U.S.C. 255 and § 1.323. *See In re Schuurs*, 218 USPQ 443 (Comm'r Pat. 1983); *In re Lambrech*, 202 USPQ 620 (Comm'r Pat. 1976); *In re Van Esdonk*, 187 USPQ 671 (Comm'r Pat. 1975).

The amendments to 35 U.S.C. 119 and 120 provide that the Office may consider the failure of the applicant to file a timely claim under 35 U.S.C. 119 or 120 as a waiver of any such claim. Sections 1.55 and 1.78 implement these amendments to 35 U.S.C. 119 and 120 by specifying time periods during the pendency of the application within which claims under 35 U.S.C. 119(a)–(d), 119(e), and 120 must be stated or are considered waived. 35 U.S.C. 119(b), 119(e), and 120 each provide that the Office may establish procedures to accept an unintentionally delayed submission of a claim under 35 U.S.C. 119(b), 119(e), or 120 (respectively); however, 35 U.S.C. 119(e) requires that such unintentionally delayed claim (amendment) be submitted during the pendency of the application. Thus, a claim under 35 U.S.C. 119(a)–(d) or 120 for the benefit of a prior application may be added (or corrected) in an issued patent by reissue or certificate of correction (assuming the conditions for reissue or certificate of correction are otherwise met) by submitting such untimely claim under the procedures established in § 1.55 or § 1.78 (including payment of any applicable surcharge). A claim under 35 U.S.C. 119(e) for the benefit of a prior provisional application, however, must be added or corrected during the pendency of the application.

Section 4504 of the American Inventors Protection Act of 1999 amends 35 U.S.C. 154 to provide that, subject to a number of conditions, a patent includes the right to obtain a reasonable royalty during the period beginning on the date of publication of the application for such patent under 35 U.S.C. 122(b) (or the date of publication under Patent Cooperation Treaty (PCT) Article 21(2) of an international application designating the United States) and ending on the date the patent is issued (''provisional rights'').

Section 4505 of the American Inventors Protection Act of 1999 amends 35 U.S.C. 102(e) to, *inter alia*, set forth the conditions under which an application published under 35 U.S.C. 122(b) or under PCT Article 21(2) is prior art as of its filing date.

Section 4506 of the American Inventors Protection Act of 1999 provides that the Office shall recover the cost of early publication required by 35 U.S.C. 122(b) by charging a separate publication fee after a notice of allowance is given under 35 U.S.C. 151.

Section 4508 of the American Inventors Protection Act of 1999 provides that its eighteen-month publication provisions take effect on November 29, 2000, and apply to applications (other than for a design patent) filed under 35 U.S.C. 111(a) on or after November 29, 2000, and to applications in compliance with 35 U.S.C. 371 that resulted from international applications filed under 35 U.S.C. 363 on or after November 29, 2000.

The Office published a notice proposing changes to the rules of practice to implement the provisions of §§ 4501 through 4508 (Subtitle E, Domestic Publication of Patent Applications Published Abroad) of the American Inventors Protection Act of 1999. *See* Changes to Implement Eighteen-Month Publication of Patent Applications, Notice of Proposed Rulemaking, 65 FR 17946 (Apr. 5, 2000), 1233 Off. Gaz. Pat. Office 121 (Apr. 25, 2000) (notice of proposed rulemaking). This final rule adopts changes to the rules of practice to implement the provisions of §§ 4501 through 4508 of the American Inventors Protection Act of 1999.

The Office's planning approach to eighteen-month publication includes: (1) Disseminating a publication document (patent application publication) for each published application; and (2) providing (under conditions set forth below) any member of the public with access to the file wrapper and contents of each published application (which may be limited to a copy of the file wrapper and contents of the application).

Patent application publication: The patent application publication will include a front page containing information similar to that contained on the front page of a patent, and the drawings (if any) and specification (including claims) of the published application. To create the patent application publication, the Office plans to use its Patent Application Capture and Review (PACR) system to create an electronic database (PACR database) containing: (1) The application papers and drawings deposited on the filing date of the application; and (2) any subsequently filed application papers and drawings needed to create the patent application publication. The application information contained in the Office's PACR database will be used to create the patent application publication, unless the applicant provides a copy of the application via the Office's electronic filing system (EFS) to be used to create the patent application publication (discussed below).

The Office currently uses the PACR database as the Office's record of the application papers submitted on the filing date of the application (i.e., the original disclosure of the invention). The application papers submitted on the filing date of the application, however, may not include the content needed

(e.g., an abstract), and the application papers or drawings may not be of sufficient quality (e.g., papers not having sufficient contrast to permit electronic capture by digital imaging and conversion to text by optical character recognition or drawings not having sufficient quality) to be used to create a patent application publication. Since the patent application publication will be a prior art document (and, in most cases, the prior art document having the earliest effective date under 35 U.S.C. 102(a), (b), and (e)), the Office must consider the usability of the patent application publication as a prior art document when determining what drawing quality is needed to create the patent application publication.

If the application papers submitted on the filing date of the application do not include the content needed, or the application papers or drawings are not of sufficient quality to be used, to create a patent application publication, the Office of Initial Patent Examination (OIPE) will issue a notice requiring that the applicant submit the needed application content, or application papers or drawings of sufficient quality, for use in creating a patent application publication. The applicant's reply to that notice (application papers and drawings needed to create the patent application publication) will then be added to the PACR database. The Office must separate the application papers and drawings deposited on the filing date of the application and the subsequently filed application papers and drawings in its PACR database because the PACR database is also used to create any requested certified copy of the application (which may only include the application papers and drawings deposited on the filing date of the application).

Initially, an application filed under 35 U.S.C. 111(a) (nonprovisional) must be entitled to a filing date (i.e., contains a written description of the invention, a drawing (if necessary for an understanding of the invention), and at least one claim) for the application to be in condition for publication. In addition, if an application filed under 35 U.S.C. 111(a) otherwise entitled to a filing date appears to omit a portion of the description or a drawing figure, the omitted portion of the description or drawing figure(s) must be supplied, or the period for supplying such portion of the description or drawing figure(s) must have expired, for the application to be in condition for publication. The requirements for an application filed under 35 U.S.C. 111(a) to be entitled to a filing date and the treatment of an application filed under 35 U.S.C. 111(a) that appears to omit a portion of the description or a drawing figure is set forth in sections 601.01(d) through 601.01(g) of the Manual of Patent Examining Procedure (7th ed. 1998) (Rev. 1, Feb. 2000) (*MPEP*).

In addition, an application filed under 35 U.S.C. 111(a) must include an executed oath or declaration (§ 1.63), an abstract (§ 1.72(b)), and an English translation (if filed in a language other than English), for the application to have the content necessary to create the patent application publication. For eighteen-month publication purposes, the oath or declaration must at a minimum: (1) Name each inventor at least by a family and given name; and (2) be signed by each inventor or a party qualified to sign under §§ 1.42, 1.43, or 1.47 in compliance with § 1.64. Finally, an application filed under 35 U.S.C. 111(a) will not be published until the basic filing fee (§ 1.16(a) or (g)) is paid.

A PCT international application must satisfy the requirements of 35 U.S.C. 371 to be subject to eighteen-month publication under 35 U.S.C. 122(b) (and to have the content necessary to create the patent application publication).

Even if an application has the content necessary to create the patent application publication, the application papers and drawings must also be reviewed to determine whether they are of sufficient quality to be used in creating the patent application publication. To be of sufficient quality to create the patent application publication, the specification must be on sheets of paper that: (1) Are flexible, strong, smooth, non-shiny, durable, and white; (2) are either A4 (21 cm × 29.7 cm) or 8½″ × 11″ with each sheet having a left margin of at least 2.5 cm (1″) and top, bottom, and right margins of at least 2.0 cm (¾″); (3) are written on one side only in portrait orientation; (4) are plainly and legibly written either by a typewriter or machine printer in permanent dark ink or its equivalent; (5) have lines that are either 1½ or double-spaced; and (6) have sufficient clarity and contrast between the paper and the writing on the paper to permit direct reproduction and electronic capture by digital imaging and optical character recognition. These quality standards and requirements are currently set forth in § 1.52(a) and (b). In addition, the title must meet the length requirement of § 1.72(a); the abstract must commence on a separate sheet and meet the word-length requirement of § 1.72(b); the claims must commence on a separate sheet; and the sequence listing (if applicable) must comply with §§ 1.821 through 1.825.

As discussed above, the Office must consider not only whether drawings are of sufficient quality to create a publication (the patent application publication), but whether they are sufficient for the publication to be routinely used as a prior art document. Thus, the drawing sheets (if drawings are included) must comply with the following requirements of § 1.84. Drawings must be done in dark ink (not pencil), except where color drawings or photographs are permitted. Photographs (or photomicrographs) are not permitted unless they are reproducible and the invention cannot be clearly illustrated in an ink drawing. *See* Interim Waiver of 37 CFR § 1.84(b)(1) for Petitions to Accept Black and White Photographs and Advance Notice of Change to M.P.E.P. § 608.02, Notice, 1213 Off. Gaz. Pat. Office 108 (Aug. 4, 1998). Drawing sheets must be reasonably free from erasures and must be free from alterations, overwritings, interlineations, folds, and copy marks. Drawing sheets must be either 21.0 cm by 29.7 cm (DIN size A4) or 21.6 cm by 27.9 cm (8 ½ by 11 inches). Each drawing sheet must include a top margin of at least 2.5 cm (1 inch), a left side margin of at least 2.5 cm (1 inch), a right side margin of at least 1.5 cm (⅝ inch), and a bottom margin of at least 1.0 cm (⅜ inch). Lines, numbers, and letters must be clean, dark (not of poor line quality), uniformly thick, and well defined. The English alphabet must be used for letters, except where another alphabet is customarily used (such as the Greek alphabet to indicate angles, wavelengths, and mathematical formulas). Numbers, letters, and reference characters must measure at least 0.32 cm (⅛ inch) in height. Lead lines are required for each reference character (except for those which indicate the surface or cross section on which they are placed, in which case the reference character must be underlined to make it clear that a lead line has not been left out by mistake). The drawing views must also be numbered in consecutive Arabic numerals, starting with 1.

Finally, the specification (including the claims) must not contain drawings or flow diagrams. *See* § 1.58(a).

In September of 1996, the Office revised the standard and format requirements for the specification (including the abstract and claims), drawings, and other application papers set forth in § 1.52 and § 1.84 for the purpose of obtaining initial application papers in condition for eighteen-month publication. *See* Miscellaneous Changes in Patent Practice, Final Rule Notice, 61 FR 42790 (Aug. 19, 1996), 1190 Off. Gaz.

Pat. Office 67 (Sept. 17, 1996). Applicants are advised that the Office will: (1) Begin enforcement of the provisions of § 1.52(a) and (b) and § 1.84 during the pre-examination processing of patent applications; and (2) not permit applicants to request that objections under § 1.52(a) and (b) and § 1.84 made during the pre-examination processing of a patent application be held in abeyance pending allowance of the application.

As discussed below, if applicant timely provides the Office with a copy of the application via the Office electronic filing system, the Office will use the electronic copy provided by the applicant (rather than the PACR database records) to create the patent application publication. Applicants may use this procedure to obtain inclusion of amendments submitted during prosecution in the patent application publication. Applicants must use this procedure when requesting: (1) Voluntary publication of an application; (2) republication of a previously published application; or (3) publication of only a redacted copy of an application.

Electronic filing system: The electronic filing system (EFS) is an electronic system for the submission of patent applications to the Office. The EFS encompasses the preparation of the application parts in a special manner on the applicant's computer (authoring), the assembling of the pieces of the application so authored, and the secure communication of that application to the Office. The same EFS software must be used by applicants who wish to submit a copy of the application for the patent application publication.

The steps for submission of an electronic version of a patent application are as follows: (1) Obtaining a digital certificate; (2) obtaining the authoring and the submission-software packages from the Office; (3) authoring the patent application; and (4) assembling the parts of the application, and validating, digitally signing, and submitting the application.

To file a copy of an application using the EFS, an applicant (or representative) must submit a request and receive an Office digital certificate to enable secure communication between the applicant and the Office. A digital certificate will allow the authorized person to conduct electronic filing of one or more applications, as well as have access to the Office's Patent Application Information Retrieval (PAIR) software to display patent application status information.

The digital certificate is given to individuals and firms that obtain a customer number, and also request a digital certificate. Instructions on how to obtain the necessary digital certificate are located at the Office's Electronic Business Center on the Office's Internet Web site (http://www.uspto.gov) (under the section Electronic Business Center, select New User for the PAIR system).

The Office makes its branded version of the security software product called Entrust Direct software available to authorized persons. The software operates in conjunction with an Office Public Key Infrastructure (PKI) that is secure and enables communication only between the Office and authorized persons who are registered with the Office.

A person signing up for EFS application filing receives a package with his or her digital certificate including: (1) the software that will attach a digital signature to a document or set of documents; (2) an authoring tool that will allow the applicant to convert a standard patent application into a specialized format; and (3) the electronic Packaging and Validation Engine (ePave) program that will assemble the parts of the application, validate that the parts are complete, encrypt and digitally sign them, and then send them to the Office.

The applicant is responsible for correctly authoring the electronic application, which is defined as reformatting the application into a form that complies with the requirements of XML (the standard eXtensible Markup Language of Internet authoring). The XML requires that all the pieces of information in the application (*e.g.,* the inventor's name, title of the invention, and the claims) are tagged with standard XML named tags before and after each piece of information. For example, XML could require that the title be tagged:

<app title> MAKING A WIDGIT </app title>

The tagged information, in turn, is ordered and positioned on the submitted document according to the formula for that document in the document type definition (DTD). The DTD contains a list of all the tagged data elements (pieces of information) that should be on that document, and the relative positioning of the elements. When combined with the document's style sheet (which contains formatting information), the DTD will completely define what the document should contain and, when printed or viewed, what it will look like.

The applicant does the authoring using the software authoring tool given to him or her by the Office and operating on the applicant's computer. The authoring tool displays a template on applicant's computer screen listing all of the data elements that should be in a patent application (according to the Office's DTD). The applicant clicks in the desired data element and types information into the template. For example, the applicant clicks the data element ''TITLE'' and types ''MAKING A WIDGIT'' into the template. The authoring tool will add the tags, paragraph numbers, and other elements that are required by XML. The applicant can continue through this whole process adding the required information to each of the data elements in the template until the application is fully authored.

The applicant can also use the authoring tool to ''cut and paste'' a previously written application into the proper format. In this mode, the applicant will open up that written application, and also open up the authoring tool template to reveal the data elements. When the applicant clicks in the data element, the applicant will copy the relevant section from the previously written application and paste that section into the template (for tagging by the authoring tool).

Paper copies of the oath or declaration (§ 1.63), drawings, and certain other documents are scanned on the applicant's digital scanner and stored in tagged image file format (TIFF). The TIFF is not tagged by the authoring tool, but is similar to an electronic photograph.

Using either mode, the applicant will produce a copy of the application in compliance with the Office EFS, including a specification and claims (in XML), an oath or declaration (in TIFF), and drawings (also in TIFF).

Once the various parts of the application are prepared, the applicant will use the software tool ePave to assemble those parts and submit the application to the Office. The ePave software interacts with the applicant to fill out an electronic transmittal and fee information letter. This document is developed in the tagged XML format. The applicant then uses the ePave software to associate these documents with the previously produced application.

This association of the related files to be submitted is called bundling. The bundle of files that will be sent to the Office will be compressed using Zip technology to reduce their size. Then ePave will apply the digital signature to the compressed bundle, to indicate who is sending the package to the Office, and check the file's integrity. The digital signature process also encrypts the bundle, for safety during transmission.

The authoring tool and ePave software on the applicant's computer perform all of this activity almost invisibly. The applicant must enter a password to apply the digital signature, and the software will finish processing the application for submission to the Office. During the processing of a copy of an application for submission to the Office for use in a patent application publication, the applicant will be advised that the application of a digital signature constitutes a statement that the EFS copy of the application contains no new matter, and, except for a redacted copy of an application (which requires the concurrent submission of other certifications on paper), that the EFS copy of the application corresponds to the application as amended by any amendment filed in the application. When processing is finished, the software will ask the applicant if the list of displayed files should be sent to the Office. The applicant will click or otherwise express his or her concurrence, and the EFS application files are electronically transmitted to the Office.

On receipt of the bundle of files comprising the application, the Office stores the bundle and takes it apart. The bundle is decrypted, the digital signature is checked, and the integrity of the package is confirmed. In the course of events, the Office sends an acknowledgment back to the applicant's computer providing the date and time of submission, the names and sizes of the files received, and other information to confirm the submission.

Obviously, an application submitted via EFS cannot include a payment by check or money order. Therefore, any publication fee or processing fee required for a copy of an application submitted via EFS for use in the patent application publication must be paid by an authorization to charge the fee to a credit card or Office deposit account.

The Office originally indicated that if a copy of an application being submitted to the Office for eighteen-month publication purposes contains a sequence listing, and the sequence listing is identical to a sequence listing previously submitted to the Office in compliance with §§ 1.821 through 1.825, the EFS copy of the application may contain a reference to the previously filed sequence listing in lieu of a copy of the previously filed sequence listing. *See Changes to Implement Eighteen-Month Publication of Patent Applications,* 65 FR at 17950, 1233 *Off. Gaz. Pat. Office* at 124. The Office, however, has determined that permitting an EFS copy of an application to reference a previously filed sequence listing (rather than include a copy of the sequence listing) will increase the chance for errors in the sequence listing included in the patent application publication. Thus, the Office is requiring that if a copy of an application being submitted to the Office for eighteen-month publication purposes contains a sequence listing, the EFS copy of the application must contain a text file copy of the sequence listing that if printed out on paper would be in compliance with § 1.823.

Finally, if the file containing a copy of an application being submitted to the Office for eighteen-month publication purposes occupies ten megabytes of memory or more, the copy of the application should be submitted on a Compact Disk-Read Only Memory (CD–ROM) or Compact Disk-Recordable (CD–R). The CD–ROM or CD–R containing the copy of the application should be addressed to: Box PGPub.

While the Office is using EFS for both new application filing and submission of a copy of a previously filed application for publication purposes, an EFS submission of a copy of an application for publication purposes will be different from the EFS submission of a new application. For example, the EFS submission of a copy of an application for publication purposes will not require an oath or declaration (in TIFF). In addition, the acknowledgment receipts issued by the Office will be different for the EFS submission of a copy of an application for publication purposes than it will be for the EFS submission of a new application.

Publication process: The current planning approach involves a fourteen-week publication cycle that results in the publication of patent application publications on Thursday of each week. Ideally, the publication date of an application will be the first Thursday after the date that is eighteen months after the filing date of the application, or if the application claims the benefit of an earlier filing date, the first Thursday after the date that is eighteen months after the earliest filing date for which a benefit is sought. An application, however, may not be published the first Thursday after the date that is eighteen months after the earliest filing date for which a benefit is sought if the application is not in condition for publication approximately fourteen months after the earliest filing date for which a benefit is sought (eighteen months less the fourteen-week publication cycle).

Obviously, there are events that will delay publication of some applications until a later date: *e.g.,* (1) The application claims the benefit under 35 U.S.C. 120 of an application filed more than eighteen months before the actual filing date of the application; (2) the basic filing fee or oath (or declaration) is not provided within eighteen months after the earliest filing date for which a benefit is sought; or (3) the application does not contain papers or drawings of publication quality within eighteen months after the earliest filing date for which a benefit is sought. In such situations, the publication date of an application will be the first Thursday after the date that is fourteen weeks after the application is in condition for publication. Applicants who attempt to delay publication by intentionally delaying the submission of the application content necessary for publication, however, may encounter a reduction in any patent term adjustment under 35 U.S.C. 154(b) (*see* 35 U.S.C. 154(b)(2)(C)(ii) and § 1.704(b)).

The Office plans to indicate a projected publication date on the filing receipt or indicate ''to be determined'' if the application is not in condition for publication. If events change the projected publication date by more than two weeks (*e.g.,* claim for priority under 35 U.S.C. 119(e) presented after mailing of the filing receipt) or the application content necessary for publication is provided, the Office will issue a change notification indicating the revised projected publication date.

The publication process involves producing weekly volumes of patent application publications on a variety of media: *e.g.,* the Office's Examiner Automated Search Tool (EAST) and Web-based Examiner Search Tool (WEST) search systems, optical disk products for sale to the public, and exchange with the Office's Intellectual Property exchange partners. Patent application publications will be available for viewing by the public in the Public Search Room via an on-line search system. The Office does not plan to provide paper copies of the patent application publications for placement in either the Public Search Room or the examiners' search rooms. The Office, however, will provide paper copies of the patent application publications to any member of the public on request (for a fee) in the manner that paper copies of patents are currently provided.

The publication process provides for: (1) Assembly of application bibliographic information for the patent application publication at fourteen weeks prior to the projected publication date; (2) assembly of the technical content (specification, including claims and abstract, and drawings) of the application for the patent application

publication at nine weeks prior to the projected publication date; and (3) placement of the application information as assembled into the patent application publication on publication media (*e.g.,* optical disks, magnetic tape) at four weeks prior to the projected publication date.

Any applicant seeking to abandon the application for the purpose of avoiding publication must take appropriate action (see § 1.138 discussed below) well prior to the projected publication date. If the application is not expressly abandoned at least four weeks prior to the projected publication date, the Office will probably not be able to avoid publication of the application or at least some application information because the Office will place the application (along with the thousands of other applications being published each week) on publication media (*e.g.,* optical disks, magnetic tape) four weeks prior to the projected date. This does not imply that a request to expressly abandon an application to avoid publication (§ 1.138) filed prior to this ''four-week'' time frame will ensure that the Office will be able to remove an application from publication. The Office simply cannot ensure that it can remove an application from publication or avoid publication of application information any time after the publication process for the application is initiated.

Access to the file wrapper and contents of a published application: The Office plans to permit: (1) Any member of the public to obtain (for a fee) a copy of the complete file wrapper and contents of, or a copy of a specific paper in, any published application, provided that no redacted copy was timely submitted for publication; (2) any member of the public to obtain (for a fee) an appropriately redacted copy of the file wrapper and contents of, or a copy of a specific paper in, any published application for which a redacted copy was timely submitted for publication; and (3) any member of the public to physically inspect (subject to the same conditions that apply to inspection of patented files) the file of any abandoned published application, provided that no redacted copy was timely submitted for publication.

Any member of the public may obtain status information concerning any published application via the Office's PAIR system. Permitting physical inspection of pending published applications, however, would interfere with the Office's ability to act on the applications within the time frames set forth in 35 U.S.C. 154(b)(1)(A) and (B). Thus, the Office must limit public access to the file wrapper of pending published applications to obtaining a copy produced by the Office (for a fee) to avoid conferring patent term adjustment on the applicant due to actions by members of the public.

Section 4805 of the American Inventors Protection Act of 1999 provides that the Comptroller General (in consultation with the Office) shall conduct a study and submit a report to Congress on the potential risks to the United States biotechnology industry relating to biological deposits in support of biotechnology patents, and that the Office shall consider the recommendations of such study in drafting regulations affecting biological deposits (including any modification of § 1.801 *et seq.*). Therefore, this notice does not contain any amendment to § 1.801 *et seq.* concerning the treatment of biological deposits in applications subject to eighteen-month publication.

Section 4732 of the American Inventors Protection Act of 1999 changed (among other things) the title ''Commissioner'' to ''Director.'' The title ''Commissioner,'' however, is not being changed to ''Director'' where it appears in the rules of practice involved in this final rule because legislation is pending before Congress that (if enacted) would restore the former title ''Commissioner.'' See Intellectual Property Technical Amendments Act of 2000, H.R. 4870, 106th Cong. (2000).

Discussion of Specific Rules

Title 37 of the Code of Federal Regulations, Parts 1 and 5, are amended as follows:

Section 1.9: Section 1.9(c) is amended to define a published application as used in 37 CFR chapter I to mean an application for patent which has been published under 35 U.S.C. 122(b).

Section 1.11: Section 1.11(a) is amended to include the file of an abandoned published application (except if a redacted copy of the application was used for the patent application publication) among the files that are open to inspection by the public.

Section 1.12: Section 1.12(a)(1) is amended to include the assignment records of a published patent application among the patent assignment records that are available to the public. Section 1.12(b) is amended to provide that the patent assignment records, digests, and indexes are available to the public unless they relate to pending or abandoned patent applications that have not been published under 35 U.S.C. 122(b).

Section 1.13: Section 1.13 is amended to include patent application publications among the records of the United States Patent and Trademark Office that are open to the public, and of which a copy (certified or uncertified) will be furnished (upon payment of the appropriate fee).

Section 1.14: Section 1.14(a) is amended to generally maintain the confidentiality of applications that have not been published as a U.S. patent application publication (see 35 U.S.C. 122(b)) pursuant to 35 U.S.C. 122(a). Status information is defined to include identification of whether the application has been published under 35 U.S.C. 122(b), as well as whether the application is pending, abandoned, or patented, and the application numerical identifier.

Section 1.14(b) is amended to provide that status information may also be supplied when the application is referred to by its numerical identifier in a U.S. patent application publication as well as a U.S. patent or a published international application. Section 1.14(b) is also amended to provide that status information may be supplied for an application which claims the benefit of the filing date of an application for which status information may be supplied. As a result, the public will be able to obtain continuity data for applications that have been published as a U.S. patent application publication or as a U.S. patent.

Section 1.14(c)(1) provides that a copy of an application-as-filed or a file wrapper and contents may be supplied where the appropriate fee is paid, and: (1) The application is incorporated by reference in a U.S. patent application publication or U.S. patent; or (2) the application is relied upon for priority under 35 U.S.C. 119(e) or 120 in a U.S. patent application publication or U.S. patent.

Section 1.14(c)(2) provides that copies of the file wrapper and contents of an application are available to the public when the application has been published as a U.S. patent application publication.

Section 1.14(e) is amended to provide public access to an abandoned application that is referenced in a U.S. patent application publication, as well as a U.S. patent, or another application that is open to public inspection.

Section 1.14(i) provides for greater access to international application files kept by the Office and applies to applications having an international filing date on or after November 29, 2000. Specifically, 35 U.S.C. 374 equates the publication under the PCT of an international application designating the U.S. to the publication of a U.S. application under 35 U.S.C. 122(b). After publication of an

application under 35 U.S.C. 122(b), the Office will make available copies of the application files and also allow for access to those files in accordance with § 1.14(c) and (e), respectively. Therefore, after publication of an international application designating the U.S. under PCT Article 21, the Office will make available copies of, and allow access to, those international application files which are kept in the Office (the Home, Search, and Examination Copies) to the extent permitted under the PCT. Additionally, § 1.14(i)(2) provides that copies of English language translations of international applications, which were published in a non-English language and which designated the U.S., and which have been submitted to the Office pursuant to 35 U.S.C. 154(d)(4), will also be available to the public. Requests for copies of, or access to, an application file under § 1.14(i) must be in the form of a written request and must include a showing that the international application has been published and that the U.S. was designated. Such a showing should preferably be in the form of the submission of a copy of the front page of the published international application. Additionally, requests for copies of international application files must also be accompanied by the appropriate fee.

Section 1.14(j) is amended to provide that this section not only applies when the Office provides access to or copies of the application, but also when the Office provides access to or copies of a part of an application.

Section 1.17: The heading of § 1.17 is amended to include a reference to reexamination to clarify that the enumerated fees in § 1.17 may also apply during reexamination proceedings, as well as to patent applications.

Section 1.17(h) is amended to include a petition under § 1.138(c) to expressly abandon an application to avoid publication among the petitions requiring the fee ($130) set forth in § 1.17(h).

Section 1.17(i) is amended to include 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 (§ 1.217), processing a request for voluntary publication or republication of an application (§ 1.221), and processing a belated submission under § 1.99 (§ 1.99(e)) to the processing services requiring the processing fee ($130) set forth in § 1.17(i).

Sections 1.17(l) and 1.17(m) are amended to set forth the fees for filing a petition under § 1.137 for revival of a terminated reexamination proceeding (on the basis of unavoidable and unintentional delay). Section 1.17(l) is amended to reflect that its $110 petition fee ($55 for a small entity) is required for a petition under § 1.137(a) to revive a terminated reexamination proceeding on the basis of an unavoidable failure of the patent owner to timely respond. Section 1.17(m) is amended to reflect that its $1,240 petition fee ($620 for a small entity) is required for a petition under § 1.137(b) to revive a terminated reexamination proceeding on the basis of an unintentional failure to timely respond. Note, however, that the newly enacted unintentional revival provisions of the American Inventors Protection Act of 1999 are not effective in any reexamination until November 29, 2000.

Section 1.17(p) is amended to make its fee ($180) applicable to a third-party submission under § 1.99, as well as an information disclosure statement under § 1.97(c) or (d).

Section 1.17(t) is added to set forth the surcharge ($1,240) for accepting an unintentionally delayed claim for priority under 35 U.S.C. 119, 120, 121, or 365(a) or 365(c) (§§ 1.55 and 1.78).

Section 1.18: Section 1.18(d) is added to specify the publication fee ($300). In view of this addition to § 1.18, the heading of § 1.18 is also amended to refer to ''post-allowance (including issue) fees'' (instead of only ''issue fees'').

Section 1.19: Section 1.19(a) is amended to provide that its $3 (regular service), $6 (next business day delivery to Office Box), or $25 (expedited delivery by commercial delivery service) fee would also be applicable to a request for a copy of the paper portion of a patent application publication. The $25 fee set forth in § 1.19(a)(4) would apply to a request for a certified copy of a patent application publication.

Section 1.24: Section 1.24 is removed and reserved. The practice of using coupons to purchase, *e.g.,* patents, statutory invention registrations, and trademark registrations, is inefficient compared to alternatives such as payment by credit card (especially for orders placed via the Internet). Coupons sold by the Office (before coupon practice is abolished) may still be used but cannot be redeemed.

Section 1.52: Section 1.52(d) is amended to provide for nonprovisional applications and provisional applications filed in a language other than English. The provisions concerning the treatment of nonprovisional applications filed in a language other than English are revised for clarity, but otherwise remain unchanged (§ 1.52(d)(1)).

Section 1.52(d)(2) provides that if a provisional application is filed in a language other than English, an English translation will not be required in the provisional application. Section 1.52(d)(2) also contains a reference to § 1.78(a) concerning the requirements for claiming the benefit of the filing date of such a provisional application in a later filed nonprovisional application.

Section 1.55: Section 1.55 is amended to implement the provisions of 35 U.S.C. 119(b) as amended by section 4503(a) of the American Inventors Protection Act of 1999, by providing: (1) A time period within which a claim for the benefit of a prior foreign application must be stated or waived; and (2) provisions for the acceptance of an unintentionally delayed submission of a claim to the benefit of a prior foreign application.

Section 1.55(a) is amended to provide that: (1) In an original application filed under 35 U.S.C. 111(a) (other than a design application), the claim for priority must be presented during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application; (2) in an application that entered the national stage from an international application after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT; and (3) the claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed before the patent is granted.

Section 1.55(c) provides that any claim for priority under 35 U.S.C. 119(a)–(d) or 365(a) not presented within the time period provided by § 1.55(a) is considered to have been waived. Section 1.55(c) also provides that if a claim to priority under 35 U.S.C. 119(a)–(d) or 365(a) is presented after the time period provided by § 1.55(a), the claim may be accepted if the claim identifying the prior foreign application by specifying its application number, country, and the day, month and year of its filing was unintentionally delayed. Section 1.55(c) also provides that a petition to accept a delayed claim for priority under 35 U.S.C. 119(a)–(d) or 365(a) must be accompanied by: (1) The surcharge set forth in § 1.17(t); and (2) a statement that the entire delay between the date the claim was due under § 1.55(a)(1) and the date the claim was filed was unintentional, and that the Commissioner may require additional

information where there is a question whether the delay was unintentional.

Section 1.72: Section 1.72(a) is amended to provide that the title of the invention may not exceed 500 characters in length. The title character number limitation is necessary to ensure that the title can be captured and recorded in the Office's Patent Application Locating and Monitoring (PALM) system. Section 1.72(a) is also amended to provide that characters that cannot be captured and recorded in the Office's automated information systems (*e.g.,* PALM) may not be reflected in the Office's records in such systems or in documents created by the Office. Thus, if a title includes a character (images) that cannot be captured by PALM, that title will not appear in the Office's PALM records for that application, and may not be reflected in documents (*e.g.,* a filing receipt, patent application publication, or patent) created by the Office.

Section 1.76: Section 1.76 is amended to provide for the inclusion of assignee information in a new § 1.76(b)(7). Section 1.76(b)(7) provides that: (1) assignee information includes the name (either person or juristic entity) and address of the assignee of the entire right, title, and interest in an application; and (3) the inclusion of this information on the application data sheet does not substitute for compliance with any requirement of 37 CFR part 3 to have an assignment recorded by the Office. Providing assignee information on the application data sheet is considered a request to include such information on the patent application publication, since there is no other reason for including such information on the application data sheet.

Section 1.78: Section 1.78(a) is amended to implement the provisions of 35 U.S.C. 119(e) and 120 as amended by § 4503(b) of the American Inventors Protection Act of 1999, by providing: (1) A time period within which a claim to the benefit of a prior nonprovisional or provisional application must be stated or waived; and (2) provisions for the acceptance of the unintentionally delayed submission of a claim to the benefit of a prior nonprovisional or provisional application.

Section 1.78(a)(2) is amended to provide that (except for a continued prosecution application filed under § 1.53(d)) any claim to the benefit of a nonprovisional application or international application must be made during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. Section 1.78(a)(2) also provides that the failure to timely submit the reference required by 35 U.S.C. 120 and § 1.78(a)(2) is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to such prior application, but that the time period set forth in § 1.78(a)(2) does not apply to an application for a design patent.

Section 1.78(a)(2) also provides that if the application claims the benefit of an international application, the first sentence of the specification must include an indication of whether the international application was published under PCT Article 21(2) in English (regardless of whether benefit to such application is claimed in the application data sheet).

Sections 1.78(a)(3) and 1.78(a)(4) are redesignated as § 1.78(a)(4) and 1.78(a)(5), respectively.

Section 1.78(a)(3) provides that if the reference required by 35 U.S.C. 120 and § 1.78(a)(2) is presented in a nonprovisional application after the time period provided by § 1.78(a)(2), the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior filed copending nonprovisional application or international application designating the United States may be accepted if the reference identifying the prior application by application number or international application number and international filing date was unintentionally delayed. Section 1.78(a)(3) also provides that a petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior filed copending application must be accompanied by: (1) The surcharge set forth in § 1.17(t); and (2) a statement that the entire delay between the date the claim was due under § 1.78(a)(2) and the date the claim was filed was unintentional, but the Commissioner may require additional information where there is a question whether the delay was unintentional.

Section 1.78(a)(4) is amended to provide that, for a nonprovisional application to claim the benefit of a provisional application, the provisional application must be entitled to a filing date as set forth in § 1.53(c), and the basic filing fee set forth in § 1.16(k) must be paid within the time period set forth in § 1.53(g).

Section 1.78(a)(5) provides that any nonprovisional application claiming the benefit of a provisional application filed in a language other than English must (in addition to the reference required by 35 U.S.C. 119(e) and § 1.78(a)(5)) contain an English language translation of the non-English language provisional application and a statement that the translation is accurate. Section 1.78(a)(5) also provides any claim for the benefit of a provisional application and English language translation of a non-English language provisional application must be submitted during the pendency of the nonprovisional application, and within the later of four months from the actual filing date of the nonprovisional application or sixteen months from the filing date of the prior provisional application. Section 1.78(a)(5) also provides that the failure to timely submit the reference and English language translation of a non-English language provisional application required by 35 U.S.C. 119(e) and § 1.78(a)(5) is considered a waiver of any benefit under 35 U.S.C. 119(e) to such prior provisional application.

Section 1.78(a)(6) provides that if the reference or English language translation of a non-English language provisional application required by 35 U.S.C. 119(e) and § 1.78(a)(5) is presented in a nonprovisional application after the time period provided by § 1.78(a)(5), the claim under 35 U.S.C. 119(e) for the benefit of a prior filed provisional application may be accepted during the pendency of the nonprovisional application if the reference identifying the prior application by provisional application number and any English language translation of a non-English language provisional application were unintentionally delayed. Section 1.78(a)(6) also provides that a petition to accept an unintentionally delayed claim under 35 U.S.C. 119(e) for the benefit of a prior filed provisional application must be accompanied by: (1) The surcharge set forth in § 1.17(t); and (2) a statement that the entire delay between the date the claim was due under § 1.78(a)(5) and the date the claim was filed was unintentional, but that the Commissioner may require additional information where there is a question whether the delay was unintentional.

Section 1.84: Section 1.84(a)(2) is amended to provide that color drawings are not permitted in an application, or copy thereof, submitted under the Office electronic filing system. Section 1.84(a)(2) is also amended to provide that any petition to accept color drawings must include a black and white photocopy that accurately depicts, to the extent possible, the subject matter shown in the color drawing. Since § 1.84(b) provides that color photographs will be accepted in utility patent applications if the conditions for accepting color drawings have been satisfied, the provisions and restrictions in amended § 1.84(a)(2) would also apply to color photographs.

Section 1.84(e) is amended to provide that photographs must be developed on

paper meeting the sheet-size requirements of § 1.84(f) and the margin requirements of § 1.84(g).

Section 1.84(j) is amended to refer to the view suitable for the front page of the patent application publication and patent, rather than the view suitable for the Official Gazette, since the front page of the patent (and patent application publication) includes the information that is (or would be) included in the Official Gazette, and the Office does not plan on creating an Official Gazette for patent application publications. Section 1.84(j) is also amended to provide that: (1) One of the views should be suitable for inclusion on the front page of the patent application publication and patent as the illustration of the invention; and (2) applicant may suggest a single view (by figure number) for inclusion on the front page of the patent application publication and patent. Applicants should indicate in the application transmittal letter the figure number of the view suggested for inclusion on the front page of the patent application publication and patent. The Office, however, is not bound by applicant's suggestion.

Section 1.85: Section 1.85(a) is amended to provide that a utility or plant application will not be placed on the files for examination until objections to the drawings have been corrected. As discussed above, these objections will concern deficiencies that must be corrected for the drawings to be of sufficient quality for use in creating a patent application publication. For example, the drawings must be reproducible and any text in the drawings must be in the English language. Since the Office plans to use the copy of the application (including the drawings) from its PACR database to create the patent application publication, the Office must require that new or corrected drawings correcting the objections to the drawings be filed before the application is released from OIPE and placed on the files for examination.

Even if an applicant files the application with a request that the application not be published pursuant to 35 U.S.C. 122(b), the applicant may rescind that request at any time. *See* 35 U.S.C. 122(b)(2)(B)(ii). In addition, at the time the Office is recording a copy of the application in its PACR database, the Office is not in a position to know whether the applicant will file an electronic filing system copy of the application for use in creating the patent application publication. Therefore, the Office must be prepared to create a patent application publication from its PACR database for each application and insist that objections to the drawings be corrected in all utility and plant applications before the application can be released from OIPE.

Section 1.85(a) is also amended to provide that (except as provided in § 1.215(c)) any patent application publication will not include drawings filed after the application has been placed on the files for examination. Thus, corrected drawings submitted after the application has been released from OIPE will not be added to the PACR database or used to create the patent application publication.

Section 1.85(a) is also amended to provide that, unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a *bona fide* attempt to advance the application to final action (§ 1.135(c)). That is, if an Office action or notice contains an objection to the drawings (and does not expressly permit such objection to be held in abeyance) and the applicant's reply does not correct the objection, the applicant will be advised that the reply is non-responsive and given the remainder of the period set in the original Office action or notice (and not a new period under § 1.135(c)) within which to correct the objection.

Since design applications are not subject to the eighteen-month publication provisions of 35 U.S.C. 122(b), drawings in a design application will continue to be admitted for examination if the drawings meet the requirements of § 1.84(e), (f), and (g) and are suitable for reproduction.

Section 1.98: Section 1.98(a)(2)(i) is amended to also refer to U.S. patent application publications. Section 1.98(b) is amended to provide that each U.S. patent application publication listed in an information disclosure statement shall be identified by applicant, patent application publication number, and publication date.

Section 1.99: Section 1.99(a) provides that a submission by a member of the public of patents or publications relevant to a pending published application will be entered in the application file if the submission complies with the requirements of § 1.99 and the application is still pending when the submission and application file are brought before the examiner. The entry of such a submission does not mean that the patents or printed publications contained in the submission will be necessarily considered and cited by the examiner. If the examiner considers a patent or printed publication contained in the submission to be pertinent in determining patentability, the examiner will initial that patent or printed publication on the listing of the patents or publications submitted for consideration by the Office. Unless, however, a patent or publication in a submission under § 1.99 is discussed during prosecution, the patent or publication will not be deemed to have been ''considered'' pursuant to the Office's *Portola* guidelines. *See* Guidelines for Reexamination of Cases in View of In re Portola Packaging, Inc., 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997), Notice, 64 FR 15346 (Mar. 31, 1999), 1223 Off. Gaz. Pat. Office 124 (June 22, 1999).

Section 1.99(b) provides that a submission under § 1.99 must identify the application to which it is directed by application number and include: (1) The fee set forth in § 1.17(p); (2) a listing of the patents or publications submitted for consideration by the Office (including the date of publication of each patent or publication); (3) a copy of each listed patent or publication in written form or at least the pertinent portions; and (4) an English language translation of all the necessary and pertinent parts of any non-English language patent or publication in written form relied upon.

Section 1.99(c) provides that a submission under § 1.99 must be served upon the applicant in accordance with § 1.248.

Section 1.99(d) provides that a submission under § 1.99 may not include any explanation of the patents or publications, or any other information, and that a submission under § 1.99 is limited to ten total patents or publications. Section 1.99(d) also provides that the Office will dispose of such explanation or information if included in a submission under § 1.99. The Office plans to review submissions under § 1.99 (*e.g.*, by a Supervisory Patent Examiner) to determine whether they are limited to patents and publications before the submission is placed in the file of the application and forwarded to the examiner, and to remove any explanations or information (other than patents and publications) from the submission before it is placed in the file of the application and forwarded to the examiner.

Section 1.99(e) provides that a submission under § 1.99 must be filed within two months from the date of publication of the application (§ 1.215(a)), or prior to the mailing of a notice of allowance (§ 1.311), whichever is earlier. Section 1.99(e) also provides

that any submission under § 1.99 not filed within this period is permitted only when the patents or publications could not have been submitted to the Office earlier, and must also be accompanied by the processing fee set forth in § 1.17(i). The phrase ''publication of the application (§ 1.215(a))'' means that republication of an application under § 1.211 has no effect on (*e.g.*, does not restart) the period specified in § 1.99(e). Section 1.99(e) also provides that a submission by a member of the public to a pending published application that does not comply with the requirements of § 1.99 will be returned or discarded.

Section 1.99(f) provides that the involvement of a member of the public in filing a submission under § 1.99 ends with the filing of the submission.

Section 1.103: Section 1.103 is amended to provide for deferred examination for up to three years from the earliest filing date for which a benefit is claimed under title 35, United States Code, at the request of the applicant. The Office previously proposed a ''deferred examination'' practice (in addition to the current suspension of action practices) to implement the Patent Business Goals. *See* Changes to Implement the Patent Business Goals, Advance Notice of Proposed Rulemaking, 63 FR 53498, 53516–17 (Oct. 5, 1998), 1215 Off. Gaz. Pat. Office 87, 104–05 (Oct. 27, 1998). The Office, however, did not proceed with proposing changes to § 1.103 to implement a ''deferred examination'' practice. *See* Changes to Implement the Patent Business Goals, Notice of Proposed Rulemaking, 64 FR 53772, 53775 (Oct. 4, 1999), 1228 Off. Gaz. Pat. Office 15, 18 (Nov. 2, 1999). The Office is now proceeding with changes to § 1.103 to implement a ''deferred examination'' practice.

Section 1.103(d) is added to provide for deferral of examination if the applicant requests deferred examination under § 1.103(d) and pays the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i). The following conditions must also be met: (1) the application must be filed on or after November 29, 2000 (or be an application for which applicant requests voluntary publication), and be an original (*i.e.*, non-reissue) utility or plant application filed under § 1.53(b) (*i.e.*, not a continued prosecution application under § 1.53(d)) or an application resulting from entry of an international application into the national stage after compliance with § 1.494 or § 1.495; (2) the applicant must not have filed a nonpublication request under § 1.213(a), or have filed a request under § 1.213(b) to rescind a previously filed nonpublication request; (3) the application must be in condition for publication as provided in § 1.211(c); and (4) the Office must not have issued either an Office action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151.

The reasons given for opposition to the October 1998 proposal concerning ''deferred examination'' were that: (1) The ''deferred examination'' of an application under an extended suspension of action and the publication of an application under such suspension of action would create uncertainty over legal rights; and (2) the publication provisions of such a suspension of action procedure amount to an eighteen-month publication system that is not authorized by 35 U.S.C. 122. The Office is adopting its deferred examination proposal because: (1) Since the deferral of examination under § 1.103(d) is limited to three years from the earliest filing date for which a benefit is claimed under title 35, United States Code, there will be no greater uncertainty over legal rights than currently exists under reissue or continuing application practice; and (2) 35 U.S.C. 122(b) now provides for eighteen-month publication of patent applications (with certain exceptions).

Section 1.104: Section 1.104(a) is amended by eliminating the provisions concerning the circumstances under which an examiner will consider applications to be copending (§ 1.104(a)(5)). This material pertains only to internal instructions to examiners and is considered appropriate for inclusion in the *MPEP* rather than the rules of practice.

Section 1.104(d) is amended to provide that if domestic (U.S.) patent application publications are cited by the examiner, their publication number, publication date, and the names of the applicants will be stated.

Section 1.130: Section 1.130(a) is amended to refer to published applications (as well as patents). Specifically, § 1.130 is also applicable to a rejection of a claim in an application or patent under reexamination based upon a patent application publication in the situation in which the application or patent under reexamination and the published application are currently owned by the same party.

Section 1.131: Section 1.131(a) is amended to provide that: (1) The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or the date that it is effective as a reference under 35 U.S.C. 102(e); and (2) prior invention may not be established under § 1.131 if the rejection is based upon either a U.S. patent or a U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as defined in § 1.601(n).

Section 1.132: Section 1.132 is revised to provide that when any claim of an application or a patent under reexamination is rejected or objected to, any evidence submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under this section. This adopts the long-standing policy that any oath or declaration not otherwise provided for is considered under § 1.132. *See MPEP* 716.

Section 1.132 as adopted does not provide that an oath or declaration may not be submitted under § 1.132 to traverse a rejection if the rejection is based upon a U.S. patent or a U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as defined in § 1.601(n). If an oath or declaration is submitted under § 1.132 to traverse a rejection, and the rejection is based upon a U.S. patent or a U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as defined in § 1.601(n), the Office will consider on a case-by-case basis whether the oath or declaration may be considered sufficient to overcome the rejection, or whether the applicant will be required to establish priority of invention through an interference proceeding.

Section 1.137: Section 1.137 is amended to: (1) Make its provisions applicable to the revival of a terminated reexamination proceeding; (2) provide for the revival of an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to timely notify the Office of the filing of an application in a foreign country or under a multinational treaty; and (3) reorganize certain provisions for clarity.

Section 1.137 (including its heading) is amended to provide for revival of *ex parte* reexamination proceedings terminated under § 1.550(d), for revival of *inter partes* reexamination proceedings terminated under § 1.957(b), or for revival of rejected claims terminated under § 1.957(c) in an *inter partes* reexamination proceeding where further prosecution has been limited to claims found allowable at the time of the failure to respond. These changes to § 1.137 were discussed in the notice of proposed rulemaking to

implement the optional inter partes reexamination provisions of the American Inventors Protection Act of 1999. *See* Rules to Implement Optional Inter Partes Reexamination Proceedings, Notice of Proposed Rulemaking, 65 FR 18154 (Apr. 6, 2000), 1234 Off. Gaz. Pat. Office 93 (May 23, 2000).

Specifically, § 1.137(a) is amended to include revival of unavoidably terminated reexamination proceedings. The unavoidable delay provisions of 35 U.S.C. 133 are imported into and are applicable to reexamination proceedings by 35 U.S.C. 305 and 314. *See In re Katrapat,* 6 USPQ2d 1863 (Comm'r Pats. 1988). Section 1.137(b) is amended to provide for revival of unintentionally terminated reexamination proceedings. The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into and are applicable to all reexamination proceedings by § 4605 of the American Inventors Protection Act of 1999. Note that these changes pertain to *all* reexaminations (*i.e.*, both *ex parte* reexaminations filed under § 1.510 and *inter partes* reexaminations filed under § 1.913) and become effective on November 29, 2000 (one year after enactment of the American Inventors Protection Act of 1999).

The reconsideration provisions of § 1.137 (formerly § 1.137(d), and § 1.137(e) as adopted) are amended to provide that extensions of time for requesting reconsideration of a decision dismissing or denying a petition requesting revival of a terminated reexamination proceeding under § 1.137(a) or § 1.137(b) must be filed under § 1.550(c) for a terminated *ex parte* reexamination proceeding, or under § 1.956 for a terminated *inter partes* reexamination proceeding.

Section 1.137(f) provides for the revival of an application abandoned for failure to timely notify the Office of a foreign filing. As discussed above, if an applicant makes a request (nonpublication request) upon filing with the appropriate certifications, the application will not be published under 35 U.S.C. 122(b)(1). *See* 35 U.S.C. 122(b)(2)(B)(i). An applicant who has made a nonpublication request but who subsequently files an application directed to the invention disclosed in the application filed in the Office in a foreign country, or under a multilateral international agreement, that requires eighteen-month publication, must notify the Office of such filing within forty-five days after the date of such filing, with the failure to timely provide such a notice to the Office resulting in abandonment of the application. *See* 35 U.S.C. 122(b)(2)(B)(iii). 35 U.S.C. 122(b)(2)(B)(iii), however, also provides that an application abandoned as a result of the failure to timely provide such a notice to the Office is subject to revival if the ''delay in submitting the notice was unintentional.'' *See id.*

35 U.S.C. 122(b)(2)(B)(iii) provides for revival only on the basis of unintentional delay, and not on the basis of unavoidable delay. Compare 35 U.S.C. 122(b)(2)(B)(iii) (''delay * * * was unintentional'') with 35 U.S.C. 111(a)(4) (''delay * * * was unavoidable or unintentional''). Therefore, § 1.137(f) provides that a nonprovisional application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to timely notify the Office of the filing of an application in a foreign country or under a multinational treaty that requires eighteen-month publication may be revived only pursuant to § 1.137(b). Section 1.137(f) also provides that the reply requirement of § 1.137(c) is met by the notification of such filing in a foreign country or under a multinational treaty, but the filing of a petition under § 1.137 will not operate to stay any period for reply that may be running against the application. Since the Office cannot ascertain whether an application is abandoned under 35 U.S.C. 122(b)(2)(B)(iii), the Office may continue to process and examine the application until the applicant notifies the Office that the application is abandoned. Therefore, § 1.137(f) provides that the filing of a petition under § 1.137 to revive such an application will not operate to stay any period for reply that may be running against the application.

Section 1.137 is also amended to locate the ''reply requirement'' provisions in § 1.137(c), rather than include duplicative provisions concerning the reply requirement in each of § 1.137(a) and (b). Thus, the terminal disclaimer provisions of § 1.137(c), reconsideration provisions of § 1.137(d), and provisional application provisions of § 1.137(e) are moved to § § 1.137(d), 1.137(e), and 1.137(g), respectively. In addition, § 1.137(c) also provides that in an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee. Thus, even if an application abandoned for failure to pay the publication fee is being revived solely for purposes of continuity with a continuing application, the petition to revive under § 1.137 must include payment of the publication fee (unless previously submitted).

Section 1.137 is also amended to take into account the provisions of 35 U.S.C. 119(e)(3), which extend the pendency of a provisional application to the next succeeding secular or business day if the day that is twelve months after the filing date of the provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia.

Section 1.138: Section 1.138(a) is amended to add ''or publication'' to clarify that a letter of express abandonment may not be recognized by the Office unless it is actually received by appropriate officials in time to act before the date of publication.

Section 1.138(c) is added to provide for a petition for express abandonment to avoid publication. Section 1.138(c) provides that an applicant seeking to abandon an application to avoid publication of the application (see § 1.211(a)(1)) must submit a declaration of express abandonment by way of a petition including the fee set forth in § 1.17(h) in sufficient time to permit the appropriate officials to recognize the abandonment and remove the application from the publication process. The petition will be granted when it is recognized in sufficient time to avoid publication of application information and will be denied when it is not recognized in sufficient time to avoid publication of application information. This will avert the situation in which an applicant files a letter of express abandonment to avoid publication, the letter of express abandonment is not recognized in sufficient time to avoid publication, upon publication the applicant wishes to rescind the letter of express abandonment, and the Office cannot revive the application (once the letter of express abandonment is recognized) because the application was expressly and intentionally abandoned by the applicant.

As discussed above, the publication process is a fourteen-week process, and the applicant should expect that the petition will not be granted and the application will be published in regular course unless such declaration of express abandonment and petition are received by the appropriate officials more than four weeks prior to the projected date of publication.

Section 1.165: Section 1.165(b) is amended to provide that if plant application drawings include a color drawing or photograph, a black and white photocopy that accurately depicts, to the extent possible, the subject matter shown in the color drawing or photograph must be submitted.

Section 1.211: Sections 1.211, 1.213, 1.215, 1.217, 1.219, and 1.221 are added to provide for the pre-grant publication of applications under 35 U.S.C. 122(b).

Section 1.211(a) provides that (with certain exceptions) each U.S. national application for patent filed in the Office under 35 U.S.C. 111(a) and each international application in compliance with 35 U.S.C. 371 will be published promptly 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.

Section 1.211(a)(1) provides that the Office will not publish applications that are recognized as no longer pending. The phrase ''recognized by the Office as no longer pending'' covers the situation in which the period for reply (either the shortened statutory period or the maximum extendable period for reply) to an Office action has expired, but the Office has not yet entered the change of status (to abandoned) of the application in the PALM system and mailed a notice of abandonment. An application will remain in the publication process until the PALM system indicates that the application is abandoned. Obviously, once the PALM system indicates that an application is abandoned, the Office will attempt to remove the application from the publication process and avoid dissemination of application information. How much dissemination of application information can be avoided depends upon how close it is to the publication date when the Office recognizes the application as abandoned. Unless an applicant has received a notice of abandonment, an applicant who wants to abandon the application to avoid publication must file a petition under § 1.138(c) to expressly abandon the application and avoid publication. An applicant permitting an application to become abandoned (for failure to reply to an Office action) to avoid publication by passively waiting for the Office to recognize that the application has become abandoned must bear the risk that the Office will not recognize that the application has become abandoned and change the status of the application in the PALM system in sufficient time to avoid publication.

Section 1.211(a)(2) provides that the Office will not publish applications that are national security classified (see § 5.2(c)), subject to a secrecy order under 35 U.S.C. 181, or under national security review.

Section 1.211(a)(3) provides that the Office will not publish applications that have issued as patents in sufficient time to be removed from the publication process. If the pre-grant publication process coincides with the patent issue process, the Office will continue with the pre-grant publication process until a patent actually issues. This is because there are many instances in which the Office mails a notice of allowance (§ 1.311) in an application but the application does not issue as a patent in regular course (abandonment due to failure to pay the issue fee, or withdrawal from issue either *sua sponte* by the Office or on petition of the applicant). Therefore, the Office will not discontinue the pre-grant publication process until a patent has actually issued. Since the Office cannot discontinue the pre-grant publication process during the last two weeks of the publication process, this will result in a few applications being issued as patents and subsequently being published as patent application publications. The Office will refund the publication fee (if paid) if the application is not published as a patent application publication, but will not refund the publication fee if the application is published as a patent application publication, even if it is published after the patent issues.

Section 1.211(a)(4) also provides that the Office will not publish applications that were filed with a nonpublication request in compliance with § 1.213(a).

Section 1.211(b) provides that provisional applications under 35 U.S.C. 111(b) shall not be published. Section 1.211(b) also provides that design applications under 35 U.S.C. chapter 16 and reissue applications under 35 U.S.C. chapter 25 shall not be published under § 1.211. Provisional applications under 35 U.S.C. 111(b) and design applications under 35 U.S.C. chapter 16 are excluded from the pre-grant publication provisions of 35 U.S.C. 122(b). *See* 35 U.S.C. 122(b)(2)(A)(iii) and (iv). Reissue applications under 35 U.S.C. chapter 25 are not maintained in confidence under 35 U.S.C. 122(a). *See* § 1.11(b).

Section 1.211(c) provides that the Office will not publish an application filed under 35 U.S.C. 111(a) until it includes the basic filing fee, an English translation if in a language other than English, and an executed oath or declaration. Section 1.211(c) also provides that publishing may be delayed until the application includes a specification having papers in compliance with § 1.52 and an abstract (§ 1.72(b)), drawings in compliance with § 1.84, and a sequence listing in compliance with § 1.821 through 1.825 (if applicable), and until any petition under § 1.47 is granted. That is, if an application does not contain the application content on papers or drawings of sufficient quality to create a patent application publication by eighteen months from its earliest claimed filing date, the Office will publish the application as soon as practical after these deficiencies are corrected.

Section 1.211(d) provides that the Office may refuse to publish an application, or to include a portion of an application in the patent application publication (§ 1.215), if publication of the application or portion thereof would violate Federal or state law, or if the application or portion thereof contains offensive or disparaging material. A similar provision exists in PCT practice, in that the International Bureau (IB) may omit expressions or drawings in an international application from its publications if the expressions or drawings are contrary to morality or public order, or contain disparaging statements. *See* PCT Article 21(6) and Rule 9.

Section 1.211(e) provides that the publication fee set forth in § 1.18(d) must be paid in each application published under this section before the patent will be granted, but does not require that the publication fee be paid prior to publication. If an application is subject to publication under this section, the sum specified in the notice of allowance under § 1.311 will also include the publication fee which must be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable. If the application is not published under this section, the publication fee (if paid) will be refunded.

Section 1.213: Section 1.213 implements the provisions of 35 U.S.C. 122(b)(2)(B)(i)–(iii). An applicant may request that the application not be published under 35 U.S.C. 122(b) and § 1.211 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. Section 1.213(a) requires that a request that an application not be published under 35 U.S.C. 122(b) (nonpublication request) must: (1) Be submitted with the application upon filing; (2) state in a conspicuous manner that the application is not to be published under 35 U.S.C. 122(b); (3) contain 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 agreement, that requires publication at eighteen months after filing; and (4) be signed in compliance with § 1.33(b). The requirement that a nonpublication request be submitted ''upon filing'' is a requirement of statute

(35 U.S.C. 122(b)(2)(B)(i)), and, as such, the Office must deny any petition requesting a waiver of this provision of § 1.213(a).

Section 1.213(b) provides that the applicant may rescind a nonpublication request at any time. *See* 35 U.S.C. 122(b)(2)(B)(ii). Section 1.213(b) also provides that a request to rescind a nonpublication request under § 1.213(a) must: (1) Identify the application to which it is directed (§ 1.5); (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). Once a request under § 1.213(b) to rescind a nonpublication request is filed and processed by the Office, the application will be scheduled for publication in accordance with § 1.211(a).

Section 1.213(c) reiterates the provisions of 35 U.S.C. 122(b)(2)(B)(iii). Section 1.213(c) specifically states that if an applicant who has submitted a nonpublication request under § 1.213(a) subsequently 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, the applicant must notify the Office of such filing within forty-five days after the date of the filing of such foreign or international application. The failure to timely notify the Office of the filing of such foreign or international application shall result in abandonment of the application in which the nonpublication request was submitted. *See* 35 U.S.C. 122(b)(2)(B)(iii).

Section 1.215: Section 1.215(a) indicates that the publication of an application under 35 U.S.C. 122(b) shall include a patent application publication. The Office will not mail a paper copy of the patent application publication to the applicant, but will mail a notice to the applicant indicating that the application has been published.

Section 1.215(a) also provides that the date of publication shall be indicated on the patent application publication.

Section 1.215(a) also provides that (except as discussed below in § 1.215(c)) the patent application publication will be based upon the application papers deposited on the filing date of the application, except for preliminary amendments, as well as the executed oath or declaration submitted to complete the application, and 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. That is, the patent application publication will not reflect the application as it was amended during the examination process, but will only reflect the application as recorded in the Office's PACR database.

Section 1.215(b) provides a mechanism by which applicants may have assignee information (the name and address of the assignee of the entire right, title, and interest in an application) included on the patent application publication. To have assignee information included on the patent application publication, the applicant must include the assignee information on the application transmittal sheet or the application data sheet under § 1.76. Providing assignee information on the application transmittal sheet or the application data sheet will be treated as an indication that the assignee information is being provided for inclusion on the patent application publication. Providing assignee information on the application transmittal sheet or the application data sheet does not substitute for compliance with any requirement of 37 CFR part 3 to have an assignment recorded by the Office.

If applicant wants to submit assignee information for inclusion on the patent application publication after filing (*i.e.,* after the application transmittal sheet or the application data sheet has been filed), applicant must file a supplemental application data sheet (§ 1.76) containing the assignee information. This applies to changes to previously submitted assignee information, as well as assignee information being provided for the first time. Nevertheless, assignee information may not be included on the patent application publication unless this information is provided on the application transmittal sheet or application data sheet included with the application on filing.

Section 1.215(c) provides a mechanism by which applicants may have the patent application publication reflect the application as amended during the examination process (rather than the application information as recorded in the Office's PACR database). Section 1.215(c) provides that the Office will use an applicant-supplied copy of the application (specification, drawings, and oath or declaration), provided that: (1) The copy is in compliance with the Office electronic filing system (EFS) requirements; and (2) the EFS copy is filed within one month of the actual filing date of the application or fourteen months of the earliest filing date for which a benefit is sought, whichever is later.

The fourteen-month period differs from the sixteen-month period provided in § 1.217 for submitting a redacted copy of an application because the sixteen-month period provided in § 1.217 is not based upon the fourteen-week publication cycle but is provided for by statute (35 U.S.C. 122(b)(2)(B)(v)).

Section 1.215(d) provides that if the copy of the application does not comply with the Office EFS requirements, the Office will publish the application based upon the application records in the Office's PACR database (as provided in § 1.215(a)). If, however, the Office has not started the publication process, the Office may use an untimely filed copy of the application supplied by the applicant under § 1.215(c) in creating the patent application publication.

Section 1.217: Section 1.217(a) implements the provisions of 35 U.S.C. 122(b)(2)(B)(v), and provides that if an applicant has filed applications in one or more foreign countries, directly or through a multilateral international agreement, and such foreign-filed applications or the description of the invention in such foreign-filed applications is less extensive than the application or description of the invention in the application filed in the Office, the applicant may submit a redacted copy of the application filed in the Office for publication, eliminating any part or description of the invention that is not also contained in any of the corresponding applications filed in a foreign country. Section 1.217(a) also provides that the Office will publish the application as provided in § 1.215(a) unless the applicant files a redacted copy of the application in compliance with § 1.217 within sixteen months after the earliest filing date for which a benefit is sought under title 35, United States Code. This sixteen-month period is provided by statute (35 U.S.C. 122(b)(2)(B)(v)), and as such, requests for waiver of this sixteen-month period will be denied.

As discussed above, this sixteen-month period provided in § 1.217 differs from the fourteen-month period provided in § 1.215(c) because the sixteen-month period provided in § 1.217 is not based upon the fourteen-week publication cycle but is provided for by statute (35 U.S.C. 122(b)(2)(B)(v)). If a redacted copy of an application is submitted in compliance with § 1.217 but later than four months prior to the projected publication date, the Office will be required to reprocess the patent

application publication (for which assembly will have already started) using the redacted copy of the application provided by applicant.

Section 1.217(b) provides that the redacted copy of the application must be submitted in compliance with the Office EFS requirements. Section 1.217(b) also provides that the title of the invention in the redacted copy of the application must correspond to the title of the application at the time the redacted copy of the application is submitted to the Office. The Office uses the title of the invention (among other information) as provided in an EFS copy of an application to confirm the identity of the application for which the EFS copy is submitted. Thus, if a portion of the title has been redacted such that the title (as redacted) in the EFS copy of the application is different from the title of the invention for the application as shown in PALM, it will appear that the redacted EFS copy of the application incorrectly identifies the application for which the redacted EFS copy is submitted. If an applicant wants to redact a portion of the title, the applicant must first submit an amendment to the title of the invention such that it will correspond to the title as redacted. Section 1.217(b) also provides that if the redacted copy of the application does not comply with the Office EFS requirements, the Office will publish the application based upon the unredacted records in the Office's PACR database.

Section 1.217(c) provides that the applicant must also concurrently submit in paper (§ 1.52(a)) to be filed in the application: (1) A certified copy of each foreign-filed application that corresponds to the application for which a redacted copy is submitted; (2) a translation of each such foreign-filed application that is in a language other than English, and a statement that the translation is accurate; (3) a marked-up copy of the application showing the redactions in brackets; and (4) a certification that the redacted copy of the application eliminates only the part or description of the invention that is not contained in any application filed in a foreign country, directly or through a multilateral international agreement, that corresponds to the application filed in the Office. The provisions of § 1.217(c) are designed to ensure that any patent application publication based upon a redacted copy of an application contains the parts and description of the invention contained in any of the corresponding applications filed in a foreign country.

Section 1.217(d) provides a mechanism for obtaining an appropriately redacted copy of the application contents to provide to members of the public requesting a copy of the file wrapper and contents of the application. Section 1.217(d) provides that the Office will provide a complete unredacted copy of the file wrapper and contents of an application for which a redacted copy was submitted under § 1.217 (upon payment of a fee) unless the applicant complies with the requirements of § 1.217(d). Since the processing required to provide redacted copies of the application content is the result of an applicant choosing to submit a redacted copy under § 1.217, it is appropriate to require the applicant to timely provide appropriate redacted copies of Office correspondence and applicant submissions, and to pay a processing fee for the special handling required for these papers, should the applicant wish to maintain the redacted portions of the application in confidence prior to the grant of a patent.

Section 1.217(d)(1) provides that the applicant must accompany the submission required by § 1.217(c) with: (1) A copy of any Office correspondence previously received by applicant including any desired redactions, and a second copy of all Office correspondence previously received by applicant showing the redacted material in brackets; and (2) a copy of each submission previously filed by the applicant including any desired redactions, and a second copy of each submission previously filed by the applicant showing the redacted material in brackets. Section 1.217(d)(2) provides that the applicant must also: (1) Within one month of the date of mailing of any correspondence from the Office, file a copy of such Office correspondence including any desired redactions, and a second copy of such Office correspondence showing the redacted material in brackets; and (2) with each submission by the applicant, include a copy of such submission including any desired redactions, and a second copy of such submission showing the redacted material in brackets. Section 1.217(d)(3) provides that each submission under § 1.217(d)(1) or § 1.217(d)(2) must also be accompanied by the processing fee set forth in § 1.17(i) and a certification that the redactions are limited to the elimination of material that is relevant only to the part or description of the invention that is not contained in the redacted copy of the application submitted for publication. If the applicant fails to comply with these requirements, the Office will provide a complete unredacted copy of the file wrapper and contents of the application to any member of the public (upon payment of a fee).

Section 1.217(e) provides that the certificate of mailing or transmission procedures set forth in provisions of § 1.8 do not apply to the time periods set forth in § 1.217.

Section 1.219: Section 1.219 implements the provisions of 35 U.S.C. 122(b)(1) that authorize (but do not require) the Office to publish earlier than at the eighteen-month period set forth in 35 U.S.C. 122(b)(1) at the request of the applicant. Section 1.219 provides that any request for early publication must be accompanied by the publication fee set forth in § 1.18(d). Section 1.219 provides that if the applicant does not submit a copy of the application in compliance with the Office EFS requirements, the Office will publish the application based upon the application records in the Office's PACR database (as provided in § 1.215(a)). Section 1.219 also provides that no consideration will be given to requests for publication on a certain date (which includes a request that certain applications be published on the same date), and such requests will be treated as a request for publication as soon as possible.

Section 1.221: Section 1.221 provides for voluntary publication of applications filed before, but pending on, November 29, 2000, and for requests for republication of applications previously published under § 1.211. Applicants may request republication of an application under § 1.221 to obtain a patent application publication that: (1) Corrects immaterial errors or errors not the result of Office mistake; or (2) reflects the application as amended during prosecution of the application.

Section 1.221(a) provides that a request for voluntary publication or republication must include a copy of the application in compliance with the Office EFS requirements and be accompanied by the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i).

Voluntary publication or republication of applications is not mandated by 35 U.S.C. 122(b)(1). Thus, if a request for voluntary publication or republication does not comply with the requirements of § 1.221, or the copy of the application does not comply with the Office EFS requirements, the Office will not publish the application based upon the application records in the Office's PACR database (as provided in § 1.215(a)). Rather, the Office will simply not publish the application and will refund the publication fee (but not the processing fee).

Section 1.221(b) provides that the Office will grant a request for a corrected or revised patent application publication other than as provided in § 1.221(a) only when the Office makes a material mistake which is apparent from Office records. The phrase ''material mistake'' means a mistake that affects the public's ability to appreciate the technical disclosure of the patent application publication or determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent (*e.g.,* error in the claims, serious error in a portion of the written description or drawings that is necessary to support the claims). The Office will permit applicants to review the bibliographic information contained in the Office's PALM database via its PAIR system. Therefore, applicants are expected to review that information and bring errors to the Office's attention at least fourteen weeks before the projected date of publication. Section 1.221(b) also provides that any request for a corrected or revised patent application publication other than as provided in § 1.221(a) must be filed within two months from the date of the patent application publication, and that this period is not extendable.

Section 1.291: Section 1.291(a)(1) implements the provisions of 35 U.S.C. 122(c), which specify that the Office shall establish appropriate procedures to ensure that no protest or other form of pre-issuance opposition to the grant of a patent may be initiated after publication of the application without the applicant's express written consent. Section 1.291 is amended to provide that a protest must be submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, whichever occurs first.

Section 1.292: Section 1.292(b)(3) is amended to require that any petition to institute a public use proceeding be submitted prior to the date the application was published or mailing of a notice of allowance under § 1.311, whichever occurs first.

Section 1.311: Section 1.311(a) is amended to provide that the sum specified in the notice of allowance may (in addition to the issue fee) also include the publication fee, in which case the issue fee and publication fee (§ 1.211(f)) must both be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. Section 1.311(a) is also amended to provide that this three-month period is not extendable. Section 1.311(b) is amended to provide that an authorization to charge any of the 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.

Section 1.417: Section 1.417 is added to provide for the submission of international publications or English language translations of international applications pursuant to 35 U.S.C. 154(d)(4). This section sets forth the requirements for the filing of an English language international publication or translation of an international application in order to ensure proper handling by the Office. Section 1.417 provides that such a submission must clearly identify the international application to which it pertains under § 1.5(a), and unless it is being submitted pursuant to § 1.494 or § 1.495, must be clearly identified as a submission pursuant to 35 U.S.C. 154(d)(4). Failure to properly identify such submissions will result in the English language international publication or translation of the international application being processed as the filing of a national application under 35 U.S.C. 111(a). Additionally, failure to properly identify the international publication or translation as a submission under 35 U.S.C. 154(d)(4) may cause the Office to be unable to properly track or retrieve the international publication or translation in relation to its international application number. Section 1.417 also provides that such submissions should be marked ''Box PCT.''

The submission of an international publication or translation of an international application for the purposes of national stage entry in accordance with § 1.494 or § 1.495 may also be relied upon as the submission for the purposes of 35 U.S.C. 154(d)(4). Likewise, an earlier filed international publication or translation (submitted for the purposes of 35 U.S.C. 154(d)(4) and properly identified as such) may also be relied upon for the purpose of satisfying the requirement of 35 U.S.C. 371(c)(2). If applicant intends to rely on such an earlier filed international publication or translation, the submission of documents under § 1.494(f) and § 1.495(g) should include an indication that the international publication or translation has been previously submitted for the purposes of 35 U.S.C. 154(d)(4) to avoid the mailing of either a Notice of Abandonment (PCT/DO/EO/909) indicating that a copy of the international application was not timely filed, or a Notice of Missing Requirements (PCT/DO/EO/905) indicating that a translation of the international application is required. While (as discussed above) applicants may rely on an earlier filed international publication or translation for the purposes of national stage entry and processing, the Office strongly recommends that a second copy of the international publication or translation be included with the initial national stage papers in order to ensure the integrity of the first submitted international publication or translation. Otherwise, processing of the national stage application may result in the alteration of the originally filed international publication or translation through, *e.g.,* the entry of amendments.

Section 1.494: Section 1.494(f) is amended to exempt a copy of the international publication or translation of the international application identified as provided in § 1.417 from the documents that must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371 to avoid being considered a submission under 35 U.S.C. 111(a).

Section 1.495: Section 1.495(g) is amended to exempt a copy of the international publication or translation of the international application identified as provided in § 1.417 from the documents that must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371 to avoid being considered a submission under 35 U.S.C. 111(a).

Part 5:

Section 5.1: Section 5.1(e) is amended to implement the provisions of 35 U.S.C. 122(d), which specify that the application will not be published under 35 U.S.C. 122(b)(1) if publication or disclosure of the application would be detrimental to national security. Section 5.1(e) provides that an application under national security review will not be published at least until six months from its filing date or three months from the date the application was referred to a defense agency, whichever is later. These are the current national security review screening time frames for foreign filing license purposes. Section 5.1(e) also provides that a national security classified patent application will not be published under § 1.211 of this chapter or allowed under § 1.311 of this chapter until the application is declassified and any secrecy order under § 5.2(a) has been rescinded.

Response to Comments

The Office received twenty-one written comments (from Intellectual Property Organizations, Businesses, Law Firms, Patent Practitioners, and others) in response to the notice of proposed rulemaking. Comments generally in support of a change are not discussed. The comments and the Office's

responses to the remaining comments follow:

Comment 1: One comment questioned whether the Office will withdraw its reservation under PCT Article 64(3), which provides for no publication of an international application at eighteen months if only the United States is designated. The comment also questioned whether the Office will revise its declaration under PCT Article 64(4)(c) in view of the amendment to 35 U.S.C. 102(e).

Response: The Office's reservation under PCT Article 64(3) and declaration under PCT Article 64(4)(c) are not germane to the proposed changes to the rules of practice to implement the eighteen-month publication provisions of the American Inventors Protection Act of 1999. The Office will make the appropriate revisions to its reservation under PCT Article 64(3) and declaration under PCT Article 64(4)(c) in due course.

Comment 2: One comment questioned whether a published English language international application designating the United States is considered a published application under § 1.9(b).

Response: An English language international application designating the United States and published under PCT Article 21(2) is not an application for patent which has been published under 35 U.S.C. 122(b). Thus, a published English language international application designating the United States is not considered a published application for purposes of § 1.9(b).

Comment 3: One comment suggested that the Office should not provide copies of the file wrapper and contents of published applications because 35 U.S.C. 122(b) allows for publishing an application, but not disclosing the entire content of an application file.

Response: 35 U.S.C. 122(b) provides that ''[n]o information concerning published patent applications shall be made available to the public except as the Director determines,'' and that ''[n]otwithstanding any other provision of law, a determination by the Director to release or not to release information concerning a published patent application shall be final and nonreviewable.'' *See* 35 U.S.C. 122(b)(1)(B) and (C). Therefore, the Office has the authority to disclose, or refuse to disclose, information contained in the file wrapper contents of a published application as the Office deems appropriate.

Comment 4: Several comments suggested that the Office should not provide copies of the file wrapper and contents of pending applications at all or until such time as the Office can produce such a copy from an electronic copy (rather than the physical application file). The comments argue that removing the application file wrapper for copying will result in disruption of the examination process and the loss or corruption of a number of application files.

Response: The Office is cognizant of the fact that providing copies of the file wrapper and contents of a pending published application to any member of the public on request (and payment of a fee) has the potential to disrupt the examination process or result in corruption of the application file. If fulfilling copy orders for the file wrapper and contents of pending published applications proves to be unmanageable, the Office will revise § 1.14 to require a member of the public requesting a copy of the file wrapper and contents of a pending published application to show cause to obtain such a copy.

Comment 5: One comment suggested that § 1.14(b)(2) should be limited to those international applications that designate the United States.

Response: The suggested revision has not been adopted. For some time, the Office has revealed status information for any U.S. application identified in any published patent document, regardless of whether the document is a foreign patent (*e.g.*, a Japanese patent or a German patent) or an international application. The only change intended by § 1.14(b)(2) is to make the meaning of ''published patent document'' more clear by adding the parenthetical expression ''*e.g.*, a U.S. patent, a U.S. patent application publication, or an international application publication.''

Comment 6: One comment contained a number of suggestions and questions on § 1.14(i): (1) PCT Article 38 does not give the Office the authority to provide access to the examination and search files of a PCT application as provided in § 1.14(i)(1); (2) how the public would know that an English translation has been filed (§ 1.14(i)(2)); (3) whether § 1.14(i)(3) requires that the applicant have entered the national stage under 35 U.S.C. 371 (and what file would be available if no United States file wrapper has been prepared); and (4) § 1.14(i)(5) appears to be in conflict with § 1.14(i)(1)(iii).

Response: Article 38 prohibits direct access to the examination file of an international application by a third party. Section 1.14(i)(1) concerns the situation in which the United States acted as the International Preliminary Examining Authority (IPEA), the United States was elected, and the International Preliminary Examination Report (IPER) has issued. PCT Rule 94 provides authority for the Office to provide copies in these situations. PCT Rule 94.2 provides that after issuance of the IPER, the IPEA shall provide copies of the examination file (or any part thereof) to the elected offices upon request, and Rule 94.3 allows the elected offices to provide access to any document in its files. Therefore, upon receipt of a request under § 1.14(i)(1) by a third party for a copy of an examination file in an international application that satisfies the requirements of § 1.14(i)(1)(iii), the United States Elected Office will request that the United States IPEA make a copy of its examination file, and the United States Elected Office will then provide a copy of such file to the requesting party.

The Office will not provide general notification to the public of the filing of translations under 35 U.S.C. 154. Under 35 U.S.C. 154, it is the responsibility of the applicant to notify any possible infringers for the purpose of obtaining provisional rights.

Section 1.14(i)(3) does not require that the applicant have entered the national stage under 35 U.S.C. 371. Section 1.14(i)(3) concerns access to international application home and search files (access to the examination files being prohibited by § 1.14(i)(5)).

Sections 1.14(i)(1)(iii) and 1.14(i)(5) are not in conflict. Section 1.14(i)(1)(iii) concerns the situations in which the United States acted as the International Preliminary Examining Authority (IPEA), the United States was elected, and the International Preliminary Examination Report (IPER) has issued (as discussed above). Section § 1.14(i)(5) concerns direct access to the examination files which is prohibited by PCT Article 38.

Comment 7: One comment suggested that the phrase ''may be provided'' in § 1.14(c)(1), (c)(2), and (e) should be changed to ''will be provided'' for consistency with § 1.13. Another comment suggested that § 1.14(c)(1) and (c)(2) be clarified as to what (the application-as-filed or the entire contents of the file wrapper) may be supplied, and whether the phrase ''may be provided'' is intended to mean that supplying such is optional or discretionary on the part of the Office.

Response: The suggestion has not been adopted. The phrase ''may be'' is used throughout §§ 1.11, 1.12, and 1.14 and is retained in § 1.14 for consistency and because ''may be'' is the appropriate terminology. For example, § 1.14(c)(2) provides that a copy of the specification, drawings, and all papers related to a published patent application may be

provided if a written request with the appropriate fee are filed. The requested copy will normally be provided, but if the file is not available because it is being reviewed by a patent examiner or is at the publishing contractor for printing a patent, the requested copy may be only provided at a delayed date. Furthermore, in the rare event that the file is lost (and a replacement copy cannot be obtained), the requested copy cannot be made and will not be provided.

Comment 8: Several comments suggested that the surcharge for the unintentionally delayed submission of a priority claim was excessive. One comment suggested that this surcharge be a nominal ($5) charge or in line with the publication fee ($300).

Response: If a significant number of unintentionally delayed claims under 35 U.S.C. 119, 120, 121, or 365(a) or (c) are presented, the Office will have difficulty scheduling applications for publication. Thus, the surcharge amount must be sufficient to provide an incentive for applicant to exercise care to ensure that any desired claim under 35 U.S.C. 119, 120, 121, or 365(a) or (c) is timely presented. The proposed surcharge amount tracks the fee amount for a petition to revive an unintentionally abandoned application (35 U.S.C. 41(a)(7)), and this fee amount is considered an appropriate surcharge for a petition to accept an unintentionally delayed claim under 35 U.S.C. 119, 120, 121, or 365(a) or (c). Since the fiscal year 2001 fee amount for a petition to revive an unintentionally abandoned application (35 U.S.C. 41(a)(7)) is $1,240 (§ 1.17(m)), this fee amount ($1,240) is considered an appropriate surcharge for a petition to accept an unintentionally delayed claim under 35 U.S.C. 119, 120, 121, or 365(a) or (c) (§ 1.17(t)).

Comment 9: Several comments suggested that the $300 publication fee was excessive. One comment argued that a publication fee should not be imposed on applicants who do not want publication but do not meet the requirements to request nonpublication under § 1.213. Several comments suggested that the publication fee (cost) be included in the other application (filing or issue) fees. One comment suggested that the publication fee be reduced by fifty percent for small entities. Another comment suggested that § 4506 of the American Inventors Protection Act of 1999 did not authorize the Office to charge a publication fee in those situations in which an application is issued as a patent and subsequently published as a patent application publication.

Response: Section 4506 of the American Inventors Protection Act of 1999 requires the Office to ''recover the cost of early publication required by the amendment [to 35 U.S.C. 122] by charging a separate publication fee.'' Section § 4506 of the American Inventors Protection Act of 1999 does not provide for the Office to: (1) Not charge the publication fee to those applicants who would prefer not to have their applications published under 35 U.S.C. 122(b); (2) build the cost of publication into other application (filing or issue) fees; or (3) apply the small entity discount (which otherwise applies only to fees under 35 U.S.C. 41(a) or (b)) to the publication fee (*cf.* 35 U.S.C. 132(b)). Finally, even when an application is issued as a patent and subsequently published as a patent application publication (because it issues too late in the publication process to stop publication), the cost of such a publication is part of the cost of early publication required by 35 U.S.C. 122(b), and § 4506 of the American Inventors Protection Act of 1999 directs the Office to also recover that cost by charging a separate publication fee.

Comment 10: A comment supporting the changes to §§ 1.52(d) and 1.78(a)(5) concerning the translation requirement for a non-English language provisional application suggested that the Office clarify whether the translation of the provisional application is to be filed in the provisional application or in any nonprovisional application claiming the benefit of the provisional application.

Response: Section 1.78(a)(5) provides that if a provisional application is filed in a language other than English, any nonprovisional application claiming the benefit of the provisional application ''must contain * * * an English language translation of the non-English language provisional application and a statement that the translation is accurate.'' Thus, § 1.78(a)(5) is clear that the English-language translation of the provisional application must be filed in any nonprovisional application claiming the benefit of the provisional application.

Comment 11: One comment questioned whether an applicant can withdraw a priority claim to change the date on which the application will be published, noting that withdrawal of priority claims is provided for in PCT Rule 90*bis*.3.

Response: The Office will recalculate the publication date in response to any change (withdrawal or addition) in priority claims. If this recalculation occurs earlier than nine weeks prior to the previously calculated publication date, the Office will reschedule the application for publication based upon the recalculated publication date. If this recalculation occurs later than nine weeks prior to the previously calculated publication date, the Office will not reschedule the application for publication based upon the recalculated publication date.

Comment 12: One comment requested clarification of the meaning of the term ''original'' in § 1.55.

Response: An ''original'' application is any application other than a reissue application, which includes continuing applications and applications claiming the benefit of a foreign-filed application. See Guidelines Concerning the Implementation of Changes to 35 U.S.C. 102(g) and 103 and the Interpretation of the Term ''Original Application'' in the American Inventors Protection Act of 1999, 1233 Off. Gaz. Pat. Office 54, 56 (Apr. 11, 2000).

Comment 13: One comment suggested that the time periods set forth in §§ 1.55 and 1.78 should not apply to an application in which a nonpublication request under § 1.213 is filed.

Response: A nonpublication request may be rescinded at any time. *See* 35 U.S.C. 122(b)(2)(B)(ii) and § 1.213(b). Thus, the Office must treat an application in which a nonpublication request under § 1.213 is filed the same as other applications for purposes of priority claims as well as review of the patent application drawing and paper (specification) during pre-examination processing of the application.

Comment 14: One comment suggested that the time periods set forth in §§ 1.55 and 1.78 unfairly limit an applicant's ability to delay presenting priority claims until the claim is necessary to avoid the prior art.

Response: An applicant's desire to delay presenting priority claims until the claim is necessary to avoid the prior art is subordinate to the need for the timely presentation of priority claims for publication promptly after eighteen months from the earliest filing date for which a benefit is claimed. The Office previously indicated that eighteen-month publication (if adopted) would require a drastic change in the practice of the presentation of priority claims filed. See General Agreement on Tariffs & Trade/North American Free Trade Agreement Student's Handbook at 6 (question 3), U.S. Patent and Trademark Office (1995).

Comment 15: One comment suggested that the time periods set forth in §§ 1.55 and 1.78 should not apply to the addition of priority claims in the situation in which the application is published within six months of its actual filing date, since the public has

not been harmed by the untimely priority claim.

Response: The Office will not be able to include such untimely priority claims on the patent application publication (and the absence of a priority claim is not considered a ''material mistake'' warranting republication of the patent application publication under § 1.221(b)). Thus, the public will be harmed by such an untimely presentation of a priority claim because the patent application publication will not contain the priority claim.

Comment 16: One comment suggested that if priority claims are not required until the later of four months from the actual filing date or sixteen months from the earliest claimed priority date, a fourteen-week publication cycle would be too long since the public could not rely upon an application being published until twenty months from its earliest claimed priority date.

Response: The Office plans to publish applications on the first Thursday after the date that is eighteen months after the filing date of the application (or if the application claims the benefit of an earlier filing date, the first Thursday after the date that is eighteen months after the earliest filing date for which a benefit is sought). Thus, the Office will schedule applications to begin the publication cycle on the date that is fourteen weeks before that date. If a priority claim under 35 U.S.C. 119, 120, 121, or 365(a) or (c) is filed within fourteen weeks of the date eighteen months after the earliest filing date for which a benefit is sought, the Office will not be able to publish the application on the first Thursday after the date that is eighteen months after the earliest filing date for which a benefit is sought because it requires a fourteen-week cycle to prepare an application for publication in view of the volume of applications to be published and preparation required for the publication.

Comment 17: One comment suggested that the phrase ''or intellectual property authority'' be added after ''country'' in § 1.55(c) for consistency with § 1.55(a)(1)(i).

Response: The parenthetical ''(or intellectual property authority)'' has been added after ''country'' in § 1.55(c) for consistency with § 1.55(a)(1)(i).

Comment 18: One comment suggested that the limitation to ''500 words'' in § 1.72(a) was in conflict with PCT Rule 4.3, which specifies that the ''title of the invention shall be short (preferable from two to seven words when in English or translated into English. * * *''

Response: Section 1.72(a) requires that the title be limited to 500 characters (not words). PCT Rule 4.3 requires that ''title of the invention shall be short,'' and a title that exceeds 500 characters is not short. Therefore, § 1.72(a) does not conflict with PCT Rule 4.3.

Comment 19: One comment suggested that the Office clarify § 1.72(a) to specify what characters can be included in the title of an application.

Response: Section 1.72(a) as adopted does not prohibit non-keyboard character (images) in a title. Section 1.72(a) as adopted, however, provides that characters that cannot be captured and recorded in the Office's automated information systems (*e.g.,* PALM) may not be reflected in the Office's records in such systems or in documents created by the Office. The Office will post the set of characters that are capable of being captured and recorded in PALM on its Internet Web site. The Office will revise the set of characters posted on its Internet Web site as characters are added to this set as a result of improvements to the Office's automated information systems. Applicants are strongly encouraged to restrict the characters in titles to characters in the set of characters indicated as capable of capture and recordation in PALM.

Comment 20: One comment questioned why the Office would use the title of the invention (which does not uniquely identify an application) as the key for associating an EFS copy of an application with the application for which the copy is being submitted.

Response: The Office uses the application number as the primary key for associating an EFS copy of an application with the application for which the copy is being submitted. In view of the number of applications filed each day, it is not practical to use the filing date to verify that the application number is correct (a transposition of the last four digits of the application number will not be revealed when compared to the filing date). The Office may also use other information to verify that the application number correctly indicates the application for which an EFS copy is being submitted.

Comment 21: One comment questioned how the time period provision of § 1.78(a)(2) applied to international applications.

Response: The time period for claiming priority of a prior application in an international application is set forth in the PCT and the Regulations under the PCT.

Comment 22: One comment suggested that the Office clarify whether the requirement in § 1.78(a)(2) that the first sentence of an application indicate whether an international application was published in English applies to international applications filed before November 29, 2000.

Response: The requirement applies to any application filed on or after November 29, 2000, that claims the benefit of a prior international application, regardless of the filing date of the international application for which a benefit is claimed.

Comment 23: One comment suggested that the expression ''[c]olor drawings are not permitted in international applications (see PCT Rule 11.13)'' in § 1.84 is redundant, since the PCT Rule is sufficient authority.

Response: The rules of practice contain a number of provisions that reiterate provisions of the PCT Articles and Regulations, as well as title 35, U.S.C. While such reiterative provisions are (strictly speaking) redundant, they are included in the rules of practice for advisory purposes. If there is a change to the PCT Articles or Regulations (or title 35, U.S.C.), it is likely that the Office's rules of practice will require conforming changes in any event.

Comment 24: One comment questioned whether there will be an Official Gazette publication with a figure when an application issues as a patent.

Response: The Office plans to continue publishing an Official Gazette containing the weekly patent issues with (among other things) a representative drawing figure.

Comment 25: One comment suggested that if the Office considers drawings in compliance with § 1.84 necessary for publication, the Office should reduce the formality requirements of § 1.84.

Response: As discussed above, the Office plans to enforce the requirements of § 1.84 necessary for creating a publication (the patent application publication) containing drawings of sufficient quality for the patent application publication to be routinely used as a prior art document.

Comment 26: One comment suggested that the Office should not require drawings in compliance with § 1.84 until fourteen months from the earliest claimed priority date. Another comment suggested that the Office release applications containing drawings that do not comply with § 1.84 to the Technology Center, flag the PACR record of such applications, and simply add the later-filed drawings in compliance with § 1.84 to the PACR database for publication.

Response: Since the eighteen-month period is not measured from an application's actual filing date, but from the earliest filing date for which a benefit is claimed, many applications will enter the publication cycle before

being transferred from OIPE to the Technology Centers. The Office would need to track which applications have been released to the Technology Center without drawings in compliance with § 1.84 and issue a notice requiring drawings in compliance with § 1.84 during the examination process to ensure that drawings in compliance with § 1.84 are filed before an application is scheduled to enter the publication cycle. Issuing such a notice during the examination process (when the Office is issuing Office actions) would result in confusion (likelihood of two different time periods running simultaneously) and would interfere with the Office's ability to meet the time frames specified in 35 U.S.C. 154(b)(1)(A)(i) and (ii).

Comment 27: Several comments opposed the change to § 1.85 requiring drawings in compliance with § 1.84 before an application will be released to the Technology Center for examination. Several comments argued that this change will increase up-front costs for patent applicants. One comment suggested a two-tiered review: one level for publication and a second level for printing in a patent.

Response: The patent statute no longer defers publication of an application until patent grant. Thus, the Office can no longer permit applicants to defer the submission of publication quality drawings (and the cost of preparing such drawings) until an application is allowed. Since the patent application publication will become the primary prior art and technology dissemination document, there is no point to providing for higher drawing quality in patents than in patent application publications.

Comment 28: Several comments suggested that § 1.98(a)(2)(ii) not require a copy of a cited copending application, especially since the Office has an electronic database containing copies of applications as filed. Another comment also argued that this provision in combination with § 1.14(c)(2) will allow third parties to obtain a copy of any cited copending application causing: (1) The cited application to become a publication that may bar the filing of the cited application in foreign countries; (2) the disclosure of trade secrets from the cited application (which may have been abandoned prior to its scheduled publication date); and (3) an increase in paper submissions to the Office.

Response: The Office proposed amending § 1.98(a)(2)(ii) to require a copy of any cited copending application in a rulemaking to implement the Patent Business Goals. See Changes to Implement the Patent Business Goals, 64 FR at 53833, 1228 Off. Gaz. Pat. Office at 18. The comments on this proposed change to § 1.98 are addressed in the final rule to implement the Patent Business Goals.

Comment 29: One comment questioned whether § 1.99 is consistent with the requirements of 35 U.S.C. 122(c) (which instruct the Office to ensure that no protest or opposition be initiated after publication without the express written consent of the applicant), and suggested that the Office not adopt this proposed rule.

Response: 35 U.S.C. 122(c) provides that the Office ''shall establish appropriate procedures to ensure that no protest or other form of pre-issuance opposition to the grant of a patent on an application may be initiated after publication of the application without the express written consent of the applicant.'' A submission under § 1.99, however, is different from either an ''opposition'' proceeding or a ''protest'' that would fall under the provisions of 35 U.S.C. 122(c).

Unlike a third-party submission of patents and publications under § 1.99, an opposition is a very complex, *inter partes* proceeding. Examples of oppositions include trademark oppositions and foreign patent office oppositions.

Trademark oppositions, conducted before the Trademark Trial and Appeal Board, are full adversarial proceedings similar to a trial, complete with pleadings, notice, discovery, stipulations, motions, briefs, evidence, and opportunity for oral argument. A trademark opposition proceeding is governed by the Federal Rules of Civil Procedure, except as otherwise provided. 37 CFR 2.101 through 2.107 and 2.116 through 2.136, sections 1503 through 1503.05 of the Trademark Manual of Examining Procedure, and Chapters 300 through 800 of the Trademark Trial And Appeal Board Manual of Procedure set forth an overview of the complex nature of trademark opposition proceedings. In view of the similarity to an *inter partes* civil proceeding, it is clear that trademark oppositions are much different in character compared to a third-party submission of patents and publications under § 1.99 (which bars a third party from even filing a paper arguing against the patentability of an application).

Similar to the Office's trademark opposition procedure, oppositions in patent cases in both the Japanese Patent Office (JPO) and the European Patent Office (EPO) are lengthy *inter partes* proceedings in which a third party has extensive participation in challenging the grant of a patent. Both the EPO and the JPO allow for evidence, multiple briefs, an oral hearing, and appeals, and the procedures to be followed are very technical and complex. *See* Chapter 66 (Patent Opposition System) of the JPO's Manual of Appeal and Trial Proceedings; *see also* Part D Opposition Procedure of Guidelines for Examination in the European Patent Office.

Likewise, a third-party submission of patents and publications under § 1.99 is not a ''protest.'' As generally understood, a protest is ''a complaint, objection, or display of unwillingness usually to an idea or course of action.'' *See* Merriam Webster's Collegiate Dictionary (1993). Under that commonly understood meaning, a third-party submission of patents and publications under § 1.99 does not rise to the level of a protest because § 1.99 does not permit the filing of any complaint or objection. No form of adversarial argument is allowed under § 1.99. Instead, a third party is limited to merely submitting prior art without any corresponding commentary.

The Office does have an existing regulation (§ 1.291) entitled: ''Protests by the public against pending applications.'' Under § 1.291, a member of the public may file a protest in a pending application, which protest comprises: (1) A list of the prior art references or other information relied upon; (2) an explanation of the relevance of each listed item; (3) a copy of each listed item; and (4) an English translation of each item, if necessary. *See* § 1.291(b). In direct contrast to a protest under § 1.291, however, § 1.99 does not permit the third party to transmit any commentary or adversarial arguments objecting to a patent application. Rather, § 1.99 is structured so as to avoid compromising the objectivity of the *ex parte* character of the examination process.

Only patents and publications (*i.e.*, prior art documents that are public information that are theoretically available to the examiner and which the Office would discover on its own in an ideal world) may be supplied to the examiner in a submission under § 1.99. As such, the bare submission of patents and publications is not a protest any more than the submission of an information disclosure statement under §§ 1.97 and 1.98 by the patent applicant is a ''protest.'' In addition, patents and publications may be submitted for various reasons: Individuals may wish to submit patents or publications to help the examiner understand the technology or the appropriate field of search. Therefore, third-party submission of

patents and publications under § 1.99 is qualitatively different from a protest under § 1.291.

Title 35, U.S.C., provides that the Office may issue a patent only if it appears that the applicant is entitled to a patent in view of the prior art (35 U.S.C. 102 and 103). 35 U.S.C. 122(c) does not disqualify prior art simply because that prior art came to the attention of the Office through a third party. Thus, the Office interprets ''protest or opposition'' in 35 U.S.C. 122(c) to mean that the Office is to ensure that no third party is given the ability (or right) to have input on the examination of the application after publication and argue against the application's patentability. Section 1.99 simply sets forth a procedure under which a third party can bring prior art relevant to a published application to the attention of the Office. As an important safeguard for the rights of the applicant, it does not give the third party the ability or right to participate in the examination of the application as a result of such prior art being brought to the attention of the Office. Accordingly, § 1.99 will improve the quality of examination and at the same time will ensure that no third parties enter written, adversarial arguments, thereby coloring the *ex parte* process.

Comment 30: One comment suggested that the limitations in § 1.99 do not adequately protect the applicant from misuse of eighteen-month publication by third parties because third parties may submit information directly to the applicant (or the applicant's representative), who in turn may be obligated under § 1.56 to disclose the information to the Office. The comment suggested amending § 1.56 to exempt persons associated with an application from considering information received from a third party.

Response: The Office did not propose changes to the provisions of § 1.56. Given the *ex parte* nature of the examination of an application for patent, the obligations placed on an applicant under § 1.56 are paramount to that examination. Therefore, the Office considers it inappropriate to alter the provisions of § 1.56 simply because eighteen-month publication may result in prior art being brought to an applicant's attention at an inopportune point in the examination process.

Comment 31: Several comments suggested that § 1.99 be amended to permit third parties to provide explanations as to the relevant parts of the patents or publications, since such explanations may be necessary in the case of a complex or voluminous patent or publication. Another comment suggested that since § 1.99(b)(4) permits translations of the necessary and pertinent parts of non-English language publications, § 1.99 should permit markings on the necessary and pertinent parts of English language publications. Another comment also suggested that examiners should be required to consider patents and publications submitted in compliance with § 1.99.

Response: To ensure that a third-party submission under § 1.99 does not amount to a protest or other opposition, the Office cannot permit the third party to either: (1) Provide explanations (*e.g.*, as to how the patents or publications render the claims unpatentable) with the patents and publications; or (2) have the right to insist that the Office ''consider'' any of the patents or publications submitted. The third party, however, may submit redacted versions of a patent or publication containing only the most relevant portions of the patent or publication.

Comment 32: One comment suggested that the rules of practice should encourage third parties to submit prior art to the Office (especially the computer software and business methods areas), and that the $180 fee (§ 1.17(p)) for a third-party submission will be contrary to the public interest by discouraging third parties from submitting prior art. The comment suggested an alternative fee structure based upon the nature of the third party (small entity, non-small entity) or nature of the submission (non-patent publications, number of patents or publications).

Response: 35 U.S.C. 41(d) authorizes the Office to establish fees to recover the estimated average cost of providing services or products not otherwise provided for. The Office has recently lowered the fee set forth in § 1.17(p) to $180, which is set at a fee amount to recover the aggregate costs of handling and reviewing the information (patents and publications) brought to the attention of the Office subsequent to the issuance of a first Office action. Since the nature of the third party (small entity, non-small entity), or nature of the submission (non-patent publications), or nature of the technology of the submission does not impact this cost, 35 U.S.C. 41(d) does not authorize the Office to vary the fee based upon these factors (and § 1.99 places a limit on the number of patents or publications in the submission).

Comment 33: Several comments suggested that § 1.99 include the following provisions to avoid becoming a means for third parties to harass the applicant or disrupt the examination process: (1) Require that the third party provide evidence that it has served the information being submitted on the applicant (rather than expecting the Office to do so); (2) require the third party to declare (under oath or declaration) whether he/she is submitting the information pursuant to an agency relationship (and, if so, to identify the real party in interest); and (3) permit the third party to submit only five (rather than twenty) patents or publications and to screen the information to eliminate patents or publications that have already been cited in the application.

Response: Section 1.99(c) requires that the submission be served on the applicant in compliance with § 1.248. Section 1.248 requires that: (1) Service be made by the third party, not the Office (§ 1.248(a)); and (2) the third party provide evidence that it has served the information being submitted on the applicant (1.248(b)).

Section 1.99 as adopted limits the number of patents and publications in such a submission to ten (rather than twenty). Nevertheless, if a patent or publication is highly probative, it would not be in the third party's interest to include such a patent or publication in a submission containing even ten patents or publications (since the third party cannot provide any explanation with the submission).

The Office considers further restrictions on the number of patents or publications in a submission under § 1.99 to be unnecessary. Since the third party has no ability or right to have input on what will happen during the examination of the application as a result of the submission under § 1.99, the real party in interest is of no concern. Finally, the Office plans (as discussed above) to screen submissions under § 1.99 to determine whether they are limited to patents and publications before the submission is placed in the file of the application and forwarded to the examiner, and to remove any explanations or information (other than patents and publications) from the submission before it is placed in the file of the application and forwarded to the examiner.

Comment 34: One comment also suggested that the Office clarify the condition (*e.g.*, delay was ''unavoidable'') under which patents and printed publications submitted later than two months from the date of publication of the application or prior to the mailing of a notice of allowance (whichever is earlier) will be considered.

Response: A submission under § 1.99 later than the period specified in § 1.99(e) is permitted only when the

patents or publications could not have been submitted to the Office earlier (*e.g.*, an amendment submitted in the published application after publication changes the scope of the claims to an extent that could not reasonably have been anticipated by a person reviewing the published application during the period specified in § 1.99(e)).

Comment 35: One comment suggested that third parties should be given three (rather than two) months from the date of publication of the application or prior to the mailing of a notice of allowance, whichever is later (rather than whichever is earlier) to submit patents or publications under § 1.99.

Response: The time period in § 1.99 balances the desirability of considering the best prior art during examination of an application with the need to avoid undue interference with the examination of the application. The Office considers a time period of two months from the date of publication of the application or prior to the mailing of a notice of allowance, whichever is earlier, as striking a better balance between these interests.

Comment 36: One comment questioned how the time period specified in § 1.99(e) would apply to an international application.

Response: The submission must be filed within two months of the publication of the application under 35 U.S.C. 122(b), and not the IB publication, or prior to the mailing of a notice of allowance, whichever is earlier.

Comment 37: One comment contained a number of questions and suggestions concerning § 1.130: (1) § 1.130 does not address the change to 35 U.S.C. 103(c) in § 4807 of the American Inventors Protection Act of 1999 and has a confusing heading; (2) the requirement for an oath or declaration that ''the application or patent under reexamination and patent or published application are currently owned by the same party'' is confusingly written; (3) it is not clear who must make the required oath or declaration under § 1.130(a)(2); and (4) it is not clear why such an oath or declaration is necessary since this information is available in the terminal disclaimer and assignments.

Response: Section 1.130 was adopted in September of 1996 to address those situations in which: (1) The rejection in an application or patent under reexamination to be overcome is a rejection under 35 U.S.C. 103 in view of a U.S. patent which is not prior art under 35 U.S.C. 102(b); (2) the inventions defined by the claims in the application or patent under reexamination and by the claims in the U.S. patent are not identical but are not patentably distinct; and (3) the inventions are owned by the same party. *See MPEP* 718; *see also Miscellaneous Changes in Patent Practice,* 61 FR at 42795, 1190 *Off. Gaz. Pat. Office* at 71. Section 1.130 does not address the change to 35 U.S.C. 103(c) in § 4807 of the American Inventors Protection Act of 1999 (and appears to have a confusing heading) because § 1.130 is not directed to implementing the provisions of 35 U.S.C. 103(c).

The phrase ''application or patent under reexamination and patent or published application'' is designed to cover four situations: (1) The rejection of a claim in an application on the basis of a commonly assigned patent; (2) the rejection of a claim in an application on the basis of a commonly assigned published application; (3) the rejection of a claim in a patent under reexamination on the basis of a commonly assigned patent; and (4) the rejection of a claim in a patent under reexamination on the basis of a commonly assigned published application.

The oath or declaration under § 1.130(a)(2) may be signed by the inventor(s), a registered practitioner of record, or the assignee of the entire interest. *See MPEP* 718.

Section 1.130 requires such an oath or declaration because the assignee information in the terminal disclaimer or recorded assignments may not be current, and the applicant is in the best position to verify that the application or patent under reexamination and patent or published application are currently owned by the same party.

Comment 38: One comment suggested that the second sentence of § 1.131 is unnecessary and inappropriately omits any reference to 35 U.S.C. 102(a), and that the phrase ''by reference to acts'' appears to have been inadvertently omitted in the subsequent two sentences.

Response: The second sentence of § 1.131(a) provides that the effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or the date that it is effective as a reference under 35 U.S.C. 102(e). While the second sentence of § 1.131 is technically unnecessary, it serves as a reminder that the effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2), for prior art purposes, may be earlier than its publication date (*i.e.,* its effective date under 35 U.S.C. 102(a)). In addition, the phrase ''by reference to acts'' has not been omitted in the subsequent two sentences of § 1.131. *See* § 1.131(a)(2)(1995)–(2000).

Comment 39: One comment suggested that § 1.132 be revised to permit an oath or declaration under § 1.132 to traverse a rejection even if the rejection is based upon a patent or application to another that claims the same patentable invention. Another comment suggested that § 1.132 be revised to permit an oath or declaration under § 1.132 to traverse a rejection even if the rejection is based upon a published application to another that claims the same patentable invention.

Response: Section 1.132 as adopted provides that when any claim of an application or a patent under reexamination is rejected or objected to, any evidence submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under § 1.132.

Comment 40: One comment suggested that the reference in § 1.137(d)(2) requiring that a terminal disclaimer also apply to utility or plant applications filed after June 8, 1995, is unnecessary.

Response: Section 1.137(d)(2) as adopted provides that such a terminal disclaimer also apply to utility or plant applications filed before (not after) June 8, 1995.

Comment 41: One comment suggested that the requirement for a terminal disclaimer in an application abandoned due to the applicant's failure to timely notify the Office of a foreign filing was unfair because such abandonment will not delay prosecution of the application.

Response: Section 1.137(d) does not require a terminal disclaimer for a utility or plant application filed on or after June 8, 1995, and the eighteen-month publication provisions of the American Inventors Protection Act of 1999 apply only to utility or plant applications filed on or after November 29, 2000.

Comment 42: One comment suggested that the provisions of § 1.137(f) should include punitive measures to avoid frivolous or fraudulent nonpublication requests, since an applicant should make a nonpublication request only when positive that an application will not be filed in a foreign country, and would be seriously negligent to intentionally make such a nonpublication request, subsequently file in a foreign country, and then fail to satisfy his or her obligation to timely notify the Office that a corresponding application has been filed in a foreign country. The comment suggested similar treatment for applications for which a redacted copy was submitted for publication, and the redacted copy

improperly omitted portions of the application.

Response: Since an applicant would have to be ''seriously negligent'' to submit a nonpublication request on filing, subsequently file a corresponding application in a foreign country, and then unintentionally fail to timely notify the Office that a corresponding application has been filed in a foreign country, the Office expects few petitions to revive an application under the provisions of § 1.137(f). If an applicant intentionally (or fraudulently) delays notifying the Office that a corresponding application has been filed in a foreign country, the applicant cannot revive the application under § 1.137 (or if revival is obtained on the basis of improper statements, such revival will not likely survive court review during any attempt to enforce the patent). An applicant who intentionally submits an improperly redacted copy of an application for publication is not dealing with the Office consistent with the duty of candor and good faith (§ 1.56), and will likely meet a similar fate when attempting to enforce any patent resulting from the application.

Comment 43: One comment suggested that the language of § 1.137(g) does not take into account the amendment to 35 U.S.C. 119(e) in § 4801(b) of the American Inventors Protection Act of 1999.

Response: Section 1.137(g) contains the phrase ''[s]ubject to the provisions of 35 U.S.C. 119(e)(3) and § 1.7(b),'' to take into account the amendment to 35 U.S.C. 119(e) in § 4801(b) of the American Inventors Protection Act of 1999.

Comment 44: One comment suggested that the Office create a special box to which an express abandonment being made to avoid publication are to be mailed to allow ''last minute'' express abandonments to achieve their goal of avoiding publication.

Response: Petitions under § 1.138 should be addressed to: Box PGPUB–ABN. While addressing a petition under § 1.138 to Box PGPUB–ABN will increase the chances of such petition being received by the appropriate officials in sufficient time to avoid publication of an application, it is unlikely that a petition under § 1.138 filed within four weeks of the projected date of publication will be effective to avoid publication under any circumstance. Thus, applicants should not rely upon Box PGPUB–ABN as permitting ''last minute'' express abandonments to achieve their goal of avoiding publication.

Comment 45: One comment suggested that eighteen-month publication will benefit only large companies since small corporations and independent inventors rely upon their applications being maintained in confidence, and that eighteen-month publication does not promote the useful arts and sciences as to small corporations and independent inventors who rely upon their applications being maintained in confidence. Another comment suggested that eighteen-month publication will benefit only large companies to the detriment of small corporations and independent inventors, and a patent application should be maintained in confidence until a patent is granted.

Response: The proposed changes to the rules of practice concern how (and not whether) the Office will implement the eighteen-month publication provisions of the American Inventors Protection Act of 1999. In any event, the eighteen-month publication provisions of the American Inventors Protection Act of 1999 permit small corporations and independent inventors (or any applicant) who do not file counterpart foreign or international applications (which are subject to eighteen-month publication) to ''opt-out'' of eighteen-month publication (§ 1.213), and provide provisional rights protection (35 U.S.C. 154(d)) to those who do not or cannot ''opt-out'' of eighteen-month publication.

Comment 46: One comment suggested that the eighteen-month period for publication of an application should not include a prior application for which the application claims a benefit as a continuation-in-part application.

Response: 35 U.S.C. 122(b) provides for publication at eighteen months ''from the earliest filing date for which a benefit is sought under this title.'' Thus, 35 U.S.C. 122(b) provides that this eighteen-month period is measured from the earliest claimed filing date, whether the benefit of that filing date is claimed as a continuation, divisional, or continuation-in-part application.

Comment 47: Several comments suggested that it is inefficient and inappropriate to (re)publish an international application if the international application has been published by the IB under PCT Article 21 in English. One comment suggested that PCT Article 29 and 35 U.S.C. 374 equate the IB publication of an international application to the publication of the application under 35 U.S.C. 122(b). Another comment suggested that if the Office means to publish an international application even if the international application has been published by the IB under PCT Article 21 in English, the Office should amend § 1.211(a) to explicitly state as much.

Response: The IB publication of an international application will not be included in the Office's patent application publication search database. The Office must (re)publish international applications that entered the national stage to place these applications into its patent application publication search database. The benefit gained by ensuring that these prior art documents will be included in the Office's patent application publication search database outweighs the cost of (re)publishing these applications.

Since § 1.211(a) states that ''each international application in compliance with 35 U.S.C. 371 will be published promptly 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.'' No amendment to § 1.211(a) is necessary for it to explicitly state that the Office will publish an international application that is in compliance with 35 U.S.C. 371 (regardless of whether the international application has been published by the IB under PCT Article 21 in English).

Comment 48: One comment suggested that the Office clarify the phrase ''sufficient time'' in § 1.211(a) so that applicants in the same situations will be treated the same.

Response: The Office cannot remove an application from the publication process later than two weeks from the projected date of publication. Thus, the phrase ''sufficient time'' means that the application must issue as a patent at least two weeks before its projected publication date. Section 1.211(a) does not include a specified time frame because improvements in the publication process may permit the Office to remove an application from the publication process later than two weeks from the projected date of publication.

Comment 49: One comment suggested that the burden should be on the Office to determine whether a corresponding application has been filed in a country that requires eighteen-month publication. The comment also suggested that the Office publish only applications that the Office can demonstrate that the application has been or will be filed in a country that requires eighteen-month publication or if the applicant affirmatively requests publication. The comment also suggested that an applicant's failure to timely notify the Office of a foreign filing should not result in abandonment of the application, and that the Office should send reminders of this obligation to those applicants who file a

nonpublication request with their applications.

Response: 35 U.S.C. 122(b)(2)(B)(i) places the burden on the applicant to affirmatively request that an application not be published, and 35 U.S.C. 122(b)(2)(B)(iii) provides that an application is abandoned (by operation of law) if an applicant submits a nonpublication request, subsequently files a corresponding application in a foreign country, and then fails to timely notify the Office that a corresponding application has been filed in a foreign country. 35 U.S.C. 122(b)(2)(B) does not provide for the Office to determine or demonstrate whether a corresponding application has been filed in a foreign country or to issue reminders to applicants who filed a nonpublication request with their applications.

Comment 50: One comment suggested that the certification requirement of § 1.213 is too severe, and that an applicant should be required to certify only that a foreign filing is not contemplated and that the applicant will notify the Office promptly in the event that a foreign filing occurs.

Response: The certification required by § 1.213 tracks the certification required by 35 U.S.C. 122(b)(2)(B)(i) (''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''). The suggested ''less severe'' certification would not be consistent with the certification required by 35 U.S.C. 122(b)(2)(B)(i).

Comment 51: One comment suggested that since submission of a nonpublication request is a serious matter and an application for which a nonpublication request is submitted requires exception handling, the Office should charge a substantial fee for submitting a nonpublication request.

Response: While the submission of a nonpublication request and certification should be considered a ''serious matter'' by applicant, the ''exception processing'' required for an application in which a nonpublication request is submitted is not sufficient to warrant charging a processing fee. The patent statute does not authorize the Office to charge ''a substantial fee'' (or surcharge) simply because of the seriousness of the request and certification.

Comment 52: Several comments requested clarification on whether the Office would grant a foreign filing license in the situation in which an application is filed with a nonpublication request (which must certify 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 agreement, that requires publication at eighteen months after filing).

Response: The Office will review an application to determine whether it is appropriate to grant a foreign filing license even if the applicant files a nonpublication request with the application because: (1) The applicant may subsequently file the application in a foreign country that requires eighteen-month publication and notify the Office of such filing; and (2) not all foreign countries require eighteen-month publication.

Comment 53: Several comments suggested that § 1.215 also state that the patent application publication include the classification of the patent application.

Response: The Office plans to include the classification on the front page of a patent application publication. The rules of practice do not set forth the particulars of what appears on the front page of a patent. Therefore, it is not necessary for the rules of practice to set forth this or other particulars of what will appear on the front page of a patent application publication.

Comment 54: Several comments suggested that the Office provide a ''transitional publication arrangement'' for applications that are due for publication shortly after they are filed (due to a claim under 35 U.S.C. 120). The comment specifically suggested that applicants should be given some period of time (after the filing date) within which to comply with the requirements for publication before the delay in compliance serves as a basis for a reduction in any patent term adjustment.

Response: The notice of proposed rulemaking sets forth with particularity the Office's planning approach to eighteen-month publication. Therefore, the public has been given over seven months of notice of the requirements an application must meet to be in condition for eighteen-month publication. Since any applicant filing an application on or after November 29, 2000, has been given this notice of the requirements an application must meet to be in condition for eighteen-month publication, the Office is not providing a ''transitional publication arrangement.'' The impact that a delay in compliance with the requirements for publication will have on patent term adjustment is set forth in 35 U.S.C. 154(b)(2)(C)(ii) and § 1.704(b).

Comment 55: Several comments suggested that the Office's reliance upon its electronic filing system (EFS) for submission of copies (redacted, as-amended, or for voluntary publication) of an application for publication purposes jeopardizes the optional publication procedures. The comments specifically suggested that: (1) The Office should not mandate the filing of a copy of an application for publication purposes by EFS until the Office has demonstrated that EFS is fully functional; (2) applicants' experience with the Office's pilot EFS program has been plagued with extra costs and information system problems; (3) an EFS submission requirement effectively excludes the small inventor community; and (4) the EFS submission requirement effectively deprives most applicants of the right to seek voluntary publication or publication of an application ''as-amended'' by requiring a copy of the previously filed application to be submitted in a particular filing system.

Response: A key objective of any pilot program is to identify improvements that can or should be made to the program. EFS pilot participant experiences have identified such improvements for the EFS software, and the Office has enhanced EFS based upon such experiences. EFS as enhanced will permit applicants to create a copy of the patent application text in a familiar word processing environment with minimal effort. The accuracy and speed resulting from the improvements to the authoring tool (word processing software for creating tagged patent application specification text), and the EFS desktop software (used for the submission of a copy of an application via EFS), will facilitate the timely and efficient publication of applications.

Examples of improvements to be implemented by November of 2000 in the next release of the Patent Application Specification Authoring Tool (PASAT) are: (1) An enhanced Office Assistant function including capability to enable or disable the help option; (2) the addition of keyboard short cuts to facilitate authoring; (3) enhanced editing capabilities to be available, for example, inserting special characters during a ''paste text'' process; (4) the capability to copy and paste tables from an existing word processing document; and (5) an enhanced authoring tool that will support Microsoft Windows 2000 and Word 2000 software.

The Office also plans to have the following improvements in the desktop software (electronic Packaging and Validation Engine (ePAVE)) in place by the fall of 2000: (1) A feature permitting applicants to enter free-form text

(comments) as part of the electronic filing transmittal; (2) providing for the entry of the application information for the application data sheet (§ 1.76); and (3) preview and printing of patent application information before submission.

These new features will be fully tested as part of the software quality assurance component of the Office's system development process for managing software development and deployment. Thus, EFS will be sufficiently enhanced by the fall of 2000 to be relied upon for submission of a copy of an application to the Office under the optional publication provisions of §§ 1.215, 1.217, and 1.221.

Finally, the Office has also conducted a number of workshops concerning its Patent Electronic Business Center (which include filings under EFS) through the Patent and Trademark Depository Libraries (PTDLs). These workshops include a portion specifically directed at independent inventors.

Comment 56: One comment suggested that the Office permit applicants to file paper copies of applications for publication and charge a fee to recover the cost of converting the application into an electronic format.

Response: The suggested approach is impractical in view of the current nature of the Office's budget. The Office cannot spend the fees it collects absent authority from Congress to do so. Recently, Congress has not authorized the Office to spend all of the fees it collects; rather, Congress has authorized the Office to spend up to only a certain amount of the fees it collects and diverted the remaining fees to other programs. Thus, even if the Office collects the suggested fee (ostensibly to recover the Office's cost of converting the application into an electronic format), such fees would likely be diverted from the Office leaving the Office with no funding to actually recover the Office's cost of converting the application into an electronic format.

Comment 57: One comment questioned how color drawings, which are still permitted to be filed on paper and are not permitted by EFS, can be submitted via EFS.

Response: Patent application publications will not contain color drawings (if an application is filed with color drawings, the patent application publication will include only a black-and-white copy of the color drawings). Therefore, it is unnecessary to provide for color drawings to be submitted by EFS for publication purposes.

Comment 58: One comment questioned how a continued prosecution application (CPA) under § 1.53(d) would be published as a patent application publication, and suggested that the Office use the claims as filed in a CPA as they existed at the termination of prosecution (in the prior application) as the basis for the patent application publication due to the provisional rights requirements of 35 U.S.C. 154(d).

Response: The Office has amended § 1.53(d)(1)(i) to provide that the prior application of a CPA (utility or plant) must have been filed prior to May 29, 2000. *See* Changes to Application Examination and Provisional Application Practice, Interim Rule, 65 FR 14865, 14872 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office 47 (Apr. 11, 2000). This should cause CPA practice (in utility or plant applications) to phase out and limit the instances in which the Office must publish a CPA. The Office plans to create a patent application publication for a CPA under § 1.53(d) using its PACR database or microfilm records. Thus, a patent application publication for a CPA will reflect the prior application (the application originally assigned the application number assigned to the CPA) as filed. For this reason, any applicant filing a CPA under § 1.53(d) on or after November 29, 2000, is advised to also file a copy of the application-as-amended for publication purposes to take full advantage of provisional rights under 35 U.S.C. 154(d).

Comment 59: One comment suggested that the Office clarify the ''separate paper'' requirement for assignee information to be printed on the patent application publication (*e.g.,* whether it can be included on a transmittal letter, whether a separate paper is required for each item of information). Another comment suggested that since it will benefit the public to have assignee information included on the patent application publication, the Office should provide a convenient manner of submitting assignee information for inclusion on the patent application publication. Another comment suggested that the Office set forth a form or format to avoid confusion over the requirements for submitting assignee information for inclusion on the patent application publication.

Response: Section 1.76 has been revised to provide for the inclusion of assignee information on the application data sheet. *See* § 1.76(b)(7). Assignee information is the name (either person or juristic entity) and address of the assignee of the entire right, title, and interest in an application. Section 1.215(b) has been revised to provide that if the applicant wants the patent application publication to include assignee information, the applicant must include the assignee information on the application transmittal sheet or the application data sheet (§ 1.76).

Comment 60: One comment suggested that the Office print the assignment information contained in its assignment records on patent application publications, rather than relying upon or expecting applicants to provide this information on a separate paper.

Response: The Office does not require that appropriate assignee information be printed on a patent and does not plan to require that appropriate assignee information be printed on a patent application publication. Therefore, the Office plans to simply print such assignee information as is provided by an applicant, rather than automatically include assignee information from its assignment records on a patent application publication.

Comment 61: One comment suggested that applicants should receive confirmation of a nonpublication request on the filing receipt. The comment also suggested that if the publication date is changed at all (and not just by more than two weeks), the applicants should be notified of the new publication date.

Response: If a nonpublication request is filed with an application, the filing receipt for the application will indicate ''No Publication'' to confirm receipt of the nonpublication request to the applicant. If the application has not yet entered the fourteen-week publication cycle, the applicant will be notified of any changes in the publication date. If the application has entered the fourteen-week publication cycle, the applicant will only be notified of changes in the publication date if the publication date is changed by more than two weeks.

Comment 62: One comment suggested that the Office should place paper copies of patent application publications in the Public Search Room and in the examiners' search rooms.

Response: The Office has considered placing paper copies of patent application publications in the Public Search Room and in the examiners' search rooms. The Office, however, is migrating to a fully electronic search and the investment necessary to create and maintain both electronic and paper collections of patent application publications is not feasible.

Comment 63: One comment suggested that the Office should place its weekly volumes of patent application publications on its Internet Web site so that they are as readily available as issued U.S. patents.

Response: The Office plans to place its weekly volumes of patent application publications (both image and text-searchable) on its Internet Web site.

Comment 64: A number of comments opposed the publication of only a redacted copy of an application (rather than the entire application). One comment questioned whether a redacted copy of an application satisfied the ''actual notice'' requirement of 35 U.S.C. 154(d).

Response: The filing of a redacted copy of an application for publication is provided for in 35 U.S.C. 122(b)(2)(B)(v). Whether publication of a redacted copy of an application will satisfy the provisional rights requirements of 35 U.S.C. 154(d) will depend upon the particulars of the situations. Any applicant seeking provisional rights requirements of 35 U.S.C. 154(d) but planning to file a redacted copy of an application for publication should carefully consider the provisions of the last sentence of 35 U.S.C. 122(b)(2)(B)(v).

Comment 65: Several comments suggested that the requirements (*e.g.,* use of EFS, multiple copies of submissions and Office actions, bracketed copy of application showing redactions, and copies and translations of foreign applications) for a redacted copy of an application for publication, are so onerous they frustrate the purpose of the statute. The comments suggested that the Office should not require that a redacted copy of an application submitted for publication purposes be filed by EFS. One comment also suggested that the Office should treat applications for which a redacted copy is submitted for publication the same as other applications.

Response: The Office is requiring a copy of the application showing redactions in brackets and copies and translations of foreign counterpart applications so that the applicant will compare the application as redacted to the foreign counterpart applications to ensure that any redaction is appropriate. This will help to avoid the situation in which an applicant inadvertently redacts material that was in fact contained in a foreign counterpart application. The Office requires multiple copies of submissions and Office actions so that the Office will have an appropriately redacted copy of the application that can be provided when the Office needs to provide a member of the public with such a copy. The Office requires EFS submission of a redacted copy of an application for publication because the Office must have the copy submitted via the most efficient means available (EFS) since the application will already be in the publication cycle by sixteen months from the earliest priority date. The Office does not treat applications for which a redacted copy is submitted for publication in the same manner as other applications because the filing of a redacted copy of an application for publication (unlike other applications) places a significant burden on the Office.

Comment 66: One comment suggested that it was not clear how to indicate the portion of the redacted contents of an application for which a redacted copy is submitted for publication.

Response: The redacted copy of the application being submitted for publication should simply not include the portions that have been redacted. The ''marked up'' copy of the application showing the redaction that is submitted for the application file should show the portions that have been redacted in brackets.

Comment 67: One comment suggested that since maintaining the file of an application for which a redacted copy of the application was submitted for publication in a partially published/partially unpublished condition requires exception handling, these applicants should be charged a significant fee ($500) and not just the $130 processing fee set forth in § 1.17(i).

Response: As indicated above, filing a redacted copy of an application for publication and maintaining a set of redacted papers in the application does place a significant burden on the Office. The $130 processing fee set forth in § 1.17(i), which must accompany each submission under § 1.17(d)(1) or § 1.17(d)(2) (§ 1.17(d)(3)) is considered an appropriate fee for this special handling.

Comment 68: One comment suggested that the certificate of mailing provisions of § 1.8 should apply to the filing of materials relating to submission of a redacted copy of an application for publication (§ 1.217).

Response: Since the redacted copy of an application for publication must be submitted via EFS (and not via the mail), the certificate of mailing practice set forth in § 1.8 is inapplicable to the submission of a redacted copy of an application for publication. In view of the significant burden that filing a redacted copy of an application for publication places on the Office, the Office considers it appropriate to require such an applicant to provide the Office with the document necessary for processing the application by means that ensure that such documents are promptly received in the Office.

Comment 69: One comment suggested that the Office should provide an opportunity to correct a defective EFS publication submission for voluntary publication or republication of an application, rather than simply refunding the publication fee and not publishing the application as provided in § 1.221.

Response: The Office plans to treat a defective EFS publication submission by attempting to contact the submitter (by telephone) to obtain correction of the submission (with a new submission that is correct). The provision in § 1.221 concerning the refunding of the publication fee and not publishing the application will apply in those situations in which the Office's attempts to contact the submitter or obtain correction of the EFS submission are unsuccessful.

Comment 70: One comment suggested that the Office provide a box other than ''Box PCT'' in § 1.417 for receipt of an international publication or copy of an English-language translation of an international application under 35 U.S.C. 154(d)(4) to avoid the commingling of these papers with other PCT submissions.

Response: The Office does not consider a separate box (other than ''Box PCT'') for copies of an international publication or copies of an English language translation of an international application under 35 U.S.C. 154(d)(4) to be necessary. The Office will create such a separate box in the event that a separate box for copies of an international publication or copy of an English language translation of an international application under 35 U.S.C. 154(d)(4) proves to be necessary.

Comment 71: One comment suggested that the Office draft a rule stating what fact situation must exist for an international application to have provisional rights protection in the United States (noting PCT Article 29(2)).

Response: The Office is not charged with administering provisional rights under 35 U.S.C. 154(d) and the enforcement of provisional rights will not be via a proceeding in the Office. Therefore, the Office is not promulgating regulations concerning what situation must exist for any type of application to have provisional rights protection. *See* 35 U.S.C. 2(b)(2)(A).

Comment 72: Several comments suggested that the Office clarify the following issues concerning the treatment of sequence listings: (1) the latest date on which a sequence listing must be submitted to avoid a delay in the transfer of an application to the Technology Centers (and without reduction of any patent term

adjustment); (2) whether applications containing sequence listings that do not comply with § 1.821 *et seq.* will be forwarded to the Technology Centers for substantive examination (or which requirements of § 1.821 *et seq.* must be complied with before the application is forwarded to the Technology Centers for substantive examination); (3) whether non-compliance with the sequence listing requirements of § 1.821 *et seq.* will be treated as strictly as non-compliance with the drawings requirements of § 1.84 (and, if so, what changes will be implemented to reduce complications associated with the use of sequence listing authoring and submission software); and (4) precisely how an applicant is to make a reference to a previously filed sequence listing.

Response: An application will not be transferred to the Technology Centers until it contains a sequence listing (if required) that complies with § 1.821 *et seq.* The impact that a delay in filing a sequence listing (if required) that complies with § 1.821 *et seq.* will have on patent term adjustment is set forth in 35 U.S.C. 154(b)(2)(C)(ii) and § 1.704(b).

Sequence submission software for creating sequence listings is available for download, and is available to make it easier to comply. Applicants are not required to use this software, and need not do so if they feel it does not meet their needs. Applicants are only required to follow the format outlined in § 1.821 *et seq.* Applicants may also obtain the ''checker'' software to check their submissions prior to sending them to the Office to reduce the chance of errors. This ''checker'' software is also available for download.

As discussed above, rather than permit an EFS copy of an application being submitted to the Office for eighteen-month publication purposes to simply contain a reference to a previously filed sequence listing, the Office is requiring that the EFS copy contain a text file copy of the sequence listing.

Classification

Administrative Procedure Act

The changes to §§ 1.19, 1.76 and 1.103 were not included in the Notice of Proposed Rulemaking. The change to § 1.19 merely sets forth the fees for copies of patent application publications, the change to § 1.76 merely provides that assignee information may be included on the application data sheet, and the change to § 1.103 merely sets forth the conditions under which the Office will defer examination of an application. Therefore, these changes concern only rules of Office procedure, and prior notice and an opportunity for public comment for these changes is not required pursuant to 5 U.S.C. 553(b)(A), or any other law.

Regulatory Flexibility Act

The Chief Counsel for Regulation of the Department of Commerce certified to the Chief Counsel for Advocacy, Small Business Administration, that the changes in this final rule do not have a significant impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)). This final rule implements the eighteen-month publication provisions of §§ 4501 through 4508 of the American Inventors Protection Act of 1999. The changes in this final rule provide procedures for the eighteen-month publication of patent applications.

An applicant may file a nonpublication request (opt-out of eighteen-month publication) if 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 eighteen-month publication. Since almost all small entities file patent applications only in the United States, almost all small entities can choose whether they want their applications to be subject to eighteen-month publication. The Office receives roughly 60,000 applications each year from small entities. Based upon input from small entity groups during the legislative process, the Office expects that small entities will file a nonpublication request for roughly 30,000 applications (fifty percent) with the remaining 30,000 applications being subject to eighteen-month publication. Since the current application allowance rate is roughly sixty-seven percent, roughly 20,000 applications subject to eighteen-month publication will be allowed, at which time a publication fee ($300) will be due. Since the publication fee is less than one-third of the combined cost of the application filing fee ($345) and patent issue fee ($605), there will not be a significant economic impact on a substantial number of small entities due to eighteen-month publication.

Executive Order 13132

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

Paperwork Reduction Act

This final rule involves information collection requirements that 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 OMB control numbers: 0651–0021, 0651–0027, 0651–0031, 0651–0032, 0651–0033, and 0651–0034.

As required by the Paperwork Reduction Act of 1995 (44 U.S.C. 3507(d)), the United States Patent and Trademark Office submitted an information collection package to OMB for its review and approval of the information collections under OMB control number 0651–0031 and 0651–0032. The United States Patent and Trademark Office is submitting these information collections to OMB for its review and approval because this final rule adds the nonpublication request, rescission of the nonpublication request, electronic filing system copy of the application (for publication purposes), copy of the application file content showing redactions, and petition to accept a delayed priority claim to these collections.

As discussed above, this final rule also involves currently approved information collections under OMB control numbers: 0651–0021, 0651–0027, 0651–0033, and 0651–0034. The United States Patent and Trademark Office is not resubmitting those information collection packages to OMB for its review and approval because the changes in this final rule do not affect the information collection requirements associated with the information collections under those OMB control numbers.

The title, description and respondent description of each of the information collections are shown below with an estimate of each of the annual reporting burdens. Included in each estimate is the time for reviewing instructions, gathering and maintaining the data needed, and completing and reviewing the collection of information.

OMB Number: 0651–0021.

Title: Patent Cooperation Treaty.

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

Type of Review: Approved through September of 2000.

Affected Public: Individuals or households, business or Other for-profit

institutions, Federal Agencies or Employees, not-for-profit institutions, small businesses or organizations.

Estimated Number of Respondents: 102,950.

Estimated Time Per Response: 0.9538 hour.

Estimated Total Annual Burden Hours: 98,195 hours.

Needs and Uses: The information collected is required by the Patent Cooperation Treaty (PCT). The general purpose of the PCT is to simplify the filing of patent applications on the same invention in different countries. It provides for a centralized filing procedure and a standardized application format.

OMB Number: 0651–0027.

Title: Changes in Patent and Trademark Assignment Practices.

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

Type of Review: Approved through May of 2002.

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

Estimated Number of Respondents: 209,040.

Estimated Time Per Response: 0.5 hour.

Estimated Total Annual Burden Hours: 104,520 hours.

Needs and Uses: The Office records about 209,040 assignments or documents related to ownership of patent and trademark cases each year. The Office requires a cover sheet to expedite the processing of these documents and to ensure that they are properly recorded.

OMB Number: 0651–0031.

Title: Patent Processing (Updating).

Form Numbers: PTO/SB/08/21–27/30–31/42/43/61/62/63/64/67/68/91/92/96/97.

Type of Review: Approved through October of 2002.

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

Estimated Number of Respondents: 2,231,365.

Estimated Time Per Response: 0.46 hours.

Estimated Total Annual Burden Hours: 1,018,736 hours.

Needs and Uses: During the processing of an application for a patent, the applicant/agent may be required or desire to submit additional information to the Office concerning the examination of a specific application. The specific information required or which may be submitted includes: Information Disclosure Statements; Terminal Disclaimers; Petitions to Revive; Express Abandonments; Appeal Notices; Petitions for Access; Powers to Inspect; Certificates of Mailing or Transmission; Statements under § 3.73(b); Amendments, Petitions and their Transmittal Letters; and Deposit Account Order Forms.

OMB Number: 0651–0032.

Title: Initial Patent Application.

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

Type of Review: Approved through October of 2002.

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

Estimated Number of Respondents: 334,100.

Estimated Time Per Response: 8.95 hours.

Estimated Total Annual Burden Hours: 2,990,260 hours.

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

OMB Number: 0651–0033.

Title: Post Allowance and Refiling.

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

Type of Review: Approved through September of 2000.

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

Estimated Number of Respondents: 135,250.

Estimated Time Per Response: 0.325 hour.

Estimated Total Annual Burden Hours: 43,893 hours.

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

OMB Number: 0651–0034.

Title: Secrecy/License to Export.

Form Numbers: None.

Type of Review: Approved through January of 2001.

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

Estimated Number of Respondents: 2,187.

Estimated Time Per Response: 0.67 hour.

Estimated Total Annual Burden Hours: 1,476 hours.

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

The principal impact of the changes in this final rule is to implement the changes to Office practice necessitated by §§ 4501 through 4508 of the American Inventors Protection Act of 1999 (enacted into law by § 1000(a)(9), Division B, of Public Law 106–113).

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, United States Patent and Trademark Office, Washington, D.C. 20231, or to the Office of Information and Regulatory Affairs of OMB, New Executive Office Building, 725 17th Street, N.W., Room 10235, Washington, D.C. 20503, Attention: Desk Officer for the United States Patent and Trademark Office.

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 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 1.9 is amended by revising paragraph (c) to read as follows:

§ 1.9 Definitions.

* * * * *

(c) A published application as used in this chapter means an application for patent which has been published under 35 U.S.C. 122(b).

* * * * *

3. Section 1.11 is amended by revising paragraph (a) to read as follows:

§ 1.11 Files open to the public.

(a) The specification, drawings, and all papers relating to the file of an abandoned published application, except if a redacted copy of the application was used for the patent application publication, a patent, or a statutory invention registration are open to inspection by the public, and copies may be obtained upon the payment of the fee set forth in § 1.19(b)(2). See § 2.27 for trademark files.

* * * * *

4. Section 1.12 is amended by revising paragraphs (a)(1) and (b) to read as follows:

§ 1.12 Assignment records open to public inspection.

(a)(1) Separate assignment records are maintained in the United States Patent and Trademark Office for patents and trademarks. The assignment records, relating to original or reissue patents, including digests and indexes (for assignments recorded on or after May 1, 1957), published patent applications, and assignment records relating to pending or abandoned trademark applications and to trademark registrations (for assignments recorded on or after January 1, 1955), are open to public inspection at the United States Patent and Trademark Office, and copies of those assignment records may be obtained upon request and payment of the fee set forth in § 1.19 and § 2.6 of this chapter.

* * * * *

(b) Assignment records, digests, and indexes relating to any pending or abandoned patent application which has not been published under 35 U.S.C. 122(b) are not available to the public. Copies of any such assignment records and related information shall be obtainable only upon written authority of the applicant or applicant's assignee or attorney or agent or upon a showing that the person seeking such information is a *bona fide* prospective or actual purchaser, mortgagee, or licensee of such application, unless it shall be necessary to the proper conduct of business before the Office or as provided in this part.

* * * * *

5. Section 1.13 is revised to read as follows:

§ 1.13 Copies and certified copies.

(a) Non-certified copies of patents, patent application publications, and trademark registrations and of any records, books, papers, or drawings within the jurisdiction of the United States Patent and Trademark Office and open to the public, will be furnished by the United States Patent and Trademark Office to any person, and copies of other records or papers will be furnished to persons entitled thereto, upon payment of the appropriate fee.

(b) Certified copies of patents, patent application publications, and trademark registrations and of any records, books, papers, or drawings within the jurisdiction of the United States Patent and Trademark Office and open to the public or persons entitled thereto will be authenticated by the seal of the United States Patent and Trademark Office and certified by the Commissioner, or in his or her name attested by an officer of the United States Patent and Trademark Office authorized by the Commissioner, upon payment of the fee for the certified copy.

6. Section § 1.14 is amended by revising paragraphs (a), (b), (c), (e), (i) and (j) to read as follows:

• 1.14 Patent applications preserved in confidence.

(a) *Confidentiality of patent application information.* Patent applications that have not been published under 35 U.S.C. 122(b) are generally preserved in confidence pursuant to 35 U.S.C. 122(a). Information concerning the filing, pendency, or subject matter of an application for patent, including status information, and access to the application, will only be given to the public as set forth in § 1.11 or in this section.

(1) *Status information* is:

(i) Whether the application is pending, abandoned, or patented;

(ii) Whether the application has been published under 35 U.S.C. 122(b); and

(iii) The application ''numerical identifier'' which may be:

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

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

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

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

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

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

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

(4) The application claims the benefit of the filing date of an application for which status information may be provided pursuant to paragraphs (b)(1) through (b)(3) of this section.

(c) *When copies may be supplied.* A copy of an application-as-filed or a file wrapper and contents may be supplied by the Office to the public[, subject to paragraph (i) of this section (which addresses international applications),] if any of the following apply:

(1) *Application-as-filed.*

(i) If a U.S. patent application publication or patent incorporates by reference, or includes a specific reference under 35 U.S.C. 119(e) or 120 to, a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request including the fee set forth in § 1.19(b)(1); or

(ii) If an international application, which designates the U.S. and which has been published in accordance with PCT Article 21(2), incorporates by

reference or claims priority under PCT Article 8 to a pending or abandoned U.S. application, a copy of that application-as-filed may be provided to any person upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate fee set forth in § 1.19(b)(1).

(2) *File wrapper and contents.* A copy of the specification, drawings, and all papers relating to the file of an abandoned or pending published application may be provided to any person upon written request, including the fee set forth in § 1.19(b)(2). If a redacted copy of the application was used for the patent application publication, the copy of the specification, drawings, and papers may be limited to a redacted copy.

* * * * *

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

(1) The application is open to public inspection pursuant to § 1.11(b); or

(2) The application is abandoned, it is not within the file jacket of a pending application under § 1.53(d), and it is referred to:

(i) In a U.S. patent application publication or patent;

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

(iii) In an international application which designates the U.S. and is published in accordance with PCT Article 21(2).

* * * * *

(i) *International applications.*

(1) Copies of international application files for international applications which designate the U.S. and which have been published in accordance with PCT Article 21(2), or copies of a document in such application files, will be furnished in accordance with PCT Articles 30 and 38 and PCT Rules 94.2 and 94.3, upon written request including a showing that the publication of the application has occurred and that the U.S. was designated, and upon payment of the appropriate fee (see § 1.19(b)(2) or 1.19(b)(3)), if:

(i) With respect to the Home Copy, the international application was filed with the U.S. Receiving Office;

(ii) With respect to the Search Copy, the U.S. acted as the International Searching Authority; or

(iii) With respect to the Examination Copy, the United States acted as the International Preliminary Examining Authority, an International Preliminary Examination Report has issued, and the United States was elected.

(2) A copy of an English language translation of an international application which has been filed in the United States Patent and Trademark Office pursuant to 35 U.S.C. 154(2)(d)(4) will be furnished upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate fee (§ 1.19(b)(2) or § 1.19(b)(3)).

(3) Access to international application files for international applications which designate the U.S. and which have been published in accordance with PCT Article 21(2), or copies of a document in such application files, will be furnished in accordance with PCT Articles 30 and 38 and PCT Rules 94.2 and 94.3, upon written request including a showing that the publication of the application has occurred and that the U.S. was designated.

(4) In accordance with PCT Article 30, copies of an international application-as-filed under paragraph (c)(1) of this section will not be provided prior to the international publication of the application pursuant to PCT Article 21(2).

(5) Access to international application files under paragraphs (e) and (i)(3) of this section will not be permitted with respect to the Examination Copy in accordance with PCT Article 38.

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

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

(2) A showing that access to the application is necessary to carry out an Act of Congress or that special circumstances exist which warrant petitioner being granted access to all or part of the application.

7. Section 1.17 is amended by revising the section heading and paragraphs (h), (i), (l), (m) and (p) and adding paragraph (t) to read as follows:

§ 1.17 Patent application and reexamination processing fees.

* * * * *

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

§ 1.12—for access to an assignment record.

§ 1.14—for access to an application.

§ 1.47—for filing by other than all the inventors or a person not the inventor.

§ 1.53(e)—to accord a filing date.

§ 1.59—for expungement and return of information.

§ 1.84—for accepting color drawings or photographs.

§ 1.91—for entry of a model or exhibit.

§ 1.102—to make an application special.

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

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

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

§ 1.183—to suspend the rules.

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

§ 1.313—to withdraw an application from issue.

§ 1.314—to defer issuance of a patent.

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

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

§ 1.644(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.

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

§ 5.15—for changing the scope of a license.

§ 5.25—for retroactive license.

(i) Processing fee for taking action under 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.

§ 1.217—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.

§ 1.497(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 terminated reexamination proceeding 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 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 terminated reexamination proceeding under 35 U.S.C. 41(a)(7) (§ 1.137(b)):

By a small entity (§ 1.27(a)): $620.00.
By other than a small entity: $1,240.00.

* * * * *

(p) For an information disclosure statement under § 1.97(c) or (d) or a submission under § 1.99: $180.00.

* * * * *

(t) For the acceptance of an unintentionally delayed claim for priority under 35 U.S.C. 119, 120, 121, or 365(a) or (c) (§§ 1.55 and 1.78): $1,240.00.

8. Section 1.18 is amended by adding paragraph (d) to read as follows:

§ 1.18 Patent post-allowance (including issue) fees.

* * * * *

Publication fee	$300.00.

* * * * *

9. Section 1.19 is amended by revising paragraph (a) to read as follows:

§ 1.19 Document supply fees.

* * * * *

(a) Uncertified copies of patent application publications and patents:

(1) Printed copy of the paper portion of a patent application publication or patent, including a design patent, statutory invention registration, or defensive publication document:	
(i) Regular service, which includes preparation of copies by the Office within two to three business days and delivery by United States Postal Service or to an Office Box; and preparation of copies by the Office within one business day of receipt and delivery by electronic means (*e.g.,* facsimile, electronic mail)	$3.00.
(ii) Next business day delivery to Office Box	$6.00.
(iii) Expedited delivery by commercial delivery service	$25.00.
(2) Printed copy of a plant patent in color:	$15.00.
(3) Color copy of a patent (other than a plant patent) or statutory invention registration containing a color drawing	$25.00.

* * * * *

10. Section 1.24 is removed and reserved.

§ 1.24 [Removed and Reserved]

11. Section 1.52 is amended by revising paragraph (d) to read as follows:

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

* * * * *

(d) A nonprovisional or provisional application may be filed in a language other than English.

(1) *Nonprovisional application.* If a nonprovisional application is filed in a language other than English, an English language translation of the non-English language application, a statement that the translation is accurate, and the processing fee set forth in § 1.17(i) are required. If these items are not filed with the application, applicant will be notified and given a period of time within which they must be filed in order to avoid abandonment.

(2) *Provisional application.* If a provisional application is filed in a language other than English, an English language translation of the non-English language provisional application will not be required in the provisional application. See § 1.78(a) for the requirements for claiming the benefit of such provisional application in a nonprovisional application.

* * * * *

12. Section 1.55 is amended by revising paragraph (a) and adding paragraph (c) to read as follows:

§ 1.55 Claim for foreign priority.

(a) An applicant in a nonprovisional application may claim the benefit of the filing date of one or more prior foreign applications under the conditions specified in 35 U.S.C. 119(a) through (d), 172, and 365(a).

(1)(i) In an original application filed under 35 U.S.C. 111(a), the claim for priority must be presented during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. This time period is not extendable. The claim must identify the foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. The time period in this paragraph does not apply to an application for a design patent.

(ii) In an application that entered the national stage from an international application after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT.

(2) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed before the patent is granted. If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by the processing fee set forth in § 1.17(i), but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323.

(3) When the application becomes involved in an interference (§ 1.630), when necessary to overcome the date of

a reference relied upon by the examiner, or when deemed necessary by the examiner, the Office may require that the claim for priority and the certified copy of the foreign application be filed earlier than provided in paragraphs (a)(1) or (a)(2) of this section.

(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.

* * * * *

(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) or 365(a) 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) or 365(a) 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) or 365(a) must be accompanied by:

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

(2) 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 Commissioner may require additional information where there is a question whether the delay was unintentional.

13. Section 1.72 is amended by revising paragraph (a) to read as follows:

§ 1.72 Title and abstract.

(a) The title of the invention may not exceed 500 characters in length and must be as short and specific as possible. Characters that cannot be captured and recorded in the Office's automated information systems may not be reflected in the Office's records in such systems or in documents created by the Office. Unless the title is supplied in an application data sheet (§ 1.76), the title of the invention should appear as a heading on the first page of the specification.

* * * * *

14. Section 1.76 is amended by adding a new paragraph (b)(7) to read as follows:

§ 1.76 Application data sheet.

* * * * *

(b) * * *

(7) *Assignee information.* This information includes the name (either person or juristic entity) and address of the assignee of the entire right, title, and interest in an application. Providing this information in the application data sheet does not substitute for compliance with any requirement of part 3 of this chapter to have an assignment recorded by the Office.

* * * * *

15. Section 1.78 is amended by revising paragraphs (a)(2), (a)(3), and (a)(4), and adding new paragraphs (a)(5) and (a)(6) to read as follows:

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

(a)(1) * * *

(2) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application claiming the benefit of one or more prior filed copending nonprovisional applications or international applications designating the United States of America must contain a reference to each such prior application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. This reference must be submitted during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. This time period is not extendable. Unless the reference required by this paragraph is included in an application data sheet (§ 1.76), the specification must contain or be amended to contain such reference in the first sentence following the title. If the application claims the benefit of an international application, the first sentence of the specification must include an indication of whether the international application was published under PCT Article 21(2) in English (regardless of whether benefit for such application is claimed in the application data sheet). The request for a continued prosecution application under § 1.53(d) is the specific reference required by 35 U.S.C. 120 to the prior application. The identification of an application by application number under this section is the specific reference required by 35 U.S.C. 120 to every application assigned that application number. Cross references to other related applications may be made when appropriate (see § 1.14). Except as provided in paragraph (a)(3) of this section, the failure to timely submit the reference required by 35 U.S.C. 120 and this paragraph is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to such prior application. The time period set forth in this paragraph does not apply to an application for a design patent.

(3) If the reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section is presented in a nonprovisional application after the time period provided by paragraph (a)(2) of this section, the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior filed copending nonprovisional application or international application designating the United States of America may be accepted if the reference identifying the prior application by application number or international application number and international filing date was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior filed application must be accompanied by:

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

(ii) A statement that the entire delay between the date the claim was due under paragraph (a)(2) of this section and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

(4) A nonprovisional application other than for a design patent may claim an invention disclosed in one or more prior filed provisional applications. In order for a nonprovisional application to claim the benefit of one or more prior filed provisional applications, each prior provisional application must name as an inventor at least one inventor named in the later filed nonprovisional application and disclose the named inventor's invention claimed in at least one claim of the later filed nonprovisional application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior provisional application must be entitled to a filing date as set forth in § 1.53(c), and the basic filing fee set forth in § 1.16(k) must be paid within the time period set forth in § 1.53(g).

(5) Any nonprovisional application claiming the benefit of one or more prior filed copending provisional applications must contain a reference to each such prior provisional application, identifying it as a provisional

application, and including the provisional application number (consisting of series code and serial number), and, if the provisional application is filed in a language other than English, an English language translation of the non-English language provisional application and a statement that the translation is accurate. This reference and English language translation of a non-English language provisional application must be submitted during the pendency of the nonprovisional application, and within the later of four months from the actual filing date of the nonprovisional application or sixteen months from the filing date of the prior provisional application. This time period is not extendable. Unless the reference required by this paragraph is included in an application data sheet (§ 1.76), the specification must contain or be amended to contain such reference in the first sentence following the title. Except as provided in paragraph (a)(6) of this section, the failure to timely submit the reference and English language translation of a non-English language provisional application required by 35 U.S.C. 119(e) and this paragraph is considered a waiver of any benefit under 35 U.S.C. 119(e) to such prior provisional application.

(6) If the reference or English language translation of a non-English language provisional application required by 35 U.S.C. 119(e) and paragraph (a)(5) of this section is presented in a nonprovisional application after the time period provided by paragraph (a)(5) of this section, the claim under 35 U.S.C. 119(e) for the benefit of a prior filed provisional application may be accepted during the pendency of the nonprovisional application if the reference identifying the prior application by provisional application number and any English language translation of a non-English language provisional application were unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 119(e) for the benefit of a prior filed provisional application must be accompanied by:

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

(ii) A statement that the entire delay between the date the claim was due under paragraph (a)(5) of this section and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

* * * * *

16. Section 1.84 is amended by revising paragraphs (a)(2), (e), and (j) to read as follows:

§ 1.84 Standards for drawings.

(a) * * *

(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;

(iii) A black and white photocopy that accurately depicts, to the extent possible, the subject matter shown in the color drawing; and

(iv) 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.

* * * * *

(e) *Type of paper.* Drawings submitted to the Office must be made on paper which is flexible, strong, white, smooth, non-shiny, and durable. All sheets must be reasonably free from cracks, creases, and folds. Only one side of the sheet may be used for the drawing. Each sheet must be reasonably free from erasures and must be free from alterations, overwritings, and interlineations. Photographs must be developed on paper meeting the sheet-size requirements of paragraph (f) of this section and the margin requirements of paragraph (g) of this section. See paragraph (b) of this section for other requirements for photographs.

* * * * *

(j) *Front page view.* The drawing must contain as many views as necessary to show the invention. One of the views should be suitable for inclusion on the front page of the patent application publication and patent as the illustration of the invention. Views must not be connected by projection lines and must not contain center lines. Applicant may suggest a single view (by figure number) for inclusion on the front page of the patent application publication and patent.

* * * * *

17. Section 1.85 is amended by revising paragraph (a) to read as follows:

§ 1.85 Corrections to drawings.

(a) A utility or plant application will not be placed on the files for examination until objections to the drawings have been corrected. Except as provided in § 1.215(c), any patent application publication will not include drawings filed after the application has been placed on the files for examination. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a *bona fide* attempt to advance the application to final action (§ 1.135(c)). If a drawing in a design application meets the requirements of § 1.84(e), (f), and (g) and is suitable for reproduction, but is not otherwise in compliance with § 1.84, the drawing may be admitted for examination.

* * * * *

18. Section 1.98 is amended by revising paragraphs (a)(2) and (b) to read as follows:

§ 1.98 Content of information disclosure statement.

(a) * * *

(2) A legible copy of:

(i) Each U.S. patent application publication and U.S. and foreign patent;

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

(iii) For each cited pending U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and

(iv) All other information or that portion which caused it to be listed; and

* * * * *

(b)(1) Each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date.

(2) Each U.S. patent application publication listed in an information disclosure statement shall be identified

by applicant, patent application publication number, and publication date.

(3) Each U.S. application listed in an information disclosure statement must be identified by the inventor, application number, and filing date.

(4) Each foreign patent or published foreign patent application listed in an information disclosure statement must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application.

(5) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.

* * * * *

19. A new § 1.99 is added to read as follows:

§ 1.99 Third-party submission in published application.

(a) A submission by a member of the public of patents or publications relevant to a pending published application may be entered in the application file if the submission complies with the requirements of this section and the application is still pending when the submission and application file are brought before the examiner.

(b) A submission under this section must identify the application to which it is directed by application number and include:

(1) The fee set forth in § 1.17(p);

(2) A list of the patents or publications submitted for consideration by the Office, including the date of publication of each patent or publication;

(3) A copy of each listed patent or publication in written form or at least the pertinent portions; and

(4) An English language translation of all the necessary and pertinent parts of any non-English language patent or publication in written form relied upon.

(c) The submission under this section must be served upon the applicant in accordance with § 1.248.

(d) A submission under this section shall not include any explanation of the patents or publications, or any other information. The Office will dispose of such explanation or information if included in a submission under this section. A submission under this section is also limited to ten total patents or publications.

(e) A submission under this section must be filed within two months from the date of publication of the application (§ 1.215(a)) or prior to the mailing of a notice of allowance (§ 1.311), whichever is earlier. Any submission under this section not filed within this period is permitted only when the patents or publications could not have been submitted to the Office earlier, and must also be accompanied by the processing fee set forth in § 1.17(i). A submission by a member of the public to a pending published application that does not comply with the requirements of this section will be returned or discarded.

(f) A member of the public may include a self-addressed postcard with a submission to receive an acknowledgment by the Office that the submission has been received. A member of the public filing a submission under this section will not receive any communications from the Office relating to the submission other than the return of a self-addressed postcard. In the absence of a request by the Office, an applicant has no duty to, and need not, reply to a submission under this section. No further submission on behalf of the member of the public will be considered, unless such submission raises new issues which could not have been earlier presented.

20.Section 1.103 is amended by redesignating paragraphs (d) through (f) as (e) through (g) and adding a new paragraph (d) to read as follows:

§ 1.103 Suspension of action by the Office.

* * * * *

(d) *Deferral of examination.* On request of the applicant, the Office may grant a deferral of examination under the conditions specified in this paragraph for a period not extending beyond three years from the earliest filing date for which a benefit is claimed under title 35, United States Code. A request for deferral of examination under this paragraph must include the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i). A request for deferral of examination under this paragraph will not be granted unless:

(1) The application is an original utility or plant application filed under § 1.53(b) or resulting from entry of an international application into the national stage after compliance with § 1.494 or § 1.495;

(2) The applicant has not filed a nonpublication request under § 1.213(a), or has filed a request under § 1.213(b) to rescind a previously filed nonpublication request;

(3) The application is in condition for publication as provided in § 1.211(c); and

(4) The Office has not issued either an Office action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151.

* * * * *

21. Section 1.104 is amended by removing paragraph (a)(5) and revising paragraph (d)(1) to read as follows:

§ 1.104 Nature of Examination.

* * * * *

(d) *Citation of references.*

(1) If domestic patents are cited by the examiner, their numbers and dates, and the names of the patentees will be stated. If domestic patent application publications are cited by the examiner, their publication number, publication date, and the names of the applicants will be stated. If foreign published applications or patents are cited, their nationality or country, numbers and dates, and the names of the patentees will be stated, and such other data will be furnished as may be necessary to enable the applicant, or in the case of a reexamination proceeding, the patent owner, to identify the published applications or patents cited. In citing foreign published applications or patents, in case only a part of the document is involved, the particular pages and sheets containing the parts relied upon will be identified. If printed publications are cited, the author (if any), title, date, pages or plates, and place of publication, or place where a copy can be found, will be given.

* * * * *

22. Section 1.130 is amended by revising the section heading and paragraph (a) to read as follows:

§ 1.130 Affidavit or declaration to disqualify commonly owned patent or published application as prior art.

(a) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 103 on a U.S. patent or U.S. patent application publication which is not prior art under 35 U.S.C. 102(b), and the inventions defined by the claims in the application or patent under reexamination and by the claims in the patent or published application are not identical but are not patentably distinct, and the inventions are owned by the same party, the applicant or owner of the patent under reexamination may disqualify the patent or patent application publication as prior art. The patent or patent application publication can be disqualified as prior art by submission of:

(1) A terminal disclaimer in accordance with § 1.321(c); and

(2) An oath or declaration stating that the application or patent under reexamination and patent or published application are currently owned by the same party, and that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104.

* * * * *

23. Section 1.131 is amended by revising paragraph (a) to read as follows:

§ 1.131 Affidavit or declaration of prior invention.

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. 102(e). Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. Prior invention may not be established under this section before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a WTO member country other than a NAFTA country. Prior invention may not be established under this section if either:

(1) The rejection is based upon a U.S. patent or U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as defined in § 1.601(n); or

(2) The rejection is based upon a statutory bar.

* * * * *

24. Section 1.132 is revised to read as follows:

§ 1.132 Affidavits or declarations traversing rejections or objections.

When any claim of an application or a patent under reexamination is rejected or objected to, any evidence submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under this section.

25. Section 1.137 is revised to read as follows:

§ 1.137 Revival of abandoned application, terminated reexamination proceeding, 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 proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

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

(3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and

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

(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 proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

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

(c) *Reply.* In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(d) *Terminal disclaimer.* (1) Any petition to revive pursuant to this section in a design application must be accompanied by a terminal disclaimer and fee as set forth in § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application. Any petition to revive pursuant to this section in either a utility or plant application filed before June 8, 1995, must be accompanied by a terminal disclaimer and fee as set forth in § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the lesser of:

(i) The period of abandonment of the application; or

(ii) The period extending beyond twenty years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application(s) under 35 U.S.C. 120, 121, or 365(c), from the date on which the earliest such application was filed.

(2) Any terminal disclaimer pursuant to paragraph (d)(1) of this section must also apply to any patent granted on a continuing utility or plant application filed before June 8, 1995, or a continuing design application, that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to the application for which revival is sought.

(3) The provisions of paragraph (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, or to reexamination proceedings.

(e) *Request for reconsideration.* Any request for reconsideration or review of a decision refusing to revive an abandoned application, a terminated reexamination proceeding, 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 terminated *ex parte* reexamination proceeding filed under § 1.510; or

(3) The provisions of § 1.956 for a terminated *inter partes* reexamination proceeding filed under § 1.913.

(f) *Abandonment for failure to notify the Office of a foreign filing:* A nonprovisional application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to timely notify the Office of the filing of an application in a foreign country or under a multinational treaty that requires publication of applications eighteen months after filing, may be revived only pursuant to paragraph (b) of this section. The reply requirement of paragraph (c) of this section is met by the notification of such filing in a foreign country or under a multinational treaty, but the filing of a petition under this section will not operate to stay any period for reply that may be running against the application.

(g) *Provisional applications.* A provisional application, abandoned for failure to timely respond to an Office requirement, may be revived pursuant to this section. Subject to the provisions of 35 U.S.C. 119(e)(3) and § 1.7(b), a provisional application will not be regarded as pending after twelve months from its filing date under any circumstances.

26.Section 1.138 is amended by revising paragraph (a) and adding paragraph (c) to read as follows:

§ 1.138 Express abandonment.

(a) An application may be expressly abandoned by filing a written declaration of abandonment identifying the application in the United States Patent and Trademark Office. Express abandonment of the application may not be recognized by the Office before the date of issue or publication unless it is actually received by appropriate officials in time to act.

* * * * *

(c) An applicant seeking to abandon an application to avoid publication of the application (see § 1.211(a)(1)) must submit a declaration of express abandonment by way of a petition under this section including the fee set forth in § 1.17(h) in sufficient time to permit the appropriate officials to recognize the abandonment and remove the application from the publication process. Applicant should expect that the petition will not be granted and the application will be published in regular course unless such declaration of express abandonment and petition are received by the appropriate officials more than four weeks prior to the projected date of publication.

27. 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 and a black and white photocopy that accurately depicts, to the extent possible, the subject matter shown in the color drawing or photograph must be submitted.

28. A new, undesignated center heading and new §§ 1.211, 1.213, 1.215, 1.217, 1.219, and 1.221 are added to Subpart B-National Processing Provisions to read as follows:

Publication of Applications

§ 1.211 Publication of applications.

(a) Each U.S. national application for patent filed in the Office under 35 U.S.C. 111(a) and each international application in compliance with 35 U.S.C. 371 will be published promptly 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, unless:

(1) The application is recognized by the Office as no longer pending;

(2) The application is national security classified (see § 5.2(c)), subject to a secrecy order under 35 U.S.C. 181, or under national security review;

(3) The application has issued as a patent in sufficient time to be removed from the publication process; or

(4) The application was filed with a nonpublication request in compliance with § 1.213(a).

(b) Provisional applications under 35 U.S.C. 111(b) shall not be published, and design applications under 35 U.S.C. chapter 16 and reissue applications under 35 U.S.C. chapter 25 shall not be published under this section.

(c) An application filed under 35 U.S.C. 111(a) will not be published until it includes the basic filing fee (§ 1.16(a) or 1.16(g)), any English translation required by § 1.52(d), and an executed oath or declaration under § 1.63. The Office may delay publishing any application until it includes a specification having papers in compliance with § 1.52 and an abstract (§ 1.72(b)), drawings in compliance with § 1.84, and a sequence listing in compliance with §§ 1.821 through 1.825 (if applicable), and until any petition under § 1.47 is granted.

(d) The Office may refuse to publish an application, or to include a portion of an application in the patent application publication (§ 1.215), if publication of the application or portion thereof would violate Federal or state law, or if the application or portion thereof contains offensive or disparaging material.

(e) The publication fee set forth in § 1.18(d) must be paid in each application published under this section before the patent will be granted. If an application is subject to publication under this section, the sum specified in the notice of allowance under § 1.311 will also include the publication fee which must be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable. If the application is not published under this section, the publication fee (if paid) will be refunded.

§ 1.213 Nonpublication request.

(a) 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:

(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 at eighteen months after filing; and

(4) The request is signed in compliance with § 1.33(b).

(b) The applicant may rescind a nonpublication request at any time. 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).

(c) If an applicant who has submitted a nonpublication request under paragraph (a) of this section subsequently 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, the applicant must notify the Office of such filing within forty-five days after the date of the filing of such foreign or

international application. The failure to timely notify the Office of the filing of such foreign or international application shall result in abandonment of the application in which the nonpublication request was submitted (35 U.S.C. 122(b)(2)(B)(iii)).

§ 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, and 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, 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.

(b) If applicant wants the patent application publication to include assignee information, the applicant must include the assignee information on the application transmittal sheet or the application data sheet (§ 1.76). Assignee information may not be included on the patent application publication unless this information is provided on the application transmittal sheet or application data sheet included with the application on filing. Providing this information on the application transmittal sheet or the application data sheet does not substitute for compliance with any requirement of part 3 of this chapter to have an assignment recorded by the Office.

(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 actual filing date of the application or fourteen months of the earliest filing date for which a benefit is sought under title 35, United States Code, whichever is later.

(d) If the copy of the application submitted pursuant to paragraph (c) of this section does not comply with the Office electronic filing system requirements, the Office will publish the application as provided in paragraph (a) of this section. If, however, the Office has not started the publication process, the Office may use an untimely filed copy of the application supplied by the applicant under paragraph (c) of this section in creating the patent application publication.

§ 1.217 Publication of a redacted copy of an application.

(a) If an applicant has filed applications in one or more foreign countries, directly or through a multilateral international agreement, and such foreign-filed applications or the description of the invention in such foreign-filed applications is less extensive than the application or description of the invention in the application filed in the Office, the applicant may submit a redacted copy of the application filed in the Office for publication, eliminating any part or description of the invention that is not also contained in any of the corresponding applications filed in a foreign country. The Office will publish the application as provided in § 1.215(a) unless the applicant files a redacted copy of the application in compliance with this section within sixteen months after the earliest filing date for which a benefit is sought under title 35, United States Code.

(b) The redacted copy of the application must be submitted in compliance with the Office electronic filing system requirements. The title of the invention in the redacted copy of the application must correspond to the title of the application at the time the redacted copy of the application is submitted to the Office. If the redacted copy of the application does not comply with the Office electronic filing system requirements, the Office will publish the application as provided in § 1.215(a).

(c) The applicant must also concurrently submit in paper (§ 1.52(a)) to be filed in the application:

(1) A certified copy of each foreign-filed application that corresponds to the application for which a redacted copy is submitted;

(2) A translation of each such foreign-filed application that is in a language other than English, and a statement that the translation is accurate;

(3) A marked-up copy of the application showing the redactions in brackets; and

(4) A certification that the redacted copy of the application eliminates only the part or description of the invention that is not contained in any application filed in a foreign country, directly or through a multilateral international agreement, that corresponds to the application filed in the Office.

(d) The Office will provide a copy of the complete file wrapper and contents of an application for which a redacted copy was submitted under this section to any person upon written request pursuant to § 1.14(c)(2), unless applicant complies with the requirements of paragraphs (d)(1), (d)(2), and (d)(3) of this section.

(1) Applicant must accompany the submission required by paragraph (c) of this section with the following:

(i) A copy of any Office correspondence previously received by applicant including any desired redactions, and a second copy of all Office correspondence previously received by applicant showing the redacted material in brackets; and

(ii) A copy of each submission previously filed by the applicant including any desired redactions, and a second copy of each submission previously filed by the applicant showing the redacted material in brackets.

(2) In addition to providing the submission required by paragraphs (c) and (d)(1) of this section, applicant must:

(i) Within one month of the date of mailing of any correspondence from the Office, file a copy of such Office correspondence including any desired redactions, and a second copy of such Office correspondence showing the redacted material in brackets; and

(ii) With each submission by the applicant, include a copy of such submission including any desired redactions, and a second copy of such submission showing the redacted material in brackets.

(3) Each submission under paragraph (d)(1) or (d)(2) of this paragraph must also be accompanied by the processing fee set forth in § 1.17(i) and a certification that the redactions are limited to the elimination of material that is relevant only to the part or description of the invention that was not contained in the redacted copy of the application submitted for publication.

(e) The provisions of § 1.8 do not apply to the time periods set forth in this section.

§ 1.219 Early publication.

(a) Applications that will be published under § 1.211 may be published earlier than as set forth in § 1.211(a) at the request of the applicant.

Any request for early publication must be accompanied by the publication fee set forth in § 1.18(d). If the applicant does not submit a copy of the application in compliance with the Office electronic filing system requirements pursuant to § 1.215(c), the Office will publish the application as provided in § 1.215(a). No consideration will be given to requests for publication on a certain date, and such requests will be treated as a request for publication as soon as possible.

§ 1.221 Voluntary publication or republication of patent application publication.

(a) Any request for publication of an application filed before, but pending on, November 29, 2000, and any request for republication of an application previously published under § 1.211, must include a copy of the application in compliance with the Office electronic filing system requirements and be accompanied by the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i). If the request does not comply with the requirements of this paragraph or the copy of the application does not comply with the Office electronic filing system requirements, the Office will not publish the application and will refund the publication fee.

(b) The Office will grant a request for a corrected or revised patent application publication other than as provided in paragraph (a) of this section only when the Office makes a material mistake which is apparent from Office records. Any request for a corrected or revised patent application publication other than as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable.

29.Section 1.291 is amended by revising paragraph (a)(1) to read as follows:

§ 1.291 Protests by the public against pending applications.

(a) * * *

(1) The protest is submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, whichever occurs first; and

* * * * *

30. Section 1.292 is amended by revising paragraph (b)(3) to read as follows:

§ 1.292 Public use proceedings.

* * * * *

(b) * * *

(3) The petition is submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, whichever occurs first.

* * * * *

31. Section 1.311 is revised to read as follows:

§ 1.311 Notice of allowance.

(a) If, on examination, it appears that the applicant is entitled to a patent under the law, a notice of allowance will be sent to the applicant at the correspondence address indicated in § 1.33. The notice of allowance shall specify a sum constituting the issue fee which must be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. The sum specified in the notice of allowance may also include the publication fee, in which case the issue fee and publication fee (§ 1.211(f)) must both be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable.

(b) An authorization to charge the issue 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 to any deposit account identified in a previously filed authorization to charge fees:

(1) An incorrect issue fee; or

(2) A completed Office-provided issue fee transmittal form (where no issue fee has been submitted).

32. A new § 1.417 is added to read as follows:

§ 1.417. Submission of translation of international application.

The submission of the international publication or an English language translation of an international application pursuant to 35 U.S.C. 154(d)(4) must clearly identify the international application to which it pertains (§ 1.5(a)) and, unless it is being submitted pursuant to § 1.494 or § 1.495, be clearly identified as a submission pursuant to 35 U.S.C. 154(d)(4). Otherwise, the submission will be treated as a filing under 35 U.S.C. 111(a). Such submissions should be marked ''Box PCT.''

33. Section 1.494 is amended by revising paragraph (f) to read as follows:

§ 1.494 Entering the national stage in the United States of America as a Designated Office.

* * * * *

(f) The documents and fees submitted under paragraphs (b) and (c) of this section must, except for a copy of the international publication or translation of the international application that is identified as provided in § 1.417, be clearly identified as a submission to enter the national stage under 35 U.S.C. 371. Otherwise, the submission will be considered as being made under 35 U.S.C. 111(a).

* * * * *

34. Section 1.495 is amended by revising paragraph (g) to read as follows:

§ 1.495 Entering the national stage in the United States of America as an Elected Office.

* * * * *

(g) The documents and fees submitted under paragraphs (b) and (c) of this section must, except for a copy of the international publication or translation of the international application that is identified as provided in § 1.417, be clearly identified as a submission to enter the national stage under 35 U.S.C. 371. Otherwise, the submission will be considered as being made under 35 U.S.C. 111(a).

* * * * *

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

35. The authority citation for 37 CFR part 5 is revised 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 Commissioner (15 CFR 370.10(j), 22 CFR 125.04, and 10 CFR 810.7).

36. Section 5.1 is amended by revising paragraph (e) to read as follows:

§ 5.1 Applications and correspondence involving national security.

* * * * *

(e) An application will not be published under § 1.211 of this chapter or allowed under § 1.311 of this chapter if publication or disclosure of the application would be detrimental to national security. An application under national security review will not be published at least until six months from its filing date or three months from the

date the application was referred to a defense agency, whichever is later. A national security classified patent application will not be published under § 1.211 of this chapter or allowed under § 1.311 of this chapter until the application is declassified and any secrecy order under § 5.2(a) has been rescinded.

Dated: September 12, 2000.

Q. Todd Dickinson,

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

[FR Doc. 00–23822 Filed 9–19–00; 8:45 am]

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