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Part II

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**United States Patent and Trademark
Office**

**37 CFR Parts 1, 3, 5, and 10
Changes To Implement the Patent
Business Goals; Final Rule**

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

[Docket No.: 980826226-0202-03]

RIN 0651-AA98

Changes To Implement the Patent Business Goals**AGENCY:** United States Patent and Trademark Office, Commerce.**ACTION:** Final rule.

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

DATES: Effective Dates: This rule is effective November 7, 2000, except that the changes to §§ 1.27, 1.78, 1.131, 1.132, 1.137, 1.152, 1.155, 1.324, 1.366, 1.740, and 1.760, and the removal of § 1.44 are effective September 8, 2000.

Applicability Dates: Computer program listings in compliance with former § 1.96 will be accepted until March 1, 2001. After that date, computer program listings must comply with revised § 1.96. Amendments in compliance with former § 1.121 will be accepted until March 1, 2001. After that date, amendments must comply with revised § 1.121.

The new two-year limit for requesting refunds under § 1.26 will be applied to any fee paid regardless of when it was paid. For previously paid fees, the two-year time period for requesting a refund will expire on the later of November 7, 2000 or the date that is two years from the date the fee was paid.

FOR FURTHER INFORMATION CONTACT: Hiram H. Bernstein ((703) 305-8713) or Robert W. Bahr ((703) 308-6906), Senior Legal Advisors, or Robert J. Spar, Director ((703) 308-5107), Office of Patent Legal Administration (OPLA), directly by phone, or by facsimile to (703) 305-1013, marked to the attention of Mr. Bernstein, or by mail addressed to: Box Comments—Patents,

Commissioner for Patents, Washington, D.C. 20231.

Additionally, the following members of OPLA may be called directly for the matters indicated:

Robert Bahr ((703) 308-6906): §§ 1.22, 1.25, 1.26, 1.53, 1.55, 1.72, 1.76, 1.78, 1.112, 1.131, 1.132, 1.137, 1.138, 1.193, 1.311 through 1.313, 1.366, Part 5, and Part 10.

Hiram Bernstein ((703) 305-8713): §§ 1.9, 1.22, 1.26 through 1.28, 1.41, 1.48, 1.56, 1.85(c), 1.97, 1.98, 1.105, 1.111, 1.115, 1.133, 1.136, 1.322 through 1.324, and Part 3.

Robert Clarke ((703) 305-9177): Processing and petition fees, and § 1.52(b)(2).

James Engel ((703) 308-5106): §§ 1.152 *et seq.*

Eugenia Jones ((703) 306-5586): §§ 1.9, 1.27, and 1.28.

Jay Lucas ((703) 308-6868) or Anton Fetting ((703) 305-8449): §§ 1.96, and 1.821 *et seq.*

Joe Narcavage ((703) 305-1795): §§ 1.52(b)(6), 1.121, 1.125, and 1.173 *et seq.*

Kenneth Schor ((703) 308-6710): §§ 1.97, 1.98, 1.173 *et seq.*, 1.510 *et seq.*, and Part 3.

Fred Silverberg ((703) 305-8986): § 1.63 (oath or declaration) form.

Karin Tyson ((703) 306-3159): §§ 1.14, 1.33, 1.44, 1.47, 1.51, 1.52 (except (b)(2) and (b)(6)), 1.59, 1.63, 1.64, 1.67, 1.77, 1.84, 1.85 (except (c)), 1.163, and 1.720 *et seq.*

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

Goal 1: Reduce Office processing time (cycle time) to twelve months or less for all inventions.

Goal 2: Establish fully-supported and integrated Industry Sectors.

Goal 3: Receive applications and publish patents electronically.

Goal 4: Exceed our customers' quality expectations, through the competencies and empowerment of our employees.

Goal 5: Align fees commensurate with resource utilization and customer efficiency.

This final rule makes changes to the regulations to support the Patent Business Goals. A properly reengineered or reinvented system eliminates the redundant or unnecessary steps that slow down processing and frustrate customers. In furtherance of the Patent

Business Goals, these changes to the rules of practice take a fresh view of the business end of issuing patents, and continue a process of simplification. Formal requirements of rules that are no longer useful are eliminated. Once the intent of an applicant is understood, the Office will simply go forward with the processing. The essentials are maintained, while formalities are greatly reduced. The object is to focus on the substance of examination and decrease the time that an application for patent is sidelined with unnecessary procedural issues.

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

The Office initially published an advance notice of proposed rulemaking containing twenty-one initiatives. See *Changes to Implement the Patent Business Goals*, Advance Notice of Proposed Rulemaking, 63 FR 53497 (October 5, 1998), 1215 *Off. Gaz. Pat. Office* (October 27, 1998) (Advance Notice). The Office published a notice of proposed rulemaking, proposing a number of changes to the rules of practice to implement the Patent Business Goals that contained about half of the topics set forth in the advance notice plus additional items. See *Changes to Implement the Patent Business Goals*, Notice of Proposed Rulemaking, 64 FR 53771 (October 4, 1999), 1228 *Off. Gaz. Pat. Office* 15 (November 2, 1999). This final rule contains a number of changes to the text of the rules as proposed for comment. The significant changes (as opposed to additional grammatical corrections) are discussed below. Familiarity with the Advance Notice and Notice of Proposed Rulemaking is assumed.

The title "Commissioner of Patents and Trademarks" was changed to "Director of the United States Patent and Trademark Office" by § 4732 of the "American Inventors Protection Act of 1999" (Title IV of the "Intellectual Property and Communications Omnibus Reform Act of 1999") that was incorporated and enacted into law on November 29, 1999, by § 1000(a)(9), Division B, of Public Law 106-113, 113 Stat. 1501 (1999). To avoid inconsistent use of the title "Commissioner" and "Director" in the rules of practice, the Office plans to change the title "Commissioner" wherever it appears in the rules of practice to "Director" in a separate rule change.

Discussion of Specific Rules and Response to Comments

The Office received forty-eight written comments (from Intellectual Property Organizations, Law Firms, Businesses, Patent Practitioners, and others) in response to the Notice of Proposed Rulemaking. The written comments have been analyzed. For contextual purposes, the comment on a specific rule and response to the comment are provided with the discussion of the specific rule. Comments in support of proposed rule changes generally have not been reported in the responses to comments sections.

Two general comments were received that the Office should conduct a public hearing for every major rulemaking, and that in a proposed notice of rulemaking the Office should use markings to indicate the proposed changes in the rules.

Response: The suggestions are not adopted. The Office determined that a public hearing was not warranted for this rulemaking. Further, while markings to indicate the proposed changes might be helpful, on balance, the additional delay in preparing the rulemaking with markings outweighed the helpfulness of providing the markings.

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

Part 1

Section 1.4: Section 1.4(b) is amended to refer to a patent or trademark application, patent file, trademark registration file, or other proceeding, rather than only an application file. Section 1.4(b) is also amended to provide that the filing of duplicate copies of correspondence in a patent or trademark application, patent file, trademark registration file, or other proceeding should be avoided (except in situations in which the Office requires the filing of duplicate copies), and that the Office may dispose of duplicate copies of correspondence in a patent or trademark application, patent file, trademark registration file, or other proceeding. Finally, §§ 1.4(b) and 1.4(c) are also amended to change “should” to “must” because the Office needs separate copies of papers directed to two or more files, or of papers dealing with different subjects.

The explicit ability under § 1.4 to dispose of duplicate correspondence papers will be effective retroactively to any present duplicate correspondence.

Section 1.6: Section 1.6(d)(9) is amended to delete the reference to recorded answers under § 1.684(c), as

§ 1.684(c) has been removed and reserved.

Section 1.9: Sections 1.9(c) through (f) relating to small entities are removed and reserved with that subject matter transferred to amended § 1.27(a).

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

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

Comment 1: One comment requested that the definitions in § 1.9(f) pertaining to small entity status be moved to the small entity provisions found in § 1.27 to provide a more cohesive policy statement, and to provide a consolidated location, which would be helpful to small entities.

Response: The comment has been adopted. Other comments related to § 1.9(f) are treated in the context of § 1.27(a) to which the subject matter has been transferred.

Comment 2: The remaining comments confirmed the Office’s analysis that the proposed changes would be beneficial.

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

Section 1.14: Section 1.14 was proposed to be amended to eliminate the provisions making continuity data of an application identified in a patent available because such liberal public access to patent application information was inconsistent with patent applications being generally maintained in confidence. Since patent applications that are also filed abroad are subject to the eighteen-month publication provisions of the “American Inventors Protection Act of 1999” (Subtitle E—Domestic Publication of Patent Applications Published Abroad), any application that claims priority to a U.S. patent is likely to be published. Accordingly, continuity data for applications that rely upon the filing date of a U.S. patent should continue to be released and the provision for doing so is retained in § 1.14(b)(4).

Section 1.14 has been reformatted and amended to make it easier to understand.

Section 1.14(a) is amended to define “status information” and “access.” “Status information” is defined as

information that the application is pending, abandoned, or patented, as well as the application’s numeric identifier. An application’s numeric identifier is (1) the eight digit application number, or (2) the six digit serial number and the filing date, or the date of entry into the national stage. “Access” is defined as providing the application file for review and copying of any material in the file.

Section 1.14(b) is amended to state when status information may be supplied, retaining the reasons set forth in prior § 1.14(a)(1)(i). Section 1.14(b)(3) is simplified so as to indicate that status information will be given for international applications in which the United States is designated, even if that application has not yet entered the national stage. If, however, an international application has not yet been assigned a U.S. application number, no such application number can be provided by the Office. The material in former § 1.14(b) (timing of destruction) was proposed to be revised and was set forth as proposed § 1.14(f), but the material has been deleted instead. The timing of any destruction of patent files and papers is governed by 44 U.S.C. 33 and 36 CFR 12, which require that records be retained in accordance with the agency records schedules approved by the National Archives and Records Administration (NARA) or the General Records Schedule issued by NARA. The law also requires that the Office generate a list of records and the dispositions of those records, and the Comprehensive Records Schedule is such a list. According to this schedule, an abandoned national patent application filed before June 8, 1995, will be destroyed after twenty years from the date of abandonment unless it is referenced in a U.S. patent. Furthermore, the schedule provides that national applications filed on or after June 8, 1995, will be destroyed twenty-three years after the date of abandonment unless referenced in a U.S. patent. In addition, the records schedule provides that International application (home and search copy) files are destroyed 20 years after their filing or deposit date. Since former § 1.14(b) could not change any records retention schedule, it was decided to delete former § 1.14(b) (proposed as § 1.14(f)) and to redesignate proposed §§ 1.14(g) through (k) as (f) through (j). For additional information about the Office’s Comprehensive Records Schedule or the Office’s records management program in general, the Office’s Records Officer should be

contacted by telephone at (703) 308-7400, or by facsimile at (703) 308-7407.

Section 1.14(c) is amended to state that a copy of an application-as-filed may be obtained, upon payment of the appropriate fee, when a U.S. patent incorporates the application by reference.

Section 1.14(d) is amended to correspond to prior § 1.14(a)(3)(iii) with additional text from prior § 1.14(e)(2). Section 1.14(d) is revised to state that an applicant, an attorney or agent of record, or an applicant's assignee may authorize access to an application by filing a power to inspect. In addition, § 1.14(d) provides that if an executed oath or declaration has not been filed, a registered attorney or agent named in the papers filed with the application may have access, or authorize another person to have access, to an application by filing a power to inspect. A registered practitioner named in a letterhead would not be sufficient, but rather a clear identification of the individual as being a representative would be required. The form for a power to inspect is PTO/SB/67.

Section 1.14(e) is amended to correspond to prior § 1.14(a)(3) and states that any person may obtain access to an application by submitting a request for access if certain conditions apply. The form for a request for access to an abandoned application is PTO/SB/68. Access to international phase application files is governed by the provisions of the PCT and not by § 1.14. Section 1.14(e)(1), as amended, corresponds to prior § 1.14(a)(3)(ii). Section 1.14(e)(2)(i) corresponds to prior § 1.14(a)(3)(iv)(A). Section 1.14(e)(2)(ii), as revised, corresponds to prior § 1.14(a)(3)(iv)(B). Section 1.14(e) does not include the provisions of prior § 1.14(a)(3)(iv)(C). This will now enable an abandoned application that claims benefit of the filing date of an application that is open to public inspection to be maintained in confidence unless the abandoned application is open to public inspection for some other reason.

Sections 1.14(f), (g), (h), and (i) contain the material of prior §§ 1.14(c), (d), (f), and (g), respectively.

Section 1.14(j) is added to contain the material of prior § 1.14(e) and amendment is made to explain the requirements of a petition for access and include the provisions of former § 1.14(e)(1). Section 1.14(j) is also revised to indicate that the Office, either sua sponte or on petition, may provide access or copies of an application if necessary to carry out an Act of Congress or if warranted by other special circumstances. The Office may,

for example, provide access to, or copies of, applications to another Federal Government agency, such as a law enforcement agency, whether the Office is acting on its own initiative or in response to a petition from the other agency when access is needed for a criminal investigation.

Comment 3: Two comments urged the Office to continue to provide status information on applications that claim the benefit of the filing date of an application for which status information is available. The information was said to be very useful to the public and to provide some measure of certainty as to whether any continuing applications have been filed.

Response: The comments are adopted. The Office will continue to release continuity data for all applications for which status information may be given.

Comment 4: Several comments supported proposed § 1.14, but addressed proposed § 1.14(d)(4), arguing that the filing of a power of attorney, not an executed oath or declaration, should control whether the registered attorney or agent named in the application papers under § 1.53 or the national stage documents under § 1.494 or § 1.495 can sign a power to inspect. The comments noted that the power of attorney need not be filed with the oath or declaration, and that the attorney who filed the application should be able to sign a power to inspect until a power of attorney is filed wherein he is not named as an attorney.

Response: The suggestion is not adopted. Once an executed oath or declaration is filed, the omission of a power of attorney may be intentional on the part of the applicant and the attorney who filed the application should not continue to be allowed to sign a power to inspect. Provision has been made for the attorney who filed the application to sign a power to inspect because an application without an executed oath or declaration would not otherwise have anyone entitled to inspect the application. Inventorship is not set until an executed oath or declaration is filed (see § 1.41(a)(1)). An attorney or agent is not of record until an executed oath or declaration and a power of attorney are filed (see § 1.34(b)). An assignee is not permitted to take action until an executed oath or declaration and an assignment are filed (see § 3.73(b)). Accordingly, without an executed oath or declaration, an executed power of attorney would be insufficient to make an attorney of record. Furthermore, once an executed oath or declaration is filed, any one of the named inventors may execute a power of attorney and it is no longer

necessary to have the attorney or agent who filed the application be permitted to execute a power to inspect.

Comment 5: Two comments suggested allowing public inspection of all applications relied upon for priority without a petition for access, and not just those that are abandoned.

Response: Applications are normally maintained in confidence pursuant to 35 U.S.C. 122 and public access to any application relied upon for priority in a U.S. Patent is not appropriate. An application that issues as a patent may be a divisional application of a pending application and the prosecution of the parent application may have little, if any, subject matter in common with the patent. Accordingly, if a petition for access is filed, only that part of the prosecution history and application that relates to the subject matter claimed in the patent is released to petitioner.

Comment 6: One comment suggested that the term "special circumstances" be defined in the rule.

Response: The suggestion is not adopted. How the Office defines the term "special circumstances" as used in 35 U.S.C. 122 and § 1.14(j) is addressed in the Manual of Patent Examining Procedure (MPEP)(February 2000) in § 103 under the subsection titled "Petition for Access," and whether "special circumstances" are present depends upon the particular facts involved, which facts may be varied.

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

set forth in the international stage (§ 1.497(d)).

Section 1.17(k) provides a fee for filing a request for expedited examination under § 1.155(a).

Sections 1.17(l) and (m) are amended for clarity, to eliminate unassociated text, and to reflect fiscal year 2001 fee amounts.

Section 1.17(p) is amended to include a reference to § 1.97(d) as well as to § 1.97(c) in view of the amendment to § 1.97(d) referencing § 1.17(p) rather than § 1.17(i). The fee set forth in § 1.17(p) is also changed from \$240 to \$180.

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

Comment 7: Comments were received opposing the change to § 1.17(p).

Response: See the discussion thereof in § 1.97(d).

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

Former sections 1.19(b)(1) and (b)(2) are divided into three sections (§§ 1.19(b)(1), 1.19(b)(2), and 1.19(b)(3)), with the former provisions of §§ 1.19(b)(3) and 1.19(b)(4) being redesignated as §§ 1.19(b)(4) and 1.19(b)(5). Section 1.19(b)(1) refers to the application as filed. Section 1.19(b)(2) is limited to charges for the paper portion of the complete patent application file wrapper, namely: \$200 for copies of the first 400 pages of a patent application file wrapper and contents and \$40 for each additional one hundred pages, or fraction thereof. Section 1.19(b)(3) provides for a charge of \$55 for a copy of a compact disc in a patent application file wrapper, and \$15 for each additional compact disc when it is part of the same order. The submission of application information on compact disc is now provided for in §§ 1.52(e), 1.96 and 1.821 *et seq.*

Section 1.19(g) is removed and reserved. The practice of comparing and certifying documents not produced by the Office is being eliminated. The Office considers it appropriate to certify copies of documents only when the copy of the document has been prepared by the Office.

Section 1.19(h) is also removed and reserved. The \$25 fee under § 1.19(h) for obtaining a corrected or duplicate filing receipt is no longer necessary as the Office is now performing that service

without charge. Consequently, where there is an error in a filing receipt, applicants need no longer provide a showing that the error was due to Office mistake or pay a \$25 fee for the corrected receipt. *See Changes In Practice In Supplying Certified Copies And Filing Receipts*, 1199 *Off. Gaz. Pat. Office* 38 (June 10, 1997).

Comment 8: One comment stated that the proposed fee of \$250 for copies of certified and uncertified patent-related file wrappers and contents of 400 or fewer pages was excessive, and that \$100 for the first 400 pages would be more reasonable, if it costs 25 cents a page for copying. In addition, the comment stated that there should be no reason why a flat page charge cannot be used; that with the proposed rule, the number of pages would have to be counted to see whether the initial 400-page limit has been reached, and that it should not be a burden to determine the number of pages that have been copied.

Response: The comment is adopted to the extent that the cost for the first 400 pages has been reduced to \$200. Much of the cost per page for copying a given application depends upon the difficulty in obtaining the application, the time required putting the papers in condition for copying and returning those same papers to the file in their original condition, and the number of pages being fed instead of copied as a single sheet. A fee of \$200 has been determined to be the appropriate price for locating, preparing, copying and mailing the average application. As to charging based upon the number of pages, this suggestion has been carefully considered but has not been adopted. In order to improve efficiency, the Office needs to have a procedure which will generally require the least communications between the requester and the Office. If a flat \$200 fee is charged for file wrappers with fewer than 400 pages, then most requesters of file wrappers can pay the set fee and receive their order without any additional communication with the Office. When the file wrapper is larger than 400 pages, then the Office either will have to receive a deposit account authorization for any fees due which can be debited or request the additional money from the requester. Since many requesters do not have deposit accounts and others will be reluctant to allow any charge to be made to their deposit account or credit card, having a system where the Office charges a set fee for most orders and possibly contacting the requester to obtain additional fees when the order is very large will assist requesters in minimizing the risk of unexpectedly large charges.

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

Section 1.22 was proposed to be amended to add §§ 1.22(c)(1) and (2) to define by rule when a fee had been paid, such as when payment is made by authorization to charge a deposit account, or by submission of a check. An effect of the rule change would have been to change the treatment for refund purposes of payments made by authorization to charge a deposit account. The proposed amendment will not be made as amendment is unnecessary in view of payment receipt dates already being governed by other rules (*e.g.*, §§ 1.6, 1.8 and 1.10). Notwithstanding the lack of amendment to § 1.22, the Office is changing in one aspect its treatment of authorizations to charge deposit accounts for refund purposes, which aspect is not explicitly governed by other rules. The Office will no longer treat authorizations to charge a deposit account as being received by the Office as of the date that the deposit account is actually debited for purposes of refund payments under §§ 1.26 and 1.28. As of the effective date of this final rule, payment by authorization to charge a deposit account will be treated for refund purposes the same as payments by other means (*e.g.*, check or credit card charge authorization), with each being treated as paid (for refund purposes) on the date of receipt in the Office as defined by § 1.6 (Example 1). The advantage of using a certificate of mailing under § 1.8 for timely reply to an Office action, while using the date of receipt by the Office (§ 1.6) of the payment for refund purposes, will be retained (Example 2). The MPEP will be revised to contain the substance of the formerly proposed amendment to § 1.22(c).

Example 1: Payment of a large entity basic filing fee by authorization to charge a deposit account is hand-carried to the Office on October 2, 2000. The deposit account is debited by the Office on February 2, 2001. A request for refund of a portion of the filing fee, based on a request for small entity status, is hand-carried to the Office on March 30, 2001. Under prior practice, the request for refund would be granted as timely submitted within two months of debiting of the deposit account. Under the new practice, the request for refund would be denied as untimely made. Applicant would, however, under the amended rule, have three months (rather

than two) from the October 2, 2000 payment date to submit the refund request.

Example 2: A Notice to File Missing Parts of Application was mailed on November 10, 2000, requiring a large entity basic filing fee with the standard period for reply of two months. A check for payment of the large entity basic filing fee is mailed with a § 1.8 certificate of mailing date of January 10, 2001, and is actually received in the Office on January 15, 2001. Under prior and current practice, the January 10, 2001 reply to the November 10, 2000 Notice to File Missing Parts of Application, which was received in the Office on January 15, 2001, is a timely reply without the need for an extension of time under § 1.136(a), and the (new) three-month period for submission of a request for refund based on small entity status under amended § 1.28(a) would expire on April 16, 2001 (April 15, 2001 being a Sunday). For a fee payment made by authorization to charge a deposit account, the payment is also timely and results in the same expiration for the refund period. For express mail fee payments under § 1.10, the express mail date is the receipt date for the payment and calculating the three month refund period and not the actual date of receipt of the payment in the Office.

Comment 9: One comment requested that explicit guidance be provided in the MPEP as to what would constitute a sufficiently clear statement of the purpose for which fees are being paid under § 1.22(b). In particular, the example was raised as to whether a statement that “filing fees were being paid” would be sufficient if the fees being paid included both a basic filing fee and an additional independent claim fee.

Response: The comment is adopted. The MPEP will be revised to provide examples that will clarify what constitutes a sufficiently clear statement. The intent of the amendment is to encourage a better explanation by applicants so that Office employees can properly account for the payments being made by applicants and not to find ways to hold a statement deficient. Specifically, the reference to filing fees would be sufficient to cover filing fees of all different types of applications and all types of claims fees.

Comment 10: One comment opposed the addition of § 1.22(c), as the addition was confusing, particularly in regard to §§ 1.8 and 1.10 payments, and the addition was not necessary to support the proposed amendment to § 1.26(b) for a two-year period for refunds from a date certain.

Response: The comment is adopted and the proposed addition of § 1.22(c) will not be made. The amendment is not in fact necessary to define when a fee has been paid, in view of the change in practice regarding treatment of deposit account practices, *supra*, §§ 1.8, or § 1.10, and the actual date of receipt (in

the absence of §§ 1.8 or 1.10 being utilized). The MPEP will be modified to better clarify date of payments, particularly as refund time periods are impacted.

Section 1.25: Section 1.25(b) is amended to provide that an authorization to charge fees under § 1.16 (which relates to national application filing fees) in an application filed under 35 U.S.C. 371 will be treated as an authorization to charge fees under § 1.492 (which relates to national stage fees). There are many instances in which papers filed for the purpose of entering the national stage under 35 U.S.C. 371 and § 1.494 or § 1.495 include an authorization to charge fees under § 1.16 (rather than fees under § 1.492) which relates to national applications under 35 U.S.C. 111. In such instances, the Office treats the authorization as an authorization to charge fees under § 1.492 since: (1) timely payment of the appropriate national fee under § 1.492 is necessary to avoid abandonment of the application as to the United States; and (2) the basic filing fee under § 1.16 is not applicable to such papers or applications. Therefore, the Office is changing § 1.25(b) to place persons filing papers to enter the national stage under 35 U.S.C. 371 and § 1.494 or § 1.495 on notice as to how an authorization to charge fees under § 1.16 will be treated.

Section 1.25(b) is also amended to provide that an authorization to charge fees set forth in § 1.18 to a deposit account is subject to the provisions of § 1.311(b), and to bring together the two sentences relating to sufficient funds.

Comment 11: See comment for § 1.311.

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

The new two year limit for requesting refunds under § 1.26 will be applied to any fee paid regardless of when it was paid. The two year time period for requesting a refund will end two years and sixty days from the date of publication in the **Federal Register** for fees paid prior to sixty days from the

date of publication in the **Federal Register**, or two years from payment of the fee for fees paid on or after sixty days from the date of publication in the **Federal Register**.

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

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

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

Section 1.26(a) is amended by dividing its first sentence into two sentences. Section 1.26(a) is further amended for consistency with 35 U.S.C. 42(d) (the Office “may refund any fee paid by mistake or any amount paid in excess of that required”). Under 35 U.S.C. 42(d), the Office may refund: (1) A fee paid when no fee is required (a fee paid by mistake); or (2) any fee paid in excess of the amount of fee that is required. *See Ex parte Grady*, 59 USPQ 276, 277 (Comm’r Pat. 1943) (the statutory authorization for the refund of fees under the “by mistake” clause is applicable only to a mistake relating to the fee payment). In the situation in which an applicant or patentee takes an action “by mistake” (e.g., files an application or maintains a patent in force “by mistake”), the submission of fees required to take that action (e.g., a filing fee submitted with such application or a maintenance fee submitted for such patent) is not a “fee paid by mistake” within the meaning of 35 U.S.C. 42(d). Section 1.26(a) is also amended to revise the “change of purpose” provisions to read “[a] change of purpose after the payment of a fee, as

when a party desires to withdraw a patent or trademark filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee."

Section 1.26(a) is also amended to change the sentence "[a]mounts of twenty-five dollars or less will not be returned unless specifically requested within a reasonable time, nor will the payor be notified of such amount; amounts over twenty-five dollars may be returned by check or, if requested, by credit to a deposit account" to "[t]he Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify the payor of such amounts." Except as discussed below, the Office intends to continue to review submitted fees to determine that they have not been paid by mistake or in excess of that required, and to *sua sponte* refund fees (of amounts over twenty-five dollars) determined to have been paid by mistake or in excess of that required. Section 1.26(a), however, is amended to eliminate language that appears to obligate the Office to *sua sponte* refund fees to be consistent with the provisions of § 1.26(b) which requires that any request for refund be filed within a specified time period.

Section 1.26(a) is also amended to facilitate refunds by electronic funds transfer. Section 31001(x) of the Omnibus Consolidated Rescissions and Appropriations Act of 1996, Pub. L. 104-134, 110 Stat. 1321 (1996) (the Debt Collection Improvement Act of 1996), amended 31 U.S.C. 3332 to require that all disbursements by Federal agencies (subject to certain exceptions and waivers) be made by electronic funds transfer. The Department of the Treasury has implemented this legislation at 31 CFR part 208. See *Management of Federal Agency Disbursements*, Final Rule Notice, 63 FR 51489 (September 25, 1998). Thus, § 1.26(a) is amended to enable the Office to: Obtain the banking information necessary for making refunds by electronic funds transfer in accordance with 31 U.S.C. 3332 and 31 CFR part 208, or obtain the deposit account information to make the refund to the deposit account, or to have the option of refunding by treasury check.

Specifically, § 1.26(a) is also amended such that if a party paying a fee or requesting a refund does not instruct that refunds be credited to a deposit account, the Office will attempt to make the refund by electronic funds transfer. If such party does not provide the banking information necessary for making refunds by electronic funds

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

Section 1.26(a) also provides that any refund of a fee paid by credit card will be by a credit to the credit card account to which the fee was charged. The Office will not refund a fee paid by credit card by Treasury check, electronic funds transfer, or credit to a deposit account (§ 1.25). Section 1.26(b) provides that any request for refund must be filed within two years from the date the fee was paid, except as otherwise provided in § 1.26(b) or in § 1.28(a).

Section 1.26(b) also provides that if the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization (§ 1.25(b)), any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge, and that such request must be accompanied by a copy of that deposit account statement. This provision of § 1.26(b) will apply, for example, in the following types of situations: (1) A deposit account is charged for an extension of time as a result of there being a prior general authorization in the application (§ 1.136(a)(3)); or (2) a deposit account is charged for the outstanding balance of a fee as a result of an insufficient fee being submitted with an authorization to charge the deposit account for any additional fees that are due. In these situations, the party providing the authorization is not in a position to

know the exact amount by which the deposit account will be charged until the date of the deposit account statement indicating the amount of the charge.

Finally, § 1.26(b) provides that the time periods set forth in § 1.26(b) are not extendable.

Section 1.27: The Office is simplifying applicant's request for small entity status under § 1.27. The currently used small entity statement forms are eliminated as they are no longer needed. Some material in §§ 1.9 and 1.28 is reorganized into § 1.27.

The new standard for asserting a claim for small entity status under § 1.27 will be effective on the date of publication in the **Federal Register**.

Small entity status is established at any time by a simple assertion of entitlement to small entity status. The previously required statements, which include a formalistic reference to § 1.9, are no longer required. Payment of an exact small entity basic filing (§§ 1.16(a), (f), (g), (h), or (k)) or national stage (§§ 1.492(a)(1), (a)(2), (a)(3), (a)(4), or (a)(5)) fee is also considered an assertion of small entity status. This is so even if the wrong exact basic filing or national fee was selected. To establish small entity status after payment of the basic filing or national stage fee as a non-small entity, a written assertion of small entity status is required to be submitted.

The parties who can assert small entity status have been expanded/liberalized to include one of several inventors (rather than all the inventors), a partial assignee (rather than all the assignees), or any attorney or agent identified in § 1.33. Written assertion of small entity status and the filing of a written assertion are not necessarily performed by the same party. Compare § 1.27(c)(2)(ii) with § 1.27(c)(2)(iii).

Other clarifying changes are made including a transfer of material into § 1.27 from § 1.9 drawn towards definitions of a small entity and from § 1.28 drawn towards: (1) Assertions in related, continuing and reissue applications; (2) notification of loss of entitlement to small entity status; and (3) fraud on the Office in regard to establishing small entity status or paying small entity fees.

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

has been determined that a claim to such status is appropriate.

For additional changes to small entity requirements see § 1.28.

Problem and Background: Section 1.27 formerly required that a request for small entity status be accompanied by submission of an appropriate statement that the party seeking small entity status qualified in accordance with former § 1.9. Either a reference to former § 1.9 or a specific statement relating to the former provisions of § 1.9 was mandatory. For a small business concern, the small business concern had to either state that exclusive rights remain with the small business concern, or if not, had to identify the party to which some rights had been transferred so that the party to which rights have been transferred could submit its own small entity statement (former § 1.27(c)(1)(iii)). This led to the submission of multiple small entity statements for each request for small entity status where rights in the invention were split. In part, to ensure that at least the reference to § 1.9 was complied with, the Office produced four types of small entity statement forms (for inventors, small business concerns, non-profit organizations, and non-inventor supporting a claim by another) that included the required reference to § 1.9 and specific statements as to exclusive rights in the invention. Where an application had not been assigned and there were multiple inventors, each inventor had to actually sign a small entity statement, the execution of which must have all been coordinated and submitted concurrently. Similarly, coordination of execution and submission of statements were needed where there was more than one assignee. Additionally, the statement forms relating to small business concerns and non-profit organizations had to be signed by an appropriate official empowered to act on behalf of the small business concern or non-profit organizations. Refunds of non-small entity fees could only be obtained if a refund was specifically requested within two months of the payment of the full (non-small entity) fee and was supported by all required small entity statements. See former § 1.28(a)(1). The former two-month refund window under § 1.28 was not extendable.

The rigid requirements of §§ 1.27 and 1.28 led to a substantial number of problems. Applicants, particularly *pro se* applicants, did not always recognize that a particular reference to former § 1.9 was required in their request to establish small entity status. They believed that all they had to do was pay the small entity fee and state that they

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

Accordingly, a simpler procedure to establish small entity status will reduce processing time within the Office and will be a tremendous benefit to small entity applicants as it will eliminate the time-consuming and aggravating processing requirements that were

mandated by the former rules. Thus, the instant simplification will help small entity applicants to receive patents sooner with fewer expenditures in fees and resources and the Office can issue the patent with fewer resources.

Assertion as to entitlement to small entity status; assertion by writing: The Office will now allow small entity status to be established by the submission of a simple written assertion of entitlement to small entity status. The former formal requirements of § 1.27, which included a reference to either former § 1.9, or to the exclusive rights in the invention, are eliminated.

The written assertion is not required to be presented in any particular form. Written assertions of small entity status or references to small entity fees will be liberally interpreted to represent the required assertion. The written assertion can be made in any paper filed in or with the application and need be no more than a simple sentence or a box checked on an application transmittal letter or reply cover sheet. It is the intent of the Office to modify its application transmittal forms to provide for such a check box. Accordingly, small entity status can be established without submission of any of the former small entity statement forms (PTO/SB/09-12) that embody and comply with the former requirements of § 1.27 and which were previously used to establish small entity status. Practitioners may, of course, continue to use such forms or similar forms if they believe small entity forms serve an educational purpose for their clients.

Assertion by Payment of Small Entity Basic Filing or Basic National Fee: The payment of an exact small entity basic filing (§§ 1.16(a), (f), (g), (h), or (k)) or basic national fee (§§ 1.492(a)(1), (a)(2), (a)(3), (a)(4), or (a)(5)) is also considered to be a sufficient assertion of entitlement to small entity status. An applicant filing a patent application and paying an exact small entity basic filing or basic national fee automatically establishes small entity status for the application even without any further written assertion of small entity status. This is so even if an applicant inadvertently selects the wrong type of small entity basic filing or basic national fee for the application being filed. If small entity status was not established when the basic filing or basic national fee was paid, such as by payment of a large entity basic filing or basic national fee, a later claim to small entity status requires an (actual) written assertion. Payment of a small entity fee other than a small entity basic filing or basic national fee (e.g., extension of time, or

issue fee) without inclusion of a written assertion is not sufficient.

Even though applicants can assert small entity status only by payment of an exact small entity basic filing or basic national fee, the Office encourages applicants to also file a written assertion of small entity status as well as pay the exact amount of the small entity basic filing or basic national fee. To that end, the Office intends to amend the application transmittal forms (PTO/SB/05, PTO/SB/18, PTO/SB/19) to include a check box that can be used as a written assertion of small entity status. A written assertion will provide small entity status should applicant fail to pay the exact small entity basic filing or basic national fee. The limited provision providing for small entity status by payment of an exact small entity basic filing or basic national fee is only intended to act as a safety net to avoid possible financial loss to inventors or small businesses that qualify for small entity status. As noted in the discussion relating to § 1.33(a), one may not wish to solely rely upon use of a written assertion and pay the exact amount of the basic filing or basic national fee, particularly for assignees and submissions by one of the inventors, after an executed oath or declaration under § 1.63 has been submitted.

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

Examples: Applications under 35 U.S.C. 111(a): If an applicant were to file a utility application under 35 U.S.C. 111(a), yet only pay the exact small entity amount for a design application (currently the small entity filing fees for utility and design applications are \$345 and \$155, respectively), small entity status for the utility application would be accorded. See the following examples:

(1) Where the utility application under 35 U.S.C. 111(a) was filed inadvertently with the exact small entity

basic filing fee for a design application rather than for a utility application and an authorization to charge the filing fee was not present, the Office would accord small entity status and mail a Notice to File Missing Parts of Application, requiring the \$190 difference between the small entity utility application filing fee owed and the small entity design application filing fee actually paid plus a small entity surcharge (of \$65) for the late submission of the correct filing fee.

(2) Where the utility application under 35 U.S.C. 111(a) was filed without any filing fee but the \$155 exact small entity filing fee for a design application was inadvertently paid in reply to a Notice to File Missing Parts of Application, small entity status would be established even though the correct small entity filing fee for a utility application was not fully paid. While the Office would notify applicant of the remaining amount due, including the need for a small entity surcharge in view of the deficiency in the filing fee, the period for reply to pay the correct small entity utility basic filing fee and surcharge would, however, continue to run. Small entity extensions of time under § 1.136(a) would be needed for the later submission of the \$190 difference between the \$345 small entity utility basic filing fee owed and the \$155 small entity design filing fee inadvertently paid as well as the small entity surcharge. If there was an authorization to charge a deposit account in the reply to the Notice, the \$190 difference would have been charged along with the small entity \$65 surcharge and the period for reply to the Notice to File Missing Parts of Application would not continue to run.

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

(1) An applicant pays \$485 (the small entity amount due under § 1.492(a)(3), where the United States was neither the International Searching Authority (ISA) nor the International Preliminary Examining Authority (IPEA) and the search report was not prepared by the European Patent Office (EPO) or Japanese Patent Office (JPO)) when in

fact the required small entity fee is \$420 under § 1.492(a)(5), because the JPO or EPO prepared the search report. The applicant will be considered to have made the assertion of small entity status. The office will apply \$420 to the payment of the basic national stage fee and refund the overpayment of \$65.

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

If payment is attempted of the proper type of basic filing or basic national fee (applicant correctly identifies the type of fee for the type of application being filed), but the amount of the fee paid is not the exact small entity fee required (an incorrect fee amount is supplied) and a written assertion of small entity status is not present, small entity status will not be accorded. The Office will mail a notice of insufficient basic filing or basic national fee with a surcharge due as in prior practice if an authorization to charge the basic filing or basic national fee is not present. The Office does not consider a basic filing or basic national fee submitted in an amount above the correct fee amount, but below the non-small entity fee amount, as a request to establish small entity status unless an additional written assertion is also present. The submission of a basic filing or basic national fee below the correct fee amount also does not serve to establish small entity status.

Where an application is originally filed by a party, who is in fact a small entity, with an authorization to charge fees (including basic filing or national fees) and there is no indication (assertion) of entitlement to small entity status present, that authorization is not sufficient to establish small entity status unless the authorization is specifically directed to small entity basic filing or basic national fees. The general

authorization to charge fees will continue to be acted upon immediately and the full (not small entity) basic filing or basic national fees will be charged. Applicant will have three months to request a refund by asserting entitlement to small entity status. This is so even if the application is a continuing application where small entity status had been established in the prior application.

Parties who can assert entitlement to small entity status by writing: The parties who can assert entitlement to small entity status by writing includes all parties permitted by § 1.33(b) to file a paper in an application. This eliminates the additional requirement of obtaining the signature of an appropriate party other than the party prosecuting the application. By way of example, in the case of three *pro se* inventors for a particular application, the three inventors upon filing the application can submit a written assertion of entitlement to small entity status and thereby establish small entity status for the application. For small business concerns and non-profit organizations, the practitioner can supply the assertion rather than require an appropriate official of the small business concern or organization to execute a small entity statement form. In addition, a written assertion of entitlement to small entity status can be made by one of several inventors or a partial assignee. Former practice did not require an assignee asserting small entity status to submit a § 3.73(b) certification, and such certification is not now required under the current revision either for partial assignees or for an assignee of the entire right, title, and interest.

Inventors asserting small entity status: Any inventor (of record) is permitted to submit a written assertion of small entity status, including individuals identified as inventors but who are not officially named of record as an executed § 1.63 oath/declaration has not yet been submitted. See § 1.41(a)(1). Where an application is filed without an executed oath/declaration pursuant to § 1.53(f), the Office will accept the written assertion of an individual who has merely been identified as an inventor on filing of the application (e.g., application transmittal letter) as opposed to having to be named as an inventor by the filing of an executed § 1.63 oath or declaration (§§ 1.41(a)(1)). Sections 1.4(d)(2) and 10.18(b) are seen as sufficient basis to permit any individual to provide a written assertion so long as the individual identifies himself or herself as an inventor. An actual inventor who has not been

identified as an inventor (e.g., by way of application transmittal letter) or named as an inventor (i.e., executed § 1.63 oath or declaration) in the file record may not file a written assertion as to small entity entitlement.

Where a § 1.63 oath or declaration is later filed, any original written assertion as to small entity status (which has been submitted to the Office by an appropriate party under § 1.33(b)) will remain unless changed by an appropriate party under § 1.27(f)(2). Where a later-filed § 1.63 oath or declaration sets forth an inventive entity that does not include the person who initially was identified as an inventor and who asserted small entity status, small entity status will also remain.

A distinction exists, however, as to who can file a written assertion of entitlement to small entity status once the written assertion is signed. Sections 1.27(c)(2)(ii) and 1.33(b) permit one of several inventors to file as well as sign a written assertion. The same is not true for a partial assignee. Section 1.27(c)(2)(iii). While a partial assignee may sign a written assertion, the written assertion must be filed by an appropriate party under § 1.33(b).

Parties who can assert entitlement to small entity status by payment of basic filing or national fee: Where small entity status is sought by way of payment of the basic filing or basic national fee, any party, such as a partial assignee, may submit payment, such as by check, and small entity status will be accorded.

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

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

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

If small entity status is desired on the basis that the entity is a small business concern, the investigation should include a review of whether the business is a small business concern as defined by section 3 of the Small Business Act (Public Law 85-536 as amended by Public Law 106-50). Review of whether the business is a "concern" as the term is used in the regulations promulgated by the Small Business Administration at 13 CFR 121 is also appropriate. Applicants should recognize that more is involved than merely determining that the number of employees of the business does not exceed a numerical cap. While 13 CFR 121.802 specifically addresses the size standards for paying reduced patent fees, it is emphasized that the provisions of general applicability set forth in 13 CFR 121 also apply. Thus, the definition of "business concern" set forth in 13 CFR 121.105, the provisions regarding what is an affiliation as set forth in 13 CFR 121.103, and the provisions on the manner in which the number of employees should be calculated as set forth in 13 CFR 121.106 are all read into 13 CFR 121.802. Additionally, if the business has assigned, granted, conveyed or licensed (or is under an obligation to do so) any rights in the invention to others directly or indirectly, the same review

for each other entity would also be appropriate.

Furthermore, once status as a small entity has been established in an application, a new determination of entitlement to small entity status is needed when the issue fee is due and when any maintenance fee is due. It should be appreciated that the costs incurred in appropriately conducting the initial and subsequent investigations may outweigh the benefit of claiming small entity status. For some applicants it may be desirable to file as a large entity (by not filing a small entity statement and by submitting large entity fees) rather than undertaking the appropriate investigations which may be both difficult and time-consuming.

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

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

Clarification of Need for Investigation: Section 1.27(f) is clarified by explicitly providing that a determination “should” be made of entitlement to small entity status according to the requirement set forth in § 1.27(a) prior to asserting small entity status. The need for such a determination of entitlement to small entity status prior to assertion of small entity status is set forth in terms of that there “should” be such a determination, rather than that there “must” be such a determination. In view of the ease with which small entity status will now be obtainable, it is deemed advisable to provide an explicit direction that a determination of entitlement to small entity status, pursuant to § 1.27(a), should be made before its assertion.

Consideration was given to making the need for a determination a requirement rather than advisory; however, the decision was made to make it advisory, particularly in view of the following possible scenario: One of three inventors submits a written assertion of entitlement to small entity status without making any determination of entitlement to such status, such as by checking with the other two inventors to see if they have assigned any rights in the invention. Small entity status is proper at the time asserted notwithstanding the lack of a proper determination. If the determination is set forth as a requirement (“must”), the lack of such a determination might act to cause an unduly harsh result where small entity status was in fact appropriate and the failure to check prior to assertion is innocent. It is recognized that the use of “should” may cause concern that a cavalier approach to asserting entitlement to small entity status may be taken by encouraging some who are asserting status not to make a complete determination as the determination is not set forth as being mandatory. On balance, it is thought that the use of “should” will lead to more equitable results. The danger of encouraging the assertion of small entity status without a prior determination as to qualification for small entity status is thought to be small, because if the status turns out to be improper, the lack of a prior determination may result in a failure to meet the lack of deceptive intent requirements under § 1.27(h) or § 1.28(c). The Office has noted that any attempt to improperly establish status as a small entity will be viewed as a serious matter. See MPEP 509.03.

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

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

Paragraph by paragraph analysis: Section 1.27 is amended: (1) in its title to reflect placement of the definitions for small entities in the section (transferred from former § 1.9(f)), (2) to indicate that an establishment of small entity status permits the payment of small entity fees, and (3) to reflect transfer of subject matter from § 1.28 relating to determination of entitlement to and notification of loss of entitlement to small entity status, and fraud on the Office.

Section 1.27 is amended to provide the definition of who can qualify to pay small entity fees: the amendments (1) define a “person” to include inventors and also noninventors holding rights in the invention; (2) explain that qualification depends on whether any rights in the invention were transferred and to whom; (3) provide that a license by a person to the Government under certain situations does not bar entitlement to small entity status.

Section 1.27(a) contains the subject matter relating to definitions of small entities: (1) Persons, (2) small business concerns; and (3) nonprofit organizations, in one paragraph rather than previously in §§ 1.9(c) through (e). The expression “independent inventor” of former § 1.9(c) is replaced with the term “person” in current § 1.27(a)(1) (and other paragraphs of this section). The term “person” in § 1.27(a) includes individuals who are inventors and also individuals who are not inventors but who have been transferred some right or rights in the invention. This clarifies that individuals who are not inventors but who have rights in the invention are covered by the provisions of § 1.27.

Sections 1.27(a)(2)(i) and (a)(3)(i) retain the requirement of former § 1.27 that in order for small entity businesses and nonprofit organizations to remain entitled to small entity status, they must not in some manner transfer or be under an obligation to transfer any rights in the invention to any party that would not qualify for small entity status. The absence of this requirement from former §§ 1.9(d) and (e) (small business concern and nonprofit organization, respectively), notwithstanding its presence in former § 1.9(c) (independent inventor), led to confusion as to the existence of such a requirement for small businesses concerns and nonprofit organizations. Former §§ 1.9(d) and (e), where this requirement was absent, have been deleted and it is now made clear that these rights transfer requirement applies to all parties (independent inventors, small business concerns and nonprofit organizations, respectively).

Section 1.27(a)(2)(ii) has the term "size" removed from the reference to standards set by the SBA as possibly misleading as the SBA standards for entitlement to small entity status for small businesses require more than a size determination.

Section 1.27(a)(4)(i) provides a new exception, relating to the granting of a license to the U.S. Government by a person, that results from a particular rights determination. Such a license would not bar entitlement to small entity status. Similarly, § 1.27 (a)(4)(ii) has transferred to it (from former §§ 1.27(c)(2) and (d)(2)) the current exceptions relating to a licence to a Federal agency by a small business or a nonprofit organization resulting from a particular funding agreement.

Sections 1.27(b) through (e) are reformatted and amended to recite "assertion" as a new means for establishing small entity status to replace "statement," and new Sections 1.27 (f), (g)(1) and (g)(2), and (h) are added.

Section 1.27(c) is reformatted to add §§ 1.27(c)(1) through (c)(4).

Section 1.27(c)(1) permits assertion of small entity status by a writing that is clearly identifiable (§ 1.27(c)(1)(i)), is signed (§ 1.27(c)(1)(ii)), and conveys the concept of small entity status without the need for specific words but with a clear indication of an intent to assert entitlement to small entity status (§ 1.27(c)(1)(iii)).

Section 1.27(c)(2) makes submission of a written assertion to obtain small entity status easier in view of increased categories of parties who could sign and file such a paper. The parties who can *sign* the written assertion are identified as: one of the parties who can currently submit a paper under § 1.33(b) (§ 1.27(c)(2)(i)), at least one of the individuals identified as an inventor (even though a § 1.63 executed oath or declaration has not been filed) (§ 1.27(c)(2)(ii)) rather than all the inventors (applicants) as required by § 1.33(b)(4) for other types of papers, or a partial assignee (§ 1.27(c)(2)(iii)) rather than all the partial assignees and any applicant retaining an interest as required by § 1.33(b)(3) for other types of papers. A § 3.73(b) certification is not required for an assignee under either §§ 1.27(c)(2)(i) or (iii). The parties who can file the signed written assertion include any one of the identified inventors (§ 1.27(c)(2)(ii)), but not a partial assignee (§ 1.27(c)(2)(iii)) unless resort is made to a party identified under § 1.33(b).

Section 1.27(c)(3) permits the payment, by any party, of an exact amount of one of the small entity basic

filing (§§ 1.16(a), (f), (g), (h), or (k)) or basic national (§§ 1.492(a)(1) through (a)(5)) fees to be treated as a written assertion of entitlement to small entity status even where an incorrect type of basic filing or basic national fee is inadvertently selected in error. Section 1.27(c)(3)(i) provides that where small entity status was accorded based on the payment of a wrong type of small entity basic filing or basic national fee, the correct small entity amount would still be owed along with the surcharge set forth in §§ 1.16(e) or (l) for the basic filing fee (there is no surcharge for the basic national fee). Section 1.27(c)(3)(ii) provides that payment of a small entity fee in its exact amount for a fee other than what is provided for in § 1.27(c)(3) is not sufficient to establish small entity status absent a concomitant written assertion of entitlement to small entity status. After a basic filing or basic national fee is paid as a large entity, a refund under § 1.28(a) of the large entity portion can only be obtained by establishing small entity status by a written assertion and not by paying a second basic filing or basic national fee in a small entity amount. Payment of a large entity basic filing or basic national fee precludes paying a second basic filing or national fee in a small entity amount to establish small entity status.

Section 1.27(c)(4) recites material transferred from former § 1.28(a)(2).

Section 1.27(d) is amended to provide that fees other than the basic filing and basic national fees can only be paid in small entity amounts if submitted with or subsequent to a written assertion of entitlement to small entity status. For refunds, where the small entity assertion is submitted after payment of a large entity fee (rather than with or subsequent to payment of a small entity fee), the paragraph clarifies that an exception exists for § 1.28(a) refunds (of the large entity portion of a fee within three months of payment thereof if the refund request is accompanied by a written assertion of entitlement to small entity status).

Section 1.27(e)(1) is added to reference § 1.27(g)(1) as the means of changing small entity status. It is clarified that where rights in an invention are assigned, or where there is an obligation to assign, to a small entity subsequent to an assertion of entitlement to small entity status, a second assertion is not required. Section 1.27(e)(2) clarifies that once small entity status is withdrawn a new written assertion is required to again obtain small entity status.

Section 1.27(f) is added to clarify the need to determine entitlement to small entity status prior to asserting small

entity status, and that the Office generally does not question assertions of entitlement to small entity status.

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

Sections 1.27(h)(1) and (2) are added to contain material transferred from former §§ 1.28(d)(1) and (d)(2) relating to fraud attempted or committed on the Office in regard to paying small entity fees. The material has been reformatted slightly to create §§ 1.27(h)(1)(i) and (ii), and §§ 1.27(h)(2)(i) and (ii).

Comment 12: Two comments state that the term "person" as proposed in § 1.9(f) (now transferred to § 1.27(a)(1)) is confusing. While person is defined in the first sentence as an inventor or other individual, the second sentence rather than using person uses inventor or other individual as if to imply that an inventor or individual who has transferred some rights is not a person within the meaning of § 1.27. This seems to be inconsistent with § 1.27(c) that qualifies "person" as a party entitled to small entity status even if an inventor has agreed to license rights in the invention to another small entity. It was suggested that the second sentence be deleted and combined with the first sentence. An additional argument was made that while it is understood that "person" was being used in the context of § 1.27 small entity rights, the normal legal definition of "person" includes corporations and the term is therefore broader than the use made of it in § 1.27. It was suggested that another word be used or the term "natural" be used as a modifier.

Response: The comments are not adopted. The use of "person" in the first sentence of § 1.27(a)(1) is intended to refer to those who can qualify for small entity status. That the second sentence starts with "[a]n inventor or other individual who has transferred some rights" is intentional in that it may be that such inventor or individual cannot qualify for small entity status if rights have been transferred to a party who cannot qualify for small entity status. It is intended under § 1.27(c) that an inventor who has transferred rights to another who can qualify shall not be disqualified from claiming small entity status whether an individual, small business or nonprofit organization. The use of two sentences enables the separation of two different concepts—where no transfer of rights has occurred, and where some transfer of rights has occurred. Use of the suggested

combined sentence may not make it clear to small entities that circumstances where there is no transfer of rights are included. Similarly, it is believed that the use of the term "person" without a modifier of "natural" would have the best opportunity for being understood by the target audience of § 1.27.

Comment 13: Several comments supported the proposed change to § 1.27, as well as to §§ 1.9 and 1.28.

Comment 14: Two comments opposed the ability to obtain small entity status based on payment of a small entity filing fee in § 1.27(c)(3) (proposed as § 1.27(b)(3)) maintaining that the entire procedure is now very complex and would not be understood by the great majority of practitioners and their support staffs and the Office support staff that must administer the program. It is believed that it is not too much to ask that someone seeking to claim small entity status make an affirmative statement regarding eligibility for such status. Although these procedures affect small entities to a greater extent, large entities are affected by the costs that would be associated with trying to implement a complex scheme of which small entities could not properly avail themselves.

Response: The comments are not adopted. Sixty percent of all refund requests that the Office handles are related to small entity status. As outlined in the proposed rulemaking and again in this final rule, small entities are having a very difficult time obtaining, in a timely manner, a benefit that they are clearly entitled to, particularly for *pro se* inventors. The amended rule will obviate many of the difficulties now encountered by small entities. The payment of an exact amount of small entity filing fee is seen to be just as much an affirmative act as the submission of a statement of entitlement, and is probably far clearer an act of intention to claim small entity status than resort only to wide variants of language inevitably submitted by *pro se* applicants that must then be interpreted by the Office. The Office will, however, endeavor to have applicants supply an actual statement of entitlement to small entity status by providing a check box for such (with a clear easily understood statement) on application transmittal forms.

Comment 15: One comment states that § 1.27(a)(4)(ii) (formerly § 1.9(f)(4)(ii)) is confusing because it states that a "license" to a Federal agency is not a "license" *per se*. Alternative language is suggested to clarify the section.

Response: The comment is adopted.

Comment 16: One comment suggested a further simplification by permitting any person authorized to act on behalf of the inventor/applicant to make an assertion of entitlement to small entity status. The Office should have an announced policy of not verifying whether the person making the assertion is in fact authorized with the burden resting with applicant that the person making the assertion is authorized to do so. The situations where a person would not be authorized are thought to be so rare as to justify the Office removing itself from determining proper authorization.

Response: The comment is not adopted. Sections 1.27(c)(2)(i) through (c)(2)(iii) identifies certain parties who can sign a written assertion of entitlement to small entity status. The parties, while not all encompassing, are nevertheless broadly defined and include all the parties who can reasonably be expected to desire to submit a written assertion. It is not seen that the Office should accept a written paper from a party not so included. Section 1.27(c)(3), as made final, permits any party (in addition to those parties defined in § 1.27(c)(2)) to pay the basic small entity filing fee and thereby assert entitlement to small entity status. If a need were to arise for some party other than those defined in § 1.27(c)(2) to assert small entity status, it would be expected to be close to the time of filing the application and when the filing fee needs to be paid. In such circumstances, any party could pay the small entity filing fee. To permit the acceptance of a paper by a third party with whatever statements both germane to small entity entitlement and whatever other matters might be raised therein would seem to be burdening applicants with unnecessary problems.

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

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

Section 1.28(b) is amended to set forth § 1.28(b)(1), defining the start date of the three-month refund period of § 1.28(a) to be the date that the full fee has been paid (transferred from former § 1.28(a)(1)), and § 1.28(b)(2), stating that the deficiency amount owed under § 1.28(c) is calculated by using the date on which the deficiency was paid in full (transferred from former § 1.28(c)).

Sections 1.28(b)(1) and (2) were proposed to be amended to refer to § 1.22(c) setting forth a definition of when a fee has been paid by the means

used to pay the fee, but will not be so amended as the proposed amendment to § 1.22(c) will not be made. The subject matter of proposed § 1.22(c), which proposed to set forth that the filing date for an authorization to charge fees starts the period for refunds under § 1.28(a) will, however, be given effect by internal instruction as of the effective date of the instant final rule and will be reflected in the MPEP. See the discussion of § 1.22, above. The previous time period for a refund request was two months from payment of the full fee. The date of payment for refund purposes varied depending on the means the applicant used to pay the required fee. For example, if the applicant paid the required fee by check, the date of payment was the date on which the fee paper, including the check, was filed in the Office. If the applicant authorized a charge to a deposit account, however, the date of payment was the date the Office debited the deposit account. In view of the change in practice that results in § 1.28(b)(1) according the same date of payment for checks and authorizations to charge deposit accounts, the refund period of § 1.28(a) is extended to three months. This will in part offset any shortening of the refund time period that may result from starting the time period as of the receipt (or §§ 1.8 or 1.10) date of the fee paper instead of the debit date for an authorization to charge a deposit account. Additionally, in view of changes in practice under § 1.27 to ease the claiming of small entity status, the need for refunds should diminish, and the different payment date of an authorization to charge a deposit account for small entity refund purposes should not cause much inconvenience to applicants.

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

In each of Fiscal Years 1999 and 2000, certain patent fees were reduced. See

Revision of Patent and Trademark Fees for Fiscal Year 2000, Final Rule, 64 FR 67774 (December 3, 1999), and *Revision of Patent Fees for Fiscal Year 1999*, Final Rule, 63 FR 67578 (December 8, 1998). Thus, a sentence was added in § 1.28(c)(2)(i) that requires a deficiency payment to be at least equal to the amount paid in error as a small entity and is also calculated as of the date the deficiency is paid in full. For example, the basic filing fee for a utility application was reduced from \$760 to \$690. Where the small entity basic filing fee had been improperly paid by submission of \$380 under the prior fee amount, if the error was determined and paid in full when the new amount is in effect, the balance owed at the date of payment in full would be \$380 (the amount that is at least equal to the amount paid in error and not \$310 (the new large entity amount of \$690—the small entity amount paid in error of \$380). (Note, for revival under § 1.137, if abandonment occurred for failure to pay a basic filing fee, the amount owed would be the fee in effect when the § 1.137 petition was filed and not the fee previously owed causing abandonment.).

Paragraph by Paragraph Analysis: The title of § 1.28 is revised in view of transfer of material to § 1.27 to focus on refunds and on how errors in status are excused.

Sections 1.28(a) through (c) are reformatted.

Section 1.28(a)(1) is amended as § 1.28(a).

Section 1.28(a) is amended to clarify that the period for a refund runs from payment of the “full fee,” and that it is the payment of the full fee that is considered the significant event relative to establishing status for a particular fee. Additionally, § 1.28(a) amends the time period for requesting a refund based upon later establishment of small entity status. The time period is three months measured from the date of the timely payment of the full fee.

Some subject matter in former § 1.28(a)(2) has been transferred to § 1.27(c)(4). The next to last sentence, relating to filing a continuing or reissue application and referencing a small entity statement in the prior application or patent, has been deleted as unnecessary. The formerly required reference to status in the prior application or patent is replaced by the equally easily written assertion of § 1.27(c)(4) in the related, continuing or reissue application. Written references to small entity status in a prior application, including submission of a copy of the small entity statement in a prior application, submitted in a

continuing application subsequent to the effective date of any final rule, will be liberally construed under § 1.27(c)(1)(iii). Similarly, the last sentence of current § 1.28(a)(2) is deleted as the payment option for establishing small entity status in continuing or reissue applications has been expanded in § 1.27(c)(3) to include all applications.

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

Example 1: A prior application has been accorded small entity status. A continued prosecution application (CPA) under § 1.53(d) is filed with a general authorization to charge fees that does not state that the fees to be charged are small entity fees. Even though the CPA contains the same application number as its prior application (and the small entity statement), it would not be accorded small entity status and large entity filing fees would be immediately charged. This would be so because a new determination of entitlement to small entity status must be made upon filing of a new application, such as a CPA. Accordingly, in filing the CPA there must be some affirmative act to indicate that the determination has been done anew and small entity status is still appropriate. Where a copy of the small entity statement from the prior application, or a written assertion in the CPA application transmittal letter, or an authorization to charge small entity fees was present, the result would be reversed and small entity status would be accorded the CPA application on filing.

Example 2: A request for continued examination under § 1.114 is not the filing of a new application and the application would retain any small entity status previously accorded without the need to do a new investigation or request status by written assertion or payment of an exact small entity § 1.17(e) fee.

The subject matter in former § 1.28(a)(3) has been transferred to § 1.27(e)(1).

Section 1.28(b) is amended to have its subject matter transferred to §§ 1.27(g)(1) and (2). New §§ 1.28(b)(1) and (b)(2) are added. Sections 1.28(b)(1) and (b)(2) were proposed to reference § 1.22(c) which was proposed to define the date that a fee was considered paid. In view of the decision not to go forward with the proposed change to § 1.22(c), the references to § 1.22(c) in §§ 1.28(b)(1) and (2) will not proceed.

Section 1.28(b)(1) defines the date a fee is paid for the purpose of starting the three-month period for refund. Former practice for authorizations to charge deposit accounts was to give benefit of the date that the deposit account was actually debited by the Office, which was a later time than when the paper

authorizing charge of the fee to a deposit account was filed with the Office. That practice is now changed, see discussion re § 1.22, and the change will be reflected in the MPEP. It is the date the fee paper is considered received in the Office, not the date of debit of the fee to a deposit account, that will start the three-month refund period.

Section 1.28(b)(2) states that the date when a deficiency payment, pursuant to § 1.28(c), is paid in full determines the amount of deficiency that is due.

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

Section 1.28(c) is amended to recite that separate submissions, including separate payments and itemizations, are required for any deficiency payment.

Section 1.28(c)(1) requires that a deficiency paper/itemization/submission be limited to one application or one patent file. Where, for example, the same set of facts has caused errors in payment in more than one application and/or patent file, a separate paper would need to be submitted in each file for which an error is to be excused.

Section 1.28(c)(2) requires that for each fee that was erroneously paid as a small entity, the deficiencies owed must be paid, and the payment of the deficiencies must be itemized. Section 1.28(c)(2)(i) provides in part where there has been a fee decrease, the deficiency owed is equal to the amount (previously) paid in error and not the difference between the amount (previously) paid in error and the new lower large entity fee. Section 1.28(c)(2)(ii) requires the following itemizations: the particular fee involved (e.g., basic filing fee, extension of time fee) (§ 1.28(c)(2)(ii)(A)), the small entity fee amount actually paid and when (for example, distinguishing between two one-month extension of time fees erroneously paid on two different dates) (§ 1.28(c)(2)(ii)(B)), the actual deficiency owed for each fee previously paid in error (§ 1.28(c)(2)(ii)(C)), and the total deficiency owed that is the sum of the individual deficiencies owed (§ 1.28(c)(2)(ii)(D)).

Section 1.28(c)(3) addresses the failure to comply with the separate submission, including separate payment

and itemization requirements of §§ 1.28(c)(1) and (c)(2). Section 1.28(c)(3), upon failure to comply, permits the Office at its option either to charge a processing fee (§ 1.17(i) is suitably amended) to process the paper or require compliance within a one-month non-extendable time period to avoid return of the paper.

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

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

Section 1.33(a) is amended to provide that in a patent application the applicant must, either in an application data sheet (§ 1.76), or in a clearly identifiable manner elsewhere, in any papers submitted with an application filing, specify a correspondence address to which the Office will send notices, letters and other communications relating to the application. It is now stated that where more than one correspondence address is specified, the Office would determine which one to establish as the correspondence address. This is intended to cover the situation where an unexecuted application is submitted with conflicting addresses, such as one correspondence address being given in the application transmittal letter, and a different one in an accompanying unexecuted § 1.63, or other similar situations. The determination of which of the conflicting correspondence addresses to use will be made on a case by case basis, to include such factors as: use of the correspondence address in the earliest of two unexecuted declarations submitted at different times, or if conflicting addresses appear in the same

declaration, use of the first correspondence address.

Section 1.33(a) requests the submission of a daytime telephone number of the party to whom correspondence is to be addressed. While business is to be conducted on the written record (§ 1.2), a daytime telephone number would be useful in initiating contact that could later be reduced to a writing. The phone number would be changeable by any party who could change the correspondence address. The term "registered" has been placed before the expression "attorney or agent" for clarification purposes. See also § 1.33(b) of this section and sections 1.34 and 1.36.

Section 1.33(a)(1) provides that any party filing the application and setting forth a correspondence address could later change the correspondence address provided that a § 1.63 oath/declaration by any of the inventors has not been submitted. The parties who may so change the correspondence address would include only the one inventor filing the application, even if more than one inventor was identified on the application transmittal letter. If two of three inventors filed the application, the two inventors filing the application would be needed to change the correspondence address. Additionally, any registered practitioner named in the application transmittal letter, or a person who has the authority to act on behalf of the party that will be the assignee (if the application was filed by the party that will be the assignee), could change the correspondence address. A registered practitioner named in a letterhead would not be sufficient, but rather a clear identification of the individual as being a representative would be required. A company (to whom the invention has been assigned, or to whom there is an obligation to assign the invention) who files an application, is permitted to designate the correspondence address, and to change the correspondence address, until such time as a (first) § 1.63 oath/declaration is filed. The mere filing of a § 1.63 oath/declaration that does not include a correspondence address does not affect any correspondence address previously established on filing of the application, or changed per § 1.63(a)(1), even if the application was filed by a company that is only a partial assignee. The expression "party that will be the assignee," rather than assignee, is used in that until a declaration is submitted, inventors have only been identified, and any attempted assignment, or partial assignment, cannot operate for Office purposes until the declaration is supplied. Hence, if the application

transmittal letter indicates that the application is being filed on behalf of XYZ company, with an assignment to be filed later, XYZ company would be allowed to change the correspondence address without resort to § 3.73(b) until an executed oath or declaration is filed, and with resort to § 3.73(b) after the oath or declaration is filed.

Section 1.33(a)(2) retains the current requirements for changing a correspondence address when a § 1.63 oath/declaration by any of the inventors has been filed. Where a correspondence address was set forth or changed pursuant to § 1.33(a)(1) (prior to the filing of a § 1.63 oath or declaration), that correspondence address remains in effect upon filing of a § 1.63 declaration and can then only be changed pursuant to § 1.33(a)(2).

Section 1.33(b) has been simplified to make it easier to understand who are appropriate parties to file papers, particularly in view of the change to § 3.71(b). The paragraph has also been amended to provide an exception for the filing of a written assertion of small entity status under § 1.27(c)(2)(ii). One of several inventors will now be able to sign a written assertion of small entity status and be an appropriate party to file such assertion/paper.

Section 1.33(b)(1) has the term "registered" placed before the expression "attorney or agent" for clarification purposes. See also § 1.33(a) and §§ 1.34 and 1.36.

Section 1.33(b)(3) is amended to add a reference to § 3.71.

Comment 17: One comment was received requesting that the ability to change the correspondence address not be keyed to the filing of a § 1.63 oath/declaration, especially when such oath/declaration is signed by less than all the inventors and when it may in no way involve the correspondence address. The flexibility to change the correspondence address established by § 1.33(a)(1) should remain until a party set forth in § 1.33(b), except § 1.33(b)(2), establishes a correspondence address.

Response: The comment is not adopted. Section 1.33(a)(1) increases the flexibility in changing a correspondence address. Such increased flexibility, however, should not extend past the time that applicants can reasonably be expected to set forth a correspondence address, such as when the inventors are named by the submission of an oath/declaration. The submission of the oath/declaration will not alter the current correspondence address of record unless the oath/declaration intentionally does so by identifying a correspondence address, or an accompanying paper to the oath/declaration does so. Upon

submission of the oath/declaration, the inventors are known for the first time and it is now their call as to the appropriate correspondence address absent intervention by the assignee of the entire right, title, and interest. It is inappropriate that once an oath/declaration is submitted, a practitioner without power of attorney or only one of the inventors can continue to change the correspondence address.

Section 1.34: Sections 1.34(a) and (b) are amended to incorporate a reference to § 1.31. Section 1.34(b) is amended to place the term “registered” before the expression “attorney or agent.” Unlike § 1.31, which provides for an applicant being represented by registered patent attorney or agent, former § 1.34(b) (and § 1.36) refers to an attorney or agent who represents an applicant. The Office of Enrollment and Discipline receives calls inquiring if § 1.34(b) (and § 1.36) explicitly or implicitly authorize unregistered attorneys to practice before the Office in view of the absence of the term “registered” in these sections, which is not the case. The amendments to §§ 1.34(a) and (b) (and § 1.36) bring §§ 1.34(a) and (b) (and § 1.36) into conformity with § 1.31, which permits an applicant to be represented by a registered attorney, or a registered agent, and clarifies that the attorney or agent referenced in §§ 1.34(a) and (b) (and § 1.36) is only the registered attorney or registered agent referenced in § 1.31. See also §§ 1.33(a) and (a)(1), and § 1.36.

Section 1.36: See the discussion relating to § 1.34.

Section 1.41: Section 1.41(a)(1) is amended to indicate that a paper including the processing fee set forth in § 1.17(i) is required for supplying or changing the name(s) of the inventor(s) where an oath or declaration prescribed in § 1.63 is not filed during pendency of a nonprovisional application, rather than a petition including a petition fee, for consistency with the amendment to § 1.17(i).

Section 1.41(a)(2) is amended to indicate that a paper including the processing fee set forth in § 1.17(q) is required for supplying or changing the name(s) of the inventor(s) where a cover sheet prescribed by § 1.51(c)(1) is not filed during the pendency of a provisional application, rather than a petition including a petition fee, for consistency with the amendment to § 1.17(q).

Section 1.41(a)(3) is amended to delete the language concerning an alphanumeric identifier, and to provide that the name, residence, and citizenship of each person believed to be an actual inventor should be provided when the application papers

pursuant to § 1.53(b) are filed without an oath or declaration, or the application papers pursuant to § 1.53(c) are filed without a cover sheet.

Section 1.41(a)(4) is added to set forth that the inventors who submitted an application under § 1.494 or § 1.495 are the inventors in the international application designating the United States and that the provisions of § 1.48(f)(1), whereby submission of an executed oath/declaration operates to change the inventorship, do not apply to applications entering the national stage.

Section 1.41(c) is amended by replacement of the term “file” with a recitation of physical or electronic delivery of the application to the Office. Section 1.41(c) permits any person authorized by the applicant to file a patent application in order to receive a filing date. The amendment clarifies that § 1.41(c) is intended to apply solely to the (physical or electronic) delivery of a patent application to the Office as opposed to being inclusive of acts preceding delivery of the application relating to drafting or otherwise preparing an application.

Comment 18: One comment opposed the change to § 1.41(a)(3). The comment noted that the Office gave no justification for the change deleting the instruction that an alphanumeric identifier should be supplied where no inventor’s name is being given. The change is believed to give the impression of reversing the practice of not requiring identification of inventors on filing of the application.

Response: The comment is not adopted. The availability of an alphanumeric identifier is no longer explicitly set forth as the Office much prefers that at least one inventor be identified, particularly to aid in the national security screening of applications. To the extent that the presence of the instruction would seem to encourage use of an identifier other than the inventors, it is desirable to eliminate it. There is, however, no intent on the part of the Office to reverse the current practice and ban the use of an identifier other than an inventor’s name. It is noted that where an inventor’s name is not supplied, some other identifier is usually present, such as an attorney docket number, and that may continue to be used as an identifier in the absence of an inventor’s name.

Comment 19: One comment opposed the change to § 1.41(a)(4) stating that it is unclear as to what the change means and that it would seem to preclude correction of the inventorship after an international application is filed.

Response: The comment is adopted in part as a clarifying parenthesis has been

added to the paragraph stating that § 1.48(f) does not apply. The intent of the change is not to preclude correction of inventorship in a 35 U.S.C. 371 national stage application, but to reflect that filing an international application signed by all applicants and publishing it locks in the naming of the inventors. Filing of a declaration does not reset the inventors as it does in national 35 U.S.C. 111 practice. Correction of inventorship for a national stage application can be done under the provisions of §§ 1.48(a) through (c).

Section 1.44: Section 1.44 is removed and reserved to eliminate the requirement that proof of the power or authority of the legal representative be recorded in the Office or filed in an application under §§ 1.42 or 1.43. Although proof of authority is no longer required to be submitted to the Office, applicants may wish to consider obtaining proof of authority of the legal representative and recording such a document with any assignment documents for record-keeping purposes. In order to make a patent application on behalf of a deceased or incapacitated inventor, the legal representative may now simply sign the § 1.63 oath or declaration (which includes the full name and citizenship of the deceased inventor as well as the residence and mailing address, if not provided on an application data sheet) as the legal representative of the particular inventor with the title “Legal Representative” placed under the signature. In other words, in a signature block containing the deceased or incapacitated inventor’s name, the legal representative will sign “for” the deceased or incapacitated inventor supplying the representative’s name and stating that he or she is the legal representative. In addition, the legal representative should provide his or her mailing address so that the Office can directly communicate with the legal representative if necessary. See § 1.64(b).

The deletion of the § 1.44 proof requirement for the legal representative of §§ 1.42 and 1.43 will be effective on the date of publication in the **Federal Register** with § 1.64 as to all pending papers under §§ 1.42 and 1.43 that have not had the proof requirement satisfied. If a requirement for proof of authority has been made by an examiner, the requirement can be satisfied by a reply referencing this final rule.

Section 1.47: Section 1.47 is amended to refer to “the fee set forth in § 1.17(h)” for consistency with the amendment to § 1.17(h) and (i). See discussion of the amendment to § 1.17. Section 1.47 is also amended to add a new § 1.47(c) providing that the Office will send

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

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

Sections 1.48(a) through (c) are amended to: Delete the recitation of “other than a reissue application” as such words are unnecessary in view of the indication in the title of the section that the section does not apply to reissue applications and the revision to § 1.48(a) (discussed below), to change “When” to “If,” and to add “nonprovisional” before “application” where it does not already appear.

Sections 1.48(a)(1) through (e)(1) are revised to replace the reference to a “petition” with a reference to a “request.” What is meant to be encompassed by the term “petition,” as it was used in the sections, may be better defined by the term “request.” The presence of “petition” formerly in the sections was misleading to the extent that it may indicate to applicants

that papers under this section have to be filed with the Office of Petitions when in fact amendments to correct the inventorship under § 1.48 are to be decided by the primary examiners in the Technology Centers and should be submitted there. See MPEP 1002.02(e). Where, however, the § 1.48 request is accompanied by a petition under § 1.183 seeking waiver of a requirement under § 1.48, both papers should be directed to the Office of Petitions.

The requirements for a statement formerly in §§ 1.48(a)(1), (c)(1), and (e)(1) are placed in §§ 1.48(a)(2), (c)(2), and (e)(2) and corresponding changes made in subsequent paragraphs.

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

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

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

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

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

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

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

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

Section 1.48(f)(1) is amended to reference § 1.497(d) for submission of an executed oath or declaration naming an inventive entity different from the inventive entity set forth in the international stage when entering the national stage under 35 U.S.C. 371 and § 1.494 or § 1.495.

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

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

Sections 1.48(a) through (i) are amended to have titles added to make locating the appropriate paragraph easier.

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

Section 1.52: The title of § 1.52 is amended to reflect the addition of § 1.52(e).

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

Section 1.52(a)(5) provides that for papers not in compliance with § 1.52(a)(1), that applicant must, within a set time period, provide appropriate substitute papers.

Section 1.52(b)(6) is being added to include optional paragraph numbering as a basis for the new amendment practice in § 1.121 and as an aid to transitioning into total electronic filing. The amended rule language sets forth a

procedure for numbering the paragraphs of the specification at the time of filing. This procedure will facilitate the entry of amendments by providing a more uniform method for identifying paragraphs in the specification to be amended, thus overcoming any differences created by word processor formatting and pagination variations.

The paragraph numbering procedure, in the interest of uniformity, encourages applicants to use four digit Arabic numerals enclosed within square brackets and including leading zeroes as the first element of the paragraph. The numbers and brackets should be highlighted in bold (*e.g.*, **[0001]**), and should appear as the first part of the paragraph immediately to the right of the left margin. Approximately four character spaces should follow the bracketed number before the beginning of the actual text of the paragraph.

A paragraph is defined as a distinct passage, or section, of the specification which has unity of meaning. A paragraph shall not contain headers or drawings, but may contain nontext elements such as tables, mathematical formulae, chemical structures, *etc.* The nontext elements shall not normally, by themselves, be considered as paragraphs but must always form part of the paragraph, either above, or around, the nontext elements, and should not be independently numbered. Any type of list, *e.g.*, a bulleted or numbered list, should be treated as part of the paragraph around or preceding the list, and should not be independently numbered. Paragraph (or section) headers, such as "Description of the Invention" or "Example 3," are not considered part of any paragraph and should not be numbered.

The procedure for paragraph numbering encourages applicants to use any method provided by existing word processing software to provide a number as the first element of the paragraph. Handwriting of paragraphs numbers while not encouraged will be permitted.

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

Section 1.52(b)(7) provides that where papers not in compliance with §§ 1.52(b)(1) through (b)(5) are submitted, the applicant, patent owner, or requester in a reexamination proceeding, after notice by the Office, must provide papers that do comply (§§ 1.52(b)(1) through (b)(5)) within a set time period in the notice.

Section 1.52(c) is amended to provide that: (1) alterations to the application papers must (rather than "should") be

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

Section 1.52(d) was proposed to provide separately for nonprovisional applications and provisional applications filed in a language other than English. The proposal was not carried forward in the instant rulemaking but will be treated in rulemaking relating to implementation of the eighteen-month publication provisions of the "American Inventors Protection Act of 1999." See *Changes to Implement Eighteen-Month Publication of Patent Applications*, Notice of Proposed Rulemaking, 65 FR 17046, 17964 (April 5, 2000), 1233 *Off. Gaz. Pat. Office* 121 (April 25, 2000).

Section 1.52(e) is amended to itemize the parts of the specification that may be submitted on a compact disc, and to specify that a compact disc (CD-ROM or CD-R) meeting ISO 9660 format standards with ASCII data files is the only acceptable archival electronic media for submissions. The Office indicated in the Notice of Proposed Rulemaking that submissions on microfiche placed a burden on the Office and the applicant. The Office indicated that it intended to accept archival electronic media. The burden of submitting and processing large biotechnology "Sequence Listing" submissions in paper form can also be avoided using archival electronic media. Large tables, common in the biotechnology arts but sometimes received in other technologies, are now also included among the items that may be submitted on acceptable compact discs. Note that these specifications do not apply to the computer readable form of Section 1.821(e), which is specified therein.

Section 1.52(e)(1) recites the three types of submissions that are acceptable on the compact disc format: (1) Computer listings; (2) nucleotide and/or amino acid "Sequence Listings"; and (3) large tables.

Section 1.52(e)(2) defines which compact disc formatted media the Office will accept for the listed submissions: compact disc—recordable (CD-Rs) and compact disc—read only memory (CD-ROMs).

Section 1.52(e)(3) set forth the standards that must be used in formatting the information on the compact discs: ASCII and ISO 9660. Section 1.52(e)(3) also discusses the packaging of the compact discs for submission to the Office, and the contents of the associated transmittal letter.

Section 1.52(e)(4) specifies that the two copies of each compact disc are required, how the two copies must be labeled, and how the Office will treat the compact discs if they are not indeed identical (Copy 1 will be used for processing.). Replacement copies are also discussed.

Section 1.52(e)(5) indicates how the material on the compact discs will be incorporated by reference into the specification, by way of a statement under § 1.77(b)(4). Section 1.52(e)(5) also provides that the Office may require that parts of the specification that were submitted on compact disc be resubmitted on paper. Only the paper portions of the application will, under our current procedures, be published, either as published applications or patents. The Office can thus require that certain information, such as related to an elected species, be submitted in the proper form (paper) to be printed.

Section 1.52(e)(6) indicates the information that shall be placed on the labels of the compact discs to help identify them.

Section 1.52(e)(7) indicates that if a file is unreadable, on the compact discs that we have received, the Office will treat that information as not having been received. Examples of the types of difficulties that render a file unreadable are given: non-standard formatting, computer viruses and defective media. The applicant is well advised to test that the compact disc can be read by a standard office computer and is compliant with Office requirements before submission.

Comment 20: One comment opposed §§ 1.52(a)(5) and (b)(7) as proposed in that the Office would be providing a service that was not requested and charging an open-ended fee.

Response: The comment has been adopted. The rule language has been modified to provide for the mailing of a notice of the noncompliance, which notice will require the applicant, patent owner, or requester in a reexamination proceeding to submit compliant papers in reply to the notice within the time period set in the notice. The proposed option, allowing the Office to prepare compliant papers for a fee, has not been adopted as final.

Comment 21: One comment suggested that sequence listing be exempted from the requirements of § 1.52(b)(2).

Response: The comment has been adopted. The computer readable form requirements of § 1.821(e) have not been modified and an exclusion placed in § 1.52(b)(2) for §§ 1.821–1.825.

Comment 22: The proposal to encourage the use of paragraph numbering first appeared in the Advance Notice in conjunction with the replacement paragraph concept as part of Topic 13, and was later carried forward in the Notice of Proposed Rulemaking as §§ 1.52(b)(6) and 1.121. Strenuous opposition was received to paragraph numbering as proposed where a substitute specification would be required for amendments to the specification in the absence of paragraph numbering. The proposal for paragraph numbering is viewed as burdensome and inconsistent with the requirements of other countries.

Response: The comments have been adopted in that the linkage to substitute specifications for amendments where paragraph numbering has not been utilized is dropped. Paragraph numbering has been retained as an option with no negative consequences if not utilized.

Comment 23: Some of the comments suggested identification of paragraphs under § 1.52(b)(6) by page and line number, rather than by paragraph numbering.

Response: This suggestion of requiring identification by page and line number could not be adopted and would, in fact, be unworkable as a transition into electronic filing since fixed pages do not exist in documents created on a computer. Page and line numbering are affected by font size, line spacing and formatting and can vary between different hardware and software components. Once each paragraph has been individually identified and tagged with a number, however, all future processing of the application, whether by paper or electronic version, may be done uniformly and accurately by both the Office and the applicant. For the time being, the concept of having applicants provide numbered paragraphs will be encouraged, although still optional.

Comment 24: One comment suggested that the paragraph numbering should be modified with the left digit in the first paragraph number being a “1.”

Response: While it was not stated why use of a “1” would be superior to the format suggested, the rule permits applicants to use any numbering system and does not require use of the form suggested in § 1.52(b)(6).

Comment 25: One comment, in addition to opposing the proposal under § 1.52(b)(6), suggested that implementation apply only to applications filed after publication of the final rule.

Response: The suggestion is inherently incorporated in the rule, in that paragraph numbering is both optional and can only be used when an application is first filed.

Comment 26: The comments regarding § 1.52(e), which were generally supportive of the rule, were concerned with the issues of alteration of the data and future readability of the electronic media.

Response: The issue of alteration and changes to the data are of great concern to the Office. Accordingly, the only electronic media that are permitted under the rule are limited to those that cannot be changed or erased. Compact Disc-Read-Write (CD-RW) media which can be erased and rewritten are not allowed under the amended rule since they do not satisfy this concern. Another concern with CD-RW media is compatibility with existing Office hardware since older CD-ROM drives may not be able to read CD-RW media. Similarly, the Office is limiting the data format to the International Standard ISO 9660 format containing ASCII data files which is supported by all of the major computer operating systems and hardware makers. In view of the media types and data formats selected, it is expected that the authenticity and reliability of Office records should be incontrovertible well into the future.

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

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

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

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

burdensome as petitions under § 1.53(e) in nonprovisional applications filed under § 1.53(b) or § 1.53(d). Therefore, it is appropriate to charge the petition fee set forth in § 1.17(h) for petitions under § 1.53(e) in applications filed under § 1.53(c), as well as for applications filed under § 1.53(b), or § 1.53(d).

Sections 1.53(f) and (g) are amended for clarity and to include a reference to "or reissue" in the paragraph heading to clarify that the provisions of § 1.53(f) apply to all nonprovisional applications, which include continuation, divisional, and continuation-in-part applications, as well as reissue applications and continued prosecution applications.

Section 1.53(f) is also amended to provide that if applicant does not pay one of either the basic filing fee or the processing and retention fee set forth in § 1.21(l) during the pendency of the application (rather than within one year of the mailing of a Notice to File Missing Parts of Application), the Office may dispose of the application. The former one-year period in § 1.53(f) for submitting the processing and retention fee confused applicants into believing that a continuing application could be filed anytime within that one-year period. This resulted in a lack of copendency (and the loss of benefits under 35 U.S.C. 120) when the prior application became abandoned for failure to timely reply to a Notice to File Missing Parts of Application and a "continuing" application was not filed until the end of the former one-year period in § 1.53(f) and after the expiration of the period for reply to the Notice to File Missing Parts of Application.

The new timeframe for submission of an application retention fee under § 1.53(f)(5) will be applicable to all applications filed on or after sixty days after the date of publication in the **Federal Register**.

Section 1.55: Section 1.55(a)(2)(iv) is amended to refer to "the processing fee set forth in § 1.17(i)" for consistency with the amendment to § 1.17(h) and (i). See discussion of the amendment to § 1.17.

Sections 1.55(a)(2)(i) through (iii) clarify the current Office practice concerning when the claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) must be filed. Specifically, § 1.55(a)(2)(i) clarifies current Office practice. In an application filed under 35 U.S.C. 111(a), the Office requires the claim for priority and the certified copy of the foreign application to be filed before a patent is granted. Section 1.55(a)(2)(ii) clarifies current Office practice. In an

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

Section 1.55(a)(2)(iv) provides that priority claims and documents may be submitted after payment of the issue fee but before the patent is granted (published), however, no further review by the Office other than placement in the application file will occur at that time.

Thus, it is now difficult for the Office to match a petition containing a priority claim or certified priority document filed after payment of the issue fee with an application file, and determine whether the applicant has met the conditions of 35 U.S.C. 119(a)-(d) to make the priority claim, before the date the application will issue as a patent. Nevertheless, it is also undesirable to prohibit applicants from filing a priority claim or certified priority document between the date the issue fee is paid and the date a patent is issued. Therefore, the Office will permit applicants to file a priority claim or certified priority document (with the processing fee set forth in § 1.17(i)) between the date the issue fee is paid and the date a patent is issued. The Office will, however, merely place such submission in the application file but will not attempt to determine whether the applicant has met the conditions of 35 U.S.C. 119(a)-(d) to make the priority claim nor include the priority claim information in the text of the patent. In such a situation, the patent will not contain the priority claim information. The patentee may request a certificate of correction under 35 U.S.C. 255 and § 1.323 and a determination of entitlement for such priority will be made after the patent is granted.

Comment 27: One comment requested that it be clarified that a claim of priority and documents filed after payment of the issue fee, but before the patent issues, will not be reviewed by the Office, and that a determination of priority entitlement will be made upon issuing a certificate of correction.

Response: The comment has been adopted and the proposed language of § 1.55(a)(2)(iv) modified.

Comment 28: Two comments have suggested that one fee of \$130 rather than two fees, one under § 1.55(a) and one under § 1.323, would be more appropriate. At least the Office should propose to reduce the § 1.55(a) fee in that the Office is no longer doing a substantive review. One of the comments suggested that a procedure should be set up to issue the certificate of correction (automatically) after the patent issues based on the previously received § 1.55(a) submission (rather than require patentee to send in a subsequent request for a certificate of correction).

Response: The comments are not adopted. Applicants may of course submit a § 1.323 certificate of correction at the same time the § 1.55(a) submission is submitted, but any procedure that would have the Office automatically later treat a § 1.55(a) submission as a certificate of correction is not workable. It is unlikely that a § 1.55(a) submission would be routinely recognized as triggering a need for the Office to issue a certificate of correction. Moreover, even if such recognition initially occurred when the § 1.55(a) submission were received, the required lapse of time between the § 1.55(a) submission and whatever time after publication that the certificate of correction would then be acted upon may cause the need to issue a certificate of correction to be overlooked. Both the processing of the § 1.55(a) submission and the § 1.323 submission generate significant costs for the Office, which costs must be recovered. A single fee would not be sufficient to recover the total cost for both treatment of the § 1.55(a) submission and the issuance of the § 1.323 certificate of correction. It should be recognized that "just placing" a paper in a file that is in line for printing is not as simple a process as the comments would indicate. Associating the paper with the file and replacing of the file in the printing queue for the contractor requires many steps by many individuals. The actual processing of the paper represents the most significant portion of the cost of the prior review process to evaluate the priority claim.

Comment 29: One comment suggested that the proposed change would negatively impact predictability of the effective filing date of issued patents where a request for a certificate of correction is not submitted. It is believed that it is better for the Office to continue to review the claims for priority submitted after payment of the issue fee rather than shift the burden to

anyone reviewing the file history where a certificate of correction has not been requested.

Response: The comment is not adopted. Absent issuance by the Office of a certificate of correction, patentee cannot rely upon a foreign priority date. While it is true that the public would not know whether patentee will ever file a certificate of correction to obtain a priority claim (there is no time limit under § 1.323), that was also true under previous practice. Even though previous practice permitted a determination of the right to priority before issuance, a patentee could request and the Office would issue a certificate of correction after issuance (recourse via reissue to correct the lack of a priority claim pursuant to *Brenner v. State of Israel*, 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968) was not required).

Comment 30: Two comments suggested that the Office consider a further rule change in regard to bypass applications (continuations of international applications filed under 35 U.S.C. 111(a) and claiming benefit of the international application under 35 U.S.C. 365(c), rather than as national stage applications) that would permit the use of a photocopy of the foreign priority document that has been sent by the International Bureau to the Office as a Designated or Elected Office under the PCT. It is argued that the statute does not specify who must make the certification and that therefore the certification can be made and was in fact made when the copy of the foreign application was prepared by WIPO (rather than the certification being made by country).

Response: The comments are not adopted. The photocopy received from the International Bureau does not constitute a certified copy (it is merely a photocopy of the priority application and is not certified by WIPO), and would not satisfy the provision that a certified copy be provided in applications filed under 35 U.S.C. 111(a). 35 U.S.C. 119(b) defines how a certified copy must be made, which requires that a statement be made by the foreign intellectual property authority in which the foreign application was filed. The procedure suggested by the comment would not meet this definition. In addition, the copy of the priority application communicated by the International Bureau is placed in a folder and is not assigned a U.S. application number unless the national stage is entered. Such folders are disposed of if the national stage is not entered. Therefore, such copies may not be available if needed later in the prosecution of a continuing application.

Accordingly, the priority documents in folders of international applications which have not entered the national stage may not be relied on.

Section 1.56: Section 1.56 is amended to add a new § 1.56(e) to provide that in any continuation-in-part application, the duty under § 1.56 includes the duty to disclose to the Office all information known to the person to be material to patentability which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application. Section 1.63(e) (second sentence) formerly required that the oath or declaration in a continuation-in-part application acknowledge that the duty under § 1.56 includes the duty to disclose to the Office all information known to the person to be material to patentability (as defined in § 1.56(b)) which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application. Thus, the examiner must object to an oath or declaration in a continuation-in-part that does not contain this statement. By amending § 1.56 to expressly provide that the duty under § 1.56 includes this duty, an acknowledgment of the duty of disclosure under § 1.56 is an acknowledgment of this duty in a continuation-in-part application, and an express statement to that effect in the oath or declaration will no longer be required (§ 1.63(e) is also amended by deletion of the second sentence).

Comment 31: Two comments stated that the purpose of the language, proposed to no longer be required in the § 1.63 oath/declaration, is to remind inventors who must sign the document of their duty in regard to continuation-in-part applications. The presence of such information in § 1.56 would not put on notice an inventor in the same manner as if it appeared in the oath/declaration.

Additionally, there does not appear to be more reason to add such a provision to § 1.56 since § 1.56 does not include other reminders about the duty of disclosure such as public use or sale, or, indeed, every other provision regarding a form of prior art.

Response: The comments are adopted to the limited extent indicated. Where a practitioner believes that there is an educational purpose to be served from the appearance of such language in an oath/declaration, the practitioner is free to provide the inventors an oath/declaration form that contains such language. Declarations that do not contain such an informational reminder,

however, will no longer be treated as informal with a new declaration required. In view of the expressed concern that the language should be present in a declaration, the Office will continue to supply § 1.63 forms containing the language being deleted as a § 1.63(e) requirement. The Office's Standard Declaration form (PTO/SB/01) will be modified to move the continuation-in-part language relating to information that became available between the filing date of a prior application and the filing date of an instant (continuing) application from page 2 to page 1. (The current placement of the continuation-in-part language on page 2 is in a portion of the Standard Declaration form that requires completion by the applicant as to continuing data. If such portion were not completed, it is unclear whether the averment concerning continuation-in-part applications actually serves any purpose. By placing the continuation-in-part language on page 1, where it would not be dependent on completion of a portion of the form relating to continuing data, the averment will automatically be made upon execution of the form).

Section 1.58: Section 1.58(b) is specifically added to provide for placing very large tables on archival electronic media rather than in a paper specification, with the additional requirement that the information, including chemical and mathematical symbols, be positioned to maintain their intended meaning. See, for example, §§ 1.96(c) and 1.821(c). Tables convey information by the arrangement of the data in the table: rows and columns must line up. Formulae also rely on character position for their meaning. Data must be submitted under the amended rule properly positioned, in ASCII encoding, with no proprietary formats allowed. Very limited special formatting characters are found in ASCII so that it is necessary for the information to be arranged using only ASCII characters in a manner that retains the spatial arrangement of the data. The intent is that the tables and formulae will display properly when viewed with a text viewer. Great care must be exercised in preparing any such tables since any amendments to correct lost formatting may convey previously undisclosed subject matter and be considered new matter.

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

Section 1.63: Section 1.63 is amended for clarity and simplicity. Specifically,

§ 1.63(a) is amended to provide that an oath or declaration filed under § 1.51(b)(2) as a part of a nonprovisional application must: (1) be executed (*i.e.*, signed) in accordance with either § 1.66 or § 1.68 (§ 1.63(a)(1)); (2) identify each inventor by full name (§ 1.63(a)(2)); (3) identify the country of citizenship of each inventor (§ 1.63(a)(3)); and (4) state that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought (§ 1.63(a)(4)). Section 1.63(a)(1) clarifies that there is no minimum age requirement for the person signing the oath or declaration, but rather that the person signing must be competent to understand what is being signed.

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

Section 1.63(c) provides that an applicant may provide identifying information either in an application data sheet (§ 1.76) or in the oath or declaration. Permitting applicants to provide such identifying information in an application data sheet (rather than in the oath or declaration) should result in: (1) an increase in the use of application data sheets; and (2) a decrease in the need for supplemental oaths or declarations (providing omitted information) for applications in which an application data sheet was submitted. Note: when one of the inventors needs to update information, such as residence, the single inventor is not a party authorized by § 1.33(b) to submit a paper. The inventor may complete a new data sheet relating only to information concerning that inventor, but it must be submitted by an appropriate party according to § 1.33(b). The amendment to § 1.63(c)(1) has replaced "post office address" with "mailing address" to avoid the confusion of some applicants who do not understand that the use of "post office address" was intended to mean

the "mailing address" (instead believing a post office box was required), which is seen as a plainer way of stating the requirement. The requirement for a mailing address is equivalent to the requirement for post office address, and therefore the same information supplied for the post office address may continue to be supplied for the mailing address (see also the discussion of § 1.76(a)(3)). Accordingly, information relating to where applicant normally receives mail is acceptable if identified under the prior § 1.63(a)(3) (that used the expression post office address) as the mailing address, or if identified under the current § 1.63(c)(1) (reciting mailing address) as the post office address.

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

Comment 32: One comment appears to object to a change made in § 1.63(c)(2) (replacing "post office address" with "mailing address") and apparently wishes to have "residence" further defined in the rule either in terms of city, and state, or foreign country, or not required at all. It is argued that terms such as residence are confusing to inventors based on the different types of geographic areas that exist throughout the world.

Response: The comments are not adopted. The change from "post office address" to "mailing address" was made in view of many queries relating that an inventor does not have a "post office box." As is recognized in the comment, residence has a variable identity depending on where one resides. It is not practical to attempt to identify the residence by rule language. Rather, the MPEP will continue to be relied upon for further definition, particularly as the Office believes it is desirable to retain a requirement that the inventor's residence be identified.

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

and shall also state the citizenship (pursuant to 35 U.S.C. 115 and 117), residence and mailing address of the legal representative.

The deletion of the § 1.44 proof requirement for the legal representative of §§ 1.42 and 1.43 will be effective on the date of publication in the **Federal Register** with § 1.64 as to all pending papers under §§ 1.42 and 1.43 that have not had the proof requirement satisfied.

Section 1.67: Section 1.67(a) is amended to create §§ 1.67(a)(1) through (a)(4). Section 1.67(a) is amended to refer to § 1.162. Deficiencies or inaccuracies in an oath or declaration may be corrected by a supplemental oath or declaration identifying the entire inventive entity. The oath or declaration must be signed: by all the inventors when the correction relates to all the inventors or (§§ 1.42, 1.43, or 1.47) applicants (§ 1.67(a)(1)), or by only those inventor(s) or (§§ 1.42, 1.43, or 1.47) applicant(s) to whom the correction relates (§ 1.67(a)(2)). A deficiency or inaccuracy relating to § 1.63(c) may also be corrected with an application data sheet (paragraph (a)(3)). Note: Section 1.67(a)(4) clarifies that the party signing the supplemental oath, declaration, or application data sheet may be someone other than the party who must submit the oath, declaration, or application data sheet pursuant to § 1.33(a)(2) and (b). Only those parties identified in §§ 1.33(a)(2) and (b) are those that may submit a paper notwithstanding who may sign the paper to be submitted. See Example 5.

Example 1: An application was filed with a § 1.63 declaration executed by inventors A–C. If it is later determined that the citizenship of inventor C was in error, a supplemental declaration identifying inventors A–C may be signed by C alone correcting C's citizenship and submitted pursuant to § 1.33.

Example 2: Same as example 1, but it is later determined that the § 1.56 clause was omitted. A new declaration would be required by each of inventors A–C with each declaration identifying the entire inventive entity. If separate declarations had been executed by each of the inventors and the § 1.56 clause had been omitted only by the declaration by B, then only B would need to execute a new declaration identifying the entire inventive entity.

Example 3: An application was filed by inventors A, B, and the legal representative of deceased inventor C. It is later determined that an error was made in the citizenship of C. A supplemental declaration identifying A and B as the inventors would be required to be signed by the legal representative of C alone correcting C's citizenship and submitted pursuant to § 1.33.

Example 4: An application is filed by inventors A and B with an executed declaration. If it is later determined that an error exists in the mailing address of B, either

a supplemental declaration may be signed by B and submitted pursuant to § 1.33(b), or an application data sheet pursuant to § 1.76 containing only a change in B's mailing address may be submitted pursuant to § 1.33(a)(2) (the supplemental application data sheet need contain no more than B's name and the (new) mailing address of B.

Example 5: Inventor C (of inventors A–C) seeks to correct his/her residence and completes a supplemental application data sheet. The sheet signed only by inventor C must be submitted by all inventors (*e.g.*, signing a cover letter), or by a registered practitioner acting on behalf of all the inventors.

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

Comment 33: Two comments requested: (1) identification of the “deficiencies or inaccuracies” present in an oath or declaration for which a supplemental oath or declaration may be submitted to correct, and (2) clarification as to what is intended by the language “an applicant other than the inventor” who may file a supplemental oath or declaration.

Response: The comments have been adopted. The language of § 1.67(a) has been amended to: (1) specify that the deficiencies or inaccuracies that may be corrected by a supplemental oath or declaration by fewer than all of the inventors are those deficiencies or inaccuracies that relate only to the inventor(s) or applicant making the supplemental oath or declaration, and (2) clarify that the applicants other than the inventor who may file a supplemental oath or declaration are applicants under §§ 1.42, 1.43, or § 1.47. The deficiencies or inaccuracies that may be corrected by the language of the supplemental oath or declaration rule include all information previously omitted or erroneously supplied by the inventors or applicants so long as all the parties to which the omission or error pertained make the supplemental oath or declaration.

Section 1.72: Section 1.72(a) is amended to state “[u]nless the title is supplied in an application data sheet (§ 1.76)” to clarify that the title is not

requested to be a heading on the first page of the specification if supplied in an application data sheet. Section 1.72(b) is amended to provide that “[t]he abstract in an application filed under 35 U.S.C. 111 may not exceed 150 words in length” to harmonize with PCT guidelines.

Comment 34: One comment requested that the title should still be required to be placed on the specification (rather than permitting it only in the application data sheet) so that the specification can be identified in the oath or declaration being executed by the inventors. The title on the application data sheet will not serve this important purpose.

Response: The comment is not adopted. The use of a title has never been a requirement (under the previous version of § 1.72 or the currently amended version). To the extent that practitioners feel an important identification purpose is served by supplying a title on the specification, they may continue to do so as the amended rule does not prohibit its presence on the specification even if it is supplied in the application data sheet. Section 1.77(b)(1) indicates that the title of the invention may be part of the specification whether or not it is supplied in the application data sheet of § 1.76. It should be noted that § 1.76(a) makes the application data sheet part of the application, and the presence of the title only on the application data sheet submitted with the specification can serve as an identification of the application for a later submitted oath or declaration under § 1.63.

Section 1.76: A new § 1.76 is added to provide for the voluntary inclusion of an application data sheet in provisional and nonprovisional applications. A guide to preparing an application data sheet (Patent Application Bibliographic Data Entry Format) can be found on the Office's Web site “<http://www.uspto.gov>” by clicking on “Patents” then in the “Applications” column, click on “PrintEFS.” In addition to an authorizing guide in two formats, there are also instructions for downloading the needed PrintEFS software, and frequently asked questions about this software.

Section 1.76(a) explains that: (1) an application data sheet is a sheet or set of sheets containing bibliographic data, which is arranged in a format specified by the Office; and (2) when an application data sheet is provided in a provisional or nonprovisional application, the application data sheet becomes part of the provisional or nonprovisional application. While the use of an application data sheet is

optional, the Office prefers its use to help facilitate the electronic capturing of this important data. The data that is suggested to be supplied by way of an application data sheet can also be provided otherwise (and the Office is considering providing an attachment form to the application transmittal form), but it is to applicant's advantage to submit the data via an application data sheet. To help ensure that the Office can, in fact, electronically capture the data, the Office specifies a particular format to be used (but does not provide an application data sheet paper form). Electronic capture of the information from the application data sheet coupled with automated entry into Office records is quicker and more accurate than the current practice of manually extracting the information from numerous documents in the application file.

Applicants benefit from their use of application data sheets as the Office will electronically capture the data provided by application data sheets and, in return, provide applicants with more accurate filing receipts and published applications. Electronic capture of the application data sheet information by scanning occurs at the same time that the application papers are scanned during initial processing. Accordingly, for applicant to obtain the maximum benefit from use of an application data sheet, it should be submitted with the application when it is filed. Application data sheets or supplemental application data sheets submitted after the application is filed will have their information captured by operators manually keying in the information from the application data sheets or supplemental application data sheets.

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

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

and 1.47) to apply for the patent on behalf of the inventor. The recitation of "mailing address" reflects the replacement of "post office address" with "mailing address" in § 1.63(c). What has been previously submitted to meet the requirement for a post office address may continue to be submitted to meet the requirement for a mailing address. The change in terminology is not a change in the type of information to be supplied but is an attempt to respond to applicants' confusion thinking post office address required them to have a post office box (see discussion related to § 1.63(c)(1) and Response to Comment 32, above).

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

Application information includes the title of the invention, a suggested classification by class and subclass, the Technology Center to which the subject matter of the invention is assigned, the total number of drawing sheets, a suggested drawing figure for publication (in a nonprovisional application), any docket number assigned to the application, and the type of application (e.g., utility, plant, design, reissue, provisional). Application information also includes whether the application discloses any significant part of the subject matter of an application under a secrecy order pursuant to § 5.2 of this chapter (see § 5.2(c)). For plant applications, application information also includes the Latin name of the genus and species of the plant claimed, as well as the variety denomination.

Although the submission of the information related to a suggested classification and Technology Center is desired for both provisional and nonprovisional applications, the Office shall not be bound to follow such information if submitted, as the Office shall continue to follow its present procedures for classifying and assigning new applications. Similarly for the suggested drawing figure, the Office may decide to print another figure on the front page of any patent issuing from the application.

Application information also includes information about provisional applications, particularly their class and subclass, and the Technology Center. The receipt by the Office of provisional applications is now up to around 70,000 per year. Provisional applications are not examined or even processed (e.g., having a class and subclass assigned or being forwarded to a Technology Center). Even though provisional applications are not examined, the

Technology Center and the class and subclass, if known to applicants, would be of benefit to the Office in giving an indication of where nonprovisional applications may be eventually received in the Office and their technologies so that the Office will be better able to plan for future workloads.

Section 1.76(b)(3) also requests that the plant patent applicant state the Latin name and the variety denomination for the plant claimed. The Latin name and the variety denomination of the claimed plant are usually included in the specification of the plant patent application, and will be included in any plant patent or plant patent application publication if included in an application data sheet or patent application. The Office, pursuant to the "International Convention for the Protection of New Varieties of Plants" (generally known by its French acronym as the UPOV convention), has been asked to compile a database of the plants patented and the database must include the Latin name and the variety denomination of each patented plant. Having this information in separate sections of the plant patent will make the process of compiling this database more efficient.

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

Domestic priority information includes the application number (series code and serial number), the filing date, the status (including patent number if available), and relationship of each application for which a benefit is claimed under 35 U.S.C. 119(e), 120, 121, or 365(c). Section 1.76(b)(5) states that providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120. While the patent rules of practice (§ 1.78(a)(2) or § 1.78(a)(4)) formerly required that this claim or specific reference be in the first line of the specification, the relevant patent statute is broader and only requires that a claim to the benefit of (specific reference to) a prior provisional (35 U.S.C. 119(e)(1)) or a prior nonprovisional (35 U.S.C. 120)

application be in the application which is making the priority claim. Since the application data sheet, if provided, is considered part of the application, the specific reference to an earlier filed provisional or nonprovisional application in the application data sheet satisfies the "specific reference" requirement of 35 U.S.C. 119(e)(1) or 120, and it also complies with § 1.78(a)(2) or § 1.78(a)(4) of this part, which sections are also correspondingly revised in this final rule to accept a specific reference in an application data sheet. Thus, a specific reference does not otherwise have to be made in the specification, such as in the first line of the specification. If continuity data is included in an application data sheet, but not in the first sentence of the specification, the continuity data to be set forth in the first line of the patent will be taken from the application data sheet. Section 1.76(b)(5) does not apply to provisional applications.

Foreign priority information includes the application number, country, and filing date of each foreign application for which priority is claimed, as well as any foreign application having a filing date before that of the application for which priority is claimed. Section 1.76(b)(6) states that providing this information in the application data sheet constitutes the claim for priority as required by 35 U.S.C. 119(b) and § 1.55(a). The patent statute (35 U.S.C. 119(b)) does not require that a claim to the benefit of a prior foreign application take any particular form. Section 1.76(b)(6) does not apply to provisional applications.

Section 1.76(c)(1) provides that supplemental application data sheets may be subsequently supplied prior to payment of the issue fee to either correct or update information in a previously submitted application data sheet, or an oath or declaration under §§ 1.63 or 1.67, except that inventorship changes are governed by § 1.48, correspondence changes are governed by § 1.33(a), and citizenship changes are governed by § 1.63 or § 1.67. Section 1.76(c)(2) provides that supplemental application data sheets should indicate the information that is being supplemented, and therefore they need not contain information previously supplied that has not changed. Submission of a supplemental application data sheet containing all the information previously supplied as well as new or updated information without identifying the changes would be harder for the Office to process as the supplemental application data sheets will not be scanned but captured manually.

Section 1.76(d) provides for resolution between inconsistencies between information that is supplied by both an application data sheet and the oath or declaration under §§ 1.63, or 1.67. Section 1.76(d)(1) provides that the latest submitted information will govern notwithstanding whether supplied by an application data sheet or by an oath or declaration under § 1.63, or § 1.67. Section 1.76(d)(2) provides that the information in the application data sheet will govern when the inconsistent information is supplied at the same time by a § 1.63 or § 1.67 oath or declaration. This is because the application data sheet (and not the oath or declaration) is intended as the means by which applicants will provide most information to the Office that will be captured by scanning to avoid manual input of data. The Office does not wish to check two documents (the application data sheet and the oath/declaration) for the same piece of information, or to automatically correct the data when the oath or declaration is inconsistent with the application data sheet. In the small number of instances where an oath or declaration under § 1.63 or § 1.67 has more accurate information than a concurrently supplied application data sheet (§ 1.76(d)(2)), a supplemental (corrected) application data sheet should be submitted to conform the information presented by the data sheets with the correct information in the oath or declaration (§ 1.76(d)(1)). Alternatively, an oath or declaration under §§ 1.63, 1.67 (§ 1.76(d)(1)), or a letter pursuant to § 1.33(b) can be used. (See also § 1.76(d)(4), below.)

For example, if an application is filed with an application data sheet improperly identifying the residence of one of the inventors, inventor B, and an executed § 1.63 declaration setting forth the correct but different residence of inventor B, the Office will capture the residence of inventor B found in the application data sheet as the residence of B, and include it in the filing receipt. If applicant desires correction of the residence, applicant should submit a supplemental application data sheet under § 1.76(c), with the name of inventor B and the corrected residence for inventor B.

For inconsistencies between an application data sheet and an oath or declaration under § 1.63 or § 1.67 exceptions are made by reference to § 1.76(d)(3) in §§ 1.76(d)(1) and (d)(2) for the naming of inventors (§ 1.41(a)(1)) and setting forth their citizenship (35 U.S.C. 115). If different inventors are listed on the application data sheet than are named in the oath or declaration for

the application, the inventors named in the oath or declaration are considered to be the inventors named in the patent application. Any change in the inventorship set forth in the oath or declaration under § 1.63 must be by way of petition under § 1.48(a) notwithstanding identification of the correct inventive entity in an application data sheet or supplemental application data sheet. Similarly, if the oath or declaration under § 1.63 incorrectly sets forth the citizenship of one of the inventors, that inventor must submit a § 1.67 supplemental oath or declaration with the correct citizenship notwithstanding the correct identification of the citizenship in an application data sheet or supplemental application data sheet.

Section 1.76(d)(4) clarifies the Office's intent to rely upon information supplied in the application data sheet over an oath or declaration even where the type of information supplied (citizenship, inventorship) is governed by the oath or declaration according to statute (35 U.S.C. 115) or other rule (§ 1.41(a)(1)). Where the oath or declaration under § 1.63 or § 1.67 contains the correct information regarding inventors or their citizenship and the application data sheet does not, even though the oath or declaration governs pursuant to § 1.76(d)(3), the information on the application data sheet must be corrected by submission of a request that the Office recapture the information and a supplemental application data sheet, or an oath or declaration under §§ 1.63 or 1.67, or a letter pursuant to § 1.33(b) showing the correct information.

For example, if an application is filed with an application data sheet correctly setting forth the citizenship of inventor B, and an executed § 1.63 declaration setting forth a different incorrect citizenship of inventor B, the Office will capture the citizenship of inventor B found in the application data sheet. Applicant, however, must submit a supplemental oath or declaration under § 1.67 by inventor B (a supplemental application data sheet or letter pursuant to § 1.33(b) cannot be used) setting forth the correct citizenship even though it appears correctly in the application data sheet. If, however, the error was one of residence, no change would be required (§ 1.76(d)(2)).

Nothing in § 1.76 is intended to change the practice in MPEP 201.03 regarding correction of a typographical or transliteration error in the spelling of an inventor's name whereby all that is required is notification of the error to the Office. Such notification should be done by filing an application data sheet or a supplemental data sheet, but may

continue to be done by filing a simple statement, such as by a practitioner, and a supplemental oath or declaration is not required.

Comment 35: One comment opposed the proposal if use of the optional data sheet by the public is being motivated by the Office's plans for some future electronic program.

Response: The comment is not adopted. The driver for the optional application data sheet is the expectation that once such information is supplied in a standard format the Office will currently be able to process the data more accurately. The benefits applicants will receive by its use is not dependent upon an electronic filing or an electronic file wrapper but will accrue both in the issuance of a more accurate filing receipt, and on publication of an application with fewer errors.

Comment 36: One comment suggested that the application data sheet provide an entry option for applicant to identify the appropriate Art Unit for examination of the application and that the Office honor such identification. There is apparently some concern that the Office will attempt to minimize the granting of patent term adjustment for delays in the 14 months to first Office action or other delays by assigning applications for examination to Art Units with entirely foreign technology but small docket loads.

Response: The suggestion to include additional information in the application data sheet is adopted, although an application data sheet format requesting such information may not be available when this rule becomes effective. The application data sheet is not a (paper) form but an electronic format provided to applicants by the Office. Since Office information systems are designed for information on the application data sheet to be arranged in a certain sequence, redesigning the electronic format is more labor intensive and expensive than redoing a paper form, and a revised application data sheet electronic format, which has a place for such information, will be made available in due course. The Office will accept such information if separately provided until the revised application data sheet format is made available.

Additionally, there is a distinction between permitting applicants to aid in identification of the appropriate Art Unit to examine the application and requiring the Office to always honor such identification/request, which could lead to misuse by some applicants as a means of forum shopping. Even when an applicant's identification of an Art Unit is appropriate, internal staffing/workload requirements may

dictate that the application be handled by another Art Unit qualified to do so, particularly where the art or claims encompass the areas of expertise of more than one Art Unit.

Section 1.77: Section 1.77(a) is separated into sections 1.77(a) and 1.77(b). New § 1.77(a) lists the order of the papers in a utility patent application, including the application data sheet (see § 1.76). New § 1.77(b) lists the order of the sections in the specification of a utility patent application. Former § 1.77(b) is redesignated as § 1.77(c). Section 1.77(b)(4), former § 1.77(a)(6), has been amended to provide for a description of the submissions of certain parts of the application on compact discs, and their incorporation by reference.

Section 1.78: Section 1.78(a)(2) is amended to provide that the specification must contain or be amended to contain a specific reference required by 35 U.S.C. 120 in the first sentence following the title, unless the reference is included in an application data sheet.

The ability under § 1.78(a)(2) to provide the specific reference under 35 U.S.C. 120 in the application data sheet of § 1.76 and not in the first sentence of the specification is effective on the date of publication in the **Federal Register**.

Section 1.78(a)(4) is amended to provide that the specification must contain or be amended to contain a specific reference required by 35 U.S.C. 119(e)(1) in the first sentence following the title, unless the reference is included in an application data sheet. See discussion of § 1.76(b)(5). Section 1.78(a)(4) is additionally amended by deletion of the term "copending" as a requirement for a nonprovisional application claiming priority to a provisional application in view of the "American Inventors Protection Act of 1999."

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

Section 1.84: Section 1.84 had been proposed to be extensively revised to remove provisions that were not necessary for reproducible drawings, although they did set forth standards for drawings that are easy to understand. For example, § 1.84(m), shading, was proposed to be deleted because shading is encouraged, but not required for drawings that are understandable and reproducible. After careful consideration of the many comments concerning drawings, it was decided not to pursue many of the proposed amendments. Most comments explained that quality drawings are necessary for understanding of the drawings and that § 1.84 should set high standards for

drawings. Accordingly, the amendments made to § 1.84 are largely either to conform with existing practice (*i.e.*, the elimination of the petition requirement for black and white photographs), or to clarify the rule (*e.g.*, color photographs must meet the requirements of both §§ 1.84(a)(2) and 1.84(b)(1)).

The resulting standards set forth in § 1.84 define conditions met by quality drawings, and applicants should be mindful of § 1.84 in submitting drawings to the Office. Applicants should submit quality drawings in order to ensure that any patent application publication or patent is printed with quality drawings. The Office's implementation of § 1.84 will include reviewing drawings to ensure that what has been submitted can be scanned and has no obvious errors, but will not include objecting to drawings merely because they could have been drawn more clearly or with more suitable views or shading.

Sections 1.84(a), (a)(2), (b)(1), and (b)(2) are amended to clarify that design applications are covered.

Section 1.84(a)(2) is amended to clarify that color drawings must be reproducible in black and white in the printed patent and that a petition (with petition fee) is required. The petition must show that color drawings are necessary for the understanding of the claimed invention.

Section 1.84(b)(1) is amended to eliminate the requirement for three copies of black and white photographs and a petition to accept such photographs. Section 1.84(b)(1) is also amended to specify that black and white photographs may be accepted where photographs are the only practical medium of illustrating the claimed invention and to give a list of examples when photographs are acceptable. For example, photographs or photomicrographs of electrophoresis gels, blots (*e.g.*, immunological, western, southern, and northern), autoradiographs, cell cultures (stained and unstained), histological tissue cross sections (stained and unstained), animals, plants, in vivo imaging, thin layer chromatography plates, crystalline structures, and, in a design patent application, ornamental effects, are acceptable. If photographs are submitted where the subject matter is capable of illustration by drawing, for example if a photograph of a syringe is submitted, the examiner may require a drawing.

Section 1.84(b)(2) is amended to clarify that both the requirements of §§ 1.84(a)(2) and 1.84(b)(1) must be met for color photographs to be acceptable.

Section 1.84(c) is amended to provide that identifying indicia should be

placed on the front of drawing sheets, in the top margin.

Section 1.84(j) is amended to provide that one of the views must be suitable for publication on the cover page of the printed patent as the illustration of the invention.

Section 1.84(k) is amended to clarify that indications such as "actual size" or "scale 1/2" on the drawings are not permitted since these lose their meaning with reproduction in a different format.

Section 1.84(o) has been reworded for clarity.

Section 1.84(y) contains text that was previously contained in § 1.84(x).

Comment 37: Many comments were received applauding the decision of the Office to publish utility and design patents with color drawings in color. Some of these comments, however, expressed concern that the standard for accepting color drawings or color photographs was not clear.

Response: The plans to publish design and utility applications with color drawings in color will not be pursued at this time in order to allow the Office's automation efforts to focus on implementation of the eighteen-month publication provisions of the "American Inventors Protection Act of 1999" and filing of applications electronically.

Comment 38: Many comments were received arguing against the proposed changes to § 1.84. The comments argued that the proposed changes would make drawings harder to understand, thereby decreasing the quality of patents, make examination more difficult, and make a patent harder to defend and understand. Several noted that low standards for patent drawings would result in loss of jobs for patent illustrators. Many other comments were received supporting the proposed changes, stating that the burden to submit quality drawings should be on the applicant and not the Office, and that the technical objections made by the Office are a waste of time.

Response: Section 1.84 has largely not been amended as proposed in order to have standards for quality drawings in one place and not spread out among the rules, the MPEP, and other materials. Although the Office has explained the requirements of quality drawings in § 1.84, this does not mean that the Office will require applicant to submit the best quality drawings possible. It is in applicant's interest that the drawings be of the best possible quality. Applicants will be informed by the Office when drawings (*e.g.*, informal drawings) are not of the normal publication standard. Accordingly, enforcement of § 1.84 will be limited to insisting upon drawings that are correct and reproducible.

Section 1.85: Sections 1.85(a) through (c) are amended to remove superfluous material.

Section 1.85(a) is amended to remove the discussion of strict enforcement of § 1.84 drawing requirements. See the discussion under § 1.84.

Section 1.85(c) is amended to make the period for filing corrected or formal drawings in reply to a Notice of Allowability a nonextendable period. Extensions under §§ 1.136(a) or (b) will no longer be permitted. Thus, the time period for submitting the issue fee and any corrected or new drawings will be uniform, three months from the Notice of Allowability. Any Notice of Allowability that is mailed under the former rule permitting an extension of time under § 1.136 may be replied to after the effective date of the instant amended rule with the use of a § 1.136 extension of time.

Elimination of the § 1.85(c) (and § 1.136) extension of time for filing corrected or formal drawings applies only where a Notice of Allowability requiring the corrected or formal drawing has been mailed on or after sixty days after publication in the **Federal Register**.

The Office is taking positive steps to make it easier for applicants to submit drawings which will be approved. See § 1.84 and the change to § 1.85(a). Therefore, the instances where formal drawings will be required when the application is allowable will be reduced because more drawings will be approved as submitted.

The elimination of extensions of time, it is hoped, will encourage applicants to submit drawings that can be approved as submitted. This will not only save applicants from paying for an extension of time to correct the drawings (and cause a possible loss of patent term adjustment, 35 U.S.C. 154), but will support eighteen-month publication of applications that is also instituted by recent statutory changes.

Comment 39: Two comments supported the change to the extension of time period. A few comments opposed the change. One comment thought it premature to eliminate the extension until such time as the Office achieves a goal of four weeks to publication from payment of the issue fee. At that point the Office could implement not by a rule change but by a statement on the notice of allowability. Even then extensions for cause under § 1.136(b) should be allowed as in some instances it will be impossible to meet the three-month deadline for good reasons. No corresponding benefit was seen for the change.

Response: The need to publish application drawings as required by eighteen-month publication of applications, rather than the need to publish quickly once the issue fee is paid, is a driver for the change. This coupled with the changes to § 1.84 will help ensure that there are very few drawings that still need correction at the time of allowance. Elimination of a need for extensions of time, which may result in loss of patent term, coupled with a uniform time frame for submission of both issue fee and drawing corrections will benefit applicants.

Comment 40: One comment urged that the change should be implemented so that requirements for corrections already into extensions of time on the date that the rule goes into effect should be grandfathered in.

Response: The comment is adopted. It is intended that the change only apply to requirements for corrections issued on or after the effective date of the rule.

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

Section 1.96: The Office indicated in the Notice of Proposed Rulemaking that the submission of computer program listings on microfiche placed a burden on applicants and the Office, and that it was considering changes to § 1.96 to permit machine readable computer program listings to be submitted on electronic media in lieu of microfiche. Section 1.96 is amended to provide for voluminous program listings containing over 300 lines of code to be submitted on archival electronic media instead of microfiche. Section 1.96(b) is amended to limit computer program listings that may be submitted as drawings or part of the specification to 300 lines or fewer, with each line comprising 72 or fewer characters.

Under § 1.96 as amended, any computer program listing may and all computer program listings over 300 lines in length (up to 72 characters per line) must be submitted as a computer program listing appendix on a compact disc pursuant to § 1.96(c) (subject to the “transitional” practice discussed below).

Computer program listings in compliance with former § 1.96 will be accepted until March 1, 2001. After that date, computer program listings must comply with revised § 1.96.

Section 1.96(c) is specifically amended to provide that a “computer program listing appendix” be submitted on a compact disc, as defined in § 1.52(e). The information submitted

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

Section 1.96(c) provides that the availability of the computer program will be directly analogous to that of the microfiche. A compact disc appendix will be stored in the file wrapper just as microfiche appendices are currently stored. § 1.96(c)(1) it is specified that multiple program listings may be placed on a single compact disc, but a separate compact disc is required for each application.

Section 1.96(c)(2) provides that the submission requirements are specified in § 1.52(e) and adds further requirements concerning the formatting of the “computer program listing appendix.”

Until March 1, 2001, the Office will continue to accept a computer program listing that complies with current § 1.96 provisions (*i.e.*, a computer program listing contained on ten or fewer sheets as drawings or part of the specification, or a “computer program listing appendix” on microfiche).

The amendments to §§ 1.96 and 1.821 *et seq.* (discussed below) for computer program listings and sequence listings will eliminate the need for submissions of hard to handle and reproduce microfiche computer program listings and voluminous paper sequence listings. To focus specifically on the Office’s difficult paper handling problem, and to simplify this project so it can be deployed in a short time span, only the computer program listings, large table information, and the nucleotide and/or amino acid sequences will be accepted in machine readable format. As the Office gains experience with this new electronic medium for submission, the use of it may expand, or be subsumed into other more flexible electronic submission methods.

Relationship to Office automation plans: These changes are the initial steps toward solutions to difficult Office paper-handling problems. The Office is

planning for voluntary full electronic submission of applications and related documents by fiscal year 2001. The changes in this final rule are an initial step in that direction, permitting certain application and related material to be submitted on an acceptable archival medium.

Comment 41: The comments (almost without exception) were supportive of this proposal. Comments specifically indicated that this proposal was "long overdue," and that the proposal should include provisional applications and other technologies, including chemical and manufacturing processes requiring precise computer control. The comments provided advice, including the concepts of safeguarding the information from alteration, of making the public access and examiner access easy and of assuring the submissions are readable in a nonproprietary format. The only negative comment was an expression of disbelief that the Office was equipped to handle electronic media submissions.

Response: The Office is amending § 1.96 to provide for voluminous program listings to be submitted on archival electronic media instead of microfiche.

Section 1.97: Sections 1.97(a) through (e), and (i) have been modified for purposes of grammar and consistency within the section.

Section 1.97(b)(1) has been amended to insert "other than an application under § 1.53(d)" to eliminate the three-month window for filing an information disclosure statement (IDS) in a continued prosecution application (CPA). Because of the streamlined processing for CPAs, it is expected that the examiner will issue an action on the merits before three months from the filing date. Under the former rule, should an examiner issue an action on the merits prior to three months from the filing date and an IDS was submitted after the Office action was mailed but within the three-month window, the examiner was required to redo the action to consider the IDS. A CPA is a continuing application, and, thus, applicant should have had ample opportunity to file an IDS. Note that § 1.103(b) now provides for a request of a three-month suspension of action upon filing of a CPA; thus, in an unusual instance where a need to file an IDS newly arises, applicant can request the three-month suspension based upon that need. In view of the above, it is appropriate to require that any IDS be filed before filing the CPA, or concurrently with the filing of the CPA.

Section 1.97(b)(1) applies to all continued prosecution applications

under § 1.53(d) filed on or after 60 days from publication of this final rule in the **Federal Register**.

Section 1.97(b)(3) has been amended to delete unassociated text. The phrase "whichever event occurs last" appeared at the end of § 1.97(b)(3), and thus it physically appeared to apply only to § 1.97(b)(3). In reality, "whichever event occurs last" should be associated with each of §§ 1.97(b)(1), (b)(2), and (b)(3). Accordingly, "whichever event occurs last" has been deleted from § 1.97(b)(3), and "within any one of the following time periods" has been added in § 1.97(b). This eliminates the unassociated text "whichever event occurs last" from § 1.97(b)(3), while, at the same time, making it clear that the IDS will be entered if it is filed within any of the time periods of §§ 1.97(b)(1), (b)(2), (b)(3) or (b)(4).

As the filing of a RCE under § 1.114 is not the filing of an application, but merely continuation of the prosecution in the current application, § 1.97(b)(4) does not provide a three-month window for submitting an IDS after the filing of a request for continued examination.

Section 1.97(c) is amended in conformance with paragraph (b) to delete "whichever occurs first." Additionally, § 1.97(c) is amended to include, in addition to a final action under § 1.113 and a notice of allowance under § 1.311, other Office actions which close prosecution in the application. This would typically occur when an Office action under *Ex parte Quayle*, 1935 Dec. Comm'r Pat. 11 (Comm'r Pat. 1935), is issued. No reason is seen for including only two of the types of actions which close prosecution (§§ 1.113, and 1.311), while not including other types.

The fee for a § 1.97(c)(2) submission has been lowered from \$240 to \$180, see § 1.17(p) and the discussion of the change to the fee for submissions under § 1.97(d). The new fee for § 1.97(c) IDS submissions applies to any IDS filed on or after two months from the date of publication in the **Federal Register**.

Section 1.97(d)(2) has been deleted in its entirety to remove all reference to the filing of a petition and the associated petition fee of \$130. A petition unduly complicates the matter, while there is really no issue to be decided other than the entry of the IDS, and this issue of entry is ordinarily decided by the patent examiner without the need for a petition. Section 1.97(d)(2) simply requires (for an IDS submitted after the close of prosecution and before payment of the issue fee) the combination of the IDS fee (in § 1.17(p)) and the statement as is specified in § 1.97(e).

Consistent with the change to the fee required by § 1.97(c), the fee referred to in § 1.97(d) has been changed from a petition fee of \$130 to a submission fee of \$180, see § 1.17(p). The Office has reevaluated the processing of submissions under §§ 1.97(c) and (d) and determined that the steps and costs involved are so similar that charging different fees was not necessary. The average cost of processing the submissions was determined to be \$180, which fee is required for submissions under either § 1.97(c) or § 1.97(d), see § 1.17(p). The new fee for § 1.97(d) IDS submissions applies to any IDS filed on or after two months from the date of publication in the **Federal Register**.

The material in former § 1.97(d)(3) is now in § 1.97(d)(2), in view of the deletion of former § 1.97(d)(2), and is amended to delete reference to the fee as a petition fee under § 1.17(i) and instead make reference to the fee as an IDS fee under § 1.17(p).

Section 1.97(e)(1) is amended to specify that an item first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the IDS is entitled to special consideration for entry into the record. An item first cited by a foreign patent office (for example) a year before the filing of the IDS in a communication from that foreign patent office, which item is once again cited by another foreign patent office within three months prior to the filing of the IDS in the Office, is not entitled to special consideration for entry, since applicant was aware of the item a year ago, yet did not submit that item. Similarly, a document cited in an examination report cannot support timely submission where the document was first previously cited more than three months previously in a search report from the same foreign office. The term "a" was replaced with the term "any" (in the second line of § 1.97(e)(1)) to make the distinction clear.

Section 1.97(i) is amended to delete "filed before the grant of a patent." This phrase is surplusage since there can be no information disclosure statement after the grant of the patent. A submission of information items after the patent grant is a "prior art citation" which is made, and treated, under § 1.501. Section 1.97(i) is also amended to make it a little clearer that both §§ 1.97 and 1.98 must be complied with to obtain consideration of an IDS (by the Office), and to change § 1.97(i) plural recitation of information disclosure statements to a singular recitation, which would be in conformance with the rest of § 1.97.

Comment 42: One comment opposed the elimination of the three-month window to file an IDS in a CPA under § 1.97(b)(1) and the charging of a fee to obtain the three-month suspension of action under § 1.103. It was suggested that no fee should be charged for the suspension request, or a lower CPA filing fee should offset the suspension fee. It was felt that there is no rational basis to require applicants to pay an additional fee simply to have the CPA obtain the same benefits (*i.e.*, the ability to file an IDS without fee during the first three-month period) as a non-CPA filing, since the full application fee is already required for the CPA filing.

Response: The proposal to amend § 1.103 was not proceeded with in this final rule, but has been included in the final rule to implement request for continued examination practice (the final rule resulting from *Changes to Application Examination and Provisional Application Practice*, Interim Rule, 65 FR 14865 (March 20, 2000), 1233 *Off. Gaz. Pat. Office* 47 (April 11, 2000)). The comment has been treated in that final rule.

Comment 43: Some comments believed that the Office has not justified raising the cost for submission of an IDS under § 1.97(d) and opposed the amendment. The previous higher fee for earlier submission was intended as an inducement to submit the IDS earlier, while the lower fee for later submission existed because an applicant must be able to certify that the art cited in the IDS is being promptly made of record. A request was made for information on the percentage of time prosecution is reopened when art was considered after final determination.

Response: The comment relating to cost justification has been adopted and the cost for submission has been reevaluated. The only factor in determining IDS submission fees is cost to the Office to process the submissions. The Office has accordingly reevaluated the cost for processing both §§ 1.97(c) and (d) fees and has determined that the appropriate cost recovery fee should be the same for both and the fee amount should be \$180.

Comment 44: One comment requested clarification of the amendment to § 1.97(e)(1). It was not clear whether the requirement of "first cited" refers to a citation by the foreign patent office that cites the information in an official action, or refers to the citation by any patent office in a counterpart application. For example, if a patent is cited in a German Office action, and it is the first time that the patent is cited in that application, but the same patent was previously cited in a Japanese

counterpart application, could the item of information be cited as the first citation in a communication from the German Patent Office? Unless the German citation could be used as the first citation, the coordination of citations among a plurality of foreign applications would create a very significant administrative burden on applicants and their representatives.

Response: The comment is adopted to the extent that § 1.97(e)(1) has been amended to make clear that the German citation could not be relied upon as the first citation. The term "a" was replaced with the term "any" (as noted in the discussion under § 1.97(e)(1)). The amendment to the rule is a clarification and does not represent a change in practice. The intent of the rule is to encourage IDS disclosures as early in the prosecution as is possible and in particular before payment of the issue fee.

Comment 45: One comment noted that the change discussed in the preamble of the notice of proposed rule changes for § 1.97(i) was not reflected in the rule language portion of the notice. Section 1.97(i) was not presented in the rule language.

Response: The language representing the clarifications discussed but not presented for § 1.97(i) has been placed in the rule language.

Section 1.98: The Office has gone forward, at the present time, with only one aspect of the plan for information disclosure statement (IDS) revision that was set forth in the Advance Notice: the proposal to require that an IDS include a legible copy of each cited pending U.S. application or that portion of the application which caused it to be listed including any claims directed to that portion. The IDS rules are also being revised for consistency and grammar, and to tie up a number of loose ends, as will be discussed below.

Other than the proposed requirement for a copy of each cited U.S. application, the IDS proposals as set forth in Topics 9 and 10 of the Advance Notice were withdrawn in the Notice of Proposed Rulemaking. Accordingly, there is no proposal at this time for a statement of personal review or for a unique description as were called for in the Advance Notice, and the number of citations that may be submitted is not presently limited. The Office issued a notice of hearing and request for public comments to obtain views of the public on issues associated with the identification and consideration of prior art during patentability determinations. *See Notice of Public Hearing and Request for Comments on Issues Related to the Identification of Prior Art During*

the Examination of a Patent Application, Notice of Hearing and Request for Public Comments, 64 FR 28803 (May 27, 1999), 1223 *Off. Gaz. Pat. Office* 91 (June 15, 1999). Pursuant to that notice, the Office held public hearings on June 28, 1999, and July 14, 1999, on the issues. These prior art issues are related to the changes presently being considered by the Office, independent of the instant final rule, to impose requirements/limits on IDS submissions in § 1.98 and in § 1.56. Thus, it would be premature to go forward with a comprehensive new IDS alternative until the results of the hearings and comments submitted in response to the notice have been appropriately evaluated. It is contemplated that any new IDS/§ 1.56 alternatives will be advanced in a future rulemaking.

The specifics of the current revisions to § 1.98 will now be discussed. The discussion will include the changes proposed in the Notice of Proposed Rulemaking, in addition to the application copy requirement that was also present in the Advance Notice of Proposed Rulemaking.

Sections 1.98(a) through (d) are amended for purposes of clarity.

Section 1.98(a)(2)(iii) is amended to be directed solely to a new requirement: For each pending U.S. application citation listed in an IDS, applicant must submit either a copy of the application specification, including the claims, and any drawing of the application, or as a minimum, the portion of the application which caused it to be listed, including any claims directed to the portion which caused it to be listed. The Office noted, in the Advance Notice (and in the Notice of Proposed Rulemaking), its concern that current § 1.98 does not require applicant to supply copies of U.S. application citations. It was pointed out that there is a real burden on the examiner to locate and copy one or more pending applications, thus delaying the examination of the application being examined (in which the U.S. application citation is made). Further, copying a cited pending application has the potential for interfering with the processing and examination of the cited application. This revision would, additionally, be a benefit to the public since the copy of the application would be readily available upon issuance of the application as a patent. Additionally, § 1.98(a)(2)(iv) has been added to contain some material removed by the change to § 1.98(a)(2)(iii). To the extent that the cited pending application represents proprietary information which applicant does not wish to be

publicly available once the patent issues, applicant may submit, prior to issue, a petition that it be expunged pursuant to § 1.59(b).

Sections 1.98(a)(3) and (b) were amended to create subparagraphs.

Section 1.98(b) was further amended to set forth the required identification for listed U.S. applications, to change "shall" to "must," to require in § 1.98(b)(1) identification of the "inventor" rather than of the "patentee" (to conform to the language of § 1.98(b)(2)), and to require in § 1.98(b)(4) identification of the "publisher."

Section 1.98(c) was amended to move the last sentence to § 1.98(a)(3)(ii).

Section 1.98(d) provides that copies of information cited in an IDS are required to be supplied to the Office with the IDS even if such copies had been previously supplied to the Office in an IDS submission in an earlier application, unless excepted under §§ 1.98(d)(1) and (2) relating to a continuing application.

Section 1.98(d)(1) states the requirement that the prior application must be relied on for a benefit claim under 35 U.S.C. 120 and that the earlier application must be properly identified in the IDS.

Section 1.98(d)(2) states that the IDS submitted in the prior application must comply with §§ 1.98(a) through (c) as amended in this notice.

Therefore, in an IDS, filed on or after the effective date of this rule, which cites a pending U.S. application, a copy of that pending application (or the portion of the application which caused it to be listed, including any claims directed to that portion) must be submitted unless:

1. The application for which the IDS was submitted claims benefit to an earlier application under 35 U.S.C. 120 and that earlier application is properly identified in the IDS; and

2. The earlier application cites, and has a copy of, the same pending U.S. application (or the portion of the application which caused it to be listed, including any claims directed to that portion).

Example 1: Application A has an IDS statement which cites pending U.S. application X. This IDS was filed prior to the effective date of the rule change to § 1.98, and applicants did not submit a copy of pending U.S. application X (as they were not required to under former § 1.98(d)). Application B is filed as a continuing application of Application A. In Application B, applicants file an IDS after the effective date of the rule change, in which the IDS lists the same pending U.S. application (*i.e.*, application X) and refers to Application A. Applicants fail to submit a copy of pending U.S. application X with the IDS filed in Application B. The

examiner will not consider pending U.S. application X during the examination of Application B since the IDS does not comply with § 1.98(a)(2)(iii). Applicants must submit a copy of pending U.S. application X in order to ensure that pending U.S. application X is considered by the examiner.

Example 2: Application C cites, and has a copy of, pending U.S. application Y. Application D is filed and claims the benefit of Application C under 35 U.S.C. 120. In Application D, applicants file an IDS, which lists the same pending U.S. application Y and refers to Application C, after the effective date of the rule change. Applicants fail to submit a copy of pending U.S. application Y. The examiner will consider pending U.S. application Y during examination of Application D, since a copy of pending U.S. application Y is not required under § 1.98(d).

This amendment to §§ 1.98(d), (d)(1), and (d)(2) is applicable to all IDS submissions filed on or after the effective date of this rule.

Comment 46: While some comments supported the amendment, others did not. It is argued that submissions of cited applications are relatively rare, and the Office's justification is based on false presumptions that the cited application file is routinely copied or that the examiner must have a copy rather than simply review the (cited) application as is done for references in a subclass. Additional arguments against the amendment are: (a) There is no guarantee that pending cited applications would be expunged from the file in which it is being cited prior to issuance of a patent, (b) it creates a significant burden to applicants and very large paper files in the PTO, (c) most pending applications will soon be available to the examiner in electronic form thus rendering the problem moot, and (d) it violates the confidentiality of 35 U.S.C. 122. It is also argued that as there is no requirement to submit a copy of an application that is cited under Cross Reference to Related Applications, there is no reason to have a different standard where the same application is cited under § 1.98. One suggestion supporting the amendment thought that applicants should be required to submit a copy of the prior art that was submitted in the cited application as well as the copy of the cited application. One comment in support of the amendment noted that the burden on applicants was minor compared to the benefit to examiners during prosecution and to the public after the application issues in obtaining papers and reducing risk of lost and misplaced papers.

Response: The comments opposing the amendment are not adopted. It is the Office's belief that it is faster access to the cited application and faster examination of the application having

the cite, and not the frequency of such application citations, that is determinative. Additionally, supplying a copy of the cited application to the examiner prevents, in most cases, the need to disrupt examination of the cited application. Even where a cited application might not be copied by the examiner, if a copy of the cited application were not supplied, there would still be significant disruption to examination of the cited application, since the examiner would need to obtain the file and usually remove it so that it could be studied in the examiner's office. A cited application is more analogous, not to the totality of references in the search files that an examiner reviews on site, but to the references that the examiner removes from the search file to study further in the examiner's office. An applicant concerned with nondisclosure of the cited application has recourse to § 1.59 expungement provided that the cited application is deemed by the Office to not be material to the examination of the application in which it is cited. On balance, when weighing the burden on applicants to produce a copy versus the Office's need to examine both the application in which another application is cited and the cited application expeditiously, it is believed that the amendment is appropriate. When electronic copies of applications become available to the examiners, the issue will be reconsidered. To the extent that applicants are concerned about supplying a copy of an application cited in an IDS, applicants may refer to the "cited" application in the specification of the "examined" application, rather than by IDS submission and would then not need to supply a copy of the referred to application; however, the Office does not review an application referred to in the specification in the same light as it does a specific IDS citation of the application with a copy supplied. For example, references in the specification may only be for purposes of supplying background information as opposed to utilizing an IDS to comply with a duty of disclosure under § 1.56.

Comment 47: One comment opposed the requirement in § 1.98(b)(2) that each listed U.S. application be identified by the inventor, application number, and filing date, as such information can be easily obtained from PALM. It was suggested that the first named inventor or identification number be used.

Response: The comment is not adopted. The burden to supply the required information is slight, and there is no need to require examiners to look the information up under PALM. Additionally, if only one piece of

information is supplied, e.g., application number, any error in the information would significantly delay identification of the application being cited.

Comment 48: One comment suggested that the change to § 1.98(d) adds a great deal of complexity for very little benefit, particularly as the examiners should be considering the prosecution history, which is independent of whether the IDS in the prior application complied with § 1.97. Additionally, there is no justification to apply § 1.98(d)(2) retroactively.

Response: The comment has been adopted. The proposed required compliance with § 1.97 for the IDS in the prior application has not been carried forward in the final rule. It is also the intent of the Office, as stated in the preamble to the instant final rule, not to apply § 1.98(d)(2) retroactively.

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

Section 1.103: The proposal to amend § 1.103 was not proceeded with in this final rule, but has been included in the final rule to implement request for continued examination practice (the final rule resulting from *Changes to Application Examination and Provisional Application Practice*, Interim Rule, 65 FR 14865 (March 20, 2000), 1233 *Off. Gaz. Pat. Office* 47 (April 11, 2000)). The comments on the proposed amendment to § 1.103 have been treated in that final rule.

Section 1.104: Section 1.104(a)(2) (second sentence) is amended to add the phrase “in an Office action” to provide basis for the phrase “Office action” in §§ 1.111(a), (b), and 1.115(a).

Section 1.104(e) has been revised by deleting the last sentence thereof. The last sentence previously stated:

Failure to file such a statement does not give rise to any implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the examiner.

This statement of the rule is inconsistent with recent decisions by the United States Supreme Court (Supreme Court) and the United States Court of Appeals for the Federal Circuit (Federal Circuit), which highlight the crucial role a prosecution history plays in determining the validity and scope of a patent. See e.g., *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 41 USPQ2d 1865 (1997); *Markman v. Westview Instruments*, 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995), aff'd 517 U.S. 320, 38 USPQ2d 1461 (1996);

Vitronics Corp. v. Conceptronic Inc., 90 F.3d 1576, 39 USPQ2d 1573 (Fed. Cir. 1996). The examiner's statement of reasons for allowance is an important source of prosecution file history. See for example *Zenith Labs., Inc. v. Bristol-Myers Squibb Co.*, 19 F.3d 1418, 30 USPQ2d 1285 (Fed. Cir. 1996), which references MPEP 1302.14 to this effect (Footnote 7 of the case).

In view of the recent case law dealing with prosecution history, the failure of an applicant to comment on damaging reasons for allowance would give rise to a presumption of acquiescence to those reasons, and the negative inferences that flow therefrom. Accordingly, the statement in the rule that failure to file comments on reasons for allowance does not give rise to any implication that an applicant (or patent owner) agrees with or acquiesces in the reasoning of the examiner is obsolete and out of step with recent case law. The deletion of this statement from the rule should require applicant to set forth his or her position in the file if he or she disagrees with the examiner's reasons for allowance, or be subject to inferences or presumptions to be determined on a case-by-case basis by a court reviewing the patent, the Office examining the patent in a reissue or reexamination proceeding, the Board of Patent Appeals and Interferences reviewing the patent in an interference proceeding, etc.

That the examiner does not respond to a statement by the applicant commenting on reasons for allowance does not mean that the examiner agrees with or acquiesces in the reasoning of such statement. While the Office may review and comment upon such a submission, the Office has no obligation to do so.

This revision of § 1.104(e) does not provide any new policy, but rather tracks the state of the case law established in the decisions of the Supreme Court and the Federal Circuit.

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

Section 1.105(a)(1) provides examiners or other Office employees explicit authority to require submission, from individuals identified under § 1.56(c) or any assignee, of such information as may be reasonably necessary for the Office to properly examine or treat a matter being addressed in an application filed under 35 U.S.C. 111 or 371, in a patent, or in a reexamination proceeding. The examples given that contain specific references in §§ 1.105(a)(1)(i), (iii), and

(vii) to inventors, and in § 1.105(a)(2) to assignees who have exercised their right to prosecute under § 3.71 are not intended to limit the scope of general applicability for all individuals identified in § 1.56(c). Abandoned applications also fall within the scope of the rule to provide for handling of petition matters. New § 1.105 is simply an explicit recitation of inherent authority that exists pursuant to 35 U.S.C. 131 and 132, and continues the practice of providing explicit authority to Office employees as was done with the Board of Patent Appeals and Interferences under § 1.196(d) and with trademark examiners under § 2.61.

The explicit authority of the examiner under § 1.105 to require such information as may be reasonably necessary to properly examine an application or treat a matter therein will be effective for any Office action written on or after the date that is sixty days after the date of publication in the **Federal Register**.

The inherent authority of the Office to require applicants to reply to requirements for information under 35 U.S.C. 131 and 132 was made explicit in § 1.105(a)(1) to encourage its use by Office employees so that the Office can perform the best quality examination possible. The authority is not intended to be used by examiners without a reasonable basis, but to address legitimate concerns that may arise during the examination of an application or consideration of some matter.

Sections 1.105(a)(1)(i) through (a)(1)(vii) identify examples of the types of information that may be required to be submitted. Section 1.105(a)(1)(i) relates to the existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention. Section 1.105(a)(1)(ii) relates to whether a search was made, and if so, what was searched. Section 1.105(a)(1)(iii) relates to a copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention. Section 1.105(a)(1)(iv) relates to a copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application. Section 1.105(a)(1)(v) relates to a copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result. Section 1.105(a)(1)(vi) relates to identification of improvements. Section 1.105(a)(1)(vii)

relates to uses of the claimed invention known to any of the inventors at the time the application is filed notwithstanding the date of the use. Knowing a particular use/application of an invention may be helpful in determining a field of search for the invention.

Other examples where the Office may require the submission of information are:

- (1) A reply to a matter raised in a protest under § 1.291;
- (2) An explanation of technical material in a publication, such as one of the inventor's publications;
- (3) The identification of changes made in a reformatted continuing application filed under § 1.53(b);
- (4) A mark-up for a continuation-in-part application showing the new matter where there is an intervening reference;
- (5) Comments on a new decision by the Federal Circuit that appears on point;
- (6) The publication date of an undated document mentioned by applicant which may qualify as printed publication prior art (35 U.S.C. 102(a) or (b)); or
- (7) Information of record which raises a question of whether applicant derived the invention from another under 35 U.S.C. 102(f).

The Office intends to provide training for its employees on the appropriate use of § 1.105. Any abuse in implementation of the authority, such as a requirement for information that is not in fact reasonably necessary to properly examine the application, may be addressed by way of petition under § 1.181.

Section 1.105 does not change current Office practice in regard to questions of fraud under § 1.56, and inquiries from examiners relating thereto are not authorized. See *MPEP 2010*.

Section 1.105(a)(2) provides that where an assignee has asserted its right to prosecute an application pursuant to § 3.71(a), matters such as §§ 1.105(a)(1)(i), (iii), and (vii) that especially relate to the inventors may also be applied to the assignee. It is also contemplated that these paragraphs may be applied to other individuals identified by § 1.56(c).

Section 1.105(a)(3) provides a safety net by specifically recognizing that where the information required to be submitted is unknown and/or is not readily available, a complete reply to the requirement for information would be a statement to that effect. There would be no requirement for a showing that in fact the information was unknown or not readily available such as by way of disclosing what was done

to attempt to satisfy the requirement for information. Nonetheless, it should be understood that a good faith attempt must be made to obtain the information and a reasonable inquiry made once the information is requested even though the Office will not look behind the answer that the information required to be submitted is unknown and/or is not readily available. An Office employee should not continue to question the scope of a specific answer merely because it is not as complete as the Office employee desires. (See Example below.)

Example: In a first action on the merits of an application with an effective filing date of May 1, 1999, the examiner notes the submission of a protest under § 1.291 relating to a public sale of the subject matter of the invention and requests a date of publication for a business circular authored by the assignee of the invention, which circular was submitted with the protest. It is expected that the attempt to reply to the requirement for information would involve contacting the assignee who would then make a good faith attempt to determine the publication date of the circular. The reply to the requirement states that the publication date of the circular is "around May 1, 1998." As "around May 1, 1998" covers dates both prior and subsequent to May 1, 1998, a *prima facie* case under 35 U.S.C. 102(b) would not exist. The examiner cannot require that the reply be more specific or hold the reply to be incomplete based on such information. The examiner can, however, in the next Office action seek confirmation that this is the most specific date that was obtained or can be obtained based on a reasonable inquiry being made if that is not already clear from the reply to the initial requirement for information.

Section 1.105(b) provides that the requirement for information may be included in an Office action, which includes a restriction requirement if appropriate, or can be sent as a separate letter independent of an Office action on the merits, such as when the information required is critical to an issue or issues that need to be addressed in a subsequent Office action. Each Technology Center can determine how best to implement the section. For example, a Technology Center having certain technologies where pertinent prior art is highly likely to be found in a commercial data base may choose to implement § 1.105(a)(1)(i) routinely for those technologies, sending out requirements for information either when such applications are first forwarded to the Technology Center, or at the time they are assigned to an examiner.

Section 1.105(c) provides that a reply to a requirement for information or failure to reply is governed by §§ 1.135

and 1.136. Note the Example provided in the discussion of § 1.105(a)(2).

Comment 49: Several comments either oppose or strongly oppose the rule. Three comments argue that the Office is without statutory basis to support the rule and in fact violates 35 U.S.C. 103(a) (patentability shall not be negated by the manner in which the invention was made), while two others argue that there is no need for the rule in view of the Office's inherent authority. All the comments opposing the rule argue that the rule imposes an unreasonable burden on the applicants. One comment argues that the rule imposes an unreasonable burden on the examiners to prepare the request. Objections to the rule include:

- (1) It will slow the examination process where applicant is required to reply;
- (2) It sets a standard of "reasonably necessary" that is new and different from the materiality standard in § 1.56;
- (3) The information may be protected by attorney-client privilege;
- (4) The information may be voluminous;
- (5) It may be difficult to make a good faith search when large corporate teams or foreign entities are involved;
- (6) New issues are created in subsequent litigation as to whether a good faith search was made and whether the duty of candor was complied with, particularly if the reply was that the information is unknown or not available; and
- (7) It may be used to shift the burden of examination from the examiner to the applicant.

There was also a concern that the Office did not address any mechanism to assure a uniform policy among the 3,000 examiners.

Response: The comments objecting to the new rule are not adopted. The Office will, however, actively work toward ensuring that examiners apply the rule uniformly and fairly, and the Office will provide a petition remedy to achieve those purposes. As to the specific burdens that the rule is said to create, it must be kept in mind that the rule is aimed at resolving an issue that is reasonably necessary for the examiner to resolve for the proper examination of the application. The requirement for information under § 1.105 thus cannot be avoided in our system of examination (as opposed to registration) and would have been made under the Office's inherent authority. Accordingly, the authority set forth in the rule is not contrary to statute. The rule is propounded not to create a new cause celebre among the bar but to encourage examiners to do the best examination

possible. Implementation of the rule is no different than what other parts of the examination process create when rejections and objections are made to which applicants must reply. Each of the claimed ill effects of § 1.105 can be equally charged against the normal examination process where a requirement under § 1.105 is not an issue.

As to fears that examiners will use such authority as a fishing expedition or a tool of harassment causing applicants extensive expenses to either attempt to comply or challenge the need for the information, as noted above, the Office will in its implementation of the rule work hard to minimize such problems. The Office recognizes that with a large examining staff there are bound to be a small number of cases that need corrective action, and the Office will be sensitive to that. The Office, however, cannot hold itself hostage to fears that a few of these situations will arise and force examination to the lowest common denominator by not permitting examiners to resolve issues that are reasonably necessary to be resolved for a quality examination.

Comment 50: One comment suggested that any Requirement for Information first be reviewed by an SPE or Director in the Technology Center before being sent.

Response: As the Office moves to implement § 1.105 the comment will be evaluated to study its feasibility.

Section 1.111: The heading of § 1.111 is amended to clarify that it applies to a reply by the applicant or patent owner to a non-final Office action.

Section 1.111 is amended to divide former § 1.111(a) into §§ 1.111(a)(1) and (a)(2). Section 1.111(a)(1) is amended to: (1) Provide a reference to § 1.104 concerning the first examination of an application; and (2) move the reference of §§ 1.135 and 1.136 (for time for reply to avoid abandonment) from § 1.111(c) to § 1.111(a).

Section 1.111(a)(2) is amended to provide that a second (or subsequent) supplemental reply will be entered unless disapproved by the Commissioner, and that disapproval may occur if the second (or subsequent) supplemental reply unduly interferes with an Office action being prepared in response to the previous reply. Factors that will be considered in disapproving a second (or subsequent) supplemental reply include: The state of preparation of the Office action responsive to the previous reply as of the date of receipt by the Office (§ 1.6) of the second (or subsequent) supplemental reply (§ 1.111(a)(2)(i)); and the nature of any changes to the specification or claims

that would result from entry of the second (or subsequent) supplemental reply (§ 1.111(a)(2)(ii)).

Disapproval of a second or subsequent reply applies to replies filed on or after two months from the date of publication in the **Federal Register**.

Disapproval of a second (or subsequent) supplemental reply will be delegated to the appropriate Technology Center Group Director under MPEP 1002.02(c). As most supplemental replies cause only a minor inconvenience to the Office, the Office is not inclined to adopt a change that would preclude the ability to file a second (or subsequent) supplemental reply when such is warranted. There are, however, some applicants who routinely file supplemental (or preliminary, see § 1.115) replies that place a significant burden on the Office by: (1) Canceling the pending claims and adding many new claims; (2) adding numerous new claims; or (3) being filed approximately two months from the date the original reply was filed (*i.e.*, when the examiner is likely to be preparing an Office action responsive to the original reply). These applicants also tend to be those having many applications simultaneously on file in the Office. These actions are calculated to interfere with the timely examination of an application and can be particularly detrimental to the Office.

The provision that the entry of a second (or subsequent) supplemental reply may be disapproved by the Commissioner (or his or her delegate) gives the Office the latitude to permit entry of those second (or subsequent) supplemental replies that do not unduly interfere with the preparation of an Office action, but also gives the Office the latitude to refuse entry of those second (or subsequent) replies that do unduly interfere with the preparation of an Office action. Factors that will be taken into consideration when deciding whether to disapprove entry of such a second (or subsequent) supplemental reply include: (1) The state of preparation of an Office action responsive to the initial or previous reply as of the date of receipt (§ 1.6, which does not include § 1.8 certificate of mailing dates) of the second (or subsequent) supplemental reply by the Office; and (2) the nature of the change to the specification or claims that would result from entry of the second (or subsequent) supplemental reply. That is, if the examiner has devoted a significant amount of time to preparing an Office action before such a second (or subsequent) supplemental amendment is received, and the nature of the change to the specification or claims that would

result from entry of the second (or subsequent) supplemental reply would require significant additional time (see examples below), it is appropriate for the Office to disapprove entry of the second (or subsequent) supplemental reply.

Example 1: If the second (or subsequent) supplemental reply amends the pending claims, adds numerous new claims, or amends the specification to change the scope of the claims, which the reply requires the examiner to devote significant additional time to prepare the Office action, the entry of such supplemental reply may be appropriately disapproved when the examiner has devoted a significant amount of time to preparing an Office action before such reply is received.

Example 2: If the second (or subsequent) supplemental reply amends the specification so that a new matter issue is raised, the entry of such reply may be appropriately disapproved when the examiner has devoted a significant amount of time to preparing an Office action before such reply is received.

Both conditions in § 1.111(a)(2) must be met, although it is not intended that the amount of time required to address the changes amount to the same period of time already spent by the examiner in preparing the initial response. Where a second (or subsequent) supplemental amendment merely cancels claims (as opposed to canceling claims and adding claims, or simply adding claims)(see below for additional examples), it is not appropriate to disapprove entry of such a second (or subsequent) supplemental amendment even if the examiner has devoted a significant amount of time to preparing an Office action before such a second (or subsequent) supplemental amendment is filed.

Example 3: If the second (or subsequent) supplemental reply amends the pending claims to alleviate rejections under 35 U.S.C. 112, ¶ 2, it would not be appropriate to disapprove the entry of such reply under § 1.111(a)(2).

Example 4: If the second (or subsequent) supplemental reply includes only changes that were previously suggested by the examiner, it may not be appropriate to disapprove the entry of such reply under § 1.111(a)(2).

Obviously, if a supplemental reply is received in the Office (§ 1.6) after the mail date of the Office action responsive to the original (or supplemental) reply, and it is not responsive to that Office action, the Office will continue the current practice of not mailing a new Office action responsive to that supplemental reply, but simply advising the applicant that the supplemental reply is nonresponsive to such Office action and that a responsive reply (under § 1.111 or § 1.113 as the situation may be) must be timely filed to avoid

abandonment. Put simply, the mailing of an Office action responsive to the original (or supplemental) reply will cut off the applicant's right to have any later-filed supplemental reply considered by the Office.

Comment 51: The proposal was widely opposed. Supplemental filings are felt to speed prosecution and remove issues. Disapproving entry will cause unnecessary work and a repeat of the filing. It was suggested that a handling fee be imposed rather than disapproving entry. The proposal places an additional administrative burden on examiners and Technology Center Group Directors in deciding appropriateness of disapproving entry.

Response: The amendment is believed to strike a reasonable balance between permitting an unlimited number of supplemental replies to be filed: (1) prior to preparation of an Office action by the examiner, and (2) after preparation of an Office action by the examiner (that is not yet mailed) that do not require a significant amount of rework versus disapproval of second or subsequent replies that unduly interfere with the preparation of an Office action. The imposition of a handling fee would not prevent this type of abuse.

Comment 52: It was argued that it is fundamentally unfair to evaluate the amount of time an examiner has spent preparing an Office action as of the date the second (or subsequent) supplemental reply is matched with the file as was initially proposed. Applicants should not be punished because of paper handling problems in the Office.

Response: The comment has been adopted. The rule now reflects that the amount of preparation time devoted to an Office action will be evaluated as of the date of receipt by the Office of the second (or subsequent) supplemental reply.

Comment 53: Clarification was requested as to whether a second * * * supplemental reply is the third reply or the second reply.

Response: The expression "second * * * supplemental reply" is seen to clearly state that only a third (or subsequent) reply will be subject to disapproval.

Comment 54: One comment suggested that the rule should set forth a standard for disapproval.

Response: The comment is adopted. The rule as proposed set forth only that second or subsequent replies will be entered unless disapproved. The rule language has been modified to recite the factors that will be used; that is, the state of preparation of the Office action, and the nature of the changes.

Comment 55: One comment objected to the paragraph (a) amendment where the language was changed from "must reply thereto and *may* request reconsideration" (underlining added) to "must reply thereto and request reconsideration." It is urged that the Office should treat the filing of a reply as an implicit request for reconsideration rather than require a separate explicit statement and the Office should include language to that effect in the rule.

Response: The language change is not considered to be a change in practice but a clarification. Replies that appear to be requests for reconsideration are treated as such whether or not there is a specific statement requesting reconsideration. There are, however, some replies that state that they are in response to an Office action, but they do not in fact represent a request for reconsideration and are not treated as such. For example, the Office has experienced replies that amount to incoherent ramblings that reply to an Office action but provide no means for an examiner to determine upon what basis reconsideration is being requested or that reconsideration is being requested for any particular ground of rejection or objection, and the reply will not be treated as a request for reconsideration.

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

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

Section 1.115(b)(1) provides that a preliminary amendment will be entered unless disapproved by the Commissioner, and that disapproval may occur if the preliminary amendment unduly interferes with the preparation of a first Office action in an application. Factors that will be considered in disapproving a preliminary amendment include: the

state of preparation of a first Office action as of the date of receipt (§ 1.6, which does not include § 1.8 certificate of mailing dates) of the preliminary amendment by the Office (paragraph (b)(1)(i)); and the nature of any changes to the specification or claims that would result from entry of the preliminary amendment (paragraph (b)(1)(ii)). See the discussion for § 1.111(a)(2).

Disapproval of a preliminary amendment applies to applications (not amendments) filed on or after two months from the date of publication in the **Federal Register**.

Section 1.115(b)(2) provides that a preliminary amendment will not be disapproved if it is filed no later than: (1) three months from the filing date of an application under § 1.53(b); (2) the filing date of a continued prosecution application under § 1.53(d); or (3) three months from the date the national stage is entered as set forth in § 1.491 in an international application. Thus, the entry of a preliminary amendment will not be disapproved under § 1.115(b)(1) if it is filed within one of the periods specified in §§ 1.115(b)(2)(i) through (iii). Nevertheless, if a "preliminary" amendment is filed after the mail date of the first Office action, it is not a preliminary amendment under § 1.115(a). If a ("preliminary") amendment is received in the Office (§ 1.6) after the mail date of the first Office action and is not responsive to the first Office action, the Office will continue the current practice of not mailing a new Office action responsive to that amendment, but simply advising the applicant that the amendment is nonresponsive to the first Office action and that a responsive reply must be timely filed to avoid abandonment. Put simply, the mailing of the first Office action will continue to cut off the applicant's right to have any later-filed preliminary amendment considered by the Office, even if that amendment is filed within the time periods specified in § 1.115(b). See also § 1.111.

Section 1.115(c) provides that the time periods specified in § 1.115(b)(2) are not extendable.

It is expected that disapproval of a preliminary amendment filed outside the period specified in § 1.115(b)(2) will be delegated to the appropriate Technology Center Group Director under MPEP 1002.02(c). The provision that the entry of a preliminary amendment filed outside the period specified in § 1.115(b)(2) may be disapproved by the Commissioner gives the Office the latitude to permit entry of those preliminary amendments filed outside the period specified in § 1.115(b)(2) that do not unduly

interfere with the preparation of an Office action, but also gives the Office the latitude to refuse entry of those preliminary amendments filed outside the period specified in § 1.115(b)(2) that do unduly interfere with the preparation of an Office action.

In an application filed under 35 U.S.C. 111(a) and § 1.53(b) or a PCT international application entering the national stage under § 1.491, the time periods specified in § 1.115(b)(2) should give the applicant time between the mailing of a filing receipt and the mailing of a first Office action to file any necessary preliminary amendment. CPA practice under § 1.53(d), however, is designed to provide a first Office action sooner than if the application had been filed as a continuation under § 1.53(b) (or under former § 1.60 or § 1.62). See *Continued Prosecution Application (CPA) Practice*, Notice, 1214 *Off. Gaz. Pat. Office* 32, 32 (September 8, 1998). An applicant filing a CPA under § 1.53(d) who needs time to prepare a preliminary amendment should file a request for suspension of action under § 1.103(b) with the CPA request.

Comment 56: The proposal was widely opposed.

Response: See the responses to comments relating to § 1.111.

Comment 57: It is believed that there is adequate incentive at present for filing preliminary amendments as soon as possible after filing of the application.

Response: Obviously if an applicant wishes an early action on the merits for a newly filed application, submission of a preliminary amendment around the time the application is to be taken up for action is not advisable. The Office has noticed, however, that certain applicants routinely submit preliminary amendments that, due to submission times and content, cause undue delays in the issuance of a first Office action and cause the Office to needlessly expend its resources, which also affects the preparation of Office actions for other applicants.

Comment 58: It is suggested that a one-month grace period for submission of a preliminary amendment be provided for a CPA or that applicants be permitted to grant themselves extensions of time.

Response: The suggestions were not adopted. The purpose of CPA filing is for a speedy first action. Section 1.103 has been amended for applicants to request up to a three-month suspension of a first Office action to permit the filing of a preliminary amendment. The ability for applicants to grant themselves extensions of time would further aggravate the problem of

examiners preparing Office actions that would then have to be redone, or require the Office to hold off on examining an application until it could be determined whether an extension had been applied for.

Section 1.121: The title to § 1.121 has been amended to add "in applications" to reinforce the fact that the section is limited to making amendments in applications, and it does not apply to making amendments in reexamination proceedings. The reference in § 1.121(i) to reexamination proceedings is only an advisory reference to look to § 1.530.

Section 1.121 is amended to change the manner of making amendments in non-reissue applications. Section 1.121 is also completely rewritten and reformatted to make it easier to understand. The new amendment practice, wherein amendments to the specification must be made by the submission of clean new or replacement paragraph(s), section(s), specification, or claim(s) will essentially eliminate (1) the need for the Office to enter changes to the text of application portions by handwriting in red ink, and (2) the presence of hard to scan brackets and underlining in amended claims. This will provide a specification (including claims) in clean, or substantially clean, form that can be effectively captured and converted by optical character recognition (OCR) scanning during the patent publishing process. The new practice also requires the applicant to provide a marked up version of the changed specification, section(s) of specification, paragraph(s), or claim(s), using applicant's choice of a marking system to indicate the changes, which will aid the examiner in identifying the changes that have been made. The marked up version must be based on the previous version and indicate (by markings) how the previous version has been modified to produce the clean replacement paragraph(s), section(s), specification, or claim(s) submitted in the current amendment. The term "previous version" means the version of record in the application as originally filed or from a previously entered amendment. Applicants will also be able to submit a clean set of all pending claims. This will also be helpful during the patent printing process, and should lead to reduced printing errors in claims in patents.

Amendments in compliance with former § 1.121 will be accepted until March 1, 2001. After that date, amendments must comply with revised § 1.121. It is the intent of the Office to send out reminders of the new manner of making amendments prior to March

1, 2001, in the form of flyers along with correspondence to applicants.

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

As discussed above, the changes to § 1.121 will result in relatively clean (e.g., without underlining, bracketing, or red ink) application specifications, including claims, that can be effectively OCR scanned as part of the printing process in the Office of Patent Publications, which, in turn, will result in a higher quality of printed patents. Clean application specifications, including claims, can more easily and accurately be scanned and converted into readable text by OCR in the patent printing process. While text marked with underlining and bracketing can be scanned, extra processing is required to delete the brackets, the text within the brackets, and to correct misreading of letters caused by the underlining. Thus, using clean replacement sections, or paragraphs, and claims will permit complete OCR scanning that is a faster and more accurate method of capturing the application for printing while eliminating an extensive amount of key-entry of subject matter. This will result in patents with fewer errors in need of correction by certificate of correction, which will be a clear benefit to patentees and also conserve Office resources.

In addition to submitting a replacement section, or paragraph, or claim to make an amendment, applicant is required to submit a marked up version of the section, or paragraph, or claim to show the differences between the replacement and either the original or the most recently filed and entered version immediately prior to the amendment. The marked up version may be created by any automated or manually entered method applicant chooses, such as underlining and bracketing, redlining, or by any system designed to provide text comparison. Where a paragraph or a claim has been added or deleted, a marked up version is not required. If a marked up version is otherwise supplied, however, any added or deleted paragraph or claim should be identified with a statement, such as, "The paragraph beginning at page 6, line 3, has been deleted." The

size of the marked up version, and the burden associated with its preparation, will be minimized, while still retaining the requirement to show changes involving any paragraph or claim that would otherwise be difficult to ascertain.

Section 1.121(b) now provides for amending application specifications by replacing §§ 1.121(a)(1) through (a)(6) of the former rule with new §§ 1.121(b) through (g), which treat the manner of making amendments in applications other than reissue applications. Section 1.121(h) relates to amendments in reissue applications, and it references § 1.173, where the provisions for making amendments in reissue applications have been transferred from former paragraph (b) of this section. Section 1.121(i) relates to amendments in reexamination proceedings and it references § 1.530, a reference to § 1.530(d) being in former § 1.121(c). Section 1.121(j) provides for amendments made in provisional applications.

Section 1.121(b)(1) provides procedures to delete, replace, or add a paragraph to the specification of an application. Section 1.121(b)(1) does not apply to amendments to materials submitted under §§ 1.96 and 1.825. § 1.121(b)(1)(i) requires an instruction to unambiguously identify the location of the amendment. If a paragraph is to be replaced by one or more paragraphs, the instruction should unambiguously identify the paragraph to be replaced either by paragraph number, page and line, or any other unambiguous method, and be accompanied by the replacement paragraph(s) in clean form.

Where paragraph numbering has been included in an application as provided in § 1.52(b)(6), applicants can easily refer to a specific paragraph by number when presenting an amendment. If a numbered paragraph is to be replaced by a single paragraph, the added replacement paragraph should be numbered with the same number as the paragraph being replaced. Where more than one paragraph is to replace a single original paragraph, the added paragraphs should be numbered using the number of the original paragraph for the first replacement paragraph, followed by increasing decimal numbers for the second and subsequent added paragraphs, *i.e.*, original paragraph [0071] has been replaced with paragraphs [0071], [0071.1], and [0071.2]. If a numbered paragraph is deleted, the numbering of subsequent paragraphs should remain unchanged.

Section 1.121(b)(1)(ii) requires that the replacement or added paragraph(s) be in clean form. This means that the

added or replacement paragraph(s) must not include any markings to indicate the changes that have been made. Section 1.121(b)(1)(iii) requires a separate version of the replacement paragraph(s) to accompany the amendment. The separate version must include each replacement paragraph with markings to show the changes relative to the previous version as an aid to the examiner. A marked up version, however, does not have to be supplied for any added paragraph(s) or any deleted paragraph(s), as it is sufficient to merely indicate or identify any paragraph which has been added or deleted.

Section 1.121(b)(2) permits applicants to amend the specification by replacement sections (*e.g.*, as provided in §§ 1.77(b), 1.154(b), or § 1.163(c)). As with replacement paragraphs, the amended version of a replacement section is required to be provided in clean form, that is, without any markings to show the changes which have been made. A separate marked up version showing the changes in the section relative to the previous version must accompany the actual amendment as an aid to the examiner.

Section 1.121(b)(3) also permits applicants to amend the specification by submitting a substitute specification, provided the requirements of § 1.125(b) are met. An accompanying separate marked up version showing the changes in the specification relative to the previous version is also required.

Section 1.121(b)(4) requires that matter deleted by amendment pursuant to any of the earlier sections of § 1.121 can only be reinstated by a subsequent amendment presenting the previously deleted subject matter. A direction by applicant to simply remove a previously entered amendment will not be permitted.

Section 1.121(c)(1) requires that all amendments to a claim be presented in the form of a rewritten claim. Any rewriting of a claim will be construed as a direction to cancel the previous version of the claim. *See In re Byers*, 230 F.2d 451, 455, 109 USPQ 53, 55 (CCPA 1956)(amendment of a claim by inclusion of an additional limitation had exactly the same effect as if the claim as originally presented had been cancelled and replaced by a new claim including that limitation). Section 1.121(c)(1)(i) requires that any rewritten or newly added claim be submitted in clean form, that is, with no markings to indicate the changes that have been made. A parenthetical expression should follow the claim number indicating the status of the claim as amended or newly added, *e.g.*,

“amended,” “twice amended,” or “new.” Section 1.121(c)(1)(ii) requires that a marked up version of any amended claim be submitted, including a parenthetical expression “amended,” “twice amended,” etc., that should follow the claim number, on pages separate from the amendment, to show the changes that have been made by way of brackets (for deleted matter) and underlining (for added matter), or by any other suitable method of comparison. This will assist the examiner in the examination process. The parenthetical expression “amended,” “twice amended,” *etc.* should be the same for both the clean version of the claim under § 1.121(c)(1)(i) and the marked up version under this paragraph. A marked up version does not have to be supplied for any added claims or any canceled claims. If a marked up version is supplied to show changes made to amended claims, however, applicant should identify (in the marked up version) any added or canceled claims with a statement, such as, “Claim 6 has been canceled.”

Section 1.121(c)(2) requires that a cancelled claim can be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

Section 1.121(c)(3) provides for the optional submission of a clean version (with no markings) of all of the pending claims in one amendment paper. The provisions under § 1.121(c)(1)(i) of this section provide for only the submission of newly added or amended claims in clean form and compliance with this section is required by March 1, 2001. During the transition phase, there will be a large number of pending applications having claims with underlining and bracketing (from amendments made prior to the effective date of the rule change) and claims in clean form (from amendments made after the effective date of the rule change) in the pending claim set. Applicants may wish to consolidate all previous versions of pending claims from a series of separate amendment papers into a single clean version in a single amendment paper. Providing this consolidation of claims in the file will be beneficial to both the Office and the applicant for patent printing purposes. When rewriting a claim in the clean set, the parenthetical expression, if any, from the claim to be rewritten should not be repeated in the clean set. Thus, the only time a parenthetical expression should appear in the clean set is when a claim is being amended.

Entry of an entire clean claim set is subject to the provisions of §§ 1.116(b)

and 1.312. For example, after receipt of a notice of allowance, applicant may wish to submit an entire clean set of claims under § 1.312, making no changes, to make publication of the patent as accurate as possible. This type of amendment will be entered. Where, however, an amendment is submitted under either § 1.116 or § 1.312 which contains an entire clean set of claims, some of which may be amended, the examiner may choose not to enter the amendment pursuant to the provisions of § 1.116 or § 1.312.

The submission of a clean version of all the pending claims shall be construed as directing the cancellation of all previous versions of any pending claims. A marked up version would only be needed for claims being changed by the current amendment (see § 1.121(c)(1)(ii)). Any claim not accompanied by a marked up version will constitute an assertion that it has not been modified relative to the immediate prior version. Thus, if applicant is not making any amendments to the claims, but is merely presenting all pending claims in clean form, without any underlining or bracketing, a marked up version should not also be submitted. The examiner has no responsibility or burden to ensure the accuracy of applicant's claim rewriting.

Section 1.121(d) is amended to clarify the requirements for amending figures of drawings in an application. A marked up copy showing changes in red must be filed for approval by the examiner. Upon approval by the examiner, new drawings in compliance with § 1.84 must be filed.

Sections 1.121(e) and (f) correspond to §§ 1.121(a)(5) and (a)(6) of the former rule and now include section titles.

Section 1.121(g) permits the Office to make amendments to the specification, including the claims, by examiner's amendments without paragraph/section/claim replacement in the interest of expediting prosecution and reducing cycle time. Additions or deletions of subject matter in the specification, including the claims, may be made by instructions to make the change at a precise location in the specification or the claims. The examiner's amendment can be created by the examiner from a facsimile transmission or e-mailed amendment received by the examiner and referenced in the examiner's amendment and attached thereto. Any subject matter, in clean version form, to be added to the specification/claims should be set forth separately by applicant/practitioner in the e-mail or facsimile submission apart from the remainder of the submission.

Only that portion of an e-mail or facsimile directed to a clean version of the subject matter to be added should be copied and attached to the examiner's amendment. A paper copy of the entire e-mail or facsimile submission should be entered in the file. Examiners would not be required to electronically save any e-mails once any e-mails or attachments thereto were printed and became part of an application file record. The e-mail practice that is an exception for examiner's amendments is restricted to e-mails to the examiner from the attorney/applicant and should not be generated by the examiner to the attorney/applicant unless such e-mails are in compliance with all of the requirements set out in MPEP 502.03.

Comment 59: Many of the comments received were opposed to the proposed change in amendment practice which would require usage of numbered paragraphs.

Response: In view of the objections to requiring numbered paragraphs, revised § 1.121(b)(1)(i) merely provides for the optional use of numbered paragraphs. Further, § 1.121(b)(1)(i) does not require amendment via substitute specification if numbered paragraphs are not used. Revised § 1.121(b)(1)(i) provides that applicants may submit amended replacement or new paragraphs if a specific location in the specification is identified.

Comment 60: A concern was raised in a number of comments that replacement paragraphs would make the identification of changes more obscure than the present system of using bracketing and underlining, would place an extra burden on practitioners and their staffs, and would work against reducing paper submissions if applicants were required to submit marked up copies of the desired changes.

Response: The comments have not been adopted. The replacement paragraph requirement, as well as the rewritten claim requirement, are both necessary to facilitate the publication of patents more expeditiously and with fewer errors. The Office's goal is to eliminate the use of red ink and bracketing/underlining in the amendment of patent applications, because OCR scanning techniques now employed in the preparation of patents for publication can best accommodate "clean form" insertions of amended subject matter. The submission of marked up versions may, for a time, increase file size but will provide the examiner with an easy way to compare the most recent amendments with earlier versions in the application files. While it may be possible for examiners

to compare the clean version with the previous version in order to detect changes, in the interest of reduced cycle time, a review of a marked up version of an amendment to show the changes that have been made, is still a very effective and useful tool to the examiner during the examination process. Sections 1.121 (b)(1)(3) and (c)(1)(ii), however, do not require that marked up versions of added or new claims, or paragraphs, be supplied so the size of the marked up version, and the burden on the practitioner to prepare the marked up version, should be minimized. The new requirements provide the needed comparative basis (for paper copies) during the transition phase into an electronic file wrapper (EFW) environment.

Comment 61: Several comments suggested identifying the replacement paragraphs by page number and line number or through the use of replacement pages.

Response: The changes to § 1.121 are intended, in part, to serve the Office and its customers during a transition into an electronic file wrapper (EFW) environment. Accordingly, total paragraph replacement will most effectively achieve the desired results. The suggestion to permit identification of paragraphs by any unambiguous method (e.g., paragraph beginning at identified page number and line number) is reasonable, and it will be permitted in § 1.121(b)(1)(i). The suggestion to permit use of replacement pages, however, will not be adopted as it will not be practical in an EFW environment.

Comment 62: One comment suggested that the instruction to present all amendments to claims as rewritten claims is likely to be understood by most practitioners as requiring the indication of insertions and deletions, and not as a requirement to submit a clean version of the amended claim. This might encourage applicants to submit a new schedule of amended claims in the form of new renumbered claims, thereby avoiding the requirement for both a clean version and a marked up version of pending claims.

Response: The requirement of the rule to provide a clean version along with a marked up version is not ambiguous. The intent of the change is twofold: (1) To provide a clean version for scanning purposes in the publication process with a concomitant reduction in the number of processing errors; and (2) to provide an aid to the examiner in the examination process by way of a marked up version indicating changes from the previous version of the claim. While circumventing the intent of the rule may

be possible, it seems to be in the best interest of applicants, as true partners in the examination process, to assist the examination process wherever possible. Providing a marked up version, in today's environment of easy-to-use software to accomplish this result, is not anticipated to be that burdensome to applicants.

Comment 63: One comment suggested that the requirement for replacement paragraphs/claims not be made applicable to examiner amendment practice in order to encourage amendments that expedite prosecution.

Response: This suggestion has been adopted with the inclusion of an exception for examiners when preparing examiner's amendments. Examiners will not be required to rewrite paragraphs of the specification or claims in an examiner's amendment when preparing an application for allowance, nor will a marked up version be required.

Comment 64: One comment questioned whether applicants could present in a single paper, a clean version of all of the pending claims in the application.

Response: In view of the fact that many pending applications will include amendments made prior to the effective date of the rule change as well as amendments made subsequent to the effective date of the rule change, the suggestion that all of the claims be represented in a single paper in clean form is reasonable and will be permitted in the final rule as an option. See § 1.121(c)(3). No accompanying marked up version will be necessary, unless the paper being submitted also includes amendments to some of the claims. In that case, a marked up version of only the claims being amended in the current paper will be required. It will be understood by the Office that any claims not accompanied by a marked up version will constitute an assertion that they have not been changed relative to the immediate prior version.

Section 1.125: Section 1.125(b)(2) is amended to require that all the changes to the specification (rather than simply all additions and deletions) be shown in a marked up version, with the term "version" being substituted for the term "copy" to avoid any confusion as to what is supposed to be supplied. Section 1.125(b)(2) is also amended to provide that numbering the paragraphs of the specification of record is not considered a change that must be shown. Thus, the marked up version of the substitute specification need not show the numbering of the paragraphs of the specification of record, and no marked up version of the substitute specification is required if the only

change is numbering of the paragraphs of the specification of record. Section 1.125(c) is amended to encourage that the paragraphs of any substitute specification be numbered in a manner consistent with § 1.52(b)(6).

Section 1.131: The heading of § 1.131 is amended to clarify that it applies to overcoming other activities in addition to cited patents or publication (by deletion of the recitation to only a cited patent or publication). Section 1.131(a) is also amended for simplicity.

Section 1.131(a) is specifically amended to provide that when any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or a party qualified under §§ 1.42, 1.43, or § 1.47 may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. Section 1.131(a) is amended to eliminate the provisions that specify which bases for rejection must be applicable for § 1.131 to apply. Instead, the approach is that § 1.131 is applicable to overcome a rejection unless the rejection is based upon a U.S. patent to another or others which claims the same patentable invention as defined in § 1.601(n) (§ 1.131(a)(1)) or a statutory bar. This avoids the situation in which the basis for rejection is not a statutory bar (under 35 U.S.C. 102(a) based upon prior use by others in the United States) and should be capable of being antedated, but the rejection is not specified as a basis for rejection that must be applicable for § 1.131 to apply.

Affidavits under § 1.131 to overcome rejections based on prior knowledge or use under 35 U.S.C. 102(a) are effective on the date of publication in the **Federal Register** for all pending applications where such issue needs to be addressed (to include appropriately filed requests for reconsideration).

Section 1.131(a) is also amended to provide that the effective date of a U.S. patent is the date that such U.S. patent is effective as a reference under 35 U.S.C. 102(e). MPEP 2136.03 provides a general discussion of the date a U.S. patent is effective as a reference under 35 U.S.C. 102(e). Finally, § 1.131(a) is amended to provide that prior invention may not be established under § 1.131 if either: (1) The rejection is based upon a U.S. patent to another or others which claims the same patentable invention as defined in § 1.601(n); or (2) the rejection is based upon a statutory bar.

Section 1.132: Section 1.132 is amended to eliminate the provisions

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

Affidavits under § 1.132 to overcome rejections based on prior knowledge or use under 35 U.S.C. 102(a) are effective on the date of publication in the **Federal Register** for all pending applications where such issue needs to be addressed (to include appropriately filed requests for reconsideration).

Sections 1.131 and 1.132 are procedural in nature providing mechanisms for the submission of evidence to antedate or otherwise traverse a rejection; however, they do not address the substantive effect of the submission of such evidence on the objection or rejection at issue. See, e.g., *In re Zletz*, 893 F.2d 319, 322-23, 13 USPQ2d 1320, 1322-23 (Fed. Cir. 1989) (§ 1.131 provides an ex parte mechanism whereby a patent applicant may antedate subject matter in a reference); *Newell Cos. v. Kenney Mfg.*, 864 F.2d 757, 768-69, 9 USPQ2d 1417, 1426-27 (Fed. Cir. 1988) (the mere submission of evidence under § 1.132 does not mandate a conclusion of patentability). An applicant's compliance with §§ 1.131 or 1.132 means that the applicant is entitled to have the evidence considered in determining the patentability of the claim(s) at issue. It does not mean that the applicant is entitled as a matter of right to have the rejection of or objection to the claim(s) withdrawn.

Section 1.133: Section 1.133 (a) is amended to create §§ 1.133(a)(1) through (a)(3). Section 1.133(a)(1) provides that interviews must be conducted on "Office premises" (rather than "in the examiner's rooms"). The purpose of this change is to account for interviews conducted in conference rooms or by video conference.

Section 1.133(a)(2) is amended to conform to the practice in MPEP 713.02 (of ordinarily) providing for an interview relating to patentability of a pending application where the

application is a continuing or substitute application. The paragraph is also amended by changing interview to the singular to clarify that ordinarily a single interview prior to first Office action is permitted in a continuing or substitute application.

Comment 65: One comment urged that interviews be allowed in a CPA prior to a first Office action.

Response: The comment has been adopted in a broader manner to apply to all continuations and substitute applications that conform to practice set forth in the MPEP.

Section 1.136: Section 1.136(c) is added to provide that if an applicant is notified in a "Notice of Allowability" that an application is otherwise in condition for allowance, the following time periods are not extendable if set in the "Notice of Allowability" or in an Office action having a mail date on or after the mail date of the "Notice of Allowability": (1) The period for submitting an oath or declaration in compliance with § 1.63; and (2) the period for submitting formal drawings set under § 1.85(c). It had also been proposed to add a third item: The period for making a deposit that is set under § 1.809(c). This portion has been held in abeyance in view of § 4805 of the "American Inventor's Protection Act of 1999." Section 4805(c) requires that in drafting regulations affecting biological deposits (including any modification of title 37, Code of Federal Regulations, § 1.801 *et seq.*), the Office shall consider the recommendations of a study that is mandated under that section. Any change relating to time periods for deposits after mailing of the "Notice of Allowability" will be postponed until the study is completed. See also the change that was proposed to § 1.809.

Elimination of the § 1.136 (and § 1.85(c)) extension of time for filing corrected or formal drawings applies only where a Notice of Allowability requiring the corrected or formal drawing has been mailed on or after sixty days after publication in the **Federal Register**.

Section 1.137: Section 1.137(c) is amended to provide that any petition under § 1.137 in either a utility or plant application filed before June 8, 1995, must be accompanied by a terminal disclaimer and fee as set forth in § 1.321 dedicating to the public a terminal part of the term of any patent granted equivalent to the lesser of: (1) The period of abandonment of the application; or (2) the period extending beyond twenty years from the date on which the application for the patent was filed in the United States or, if the

application contains a specific reference to an earlier filed application(s) under 35 U.S.C. 120, 121, or 365(c), from the date on which the earliest such application was filed. This change will further harmonize effective treatment under the patent term provisions of 35 U.S.C. 154 (b) and (c) of utility and plant applications filed before June 8, 1995, with utility and plant applications filed on or after June 8, 1995. Section 1.137(c) also provides that its terminal disclaimer requirement does not apply to applications for which revival is sought solely for purposes of copendency with a utility or plant application filed on or after June 8, 1995, or to lapsed patents.

The amendments to revivals under § 1.137 is effective on the date of publication in the **Federal Register**.

When a terminal disclaimer (under § 1.137(c)) is filed with a petition under § 1.137 to revive an abandoned application, the Office currently indicates the period disclaimed in the decision granting such petition. The Office, however, cannot determine (at the time a petition to revive is granted) the period disclaimed under revised § 1.137(c) (*i.e.*, which period is lesser: The period of abandonment of the application, or 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). Therefore, the Office will discontinue indicating the period disclaimed under § 1.137(c) in its decision granting a petition under § 1.137 to revive an abandoned application.

The period of abandonment is the number of days between the date of abandonment and the mailing date of the decision reviving the abandoned application. MPEP 710.01(a) provides an explanation of how the date of abandonment is determined. The date that is 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, should be ascertainable from the filing date and continuity information provided on the front page of the patent. The period extending beyond that date is the number of days between that date and the day that is seventeen years from the date of grant of the patent. The period

disclaimed is the lesser of these two periods.

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

Section 1.152: Section 1.152 was amended to delete the reference to the requirement for a petition for color photographs and drawings as unnecessary in view of the clarifications to §§ 1.84(a), (a)(2), (b)(1), and (b)(2) that now include a specific reference to design applications. Former §§ 1.152(a), (a)(1), and (a)(2) were deleted with the remaining text combined into a single paragraph.

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

The elimination of provisions relating to the integral nature of designs in § 1.152 is effective on the date of publication in the **Federal Register**.

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

Comment 66: One comment suggested adding the words “in a design application” to the end of the § 1.154 header for clarity.

Response: The comment has been adopted.

Section 1.155: Section 1.155 is revised to eliminate all former § 1.155 provisions as being unnecessarily duplicative of the provisions of §§ 1.311(a) and 1.316, which apply to the issuance of all patents, including designs. Revised § 1.155 establishes an expedited procedure for design applications. The procedure is available to all design applicants who first conduct a preliminary examination search and file a request for expedited treatment accompanied by a fee commensurate with the Office cost of the expedited treatment and handling (§ 1.17(k)). This cost-based expedited treatment is intended to fulfill a particular need by affording rapid design patent protection that may be especially important where marketplace conditions are such that new designs on articles are typically in vogue for limited periods of time. The Office requires a statement that a preexamination search was conducted, which must also indicate the field of search and include an information disclosure statement in compliance with § 1.98. Formal drawings in compliance with § 1.84 are also required. The applications will be individually examined with priority, and the clerical processing will be conducted and/or monitored by specially designated personnel to achieve expeditious processing through initial application processing and the Design Examining Group. The Office will not examine an application that is not in condition for examination even if the applicant files a request for expedited examination under this section.

The expedited procedure for design applications under § 1.155 is effective on the date of publication in the **Federal Register**.

Comment 67: Two comments considered the \$900 fee for the expedited processing of design applications to be excessive when

compared to the fee for a “Petition to Make Special.”

Response: Based on a conservative cost estimate, the \$900 fee specified in § 1.17(k) for the expedited examination of design applications is the fee necessary to recover the Office’s cost of providing such expedited examination. *See* 35 U.S.C. 41(d). An application granted special status pursuant to a successful “Petition to Make Special” is prioritized while it is on the examiner’s docket so that the application will be examined out of turn responsive to each successive communication from the applicant requiring Office action. The expedited treatment available under § 1.155, however, occurs through initial application processing and the Design Examining Group. For a patentable design application, the expedited treatment would be a streamlined filing-to-issuance procedure. This procedure further expedites design application processing by decreasing clerical processing time as well as the time spent routing the application between processing steps. Specially designated personnel will be required to conduct and/or monitor the expedited clerical processing. Also, expedited design applications may be individually treated throughout the examination process where necessary for expedited treatment, whereas normally, the search phase of design application examination is conducted in groups. Further, the “Petition to Make Special” procedure will continue to be made available without any anticipated increase in the required petition fee.

Comment 68: Two comments suggested requiring a fee in exchange for expedited examination instead of requiring a fee “[F]or filing a request for expedited examination under § 1.155(a)” as stated in § 1.17(k). According to the comments, the suggested recharacterization of the fee would permit refunding the fee as a payment made “in excess of that required” (§ 1.26) if the expedited service is not in fact provided.

Response: The comments are not adopted. Statutory authority for § 1.26 is found at 35 U.S.C. 42(d) which permits a refund “of any fee paid by mistake or any amount paid in excess of that required.” According to the statute, any refund of an “amount paid in excess” must be based upon an overpayment of a fee that was, in fact, “required” when the fee was paid. The suggested fee characterization would have no effect in that regard. The required amount is the § 1.17(k) fee whether it is for a request for expedited examination or for an actual expedited examination. Furthermore, the rule is silent as to any

timeframe definition of expedited treatment. It is the Office’s intent to set forth an objective for examination, such as three months, and an objective for printing. Should the Office fail to meet a stated objective for any one particular design application, applicant may still have received significant benefit, particularly if the objective was missed only by a week or month. Applicants can choose whether to spend the additional fee in part based on the Office’s performance in meeting its objectives with other design applications.

Comment 69: One comment reasoned that in order to provide the expedited service without compromising application quality, design application examiners would have to be allotted extra time to individually search expedited applications.

Response: Individual searching of a design application may not necessarily be required to meet the objective of expedited treatment. Where an individual search is required, the Technology Center will address the matter on a case-by-case basis.

Section 1.163: The title of § 1.163 is amended for clarity by the addition of “in a plant application.”

Section 1.163(a) second sentence is amended by substituting “For” for “[i]n the case of.”

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

New § 1.163(c)(4) and § 1.163(c)(5) request that the plant patent applicant state the Latin name and the variety denomination for the plant claimed. As discussed above, the Office, has been asked to compile a database of the plants patented and the database must include the Latin name and the variety denomination of each patented plant, and having this information in separate sections of the plant patent application will make the process of compiling this database more efficient.

Current §§ 1.163(c)(3) through (c)(5) are redesignated §§ 1.163(c)(1) through (c)(3), respectively.

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

Comment 70: One comment suggested that the title be amended for clarity by addition of "in a plant application."

Response: The suggestion has been adopted.

Section 1.173: Section 1.173 is amended to consolidate (1) the requirements for the filing of reissue applications formerly in § 1.173, (2) the requirements for amending reissue applications formerly in § 1.121, and (3) the requirements for reissue drawings formerly in § 1.174. Section 1.174 is being eliminated as the requirements for filing drawings in reissue applications have been moved to § 1.173. Section 1.173 also has been amended to include the same basic filing requirements for reissue applications that are currently only set forth in the MPEP. All of these changes have been made so that applicants will be able to find, in a single rule section, all of these critical requirements that must be complied with when preparing and filing a reissue application. Further, the requirements for the specification, claims and drawings are now set forth in separate paragraphs, which are clearer and easier to understand.

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

Section 1.173(a) provides the current requirements for the contents of a reissue application at filing. The existing prohibition against new matter in a reissue application, and the statutory provision permitting enlarging the scope of the original patent claims within two years of the patent date, formerly in § 1.121(b)(5), are added to this section.

Section 1.173(a)(1) now requires that the specification, including the claims, be furnished in the form of a copy of the printed patent in double column format (as the patent can be simply copied without cutting into single columns) with one page of the patent appearing on only one side of each individual page of the specification of the reissue

application. This format for submitting a reissue application represents a change from what was formerly set out as an option in MPEP 1411. Section 1.173(a)(1) also provides that amendments made to the specification at filing be made according to § 1.173(b). A cross-reference has been added to § 1.52, wherein form requirements are provided for papers in patent applications, including reissue applications. Additionally, a copy of any disclaimer (§ 1.321), certificate of correction (§§ 1.322 through 1.324), or reexamination certificate (§ 1.570) issued in the patent must be supplied. See also § 1.178.

Section 1.173(a)(1) applies to reissue applications filed on or after two months from the date of publication of the rule in the **Federal Register**.

Section 1.173(a)(2) sets forth the requirements for the drawings at the time the reissue application is filed. If clean copies (*i.e.*, good quality photocopies free of any extraneous markings) of the drawings from the original patent are supplied by applicant at the time of filing the reissue application, and the copies meet the requirements of § 1.84, no further (formal) drawings will be required. The former provision of § 1.174 requiring temporary drawings is eliminated in view of this amendment to § 1.173. The Office will now print a reissue patent using clean copies of the patent drawings. How changes to the patent drawings may be made at the time of filing of the reissue application, or during the prosecution, is now specifically set forth. Such changes must be made in accordance with the requirements of amended § 1.173(b)(3) (which are essentially the requirements of former §§ 1.121(b)(3)(i) and (ii)). If applicant does not provide clean copies of the patent drawings, or if changes are made to the drawings during the reissue prosecution, drawings in compliance with § 1.84 will be required at the time of allowance. The practice of transferring drawings from the patent file is eliminated since clean photocopies of patent drawings will be acceptable for use in the printing of the reissue patent.

Section 1.173(b) provides for the manner of making amendments in a reissue application. Amendments may be made either by physically incorporating the changes within the body of the specification (including the claims) as filed, or by a separate amendment paper (either at filing or during the prosecution of the application), directing that specified changes be made to the application specification, including the claims, or to

the drawings. If amendments are submitted as part of the specification as filed, they may be incorporated by cutting the column, inserting the added material and rejoining the remainder of the column.

Sections 1.173(b)(1) and (b)(2) incorporate the provisions formerly part of §§ 1.121(b)(1) and (b)(2) as to the manner of amending the specification and claims, respectively. Section 1.173(b)(1) is clarified to note that the paragraph applies whether or not an amendment is submitted on paper or compact disc pursuant to §§ 1.52(e)(1) and 1.821(c) but not for discs submitted under § 1.821(e).

Section 1.173(b)(3) incorporates the provisions formerly set forth in § 1.121(b)(3) as to amending reissue drawings.

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

Section 1.173(c) applies to any pending or newly filed application two months from the date of publication of the rule in the **Federal Register**.

Section 1.173(d) incorporates the provisions of former §§ 1.121(b)(1)(iii) and (b)(2)(i)(C) as to how changes in reissue applications are shown in the specification and claims, respectively. An exception to the normal underlining requirement is made for compact disc submissions. Instead of underlining the material, the following XML tag must be used to identify the material that is being added: start with <U> and end with </U> to properly identify the material being added.

Sections 1.173(e), (f), and (g) merely reiterate requirements for retaining original claim numbering, amending the disclosure when required, and making amendments relative to the original patent, which were formerly set out in §§ 1.121(b)(2)(B), (b)(4), and (b)(6), respectively.

Comment 71: A comment was made calling attention to the fact that amendments made to sequence listings are provided for in sections on sequence listings (§ 1.821 *et seq.*).

Response: The comment has been adopted. With respect to the existing practice of making submissions under § 1.821(e), § 1.173 has been amended to limit the application of this section to computer programs and tables (see § 1.52(e)(1)) and to § 1.821(c), but not to submissions under § 1.821(e).

Section 1.174: Section 1.174 is removed (and reserved) in view of the inclusion of all filing and amendment requirements for reissue drawings in amended § 1.173. Thus, in addition to the reissue filing requirements of former § 1.173, the reissue amendment requirements of former § 1.121(b) and the reissue drawing requirements of former § 1.174 are all included in a single rule, amended § 1.173. The changes consolidating several former rules into a single rule should make the requirements for all reissue filings and amendments quicker to locate and easier to understand.

Section 1.176: Section 1.176 is amended to create §§ 1.176(a) and (b). Section § 1.176(a) contains material retained from the former rule, while § 1.176(b) contains new material permitting certain restrictions.

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

Elimination of the prohibition against restriction in divisional application under § 1.176 is effective for reissue applications filed on or after the date that is sixty days after the date of publication in the **Federal Register**.

Section 1.176(b) now allows the Office to make a restriction requirement in a reissue application between claims added in a reissue application and the original patent claims, where the added claims are directed to an invention which is separate and distinct from the invention(s) defined by the original patent claims. The criteria for making a restriction requirement in a reissue application between added claims and original patent claims is the same as that applied in an original application. See MPEP 806 through 806.05(i). Where a restriction requirement is made, the original patent claims will be held to be constructively elected and the examiner will issue an Office action on the merits

providing notification of the restriction requirement in such Office action.

If a requirement for restriction between the claims of the original patent and those added claims which are directed towards previously unclaimed subject matter is made by the examiner, the group containing the original patent claims (amended or unamended) will be held to be constructively elected, unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.

The original patent claims (which have been constructively elected) will receive a complete examination on their merits, while the nonelected (added) claims (to any added invention(s)) will be held in abeyance in a withdrawn status. These nonelected (added) claims will only be examined if filed in a divisional reissue application. If the reissue application contains only original unamended claims and is found to be allowable, further action in the reissue application may have to be suspended, since the Office will not allow a reissue patent which does not correct any error in the original patent. If the divisional reissue application containing the added claims is examined and is found to be allowable, the Office may recombine the several sets of examined and allowable claims into one of the reissue applications, which then can be allowed. See the discussion of § 1.177 for additional details for presenting multiple reissue applications.

The Office is requiring a constructive election of the original (patented) claims to ensure that the original (patented) claims receive an examination on their merits. If a reissue applicant was permitted to elect the added claims directed toward previously unclaimed subject matter, and, after an examination of only these added claims, the divisional claims were determined to be unpatentable, applicant would most likely let the reissue application go abandoned and not file a divisional reissue application directed toward the original claims of the patent. In this circumstance, no examination of the original claims of the patent would be made. This would not be appropriate as the filing of the reissue application would mandate that the original patent claims be reevaluated/examined again. Thus, a constructive election of the original patent claims and an examination thereof in the first reissue application would force the applicant to file a divisional reissue application with claims to the added invention in order

to secure an examination of such added claims.

The Office will continue to not require restriction among original claims of the patent (*i.e.*, among claims that were in the patent prior to filing the reissue application) and the rule has been amended to reflect that practice. In order for restriction to be required between the original patent claims and added claims, the added claims must be directed toward inventions which are separate and distinct from the invention(s) defined by the original patent claims. Restriction between multiple inventions in the added claims will be permitted provided the added claims are drawn to several separate and distinct inventions.

Section 1.176 has been further amended to delete the two-month portion of the rule relating to when a reissue application will be acted upon. When any particular reissue application is taken up for action is an internal Office policy that need not be set forth in the rules of practice. Moreover, it is the intent of the Office to consider acting on divisional reissue applications prior to expiration of the two-month period after announcement of the reissue filing in the *Official Gazette*.

The amendments to this section are not intended to affect the types of errors that are or are not appropriate for correction under 35 U.S.C. 251 (*e.g.*, applicant's failure to timely file a divisional application is not considered to be the type of error that can be corrected by a reissue). See *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990); *In re Mead*, 581 F.2d 251, 198 USPQ 412 (CCPA 1978); and *In re Orita*, 550 F.2d 1277, 193 USPQ 145 (CCPA 1977).

Section 1.177: The title to § 1.177 has been amended to read "Issuance of multiple reissue patents" in order to include procedures pertaining to continuation reissue applications as well as divisional reissue applications.

Section 1.177 is amended to eliminate former requirements that divisional reissues be limited to separate and distinct parts of the thing patented, and that they be issued simultaneously unless ordered by the Commissioner. The rule is expanded to include continuations of reissues as well as divisionals. See *In re Graff*, 111 F.3d 874, 876-77, 42 USPQ2d 1471, 1473 (Fed. Cir. 1997). The Federal Circuit specifically stated:

. . . [35 U.S.C. 251, ¶ 3.] provides that the general rules for patent applications apply also to reissue applications, and [35 U.S.C. 251, ¶ 2.] expressly recognizes that there may be more than one reissue patent for distinct and separate parts of the thing patented. [35

U.S.C. 251] does not prohibit divisional or continuation reissue applications, and does not place stricter limitations on such applications when they are presented by reissue, provided of course that the statutory requirements specific to reissue applications are met. *See* [35 U.S.C. 251, ¶ 3]

. . . [35 U.S.C. 251, ¶ 2.] is plainly intended as enabling, not limiting. [35 U.S.C. 251, ¶ 2.] has the effect of assuring that a different burden is not placed on divisional or continuation reissue applications, compared with divisions and continuations of original applications, by codifying [*The Corn-Planter Patent*, 90 U.S. 181 (1874).] which recognized that more than one patent can result from a reissue proceeding. Thus, [35 U.S.C. 251, ¶ 2.] places no greater burden on [a] continuation reissue application than upon a continuation of an original application; [35 U.S.C. 251, ¶ 2.] neither overrides, enlarges, nor limits the statement in [35 U.S.C. 251, ¶ 3.] that the provisions of Title 35 apply to reissues.

See id. at 876–77, 42 USPQ2d at 1473.

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

Following *Graff*, the Office has adopted a policy of treating continuations/divisionals of reissue applications in much the same manner as continuations/divisionals of non-reissue applications. Accordingly, the former requirements of § 1.177 as to petitioning for non-simultaneous issuance of multiple reissue patents, suspending prosecution in an allowable reissue application while the other is prosecuted, and limiting the content of each reissue application to separate and distinct parts of the thing patented, are all eliminated. These requirements were considered unique to reissue continuations/divisionals, imposed additional burdens on reissue applicants, and are now inconsistent with the Federal Circuit’s discussion of 35 U.S.C. 251, ¶ 2, in *Graff*.

The changes to § 1.177 relating to divisional reissues are effective on the date of publication of the rule in the **Federal Register** for all pending and new reissue applications.

Additionally, § 1.177(a) is amended to require that all multiple reissue applications of a single patent include as the first line of the respective specifications a cross-reference to the other reissue application(s). The cross-

reference will provide the public with notice that more than one reissue application has been filed to correct an error (or errors) in a single patent. If one reissue has already issued without the appropriate cross-reference, a certificate of correction will be issued to provide the cross-reference in the issued reissue patent. The Office will initiate a certificate of correction under § 1.322 to include the appropriate cross-reference in the already issued first reissue patent before passing the pending reissue application to issue.

Section 1.177(b) is amended to require that all of the claims of the patent be presented in each application as amended, unamended or canceled, and that the same claim not be presented for examination in more than one application in its original unamended version. Any added claims must be numbered beginning with the next highest number following the last patent claim.

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

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

other(s) in each of the respective specifications.

Section 1.178: The title of § 1.178 is amended to reflect the addition of the material in new § 1.178(b), and the rule is amended to create § 1.178(a) containing some of the material in the former rule, and § 1.178(b).

Section 1.178(a) is amended to no longer require an offer to surrender the original patent at the time of filing as part of the reissue application filing requirements. Omission of this formality by applicants in the past has resulted in processing delays due to the Office’s sending of a Notice to File Missing Parts of Application. The change to this section relaxes the former requirement and permits examination to commence without the “offer” to surrender the original patent. The requirement for actual surrender of the original patent (or a “statement” of its loss, as set out below) before the reissue application is allowed, however, is retained.

Section 1.178(a) is also amended to change “affidavit or declaration” (attesting to the loss or inaccessibility of the original patent) to “statement.” This change will eliminate the verification requirements of the former rule, which are formalities covered by §§ 1.4 and 10.18.

Replacement in § 1.178(a) of the oath or declaration with a statement that the original patent is lost or inaccessible is effective on the date of publication in the **Federal Register** for all pending or new reissue applications.

Section 1.178(b) has been added to require reissue applicants to call to the attention of the Office any prior or concurrent proceeding in which the patent (for which reissue is requested) is or was involved, such as interferences, reissues, reexaminations, or litigation (litigation covers any papers filed in the court or issued by the court, such as, for example, motions, pleadings, and court decisions including court orders) and the results of such proceedings. The duty to submit such information is a continuing duty and runs from the time the reissue application is filed until the reissue application is abandoned or issues as a reissue patent. The addition of § 1.178(b) is intended to further the Office’s desire to make consistent both reissue and reexamination proceedings as much as possible (*see* §§ 1.565(a) and (b)). *See also* § 1.173(a)(1).

The need to call the attention of the Office to prior or concurrent proceedings in which the patent (for which reissue is requested) is or was involved applies to pending and new reissue applications.

Section 1.181: Section 1.181 provides generically for petitions to the

Commissioner of Patents and Trademarks concerning patent-related matters. Section 1.181(f) is amended to provide that any petition under 37 CFR part 1 not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely (except as otherwise provided). Thus, any petition under § 1.182 or § 1.183 not filed within two months from the mailing date of the action or notice placing petitioner on notice of the situation from which relief is requested may be dismissed as untimely.

The Office has long considered the two-month period in § 1.181(f) to be the benchmark for determining the timeliness of petitions. See *Changes to Patent Practice and Procedure*, 62 FR at 53161, 1203 *Off. Gaz. Pat. Office* at 88 (the Office considers the two-month period in § 1.181(f) to be the appropriate period by which the timeliness of a petition should be determined). Nevertheless, there appears to be some confusion as to when other petitions (e.g., §§ 1.182 and 1.183) must be filed to be timely, or even whether there is any period within which other petitions must be filed to be timely. See *Helfgott v. Dickinson*, 209 F.3d 1328, 1333 n.3, 54 USPQ2d 1425, 1428 n.3 (Fed. Cir. 2000).

Therefore, the Office is revising § 1.181(f) to clarify that its two-month time period applies to any petition under 37 CFR part 1, except as otherwise provided. Section 1.181(f) is also amended to provide that this two-month period is not extendable. A number of sections (e.g., §§ 1.377, 1.378, 1.644, 1.740) specify the time period within which a petition must be filed (or may be dismissed as untimely). The two-month time period in § 1.181(f) applies to a petition under any section that does not specify the time period within which a petition must be filed.

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

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

Section 1.311: Section 1.311(b) is amended to create §§ 1.311(b), (b)(1), and (b)(2). Section 1.311(b) provides that an authorization to charge the issue fee (§ 1.18) to a deposit account may be filed in an individual application only after the mailing of the notice of allowance. Accordingly, general authorizations to pay fees and specific authorizations to pay the issue fee that are filed prior to the mailing of a notice of allowance will generally not be treated as requesting payment of the issue fee and will not be given effect to act as a reply to the notice of allowance. Applicant, when paying the issue fee, should submit a new authorization to charge fees, such as by completing box 6b. on the current PTOL-85B form. Where no reply to the notice of allowance is received, the application will stand abandoned notwithstanding the presence of general authorizations to pay fees or a specific authorization to pay the issue fee that were submitted prior to mailing of the notice of allowance. Where an attempt is made to pay the issue fee but an incorrect amount is submitted, § 1.311(b)(1), or where the Office's issue fee transmittal form (currently PTOL-85(B)) is completed by applicant and submitted, § 1.311(b)(2), in reply to a notice of allowance, an exception will be made. Such submissions will operate as a request to charge the issue fee to any deposit account identified in a previously filed authorization to charge fees, § 1.311(b). See also the change to § 1.26(b).

The limitation on authorization to charge issue fees to a deposit account under § 1.311(b) will apply only where a Notice of Allowance requiring the issue fee has been mailed on or after the date that is 60 days after publication in the **Federal Register**.

Previous § 1.311(b) caused problems for the Office that tended to increase Office processing time. The language used by applicants to authorize that fees be charged to a deposit account often varies from one application to another. As a result, conflicts arise between the Office and applicants as to the proper interpretation of authorizing language found in their applications. For example, some applicants are not aware that it is current Office policy to interpret broad language to "charge any additional fees which may be required at any time during the prosecution of the application" as authorization to charge the issue fee on applications filed on or after October 1, 1982. See *Deposit Account Authorization to Charge Issue Fee*, 1095 *Off. Gaz. Pat. Office* 44 (October 25, 1988), reprinted

at 1206 *Off. Gaz. Pat. Office* 95 (January 6, 1998).

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

Clerical problems are not the main reason for eliminating the practice. The Office would like all of the information necessary for printing a patent to be in the application when the issue fee is paid. Thus, the Office is eliminating petitions under § 3.81(b), see below, and intends to no longer print any assignee data that is submitted after payment of the issue fee. As explained in the previous two Notices, it is not generally in applicant's best interest to pay the issue fee at the time the notice of allowance is mailed, since it is much easier to have a necessary amendment or an information disclosure statement considered if filed before the issue fee is paid rather than after the issue fee is paid. See current §§ 1.97 and 1.312(b). Also, once the issue fee has been paid, applicant's window of opportunity for filing a continuing application is reduced and the applicant no longer has the option of filing a continuation or divisional application as a continued prosecution application (CPA) under § 1.53(d). See *Patents to Issue More Quickly After Issue Fee Payment*, 1220 *Off. Gaz. Pat. Office* 42, and *Filing of Continuing Applications, Amendments, or Petitions after Payment of Issue Fee*,

1221 *Off. Gaz. Pat. Office* 14. Many applicants find the time period between the mailing date of the notice of allowance and the due date for paying the issue fee useful for re-evaluating the scope of protection afforded by the allowed claim(s) and for deciding whether to pay the issue fee and/or to file one or more continuing applications.

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

As an additional aid to applicants, the rule as proposed has been further amended to include §§ 1.311(b)(1) and (b)(2) that can act as safety mechanisms. Where it is clear that an applicant actually intends to pay the issue fee such as by submitting an incorrect issue fee amount, or completing the issue fee transmittal form provided by the Office with the notice of allowance, a general authorization to pay fees or a specific authorization to pay the issue fee, submitted prior to the mailing of a notice of allowance, will be allowed to act as payment of the correct issue fee.

Thus, it is not seen that the proposal to eliminate the preauthorization to pay the issue fee would have any adverse effects on our customers.

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

Comment 72: One comment was received in response to the Notice of Proposed Rulemaking. The comment supported the change, particularly in view of the stricter standards proposed to §§ 1.312 and 1.313.

Section 1.312: The proposal to amend § 1.312 was not proceeded with in this final rule, but has been included in the interim rule *Changes to Application Examination and Provisional Application Practice*, 65 FR 14865

(March 20, 2000), 1233 *Off. Gaz. Pat. Office* 47 (April 11, 2000).

Section 1.313: The proposal to amend § 1.313 was not proceeded with in this final rule, but has been included in the interim rule *Changes to Application Examination and Provisional Application Practice*, 65 FR 14865 (March 20, 2000), 1233 *Off. Gaz. Pat. Office* 47 (April 11, 2000).

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

Section 1.322: Section 1.322(a) is amended to create §§ 1.322(a)(1) through (a)(4), and to incorporate the provisions of 35 U.S.C. 254.

Section 1.322(a)(1) provides that the Commissioner may issue a certificate of correction to correct a mistake in a patent, incurred through the fault of the Office, which mistake is clearly disclosed in the records of the Office.

Section 1.322(a)(1)(i) provides that a certificate of correction may be issued at the request of patentee or the patentee's assignee. Section 1.322(a)(1)(ii) provides that a certificate of correction may be issued sua sponte by the Commissioner for mistakes that the Office discovers. Section 1.322(a)(1)(iii) provides that a certificate of correction may be issued based on information supplied by a third party.

Section 1.322(a)(2)(i) provides that there is no obligation on the Office to act on or respond to submissions of information or requests to issue a certificate of correction by a third party under § 1.322(a)(1)(iii). The provisions of §§ 1.322(a)(1)(iii) and (a)(2) are intended to provide the Office flexibility in handling a request by a third party without an obligation to do so. Section 1.322(a)(2)(ii) provides that a paper submitted by a third party under this section will not be made of record in the file that it relates to nor be retained by the Office. The Office, however, will review such paper to determine whether the Office wishes to proceed with a certificate of correction based on the information supplied in such a paper.

Section 1.322(a)(3) continues to provide that if the request relates to a patent involved in an interference, the request must comply with the requirements of this section and be accompanied by a motion under § 1.635.

Section 1.322(a)(4) continues to provide that the Office will not issue such a certificate on its own initiative without first notifying the patentee (including any assignee of record) at the correspondence address of record and

affording the patentee an opportunity to be heard.

The certificate of correction practice re third parties applies to requests by third parties filed on or after two months from the date of publication in the **Federal Register**.

The former wording of § 1.322(a) contained language (“certificate will not be issued at the request or suggestion of anyone not owning an interest in the patent * * * without first notifying the patentee”) which has led third parties to conclude that they have standing to demand that the Office issue, or refuse to issue, a certificate of correction. Third parties do not have standing to demand that the Office issue, or refuse to issue, a certificate of correction. See *Hallmark Cards, Inc. v. Lehman*, 959 F. Supp. 539, 543-44, 42 USPQ2d 1134, 1138 (D.D.C. 1997). Section 1.322(a)(2), therefore, has been amended to clarify that third parties do not have standing to demand that the Office act on, respond to, issue, or refuse to issue a certificate of correction.

The Office is, however, cognizant of the need for the public to have correct information about published patents and may therefore accept information about mistakes in patents from third parties and may issue certificates of correction based upon that information (whether or not it is accompanied by a specific request for issuance of a certificate of correction), § 1.322(a)(1)(iii). The Office intends to retain its discretion under 35 U.S.C. 254 and may not issue a certificate of correction even if a mistake is identified, particularly if the identified mistake is not a significant one that would justify the cost and time to issue a certificate of correction even if requested by the patentee or patentee's assignee.

When such information (about mistakes in patents) is received by the Office, the Office does not intend to correspond with third parties about the information they submitted either to inform the third parties of whether it intends to issue a certificate of correction or to issue a denial of any request for issuance of a certificate of correction that may accompany the information. The Office will confirm to the party submitting such information that such information has in fact been received by the Office if a stamped, self-addressed post card has been submitted. See MPEP 503.

The proposed amendment to the rule set forth in the Notice of Proposed Rulemaking was intended to exclude third parties from submitting requests for certificates of correction. The final rule language has been modified to

permit third parties to submit information about mistakes in patents, while clarifying that the Office need not act on that information or deny any accompanying request for issuance of a certificate of correction. The Office may choose to issue a certificate of correction on its own initiative based on the information supplied by a third party if it desires to do so. Accordingly, a fee for submission of the information by a third party has not been imposed.

The Office in implementing the rule (and in setting forth the implementation in the MPEP) will consider establishing guidelines for the types of mistakes that it will issue a certificate of correction for (as the rule does not represent a requirement on the Office but is permissive in nature as is 35 U.S.C. 254 that states that the "Commissioner may issue a certificate of correction" but does not require the Commissioner to do so).

Comment 73: One comment supported the proposed amendment as it clarified that third parties do not have a right to demand issuance of a certificate of correction. Two comments opposed the proposed amendment arguing that the public has a right to know about apparent errors, such as by a third party requesting a certificate of correction.

Response: The comments have been adopted in a compromise whereby the rule has been amended to clarify that third parties do not have a right to request issuance of a certificate of correction, but that the Office will accept information regarding mistakes about published patents and may issue at its own initiative, after notice to the patentee or the patentee's assignee, a certificate of correction for significant mistakes.

Section 1.323: Section 1.323 is amended to provide that the Office may issue a certificate of correction under the conditions specified in 35 U.S.C. 255 at the request of the patentee or the patentee's assignee, upon payment of the fee set forth in § 1.20(a). The specific conditions set forth in the statute that were previously set forth in the rule have been replaced by a reference in the rule to the statute. Section 1.323 continues to provide that if the request relates to a patent involved in an interference, the request must comply with the requirements of this section and be accompanied by a motion under § 1.635.

Section 1.324: Section 1.324 has its title revised to reference the statutory basis for the rule, 35 U.S.C. 256. It is particularly important to recognize that 35 U.S.C. 256, the statutory basis for corrections of inventorship in patents

under § 1.324, is stricter than 35 U.S.C. 116, the statutory basis for corrections of inventorship in applications under § 1.48. 35 U.S.C. 256 requires "on application of all the parties and assignees," while 35 U.S.C. 116 does not have the same requirement. Thus, the flexibility under 35 U.S.C. 116, and § 1.48, wherein waiver requests under § 1.183 may be submitted (e.g., MPEP 201.03 (under the heading "Statement of Lack of Deceptive Intention")), is not possible under 35 U.S.C. 256, and § 1.324.

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

Elimination in § 1.324 of the requirement for a statement from the inventor being deleted to correct an inventorship error in a patent is effective on the date of publication in the **Federal Register**.

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

Section 1.324(c) is a newly added paragraph for reference §§ 1.48, 1.497, and 1.634 for corrections of inventorship in national applications, international applications, and interferences, respectively.

Comment 74: Two comments state that when adding an inventor to a patent, a new oath or declaration under § 1.63 should be required for all inventors, including the inventor to be added. This is seen to be required by 35 U.S.C. 115.

Response: The comments are not adopted. The change proposed to § 1.324 was directed to statements of lack of deceptive intent and not to the advisability of adding a § 1.63 declaration requirement; however, the suggested change will be addressed substantively.

35 U.S.C. 115 requires an applicant to make an oath that he believes himself to be the original and first inventor of the invention for which he solicits a patent. The statute is directed to applicant's filing of an application for a patent. 35 U.S.C. 256 is directed to correction of the inventorship in an issued patent and does not explicitly require the execution of a new oath/declaration. The statute does require application of all the parties and assignees, a requirement that is met by the provisions of §§ 1.324(b)(1) and (b)(2) (for the inventors), and § 1.324(c) (for the assignees).

Moreover, the major utility of a § 1.63 declaration, as far as the Office is concerned, is providing the inventors specific recognition of the need to disclose material information to the Office to aid in examination of their applications. Corrections relating to § 1.324 are directed to changes in inventorship and cannot at that time cause further examination of the application notwithstanding any change in the inventorship viz-a-viz prior art.

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

That the Office under § 1.366 may apply a maintenance fee payment where only the patent number is identified is effective on the date of publication in the **Federal Register**.

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

Section 1.446: Section 1.446 is amended so that its refund provisions are consistent with the refund provisions of § 1.26. See discussion of § 1.26.

Section 1.497: Section 1.497(b)(2) has been amended in a manner consistent with § 1.64(b). Therefore, § 1.497(b)(2) is amended to refer to any supplemental oath or declaration and to provide that if the person making the oath or declaration is the legal representative, the oath or declaration shall state that the person is the legal representative and shall state the citizenship (pursuant to 35 U.S.C. 115 and 117), residence, and mailing address of the legal representative. In addition, § 1.497(b)(2) is amended to delete the requirement that the oath or declaration state the facts required by §§ 1.42, 1.43, and 1.47. These facts are not required to be in the § 1.497 oath or declaration and should be included in a separate paper or a petition under § 1.47 and be signed by a person with firsthand knowledge of the facts.

Section 1.497(d) provides for the situation in which an oath or declaration filed pursuant to 35 U.S.C.

371(c)(4) and § 1.497 names an inventive entity different from the inventive entity set forth in the international application. Section 1.497(d) is added to provide that such an oath or declaration must be accompanied by: (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in § 1.17(i); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b)). Thus, naming a different inventive entity in an oath or declaration filed to enter the national stage under 35 U.S.C. 371 in an international application is not analogous to the filing of an oath or declaration to complete an application under 35 U.S.C. 111(a) (which operates to name the new inventive entity under §§ 1.41(a)(1) and 1.48(f)(1)), but is analogous to correction of inventorship under § 1.48(a).

Section 1.497(e) is added to explicitly state that the Office may require such other information as may be deemed appropriate under the particular circumstances surrounding the correction of inventorship. See also § 1.48(g).

Section 1.510: Section 1.510(b)(4) is amended to correspond to 1.173(a) as amended by the instant final rule, see the discussion as to the amendment of § 1.173. Section 1.510(b)(4) now sets forth the requirement that a copy of the patent for which reexamination is requested must be submitted in double column format, on single-sided sheets only. It is considered advantageous for the reexamination and reissue provisions to correspond with each other to the maximum extent possible, in order to eliminate confusion.

The double column format on single sided sheets requirement applies only to requests for reexamination filed on or after two months from the date of publication of the rule in the **Federal Register**.

Section 1.510(e) is provided with a conforming amendment to the amendment made to § 1.530. The reference in § 1.510(e) to “§ 1.530(d)” is changed to “§ 1.530” in view of the presence of amendment material in §§ 1.530(d) through (f).

Section 1.530: The title of § 1.530 has been amended to include procedures for changes in inventorship which can now be made during a reexamination proceeding.

Sections 1.530(d)(1), (d)(2), and (d)(6) are amended and rewritten as §§ 1.530(d)(1), (d)(2), and (d)(3). Sections 1.530(d)(3) and (d)(4) are redesignated as §§ 1.530(j) and (k). Section 1.530(d)(5) has been removed and replaced with a new § 1.530(d)(4) that cross-references § 1.52. Section 1.52 has been amended to extend the form requirements of applications to reexaminations proceedings where applicable.

Sections 1.530(e) through (i) are added, to provide a correspondence to §§ 1.173(b) *et seq.* as amended by the instant final rule, see the discussion as to the amendment of § 1.173. It is considered advantageous for the reexamination and reissue provisions to correspond with each other to the maximum extent possible, in order to eliminate confusion. The amendments make no substantive changes to reexamination practice.

Section 1.530(d)(1) is clarified to note that the paragraph applies whether or not an amendment is submitted on paper or compact disc pursuant to §§ 1.96 and 1.825.

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

Section 1.550: Section 1.550(a) is amended to add references to newly added §§ 1.105, and 1.115.

Section 1.550(b) is amended to clarify that responses by the owner to any rejection may include further statements “and/” or proposed amendments or new claims.

Section 1.550(c) had been proposed to be revised into § 1.550(c)(1), containing the current subject matter of § 1.550(c), and a § 1.550(c)(2) containing a proposal to add an “unintentional delay” relief alternative (to that of “unavoidable

delay”) for a reexamination proceeding that is terminated analogous to what is available for an application which is abandoned. The relief would have been provided in the form of an extension of time. The proposal will not be carried forward in view of § 4605(a) of the “American Inventors Protection Act of 1999,” which establishes unintentional delay relief for reexaminations. Section 4605(a) of the “American Inventors Protection Act of 1999” will become effective on November 29, 2000. The Office plans to provide unintentional delay relief for both “*ex parte*” and “*inter partes*” reexamination under § 4605(a) of the “American Inventors Protection Act of 1999.”

Section 1.565: Section 1.565(a) is amended to change “shall” to “must,” as a conforming change with §§ 1.510(b)(4), 1.173(a)(1), and 1.178(b). This is not a change in substance.

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

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

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

behalf of the patent owner. This proof is generally in the form of a letter signed by the patent owner authorizing the marketing applicant to act on behalf of the patent owner in applying for term extension. Lastly, § 1.730(d) states that the Office may require proof of authority of a registered practitioner who signs the application for patent term extension on behalf of the patent owner or the agent of the patent owner. This proof of authority would generally be in the form of a power of attorney signed by the patent owner and establishing ownership of the patent by reference to an attached assignment document or the reel and frame number of the recorded assignment document as set forth in § 3.73(b).

Section 1.740: Currently, for each product claim, method of use claim, and method of manufacturing claim which reads on the approved product, a showing is required demonstrating the manner in which each applicable claim reads on the approved product. 35 U.S.C. 156 provides that a patent, which includes one of the following three categories of claims: An approved product, method of using an approved product, and method of manufacturing an approved product, shall be extended if certain conditions apply, and provides rights specific to the three claim categories. See 35 U.S.C. 156(a) and (b). 35 U.S.C. 156(d) requires that an application for extension identify each relevant claim of the patent but does not require an explanation of how each identified claim of the patent claims the approved product, or a method of use of an approved product, or a method of manufacturing an approved product. Often one patent contains many claims to an approved product, but once it is explained how one such claim of the patent claims the approved product, further explanation as to other claims of the patent which claim the approved product is redundant. It is similarly redundant to explain how multiple claims of the patent claim the method of using an approved product, or the method of manufacturing the approved product. In order to reduce the time required to prepare and review an application for patent term extension, the rule now provides that only one claim, in each of the three categories of claims must be explained but retains the statutory requirement that all claims relevant to each of the three categories of claims be identified.

Section 1.740(a)(9) is amended to provide that the application for patent term extension need only explain how *one* product claim of the patent claims the approved product, if there is a claim

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

The need under § 1.740(a)(9) for an explanation of how only one claim in a category reads on the approved product, or method of using, or method of manufacturing is effective on the date of publication in the **Federal Register**.

Sections 1.740(a)(10)(i) through (a)(10)(v) are amended to separate the text therein into aid in comprehension of the text.

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

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

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

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

Section 1.740(b) is amended to delete the requirement for an oath or declaration since the averments set forth in § 1.740(b) are implicit in the submission of an application for patent term extension and the signature on the application, and now contains subject matter transferred from former § 1.740(a)(16).

The deletion of the oath/declaration requirement in § 1.740(b) is effective on the date of publication in the **Federal Register**.

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

Section 1.741: Section 1.741(a) is amended to clarify the language to

reference §§ 1.8 and 1.10 instead of referencing the rules and the titles of the rules. Section 1.741(a)(5) is amended to correct the format of the citation of the statute.

Section 1.741(b) is amended to provide that requests for review of a decision that the application for patent term extension is incomplete, or review of the filing date accorded to the application, must be filed as a petition under § 1.741 accompanied by the fee set forth in § 1.17(h), rather than a petition under § 1.181, that the petition must be filed within two months of the date of the notice, and that the extension of time provisions of § 1.136 apply, unless the notice indicates otherwise.

Section 1.760: Section 1.760 is amended to correct the spelling of "Official Gazette."

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

Section 1.809: The following proposed changes to § 1.809 are being held in abeyance in view of the statutory mandate to consider recommendations of a required study (that will need to be done) prior to drafting regulatory changes affecting biological deposits (see discussion in § 1.136): Section 1.809(b) to change "respond" to "reply" (see § 1.111); Section 1.809(b)(1) to eliminate the language discussing payment of the issue fee; Section 1.809(c) to provide that if an application for patent is otherwise in condition for allowance except for a needed deposit and the Office has received a written assurance that an acceptable deposit will be made, applicant will be notified and given a period of time within which the deposit must be made in order to avoid abandonment; Section 1.809(c) to provide that this time period is not extendable under § 1.136(a) or (b) (see § 1.136(c)); Section 1.809(c) to eliminate the language stating that failure to make a needed deposit will result in abandonment for failure to prosecute, because abandonment for failure to prosecute occurs by operation of law when an applicant fails to timely comply with such a requirement (see 35 U.S.C. 133).

Section 1.821: The Office indicated in the Notice of Proposed Rulemaking that the submission of sequence listings on paper is a significant burden on the applicants and the Office, and that it was considering changes to § 1.821 *et seq.* to: (1) permit a machine-readable submission of the nucleotide and/or amino acid sequence listings to be submitted in an appropriate archival

medium; and (2) no longer require the voluminous paper submission of nucleotide and/or amino acid sequence listings.

Unlike a computer program listing appendix under § 1.96(c), a sequence listing under § 1.821 is part of the official disclosure of the application. Nevertheless, as § 4804(a) of the "American Inventors Protection Act of 1999" amended 35 U.S.C. 22 to provide that the Office "may require papers filed in the Patent and Trademark Office to be printed, typewritten or on an electronic medium," the Office may accept or even require the electronic filing of material in a patent application.

As discussed above with regard to the amendments to § 1.96, CD-ROM and CD-R are the only practical electronic media of archival quality. The "Sequence Listing" on a compact disc, specified by § 1.52(e) and § 1.821(c), would serve as the "original" of the sequence listing, in lieu of the paper, yet offers the conveniences of small size and ease in viewing. Thus, the Office is specifically revising § 1.821 *et seq.* to permit applicants to submit the official copy of the sequence listing either on paper or on compact discs.

Though the sequence listing on the compact disc will not be entered into the text search system of the Office, it will be searchable through the usual facilities of the Automated Biotech Search System after the patent is issued or the application is published. It will be available to the public through channels already provided.

Section 1.821(c) is amended to provide that a "Sequence Listing" must be submitted either: (1) on paper, or (2) on a compact disc, as defined in the amended § 1.52(e) and as further specified in § 1.823(a)(2). For nucleotide and/or amino acid sequences, no change is made to the computer readable form (CRF) practice under § 1.821(e). The requirement for a paper copy of the sequences under § 1.821(c) is modified to allow applicants to satisfy § 1.821(c) with either a paper version as under the former practice or a submission on a CD-ROM or CD-R presented in duplicate. Any submission on CD-ROM or CD-R under § 1.821(c) is in addition to and not a replacement for the CRF required under § 1.821(e).

Section 1.821(e) concerning the computer readable form has been amended only as to matters of form. The compact disc submitted under § 1.821(c) may, if it contains no tables, be identical to the CRF submitted under § 1.821(e) and § 1.824, if that CRF is submitted on a compact disc. Even if the compact discs submitted under §§ 1.821(c) and (e) are identical, each compact disc

submitted under § 1.821(c) must be submitted in duplicate, in addition to the CRF copy under § 1.821(e). However, the right of the applicant to submit the CRF on other media, such as magnetic disks, tape or Zip disks has been maintained.

Section 1.821(f) is amended for consistency with the provisions in § 1.821(c) that permit the official copy of the "Sequence Listing" required by § 1.821(c) to be a paper or a CD-ROM or CD-R.

Section 1.823: Section 1.823(a)(2) is added to set forth the new requirements if the "Sequence Listing" submitted pursuant to § 1.821(c) is on a compact disc.

Section 1.823(a)(2) is amended to provide that any "Sequence Listing" submitted under § 1.821(c) must conform to the specifications in § 1.52(e). The compact disc that is used to submit the "Sequence Listing" may also contain tables or text information from the figures when such sections of the application are also of inconvenient size (over 50 pages). The tables are often used as explanatory devices in the biotechnology applications to describe the sequences and their purposes and differences. They can be quite lengthy. As an example, a table of over 30,000 pages has been submitted.

Section 1.824: Section 1.824 is amended as to matters of form. Section 1.824(b) is amended only to recognize the acceptability of electronic "Sequence Listings" created under the MS-Windows operating system, as well as DOS and the other operating systems itemized in § 1.824(b)(2). Section 1.824(c) is amended to recognize the acceptability of compact discs, recordable (CD-Rs) as a submission medium, in addition to CD-ROMs. The generic term compact disc is indicated.

Section 1.825: Section 1.825(a) is amended to provide that any amendment to the compact disc copy of the "Sequence Listing" submitted pursuant to § 1.821(c) must be made by submission of a new compact disc containing a substitute "Sequence Listing" and that such amendments must be accompanied by a statement that indicates support for the amendment in the application-as-filed, and a statement that the new compact disc includes no new matter. Section 1.825(b) is amended to provide that any amendment to the CD-ROM or CD-R copy of the "Sequence Listing" pursuant to § 1.825(a) must be accompanied by a substitute copy of the computer readable form of the "Sequence Listing" required pursuant to § 1.821(e), including all previously submitted data with the amendment

incorporated therein, and accompanied by a statement that the computer readable form copy is the same as the new compact disc copy of the "Sequence Listing."

Comments received on this section are addressed above in the discussion of the change to § 1.96.

Part 3

Section 3.27: Section 3.27 is amended to eliminate separate §§ 3.27(a) and (b). The rule is also amended to eliminate the reference, under former § 3.27(b), to a document required by Executive Order 9424 which does not affect title, and to replace the reference to a "petition" with a reference to a "request" in conformance with the change to § 3.81.

Section 3.71: Section 3.71 is revised as discussed below. In conjunction with this revision, the section is broken into §§ 3.71(a) through (d), with each section being given a heading, in order to more clearly delineate the topics of the sections.

Section 3.71(a) clarifies that the assignee must be of record pursuant to § 3.71(c) in a U.S. national patent application or reexamination proceeding in order to conduct prosecution in place of the inventive entity (the inventors of the application) or any previous assignee that was entitled to conduct prosecution.

Section 3.71(b) is added to clarify and define what is meant by the § 3.71(a) assignee which may conduct the prosecution of a U.S. national application for a patent or reexamination proceeding.

A national patent application is owned by the inventor(s), the assignee(s) of the inventor(s), or some combination of the two. All parties having a portion of the ownership must act together in order to be entitled to conduct the prosecution.

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

If there is no assignee of the entire right, title and interest of the patent application, then two possibilities exist: *First:* the application is not assigned; thus, ownership resides solely in the inventor(s) (*i.e.*, the applicant(s)). In this situation, § 3.71 does not apply since there is no assignee, and the single inventor, or the combination of all the joint inventors, is needed to conduct the prosecution of an application. *Second:* the application has been assigned; thus, there is at least one "partial assignee." As pointed out in § 3.71(b)(2), a partial assignee is any assignee of record who has less than the entire right, title and

interest in the application (or patent being reexamined). The application will be owned by the combination of all partial assignees and all inventors who have not assigned away their right, title, and interest in the application. Section 3.71(b)(2) points out that where at least one inventor retains an ownership interest together with the partial assignee(s), the combination of all partial assignees and all inventors retaining ownership interest is needed to conduct the prosecution of an application. Where no inventor retains an ownership interest, the combination of all partial assignees is needed to conduct the prosecution of an application.

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

This definition of the assignee would apply wherever the assignee is permitted to take action in the prosecution of an application for patent or reexamination proceeding.

Section 3.71(c) defines the meaning of the term "of record" used in § 3.71(b). An assignee is made of record in an application by filing a statement which is in compliance with § 3.73(b). The statement must be signed by a party authorized to act on behalf of the assignee as defined in § 3.73(b)(2). *See also* MPEP 324. Note that the assignee being made "of record" in an application is different from the recording of an assignment in the assignment records of the Office pursuant to § 3.11. Recording in the assignment records is not sufficient to establish a new assignee in an individual application or reexamination proceeding; a § 3.73(b) statement must be filed in the individual application or proceeding to establish the new assignee for that application or reexamination proceeding.

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

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

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

Section 3.73: Section 3.73(a), the second sentence is revised to include a trademark registration, in addition to a trademark application which is currently recited. The sentence has been revised to read: "The original applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment."

Section 3.73(b) is revised for clarity and paragraph formatting, creating §§ 3.73(b)(1) and (b)(2). Section 3.73(b)(1) clarifies that the statement establishing ownership must explicitly identify the assignee (by adding the language "a signed statement identifying the assignee"). Section 3.73(b)(1) makes it clear that while the submission establishing ownership is separate from, and in addition to, the specific action taken by the assignee (*e.g.*, appointing a new attorney), the two may be presented together as part of the same paper. This clarification has been effected by adding "The establishment of ownership by the assignee may be combined with the paper that requests or takes the action."

Previously, § 3.73(b) required that the submission (statement) establishing ownership "must be signed by a party authorized to act on behalf of the assignee." Section 3.73(b)(2) now clarifies what is acceptable to show that the party signing the submission is authorized to act on behalf of the

assignee. The submission could include a statement that the party signing the submission is authorized to act on behalf of the assignee, pursuant to § 3.73(b)(2)(i). Alternatively, the submission could be signed by a person having apparent authority to sign on behalf of the assignee, *e.g.*, an officer of the assignee, pursuant to § 3.73(b)(2)(ii).

In the first case, the statement that the party signing the submission is authorized to act on behalf of the assignee could be an actual statement included in the text of the submission that the signing person "is authorized to act on behalf of the assignee."

Alternatively, it could be in the form of a resolution by the organization or business entity owning the property (*e.g.*, a corporate resolution, a partnership resolution) included with the submission.

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

New § 3.73(c)(1) requires that the submission establishing ownership by the assignee must be submitted prior to, or at the same time, as the paper requesting or taking action is submitted. If the submission establishing ownership is not present, the action sought to be taken will not be given effect. If the submission establishing ownership is submitted at a later date, that date will be the date of the request for action or action taken.

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

submission as an establishment of ownership.

Section 3.81: Section 3.81 was proposed to be amended to eliminate entirely the provisions of § 3.81(b), which provide a petition remedy to have the patent issue to the assignee where a petition for such issuance is submitted after the date of payment of the issue fee. The Office is not proceeding with this proposal in this final rule but it is eliminating the requirement for a petition.

Section 3.81 has been amended to reformat the section by removing material from § 3.81(a) relating to partial assignees and placing it in new § 3.81(c) that applies to both §§ 3.81(a) and (b). Titles for §§ 3.81(a) through (c) have been added.

Section 3.81 has been amended to permit proof of the application's assignment to be submitted with or after the payment of the issue fee so that a patent may issue in the name(s) of the assignee(s) consistent with the application's assignment. The need for a petition after the issue fee has been paid has been eliminated as the Office intends to comply with requests to issue patents in the names of assignee(s). Obviously, the extent to which the Office can comply with such requests will depend upon the time frames of when the request is filed, the time it takes to match the request with the file, and when the application is due to issue as a patent.

Section 3.81 formerly required that the assignment had to have been recorded among the Office's assignment records before a patent could be issued to the assignee(s). An applicant could comply with this requirement by submitting the assignment along with directions to record it among the Office's assignment records at the same time that the issue fee and the PTOL-85B form are filed. Revised § 3.81 now provides another option. It is now permitted to rely on a § 3.73(b) statement, which would require that a copy of the assignment be supplied but the assignment would not have to be recorded. Thus, if the assignment is already recorded in the Office, applicant would probably not choose the § 3.73(b) option. Where the § 3.73(b) option is chosen, reliance may be had on a § 3.73(b) statement previously made of record in the application (if the statement is still accurate at the time the request is filed), or the § 3.73(b) statement may be filed with the issue fee and the PTOL-85B filing.

This amendment is consistent with current practice under §§ 3.71 and 3.73 for other matters, where a statement rather than a recording is required.

Adding the option of relying on a § 3.73(b) statement and the elimination of the "petition" requirement should result in faster processing of § 3.81 requests by the Office of Patent Publications, particularly as a separate assignment paper, if submitted at the time the issue fee is paid, would not need to be sent to Assignment Division for recording.

Part 5

Section 5.1: Section 5.1 is amended to locate its current text in § 5.1(a), and to remove the term "Assistant" in the title of the Office official who should be the addressee.

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

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

Section 5.1 is also amended to add a § 5.1(d) to provide that: (1) The applicant in a national security classified patent application must obtain a secrecy order pursuant to § 5.2(a); (2) if a national security classified patent application is filed without a notification pursuant to § 5.2(a), the Office will set a time period within which either the application must be declassified, or the application must be placed under a secrecy order pursuant to § 5.2(a), or the applicant must submit evidence of a good faith effort to obtain a secrecy order pursuant to § 5.2(a) from the relevant department or agency in order to prevent abandonment of the application; and (3) if evidence of a good faith effort to obtain a secrecy order pursuant to § 5.2(a) from the relevant department or agency is submitted by the applicant within the time period set by the Office, but the application has not been declassified or placed under a secrecy order pursuant to § 5.2(a), the Office

will again set a time period within which either the application must be declassified, or the application must be placed under a secrecy order pursuant to § 5.2(a), or the applicant must submit evidence of a good faith effort to again obtain a secrecy order pursuant to § 5.2(a) from the relevant department or agency in order to prevent abandonment of the application. Section 5.1(d) sets forth the treatment of national security classified applications that is currently set forth in MPEP 130.

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

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

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

Section 5.12: Section 5.12(b) is amended to require that the fee set forth in § 1.17(h) is required for any petition under § 5.12 for a foreign filing license. As a practical matter, all petitions under § 5.12 are treated on an expedited basis. Therefore, it is appropriate to require the fee set forth in § 1.17(h) for all petitions under § 5.12.

Part 10

The title has been amended to reflect the name change of the Office by the addition of "United States."

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

Classification

Administrative Procedure Act: The change to § 1.181 was not included in the Notice of Proposed Rulemaking.

This change to the rules of practice simply sets a time period within which any petition must be filed to avoid being dismissed as untimely. Therefore, this change concerns only rules of Office procedure, and prior notice and an opportunity for public comment for this change is not required pursuant to 5 U.S.C. 553(b)(A), or any other law. In addition, pursuant to the authority at 5 U.S.C. 553(d)(1), the changes to §§ 1.27, 1.78, 1.131, 1.132, 1.137, 1.152, 1.155, 1.324, 1.366, 1.740, and 1.760, and the removal of § 1.44, may be made effective immediately because they relieve restrictions in the rules of practice.

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

Executive Order 13132: This rulemaking does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (August 4, 1999).

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

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

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 proposed information collections under OMB control numbers 0651-0031, 0651-0032, and 0651-0035. The Office submitted these information collections to OMB for its review and approval because the following changes in this final rule affect the information collection requirements associated with the information collections under OMB control numbers 0651-0031, 0651-0032, and 0651-0035: (1) The change to § 1.27 and permits an applicant to establish small entity status in an application by a simple assertion of entitlement to small entity status (without a statement having a formalistic reference to § 1.9 or a standard form (PTO/SB/09/10/11/12)); (2) the change to §§ 1.55, 1.63 and 1.78 eliminates the need for an applicant using the application data sheet (§ 1.76) to provide priority claims in the oath or declaration or specification; (3) the change to § 1.96 requires applicants to submit lengthy computer listings on a CD-ROM or CD-R (rather than microfiche); (4) the change to §§ 1.821, 1.823, and 1.825 permits applicants to submit sequence listings on a CD-ROM or CD-R (rather than paper); and (5) the change to § 1.155 allows an applicant to seek expedited examination of a design application by filing a request for expedited examination.

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

The title, description and respondent description of each of the information collections are shown below with an estimate of each of the annual reporting burdens. Included in each estimate is the time for reviewing instructions, gathering and maintaining the data needed, and completing and reviewing the collection of information. The principal impact of the changes in this final rule is to raise the efficiency and effectiveness of the Office's business processes to make the Office a more business-like agency and increase the level of the Office's service to the public.

OMB Number: 0651-0016.

Title: Rules for Patent Maintenance Fees.

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

Type of Review: Approved through December of 2002.

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

Estimated Number of Respondents: 326,101.

Estimated Time Per Response: 0.08 hour.

Estimated Total Annual Burden Hours: 26,099 hours.

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

OMB Number: 0651-0020.

Title: Patent Term Extension.

Form Numbers: None.

Type of Review: Approved through September of 2001.

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

Estimated Number of Respondents: 57.

Estimated Time Per Response: 22.8 hours.

Estimated Total Annual Burden Hours: 1,302 hours.

Needs and Uses: The information supplied to the Office by an applicant seeking a patent term extension is used by the Office, the Department of Health and Human Services, and the Department of Agriculture to determine the eligibility of a patent for extension and to determine the period of any such extension. The applicant can apply for

patent term and interim extensions, petition the Office to review final eligibility decisions, and withdraw patent term extensions. If there are multiple patents, the applicant can designate which patents should be extended. An applicant can also declare their eligibility to apply for a patent term extension.

OMB Number: 0651-0021.

Title: Patent Cooperation Treaty.

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

Type of Review: Approved through August of 2000.

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

Estimated Number of Respondents: 102,950.

Estimated Time Per Response: 0.9538 hour.

Estimated Total Annual Burden Hours: 98,195 hours.

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

OMB Number: 0651-0022.

Title: Deposit of Biological Materials for Patent Purposes.

Form Numbers: None.

Type of Review: Approved through December of 2000.

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

Estimated Number of Respondents: 3,300.

Estimated Time Per Response: 1.0 hour.

Estimated Total Annual Burden Hours: 3,300 hours.

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

OMB Number: 0651-0024.

Title: Requirements for Patent Applications Containing Nucleotide

Sequence and/or Amino Acid Sequence Disclosures.

Form Numbers: None.

Type of Review: Approved through November of 1999. Resubmitted on April 6, 2000.

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

Estimated Number of Respondents: 4,600.

Estimated Time Per Response: 1.33 hours.

Estimated Total Annual Burden Hours: 6,133 hours.

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

OMB Number: 0651-0027.

Title: Changes in Patent and Trademark Assignment Practices.

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

Type of Review: Approved through May of 2002.

Affected Public: Individuals or Households and Businesses or Other For-Profit 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/08/21-27/31/42/43/61/62/63/64/67/68/91/92/96/97.

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: 2,040,630.

Estimated Time Per Response: 0.39 hours.

Estimated Total Annual Burden Hours: 788,421 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: 344,100.

Estimated Time Per Response: 8.7 hours.

Estimated Total Annual Burden Hours: 2,994,160 hours.

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

OMB Number: 0651-0033.

Title: Post Allowance and Refiling.

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

Type of Review: Approved through September of 2000.

Affected Public: Individuals or Households, Business or Other For-Profit 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.

OMB Number: 0651-0035.

Title: Address-Affecting Provisions.

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

Type of Review: Approved through October of 2002.

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

Estimated Number of Respondents: 263,520.

Estimated Time Per Response: 0.05 hour.

Estimated Total Annual Burden Hours: 13,386 hours.

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

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, Office of Management and Budget, New Executive Office Building, 725 17th Street, N.W., Room 10235, Washington, D.C. 20503, Attention: Desk Officer for the 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 recordkeeping requirements, Small businesses.

37 CFR Part 3

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

37 CFR Part 5

Classified information, Foreign relations, Inventions and patents.

37 CFR Part 10

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

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

PART 1—RULES OF PRACTICE IN PATENT CASES

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

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

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

§ 1.4 Nature of correspondence and signature requirements.

* * * * *

(b) Since each file must be complete in itself, a separate copy of every paper to be filed in a patent or trademark

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

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

* * * * *

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

§ 1.6 Receipt of correspondence.

* * * * *

(d) * * *

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

* * * * *

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

§ 1.9 Definitions.

* * * * *

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

* * * * *

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

§ 1.12 Assignment records open to public inspection.

* * * * *

(c) * * *

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

* * * * *

6. Section 1.14 is revised to read as follows:

§ 1.14 Patent applications preserved in confidence.

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

(1) *Status information is:*

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

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

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

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

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

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

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

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

(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) *Copy of application-as-filed.* If a U.S. patent incorporates by reference a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request accompanied by the fee set forth in § 1.19(b)(1).

(d) *Power to inspect a pending or abandoned application.* Access to an application may be provided to any person if the application file is available, and the application contains written authority (e.g., a power to

inspect) granting access to such person. The written authority must be signed by:

(1) An applicant;

(2) An attorney or agent of record;

(3) An authorized official of an assignee of record (made of record pursuant to § 3.71 of this chapter); or

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

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

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

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

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

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

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

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

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

(2) The applicant, or a party involved in an interference for which a decision was rendered, is given notice and an opportunity to object in writing within two months on the ground that the decision discloses a trade secret or other confidential information. Any objection must identify the deletions in the text of

the decision considered necessary to protect the information, or explain why the entire decision must be withheld from the public to protect such information. An applicant or party will be given time, not less than twenty days, to request reconsideration and seek court review before any portions of a decision are made public under this paragraph over his or her objection.

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

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

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

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

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

§ 1.17 Patent application processing fees.

* * * * *

(h) For filing a petition to the Commissioner 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.
§ 1.182—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 an interference settlement agreement.
§ 1.741(b)—to accord a filing date to an application for extension of a patent term.
§ 5.12—for expedited handling of a foreign filing license.
§ 5.15—for changing the scope of a license.
§ 5.25—for a 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(c)(3)—to convert a provisional application filed under § 1.53(c) to a nonprovisional application under § 1.53(b).
§ 1.55—for entry of late priority papers.
§ 1.103(b)—for requesting limited suspension of action in continued prosecution application (§ 1.53(d)).
§ 1.103(c)—for requesting limited suspension of action after a request for continued examination (§ 1.114).
§ 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.

* * * * *

(k) For filing a request for expedited examination under § 1.155(a)—\$900.00

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

By a small entity (§ 1.27(a))—\$55.00

By other than a small entity—\$110.00

(m) For filing a petition for the revival of an unintentionally abandoned application or the unintentionally delayed payment of the issue fee under 35 U.S.C. 41(a)(7) (§ 1.137(b)):

By a small entity (§ 1.27(a))—\$620.00
By other than a small entity—\$1,240.00

* * * * *

(p) For submission of an information disclosure statement under § 1.97(c) and (d)—\$180.00

(q) Processing fee for taking action under one of the following sections which refers to this paragraph—\$50.00

§ 1.41—to supply the name or names of the inventor or inventors after the filing date without a cover sheet as prescribed by § 1.51(c)(1) in a provisional application.
§ 1.48—for correction of inventorship in a provisional application.
§ 1.53(c)(2)—to convert a nonprovisional application filed under § 1.53(b) to a provisional application under § 1.53(c).

* * * * *

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

§ 1.19 Document supply fees.

The United States Patent and Trademark Office will supply copies of the following documents upon payment of the fees indicated. The copies will be in black and white unless the original document is in color, a color copy is requested and the fee for a color copy is paid.

(a) Uncertified copies of patents:
(1) Printed copy of the paper portion of a patent, including a design patent, statutory invention registration, or defensive publication document:
(i) Regular service—\$3.00
(ii) Overnight delivery to Office Box or overnight facsimile—\$6.00
(iii) Expedited service for copy ordered by expedited mail or facsimile delivery service and delivered to the customer within two workdays—\$25.00
(2) Printed copy of a plant patent in color—\$15.00
(3) Color copy of a patent (other than a plant patent) or statutory invention registration containing a color drawing—\$25.00

(b) Certified and uncertified copies of Office documents:

(1) Certified or uncertified copy of the paper portion of patent application as filed:

(i) Regular service—\$15.00
(ii) Expedited regular service—\$30.00
(2) Certified or uncertified copy of paper portion of patent-related file wrapper and contents:
(i) File wrapper and paper contents of 400 or fewer pages—\$200.00

- (ii) Additional fee for each additional 100 pages or portion thereof—\$40.00
- (iii) Additional fee for certification—\$25.00

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

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

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

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

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

* * * * *

9. Section 1.22 is amended by revising paragraph (b) to read as follows:

§ 1.22 Fee payable in advance.

* * * * *

(b) All fees paid to the United States Patent and Trademark Office must be itemized in each individual application, patent, trademark registration file, or other proceeding in such a manner that it is clear for which purpose the fees are paid. The Office may return fees that are not itemized as required by this paragraph. The provisions of § 1.5(a) do not apply to the resubmission of fees returned pursuant to this paragraph.

* * * * *

10. Section 1.25 is amended by revising paragraph (b) to read as follows:

§ 1.25 Deposit accounts.

* * * * *

(b) Filing, issue, appeal, international-type search report, international application processing, petition, and post-issuance fees may be charged against these accounts if sufficient funds are on deposit to cover such fees. A general authorization to charge all fees, or only certain fees, set forth in § 1.16 to § 1.18 to a deposit account containing sufficient funds may be filed in an individual application, either for the entire pendency of the application or with respect to a particular paper filed. An authorization to charge a fee to a deposit account will not be considered payment of the fee on the date the authorization to charge the fee is effective as to the particular fee to be charged unless sufficient funds are present in the account to cover the fee. An authorization to charge fees under § 1.16 in an application filed under 35 U.S.C. 371 will be treated as an authorization to charge fees under § 1.492. An authorization to charge fees

set forth in § 1.18 to a deposit account is subject to the provisions of § 1.311(b). An authorization to charge to a deposit account the fee for a request for reexamination pursuant to § 1.510 and any other fees required in a reexamination proceeding in a patent may also be filed with the request for reexamination.

* * * * *

11. Section 1.26 is amended by revising paragraph (a) and adding paragraph (b) to read as follows:

§ 1.26 Refunds.

(a) The Commissioner may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent or trademark filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify the payor of such amounts. If a party paying a fee or requesting a refund does not provide the banking information necessary for making refunds by electronic funds transfer (31 U.S.C. 3332 and 31 CFR part 208), or instruct the Office that refunds are to be credited to a deposit account, the Commissioner may require such information, or use the banking information on the payment instrument to make a refund. Any refund of a fee paid by credit card will be by a credit to the credit card account to which the fee was charged.

(b) Any request for refund must be filed within two years from the date the fee was paid, except as otherwise provided in this paragraph or in § 1.28(a). If the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization (§ 1.25(b)), any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge, and include a copy of that deposit account statement. The time periods set forth in this paragraph are not extendable.

* * * * *

12. Section 1.27 is revised to read as follows:

§ 1.27 Definition of small entities and establishing status as a small entity to permit payment of small entity fees; when a determination of entitlement to small entity status and notification of loss of entitlement to small entity status are required; fraud on the Office.

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

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

(2) *Small business concern.* A small business concern, as used in paragraph (c) of this section, means any business concern that:

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

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

(3) *Nonprofit Organization.* A nonprofit organization, as used in paragraph (c) of this section, means any nonprofit organization that:

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

(ii) Is either:

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

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

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

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

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

(ii) For small business concerns and nonprofit organizations under paragraphs (a)(2) and (a)(3) of this section, a license to a Federal agency resulting from a funding agreement with that agency pursuant to 35 U.S.C. 202(c)(4) does not constitute a license for the purposes of paragraphs (a)(2)(i) and (a)(3)(i) of this section.

(b) *Establishment of small entity status permits payment of reduced fees.* A small entity, as defined in paragraph (a) of this section, who has properly asserted entitlement to small entity status pursuant to paragraph (c) of this section will be accorded small entity status by the Office in the particular application or patent in which entitlement to small entity status was asserted. Establishment of small entity status allows the payment of certain reduced patent fees pursuant to 35 U.S.C. 41(h).

(c) *Assertion of small entity status.* Any party (person, small business concern or nonprofit organization) should make a determination, pursuant to paragraph (f) of this section, of entitlement to be accorded small entity status based on the definitions set forth in paragraph (a) of this section, and must, in order to establish small entity status for the purpose of paying small entity fees, actually make an assertion of entitlement to small entity status, in the manner set forth in paragraphs (c)(1) or (c)(3) of this section, in the application or patent in which such small entity fees are to be paid.

(1) *Assertion by writing.* Small entity status may be established by a written assertion of entitlement to small entity status. A written assertion must:

(i) Be clearly identifiable;

(ii) Be signed (see paragraph (c)(2) of this section); and

(iii) Convey the concept of entitlement to small entity status, such as by stating that applicant is a small entity, or that small entity status is entitled to be asserted for the application or patent. While no specific words or wording are required to assert small entity status, the intent to assert small entity status must be clearly indicated in order to comply with the assertion requirement.

(2) *Parties who can sign and file the written assertion.* The written assertion can be signed by:

(i) One of the parties identified in § 1.33(b) (e.g., an attorney or agent registered with the Office), § 3.73(b) of this chapter notwithstanding, who can also file the written assertion;

(ii) At least one of the individuals identified as an inventor (even though a § 1.63 executed oath or declaration has not been submitted), notwithstanding § 1.33(b)(4), who can also file the written assertion pursuant to the exception under § 1.33(b) of this part; or

(iii) An assignee of an undivided part interest, notwithstanding §§ 1.33(b)(3) and 3.73(b) of this chapter, but the partial assignee cannot file the assertion without resort to a party identified under § 1.33(b) of this part.

(3) *Assertion by payment of the small entity basic filing or basic national fee.* The payment, by any party, of the exact amount of one of the small entity basic filing fees set forth in §§ 1.16(a), (f), (g), (h), or (k), or one of the small entity basic national fees set forth in §§ 1.492(a)(1), (a)(2), (a)(3), (a)(4), or (a)(5), will be treated as a written assertion of entitlement to small entity status even if the type of basic filing or basic national fee is inadvertently selected in error.

(i) If the Office accords small entity status based on payment of a small entity basic filing or basic national fee under paragraph (c)(3) of this section that is not applicable to that application, any balance of the small entity fee that is applicable to that application will be due along with the appropriate surcharge set forth in § 1.16(e), or § 1.16(l).

(ii) The payment of any small entity fee other than those set forth in paragraph (c)(3) of this section (whether in the exact fee amount or not) will not be treated as a written assertion of entitlement to small entity status and will not be sufficient to establish small entity status in an application or a patent.

(4) *Assertion required in related, continuing, and reissue applications.*

Status as a small entity must be specifically established by an assertion in each related, continuing and reissue application in which status is appropriate and desired. Status as a small entity in one application or patent does not affect the status of any other application or patent, regardless of the relationship of the applications or patents. The refiling of an application under § 1.53 as a continuation, divisional, or continuation-in-part application (including a continued prosecution application under § 1.53(d)), or the filing of a reissue application, requires a new assertion as to continued entitlement to small entity status for the continuing or reissue application.

(d) *When small entity fees can be paid.* Any fee, other than the small entity basic filing fees and the small entity national fees of paragraph (c)(3) of this section, can be paid in the small entity amount only if it is submitted with, or subsequent to, the submission of a written assertion of entitlement to small entity status, except when refunds are permitted by § 1.28(a).

(e) *Only one assertion required.* (1) An assertion of small entity status need only be filed once in an application or patent. Small entity status, once established, remains in effect until changed pursuant to paragraph (g)(1) of this section. Where an assignment of rights or an obligation to assign rights to other parties who are small entities occurs subsequent to an assertion of small entity status, a second assertion is not required.

(2) Once small entity status is withdrawn pursuant to paragraph (g)(2) of this section, a new written assertion is required to again obtain small entity status.

(f) *Assertion requires a determination of entitlement to pay small entity fees.* Prior to submitting an assertion of entitlement to small entity status in an application, including a related, continuing, or reissue application, a determination of such entitlement should be made pursuant to the requirements of paragraph (a) of this section. It should be determined that all parties holding rights in the invention qualify for small entity status. The Office will generally not question any assertion of small entity status that is made in accordance with the requirements of this section, but note paragraph (h) of this section.

(g)(1) *New determination of entitlement to small entity status is needed when issue and maintenance fees are due.* Once status as a small entity has been established in an application or patent, fees as a small

entity may thereafter be paid in that application or patent without regard to a change in status until the issue fee is due or any maintenance fee is due.

(2) *Notification of loss of entitlement to small entity status is required when issue and maintenance fees are due.* Notification of a loss of entitlement to small entity status must be filed in the application or patent prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity as defined in paragraph (a) of this section is no longer appropriate. The notification that small entity status is no longer appropriate must be signed by a party identified in § 1.33(b). Payment of a fee in other than the small entity amount is not sufficient notification that small entity status is no longer appropriate.

(h) *Fraud attempted or practiced on the Office.*

(1) Any attempt to fraudulently establish status as a small entity, or pay fees as a small entity, shall be considered as a fraud practiced or attempted on the Office.

(2) Improperly, and with intent to deceive, establishing status as a small entity, or paying fees as a small entity, shall be considered as a fraud practiced or attempted on the Office.

13. Section 1.28 is revised to read as follows:

§ 1.28 Refunds when small entity status is later established; how errors in small entity status are excused.

(a) *Refunds based on later establishment of small entity status.* A refund pursuant to § 1.26, based on establishment of small entity status, of a portion of fees timely paid in full prior to establishing status as a small entity may only be obtained if an assertion under § 1.27(c) and a request for a refund of the excess amount are filed within three months of the date of the timely payment of the full fee. The three-month time period is not extendable under § 1.136. Status as a small entity is waived for any fee by the failure to establish the status prior to paying, at the time of paying, or within three months of the date of payment of, the full fee.

(b) *Date of payment.* (1) The three-month period for requesting a refund, pursuant to paragraph (a) of this section, starts on the date that a full fee has been paid;

(2) The date when a deficiency payment is paid in full determines the amount of deficiency that is due, pursuant to paragraph (c) of this section.

(c) *How errors in small entity status are excused.* If status as a small entity

is established in good faith, and fees as a small entity are paid in good faith, in any application or patent, and it is later discovered that such status as a small entity was established in error, or that through error the Office was not notified of a loss of entitlement to small entity status as required by § 1.27(g)(2), the error will be excused upon: compliance with the separate submission and itemization requirements of paragraphs (c)(1) and (c)(2) of this section, and the deficiency payment requirement of paragraph (c)(2) of this section:

(1) *Separate submission required for each application or patent.* Any paper submitted under this paragraph must be limited to the deficiency payment (all fees paid in error), required by paragraph (c)(2) of this section, for one application or one patent. Where more than one application or patent is involved, separate submissions of deficiency payments (e.g., checks) and itemizations are required for each application or patent. See § 1.4(b).

(2) *Payment of deficiency owed.* The deficiency owed, resulting from the previous erroneous payment of small entity fees, must be paid.

(i) *Calculation of the deficiency owed.* The deficiency owed for each previous fee erroneously paid as a small entity is the difference between the current fee amount (for other than a small entity) on the date the deficiency is paid in full and the amount of the previous erroneous (small entity) fee payment. The total deficiency payment owed is the sum of the individual deficiency owed amounts for each fee amount previously erroneously paid as a small entity. Where a fee paid in error as a small entity was subject to a fee decrease between the time the fee was paid in error and the time the deficiency is paid in full, the deficiency owed is equal to the amount (previously) paid in error;

(ii) *Itemization of the deficiency payment.* An itemization of the total deficiency payment is required. The itemization must include the following information:

(A) Each particular type of fee that was erroneously paid as a small entity, (e.g., basic statutory filing fee, two-month extension of time fee) along with the current fee amount for a non-small entity;

(B) The small entity fee actually paid, and when. This will permit the Office to differentiate, for example, between two one-month extension of time fees erroneously paid as a small entity but on different dates;

(C) The deficiency owed amount (for each fee erroneously paid); and

(D) The total deficiency payment owed, which is the sum or total of the individual deficiency owed amounts set forth in paragraph (c)(2)(ii)(C) of this section.

(3) *Failure to comply with requirements.* If the requirements of paragraphs (c)(1) and (c)(2) of this section are not complied with, such failure will either: be treated as an authorization for the Office to process the deficiency payment and charge the processing fee set forth in § 1.17(i), or result in a requirement for compliance within a one-month non-extendable time period under § 1.136(a) to avoid the return of the fee deficiency paper, at the option of the Office.

(d) *Payment of deficiency operates as notification of loss of status.* Any deficiency payment (based on a previous erroneous payment of a small entity fee) submitted under paragraph (c) of this section will be treated under § 1.27(g)(2) as a notification of a loss of entitlement to small entity status.

14. Section 1.33 is amended by revising paragraphs (a) and (b) to read as follows:

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

(a) *Correspondence address and daytime telephone number.* When filing an application, a correspondence address must be set forth in either an application data sheet (§ 1.76), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing. If no correspondence address is specified, the Office may treat the mailing address of the first named inventor (if provided, see §§ 1.76(b)(1) and 1.63(c)(2)) as the correspondence address. The Office will direct all notices, official letters, and other communications relating to the application to the correspondence address. The Office will not engage in double correspondence with an applicant and a registered attorney or agent, or with more than one registered attorney or agent except as deemed necessary by the Commissioner. If more than one correspondence address is specified, the Office will establish one as the correspondence address. For the party to whom correspondence is to be addressed, a daytime telephone number should be supplied in a clearly identifiable manner and may be changed by any party who may change the correspondence address. The correspondence address may be changed as follows:

(1) *Prior to filing of a § 1.63 oath or declaration by any of the inventors.* If a § 1.63 oath or declaration has not been

filed by any of the inventors, the correspondence address may be changed by the party who filed the application. If the application was filed by a registered attorney or agent, any other registered practitioner named in the transmittal papers may also change the correspondence address. Thus, the inventor(s), any registered practitioner named in the transmittal papers accompanying the original application, or a party that will be the assignee who filed the application, may change the correspondence address in that application under this paragraph.

(2) Where a § 1.63 oath or declaration has been filed by any of the inventors. If a § 1.63 oath or declaration has been filed, or is filed concurrent with the filing of an application, by any of the inventors, the correspondence address may be changed by the parties set forth in paragraph (b) of this section, except for paragraph (b)(2).

(b) *Amendments and other papers.* Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:

(1) A registered attorney or agent of record appointed in compliance with § 1.34(b);

(2) A registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a);

(3) An assignee as provided for under § 3.71(b) of this chapter; or

(4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

* * * * *

15. Section 1.34 is revised to read as follows:

§ 1.34 Recognition for representation.

(a) When a registered attorney or agent acting in a representative capacity, pursuant to § 1.31, appears in person or signs a paper in practice before the United States Patent and Trademark Office in a patent case, his or her personal appearance or signature shall constitute a representation to the United States Patent and Trademark Office that under the provisions of this subchapter and the law, he or she is authorized to represent the particular party in whose behalf he or she acts. In filing such a paper, the registered attorney or agent should specify his or her registration number with his or her signature. Further proof of authority to act in a representative capacity may be required.

(b) When a registered attorney or agent shall have filed his or her power

of attorney, or authorization, duly executed by the person or persons entitled to prosecute an application or a patent involved in a reexamination proceeding, pursuant to § 1.31, he or she is a principal registered attorney or agent of record in the case. A principal registered attorney or agent, so appointed, may appoint an associate registered attorney or agent who shall also then be of record.

16. Section 1.36 is revised to read as follows:

§ 1.36 Revocation of power of attorney or authorization; withdrawal of registered attorney or agent.

A power of attorney or authorization of agent, pursuant to § 1.31, may be revoked at any stage in the proceedings of a case, and a registered attorney or agent may withdraw, upon application to and approval by the Commissioner. A registered attorney or agent, except an associate registered attorney or agent whose address is the same as that of the principal registered attorney or agent, will be notified of the revocation of the power of attorney or authorization, and the applicant or patent owner will be notified of the withdrawal of the registered attorney or agent. An assignment will not of itself operate as a revocation of a power or authorization previously given, but the assignee of the entire interest may revoke previous powers and be represented by a registered attorney or agent of the assignee's own selection. See § 1.613(d) for withdrawal in an interference.

17. Section 1.41 is amended by revising paragraphs (a) and (c) to read as follows:

§ 1.41 Applicant for patent.

(a) A patent is applied for in the name or names of the actual inventor or inventors.

(1) The inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribed by § 1.63, except as provided for in §§ 1.53(d)(4) and 1.63(d). If an oath or declaration as prescribed by § 1.63 is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to § 1.53(b), unless applicant files a paper, including the processing fee set forth in § 1.17(i), supplying or changing the name or names of the inventor or inventors.

(2) The inventorship of a provisional application is that inventorship set forth in the cover sheet as prescribed by § 1.51(c)(1). If a cover sheet as prescribed by § 1.51(c)(1) is not filed during the pendency of a provisional

application, the inventorship is that inventorship set forth in the application papers filed pursuant to § 1.53(c), unless applicant files a paper including the processing fee set forth in § 1.17(q), supplying or changing the name or names of the inventor or inventors.

(3) In a nonprovisional application filed without an oath or declaration as prescribed by § 1.63 or a provisional application filed without a cover sheet as prescribed by § 1.51(c)(1), the name, residence, and citizenship of each person believed to be an actual inventor should be provided when the application papers pursuant to § 1.53(b) or § 1.53(c) are filed.

(4) The inventors who submitted an application under § 1.494 or § 1.495 are the inventors in the international application designating the United States (§ 1.48(f)(1) does not apply to applications entering the national stage).

* * * * *

(c) Any person authorized by the applicant may physically or electronically deliver an application for patent to the Office on behalf of the inventor or inventors, but an oath or declaration for the application (§ 1.63) can only be made in accordance with § 1.64.

* * * * *

§ 1.44 [Reserved]

18. Section 1.44 is removed and reserved.

19. Section 1.47 is revised to read as follows:

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

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in

such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in § 1.17(h), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

(c) The Office will send notice of the filing of the application to all inventors who have not joined in the application at the address(es) provided in the petition under this section, and publish notice of the filing of the application in the Official Gazette. The Office may dispense with this notice provision in a continuation or divisional application, if notice regarding the filing of the prior application was given to the nonsigning inventor(s).

20. Section 1.48 is revised to read as follows:

§ 1.48 Correction of inventorship in a patent application, other than a reissue application, pursuant to 35 U.S.C. 116.

(a) *Nonprovisional application after oath/declaration filed.* If the inventive entity is set forth in error in an executed § 1.63 oath or declaration in a nonprovisional application, and such error arose without any deceptive intention on the part of the person named as an inventor in error or on the part of the person who through error was not named as an inventor, the inventorship of the nonprovisional application may be amended to name only the actual inventor or inventors. If the nonprovisional application is involved in an interference, the amendment must comply with the requirements of this section and must be accompanied by a motion under § 1.634. Amendment of the inventorship requires:

(1) A request to correct the inventorship that sets forth the desired inventorship change;

(2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;

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

(4) The processing fee set forth in § 1.17(i); and

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

(b) *Nonprovisional application—fewer inventors due to amendment or cancellation of claims.* If the correct inventors are named in a nonprovisional application, and the prosecution of the nonprovisional application results in the amendment or cancellation of claims so that fewer than all of the currently named inventors are the actual inventors of the invention being claimed in the nonprovisional application, an amendment must be filed requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed. If the application is involved in an interference, the amendment must comply with the requirements of this section and must be accompanied by a motion under § 1.634. Amendment of the inventorship requires:

(1) A request, signed by a party set forth in § 1.33(b), to correct the inventorship that identifies the named inventor or inventors being deleted and acknowledges that the inventor's invention is no longer being claimed in the nonprovisional application; and

(2) The processing fee set forth in § 1.17(i).

(c) *Nonprovisional application—inventors added for claims to previously unclaimed subject matter.* If a nonprovisional application discloses unclaimed subject matter by an inventor or inventors not named in the application, the application may be amended to add claims to the subject matter and name the correct inventors for the application. If the application is involved in an interference, the amendment must comply with the requirements of this section and must be accompanied by a motion under § 1.634. Amendment of the inventorship requires:

(1) A request to correct the inventorship that sets forth the desired inventorship change;

(2) A statement from each person being added as an inventor that the addition is necessitated by amendment of the claims and that the inventorship error occurred without deceptive intention on his or her part;

(3) An oath or declaration by the actual inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43, or § 1.47;

(4) The processing fee set forth in § 1.17(i); and

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

(d) *Provisional application—adding omitted inventors.* If the name or names of an inventor or inventors were omitted in a provisional application through error without any deceptive intention

on the part of the omitted inventor or inventors, the provisional application may be amended to add the name or names of the omitted inventor or inventors. Amendment of the inventorship requires:

(1) A request, signed by a party set forth in § 1.33(b), to correct the inventorship that identifies the inventor or inventors being added and states that the inventorship error occurred without deceptive intention on the part of the omitted inventor or inventors; and

(2) The processing fee set forth in § 1.17(q).

(e) *Provisional application—deleting the name or names of the inventor or inventors.* If a person or persons were named as an inventor or inventors in a provisional application through error without any deceptive intention on the part of such person or persons, an amendment may be filed in the provisional application deleting the name or names of the person or persons who were erroneously named. Amendment of the inventorship requires:

(1) A request to correct the inventorship that sets forth the desired inventorship change;

(2) A statement by the person or persons whose name or names are being deleted that the inventorship error occurred without deceptive intention on the part of such person or persons;

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

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

(f)(1) *Nonprovisional application—filing executed oath/declaration corrects inventorship.* If the correct inventor or inventors are not named on filing a nonprovisional application under § 1.53(b) without an executed oath or declaration under § 1.63 by any of the inventors, the first submission of an executed oath or declaration under § 1.63 by any of the inventors during the pendency of the application will act to correct the earlier identification of inventorship. See §§ 1.41(a)(4) and 1.497(d) for submission of an executed oath or declaration to enter the national stage under 35 U.S.C. 371 and § 1.494 or § 1.495 naming an inventive entity different from the inventive entity set forth in the international stage.

(2) *Provisional application—filing cover sheet corrects inventorship.* If the correct inventor or inventors are not named on filing a provisional application without a cover sheet under § 1.51(c)(1), the later submission of a cover sheet under § 1.51(c)(1) during the pendency of the application will act to

correct the earlier identification of inventorship.

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

(h) *Reissue applications not covered.* The provisions of this section do not apply to reissue applications. See §§ 1.171 and 1.175 for correction of inventorship in a patent via a reissue application.

(i) *Correction of inventorship in patent or interference.* See § 1.324 for correction of inventorship in a patent, and § 1.634 for correction of inventorship in an interference.

21. Section 1.51 is amended by revising paragraph (b) to read as follows:

§ 1.51 General requisites of an application.

* * * * *

(b) A complete application filed under § 1.53(b) or § 1.53(d) comprises:

(1) A specification as prescribed by 35 U.S.C. 112, including a claim or claims, see §§ 1.71 to 1.77;

(2) An oath or declaration, see §§ 1.63 and 1.68;

(3) Drawings, when necessary, see §§ 1.81 to 1.85; and

(4) The prescribed filing fee, see § 1.16.

* * * * *

22. Section 1.52 is amended by revising paragraphs (a), (b), and (c), and adding paragraph (e) to read as follows:

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

(a) *Papers that are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or a reexamination proceeding.*

(1) All papers, other than drawings, that are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding must be on sheets of paper that are the same size, and:

(i) Flexible, strong, smooth, non-shiny, durable, and white;

(ii) Either 21.0 cm by 29.7 cm (DIN size A4) or 21.6 cm by 27.9 cm (8½ by 11 inches), with each sheet including a top margin of at least 2.0 cm (¾ inch), a left side margin of at least 2.5 cm (1 inch), a right side margin of at least 2.0 cm (¾ inch), and a bottom margin of at least 2.0 cm (¾ inch);

(iii) Written on only one side in portrait orientation;

(iv) Plainly and legibly written either by a typewriter or machine printer in

permanent dark ink or its equivalent; and

(v) Presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by use of digital imaging and optical character recognition.

(2) All papers that are to become a part of the permanent records of the United States Patent and Trademark Office should have no holes in the sheets as submitted.

(3) The provisions of this paragraph and paragraph (b) of this section do not apply to the pre-printed information on forms provided by the Office, or to the copy of the patent submitted in double column format as the specification in a reissue application or request for reexamination.

(4) See § 1.58 for chemical and mathematical formulae and tables, and § 1.84 for drawings.

(5) If papers that do not comply with paragraph (a)(1) of this section are submitted as part of the permanent record, other than the drawings, applicant, or the patent owner, or the requester in a reexamination proceeding, will be notified and must provide substitute papers that comply with paragraph (a)(1) of this section within a set time period.

(b) *The application (specification, including the claims, drawings, and oath or declaration) or reexamination proceeding and any amendments or corrections to the application or reexamination proceeding.* (1) The application or proceeding and any amendments or corrections to the application (including any translation submitted pursuant to paragraph (d) of this section) or proceeding, except as provided for in § 1.69 and paragraph (d) of this section, must:

(i) Comply with the requirements of paragraph (a) of this section; and

(ii) Be in the English language or be accompanied by a translation of the application and a translation of any corrections or amendments into the English language together with a statement that the translation is accurate.

(2) The specification (including the abstract and claims) for other than reissue applications and reexamination proceedings, and any amendments for applications (including reissue applications) and reexamination proceedings to the specification, except as provided for in §§ 1.821 through 1.825, must have:

(i) Lines that are 1½ or double spaced;

(ii) Text written in a nonscript type font (e.g., Arial, Times Roman, or Courier) lettering style having capital letters which are at least 0.21 cm (0.08 inch) high; and

(iii) Only a single column of text.

(3) The claim or claims must commence on a separate sheet (§ 1.75(h)).

(4) The abstract must commence on a separate sheet or be submitted as the first page of the patent in a reissue application or reexamination proceeding (§ 1.72(b)).

(5) Other than in a reissue application or reexamination proceeding, the pages of the specification including claims and abstract must be numbered consecutively, starting with 1, the numbers being centrally located above or preferably, below, the text.

(6) Other than in a reissue application or reexamination proceeding, the paragraphs of the specification, other than in the claims or abstract, may be numbered at the time the application is filed, and should be individually and consecutively numbered using Arabic numerals, so as to unambiguously identify each paragraph. The number should consist of at least four numerals enclosed in square brackets, including leading zeros (e.g., [0001]). The numbers and enclosing brackets should appear to the right of the left margin as the first item in each paragraph, before the first word of the paragraph, and should be highlighted in bold. A gap, equivalent to approximately four spaces, should follow the number. Nontext elements (e.g., tables, mathematical or chemical formulae, chemical structures, and sequence data) are considered part of the numbered paragraph around or above the elements, and should not be independently numbered. If a nontext element extends to the left margin, it should not be numbered as a separate and independent paragraph. A list is also treated as part of the paragraph around or above the list, and should not be independently numbered. Paragraph or section headers (titles), whether abutting the left margin or centered on the page, are not considered paragraphs and should not be numbered.

(7) If papers that do not comply with paragraphs (b)(1) through (b)(5) of this section are submitted as part of the application, applicant, or patent owner, or requester in a reexamination proceeding, will be notified and the applicant, patent owner or requester in a reexamination proceeding must provide substitute papers that comply with paragraphs (b)(1) through (b)(5) of this section within a set time period.

(c)(1) Any interlineation, erasure, cancellation or other alteration of the application papers filed must be made before the signing of any accompanying oath or declaration pursuant to § 1.63 referring to those application papers and should be dated and initialed or signed by the applicant on the same sheet of paper. Application papers containing alterations made after the signing of an oath or declaration referring to those application papers must be supported by a supplemental oath or declaration under § 1.67. In either situation, a substitute specification (§ 1.125) is required if the application papers do not comply with paragraphs (a) and (b) of this section.

(2) After the signing of the oath or declaration referring to the application papers, amendments may only be made in the manner provided by § 1.121.

(3) Notwithstanding the provisions of this paragraph, if an oath or declaration is a copy of the oath or declaration from a prior application, the application for which such copy is submitted may contain alterations that do not introduce matter that would have been new matter in the prior application.

* * * * *

(e) *Electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding.*

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

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

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

(iii) A table (see § 1.58) that has more than 50 pages of text.

(2) A compact disc as used in this part means a Compact Disc-Read Only Memory (CD-ROM) or a Compact Disc-Recordable (CD-R) in compliance with this paragraph. A CD-ROM is a "read-only" medium on which the data is pressed into the disc so that it cannot be changed or erased. A CD-R is a "write once" medium on which once the data is recorded, it is permanent and cannot be changed or erased.

(3)(i) Each compact disc must conform to the International Standards Organization (ISO) 9660 standard, and the contents of each compact disc must be in compliance with the American Standard Code for Information Interchange (ASCII).

(ii) Each compact disc must be enclosed in a hard compact disc case within an unsealed padded and protective mailing envelope and

accompanied by a transmittal letter on paper in accordance with paragraph (a) of this section. The transmittal letter must list for each compact disc the machine format (e.g., IBM-PC, Macintosh), the operating system compatibility (e.g., MS-DOS, MS-Windows, Macintosh, Unix), a list of files contained on the compact disc including their names, sizes in bytes, and dates of creation, plus any other special information that is necessary to identify, maintain, and interpret the information on the compact disc. Compact discs submitted to the Office will not be returned to the applicant.

(4) Any compact disc must be submitted in duplicate unless it contains only the "Sequence Listing" in computer readable form required by § 1.821(e). The compact disc and duplicate copy must be labeled "Copy 1" and "Copy 2," respectively. The transmittal letter which accompanies the compact disc must include a statement that the two compact discs are identical. In the event that the two compact discs are not identical, the Office will use the compact disc labeled "Copy 1" for further processing. Any amendment to the information on a compact disc must be by way of a replacement compact disc in compliance with this paragraph containing the substitute information, and must be accompanied by a statement that the replacement compact disc contains no new matter. The compact disc and copy must be labeled "COPY 1 REPLACEMENT MM/DD/YYYY" (with the month, day and year of creation indicated), and "COPY 2 REPLACEMENT MM/DD/YYYY," respectively.

(5) The specification must contain an incorporation-by-reference of the material on the compact disc in a separate paragraph (§ 1.77(b)(4)), identifying each compact disc by the names of the files contained on each of the compact discs, their date of creation and their sizes in bytes. The Office may require applicant to amend the specification to include in the paper portion any part of the specification previously submitted on compact disc.

(6) A compact disc must also be labeled with the following information:

(i) The name of each inventor (if known);

(ii) Title of the invention;

(iii) The docket number, or application number if known, used by the person filing the application to identify the application; and

(iv) A creation date of the compact disc.

(v) If multiple compact discs are submitted, the label shall indicate their order (e.g. "1 of X").

(vi) An indication that the disk is "Copy 1" or "Copy 2" of the submission. See paragraph (b)(4) of this section.

(7) If a file is unreadable on both copies of the disc, the unreadable file will be treated as not having been submitted. A file is unreadable if, for example, it is of a format that does not comply with the requirements of paragraph (e)(3) of this section, it is corrupted by a computer virus, or it is written onto a defective compact disc.

* * * * *

23. Section 1.53 is amended by revising paragraphs (c)(1), (c)(2), (d)(4), (e)(2), (f) and (g) and adding paragraph (d)(10) to read as follows:

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

* * * * *

(c) * * *

(1) A provisional application must also include the cover sheet required by § 1.51(c)(1), which may be an application data sheet (§ 1.76), or a cover letter identifying the application as a provisional application. Otherwise, the application will be treated as an application filed under paragraph (b) of this section.

(2) An application for patent filed under paragraph (b) of this section may be converted to a provisional application and be accorded the original filing date of the application filed under paragraph (b) of this section. The grant of such a request for conversion will not entitle applicant to a refund of the fees that were properly paid in the application filed under paragraph (b) of this section. Such a request for conversion must be accompanied by the processing fee set forth in § 1.17(q) and be filed prior to the earliest of:

(i) Abandonment of the application filed under paragraph (b) of this section;

(ii) Payment of the issue fee on the application filed under paragraph (b) of this section;

(iii) Expiration of twelve months after the filing date of the application filed under paragraph (b) of this section; or

(iv) The filing of a request for a statutory invention registration under § 1.293 in the application filed under paragraph (b) of this section.

* * * * *

(d) * * *

(4) An application filed under this paragraph may be filed by fewer than all the inventors named in the prior application, provided that the request for an application under this paragraph

when filed is accompanied by a statement requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed in the new application. No person may be named as an inventor in an application filed under this paragraph who was not named as an inventor in the prior application on the date the application under this paragraph was filed, except by way of correction of inventorship under § 1.48.

* * * * *

(10) See § 1.103(b) for requesting a limited suspension of action in an application filed under this paragraph.

(e) * * *

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

* * * * *

(f) *Completion of application subsequent to filing—Nonprovisional (including continued prosecution or reissue) application.*

(1) If an application which has been accorded a filing date pursuant to paragraph (b) or (d) of this section does not include the basic filing fee, or if an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include an oath or declaration by the applicant pursuant to §§ 1.63, 1.162 or § 1.175, and applicant has provided a correspondence address (§ 1.33(a)), applicant will be notified and given a period of time within which to pay the filing fee, file an oath or declaration in an application under paragraph (b) of this section, and pay the surcharge required by § 1.16(e) to avoid abandonment.

(2) If an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include the basic filing fee or an oath or declaration by the applicant pursuant to §§ 1.63, 1.162 or § 1.175, and applicant has not provided a correspondence address (§ 1.33(a)), applicant has two months from the filing date of the application within which to pay the basic filing fee, file an oath or declaration, and pay the surcharge required by § 1.16(e) to avoid abandonment.

(3) This paragraph applies to continuation or divisional applications under paragraphs (b) or (d) of this section and to continuation-in-part applications under paragraph (b) of this section.

(4) See § 1.63(d) concerning the submission of a copy of the oath or declaration from the prior application for a continuation or divisional application under paragraph (b) of this section.

(5) If applicant does not pay one of the basic filing or the processing and retention fees (§ 1.21(l)) during the pendency of the application, the Office may dispose of the application.

(g) *Completion of application subsequent to filing—provisional application.*

(1) If a provisional application which has been accorded a filing date pursuant to paragraph (c) of this section does not include the cover sheet required by § 1.51(c)(1) or the basic filing fee (§ 1.16(k)), and applicant has provided a correspondence address (§ 1.33(a)), applicant will be notified and given a period of time within which to pay the basic filing fee, file a cover sheet (§ 1.51(c)(1)), and pay the surcharge required by § 1.16(l) to avoid abandonment.

(2) If a provisional application which has been accorded a filing date pursuant to paragraph (c) of this section does not include the cover sheet required by § 1.51(c)(1) or the basic filing fee (§ 1.16(k)), and applicant has not provided a correspondence address (§ 1.33(a)), applicant has two months from the filing date of the application within which to pay the basic filing fee, file a cover sheet (§ 1.51(c)(1)), and pay the surcharge required by § 1.16(l) to avoid abandonment.

(3) If applicant does not pay the basic filing fee during the pendency of the application, the Office may dispose of the application.

* * * * *

24. Section 1.55 is amended by revising paragraph (a) to read as follows:

§ 1.55 Claim for foreign priority.

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

(1) The claim for priority must identify the foreign application for which priority is claimed, as well as any foreign application for the same subject having a filing date before that of the application for which priority is claimed, by specifying the application

number, country (or intergovernmental organization), day, month, and year of its filing.

(2)(i) In an application filed under 35 U.S.C. 111(a), the claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) must be filed before the patent is granted.

(ii) In an application that entered the national stage from an international application after compliance with 35 U.S.C. 371, the claim for priority must be made within the time limit set forth in the PCT and the regulations under the PCT. If the certified copy of the foreign application has not been filed in accordance with the PCT and the regulations under the PCT, it must be filed before the patent is granted.

(iii) When the application becomes involved in an interference (§ 1.630), when necessary to overcome the date of a reference relied upon by the examiner, or when deemed necessary by the examiner, the Office may require that the claim for priority and the certified copy of the foreign application be filed earlier than provided in paragraph (a)(2)(i) or (a)(2)(ii) of this section.

(iv) If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid but before the patent is granted (published), it must be accompanied by the processing fee set forth in § 1.17(i). While the priority claim or certified copy filed at such time will be placed in the file record, neither will be reviewed and the patent when published will not include the priority claim. In such instances, patentee may request a certificate of correction under 35 U.S.C. 255 and § 1.323, and a determination of entitlement for priority will be made after the patent is granted.

(3) An English-language translation of a non-English-language foreign application is not required except when the application is involved in an interference (§ 1.630), when necessary to overcome the date of a reference relied upon by the examiner, or when specifically required by the examiner. If an English-language translation is required, it must be filed together with a statement that the translation of the certified copy is accurate.

* * * * *

25. Section 1.56 is amended by adding a new paragraph (e) to read as follows:

§ 1.56 Duty to disclose information material to patentability.

* * * * *

(e) In any continuation-in-part application, the duty under this section includes the duty to disclose to the

Office all information known to the person to be material to patentability, as defined in paragraph (b) of this section, which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

26. Section 1.58 is amended by adding paragraph (b) to read as follows:

§ 1.58 Chemical and mathematical formulae and tables.

* * * * *

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

* * * * *

27. Section 1.59 is amended by revising paragraph (b) to read as follows:

§ 1.59 Expungement of information or copy of papers in application file.

* * * * *

(b) An applicant may request that the Office expunge and return information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge and return information from an application must include the fee set forth in § 1.17(h) and establish to the satisfaction of the Commissioner that the return of the information is appropriate.

* * * * *

28. Section 1.63 is amended by revising paragraphs (a), (b), (c), and (e) to read as follows:

§ 1.63 Oath or declaration.

(a) An oath or declaration filed under § 1.51(b)(2) as a part of a nonprovisional application must:

(1) Be executed, *i.e.*, signed, in accordance with either § 1.66 or § 1.68. There is no minimum age for a person to be qualified to sign, but the person must be competent to sign, *i.e.*, understand the document that the person is signing;

(2) Identify each inventor by full name, including the family name, and at least one given name without abbreviation together with any other given name or initial;

(3) Identify the country of citizenship of each inventor; and

(4) State that the person making the oath or declaration believes the named inventor or inventors to be the original

and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

(b) In addition to meeting the requirements of paragraph (a) of this section, the oath or declaration must also:

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

(2) State that the person making the oath or declaration has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration; and

(3) State that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

(c) Unless such information is supplied on an application data sheet in accordance with § 1.76, the oath or declaration must also identify:

(1) The mailing address, and the residence if an inventor lives at a location which is different from where the inventor customarily receives mail, of each inventor; and

(2) Any foreign application for patent (or inventor's certificate) for which a claim for priority is made pursuant to § 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing.

* * * * *

(e) A newly executed oath or declaration must be filed in any continuation-in-part application, which application may name all, more, or fewer than all of the inventors named in the prior application.

* * * * *

29. Section 1.64 is revised to read as follows:

§ 1.64 Person making oath or declaration.

(a) The oath or declaration (§ 1.63), including any supplemental oath or declaration (§ 1.67), must be made by all of the actual inventors except as provided for in §§ 1.42, 1.43, 1.47, or § 1.67.

(b) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, 1.47, or § 1.67), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor is required to state. If the person signing the oath or declaration is the legal representative of a deceased

inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

30. Section 1.67 is amended by revising paragraph (a) and removing and reserving paragraph (c) to read as follows:

§ 1.67 Supplemental oath or declaration.

(a) The Office may require, or inventors and applicants may submit, a supplemental oath or declaration meeting the requirements of § 1.63 or § 1.162 to correct any deficiencies or inaccuracies present in the earlier filed oath or declaration.

(1) Deficiencies or inaccuracies relating to all the inventors or applicants (§§ 1.42, 1.43, or § 1.47) may be corrected with a supplemental oath or declaration signed by all the inventors or applicants.

(2) Deficiencies or inaccuracies relating to fewer than all of the inventor(s) or applicant(s) (§§ 1.42, 1.43 or § 1.47) may be corrected with a supplemental oath or declaration identifying the entire inventive entity but signed only by the inventor(s) or applicant(s) to whom the error or deficiency relates.

(3) Deficiencies or inaccuracies due to the failure to meet the requirements of § 1.63(c) (*e.g.*, to correct the omission of a mailing address of an inventor) in an oath or declaration may be corrected with an application data sheet in accordance with § 1.76.

(4) Submission of a supplemental oath or declaration or an application data sheet (§ 1.76), as opposed to who must sign the supplemental oath or declaration or an application data sheet, is governed by § 1.33(a)(2) and paragraph (b) of this section.

* * * * *

31. Section 1.72 is revised to read as follows:

§ 1.72 Title and abstract.

(a) Unless the title is supplied in an application data sheet (§ 1.76), the title of the invention, which should be as short and specific as possible, should appear as a heading on the first page of the specification.

(b) A brief abstract of the technical disclosure in the specification must commence on a separate sheet, preferably following the claims, under the heading "Abstract" or "Abstract of the Disclosure." The abstract in an application filed under 35 U.S.C. 111 may not exceed 150 words in length. The purpose of the abstract is to enable the United States Patent and Trademark

Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure. The abstract will not be used for interpreting the scope of the claims.

32. A new § 1.76 is added to read as follows:

§ 1.76 Application data sheet.

(a) *Application data sheet.* An application data sheet is a sheet or sheets, that may be voluntarily submitted in either provisional or nonprovisional applications, which contains bibliographic data, arranged in a format specified by the Office. If an application data sheet is provided, the application data sheet is part of the provisional or nonprovisional application for which it has been submitted.

(b) *Bibliographic data.* Bibliographic data as used in paragraph (a) of this section includes:

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

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

(3) *Application information.* This information includes the title of the invention, a suggested classification, by class and subclass, the Technology Center to which the subject matter of the invention is assigned, the total number of drawing sheets, a suggested drawing figure for publication (in a nonprovisional application), any docket number assigned to the application, the type of application (*e.g.*, utility, plant, design, reissue, provisional), whether the application discloses any significant part of the subject matter of an application under a secrecy order pursuant to § 5.2 of this chapter (*see* § 5.2(c)), and, for plant applications, the Latin name of the genus and species of the plant claimed, as well as the variety denomination. The suggested classification and Technology Center information should be supplied for provisional applications whether or not claims are present. If claims are not present in a provisional application, the

suggested classification and Technology Center should be based upon the disclosure.

(4) *Representative information.* This information includes the registration number of each practitioner having a power of attorney or authorization of agent in the application (preferably by reference to a customer number). Providing this information in the application data sheet does not constitute a power of attorney or authorization of agent in the application (*see* § 1.34(b)).

(5) *Domestic priority information.* This information includes the application number, the filing date, the status (including patent number if available), and relationship of each application for which a benefit is claimed under 35 U.S.C. 119(e), 120, 121, or 365(c). Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and § 1.78(a)(2) or § 1.78(a)(4), and need not otherwise be made part of the specification.

(6) *Foreign priority information.* This information includes the application number, country, and filing date of each foreign application for which priority is claimed, as well as any foreign application having a filing date before that of the application for which priority is claimed. Providing this information in the application data sheet constitutes the claim for priority as required by 35 U.S.C. 119(b) and § 1.55(a).

(c) *Supplemental application data sheets.* Supplemental application data sheets:

(1) May be subsequently supplied prior to payment of the issue fee either to correct or update information in a previously submitted application data sheet, or an oath or declaration under § 1.63 or § 1.67, except that inventorship changes are governed by § 1.48, correspondence changes are governed by § 1.33(a), and citizenship changes are governed by § 1.63 or § 1.67; and

(2) Should identify the information that is being changed (added, deleted, or modified) and therefore need not contain all the previously submitted information that has not changed.

(d) *Inconsistencies between application data sheet and oath or declaration.* For inconsistencies between information that is supplied by both an application data sheet under this section and by an oath or declaration under §§ 1.63 and 1.67:

(1) The latest submitted information will govern notwithstanding whether supplied by an application data sheet, or by a § 1.63 or § 1.67 oath or

declaration, except as provided by paragraph (d)(3) of this section;

(2) The information in the application data sheet will govern when the inconsistent information is supplied at the same time by a § 1.63 or § 1.67 oath or declaration, except as provided by paragraph (d)(3) of this section;

(3) The oath or declaration under § 1.63 or § 1.67 governs inconsistencies with the application data sheet in the naming of inventors (§ 1.41(a)(1)) and setting forth their citizenship (35 U.S.C. 115);

(4) The Office will initially capture bibliographic information from the application data sheet (notwithstanding whether an oath or declaration governs the information). Thus, the Office shall generally not look to an oath or declaration under § 1.63 to see if the bibliographic information contained therein is consistent with the bibliographic information captured from an application data sheet (whether the oath or declaration is submitted prior to or subsequent to the application data sheet). Captured bibliographic information derived from an application data sheet containing errors may be recaptured by a request therefor and the submission of a supplemental application data sheet, an oath or declaration under § 1.63 or § 1.67, or a letter pursuant to § 1.33(b).

33. Section 1.77 is revised to read as follows:

§ 1.77 Arrangement of application elements.

(a) The elements of the application, if applicable, should appear in the following order:

- (1) Utility application transmittal form.
- (2) Fee transmittal form.
- (3) Application data sheet (*see* § 1.76).
- (4) Specification.
- (5) Drawings.
- (6) Executed oath or declaration.

(b) The specification should include the following sections in order:

(1) Title of the invention, which may be accompanied by an introductory portion stating the name, citizenship, and residence of the applicant (unless included in the application data sheet).

(2) Cross-reference to related applications (unless included in the application data sheet).

(3) Statement regarding federally sponsored research or development.

(4) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on a compact disc and an incorporation-by-reference of the material on the compact disc (*see* § 1.52(e)(5)). The total number of compact discs including duplicates and

the files on each compact disc shall be specified.

(5) Background of the invention.

(6) Brief summary of the invention.

(7) Brief description of the several views of the drawing.

(8) Detailed description of the invention.

(9) A claim or claims.

(10) Abstract of the disclosure.

(11) "Sequence Listing," if on paper (see §§ 1.821 through 1.825).

(c) The text of the specification sections defined in paragraphs (b)(1) through (b)(11) of this section, if applicable, should be preceded by a section heading in uppercase and without underlining or bold type.

34. Section 1.78 is amended by revising paragraphs (a)(2), (a)(4) and (c) to read as follows:

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

(a) * * *

(2) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application claiming the benefit of one or more prior filed copending nonprovisional applications or international applications designating the United States of America must contain a reference to each such prior application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Unless the reference required by this paragraph is included in an application data sheet (§ 1.76), the specification must contain or be amended to contain such reference in the first sentence following any title. The request for a continued prosecution application under § 1.53(d) is the specific reference required by 35 U.S.C. 120 to the prior application. The identification of an application by application number under this section is the specific reference required by 35 U.S.C. 120 to every application assigned that application number. Cross-references to other related applications may be made when appropriate (see § 1.14).

* * * * *

(4) Any nonprovisional application claiming the benefit of one or more prior filed provisional applications must contain a reference to each such prior provisional application, identifying it as a provisional application, and including the provisional application number (consisting of series code and serial number). Unless the reference required by this paragraph is included in an application data sheet (§ 1.76), the specification must contain or be

amended to contain such reference in the first sentence following the title.

* * * * *

(c) If an application or a patent under reexamination and at least one other application naming different inventors are owned by the same party and contain conflicting claims, and there is no statement of record indicating that the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, the Office may require the assignee to state whether the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, and, if not, indicate which named inventor is the prior inventor.

* * * * *

35. Section 1.84 is amended by revising paragraphs (a), (b), (c), (j), (k), (o), and (x), and adding paragraph (y) to read as follows:

§ 1.84 Standards for drawings.

(a) *Drawings*. There are two acceptable categories for presenting drawings in utility and design patent applications.

(1) *Black ink*. Black and white drawings are normally required. India ink, or its equivalent that secures solid black lines, must be used for drawings; or

(2) *Color*. On rare occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility or design patent application or the subject matter of a statutory invention registration. The color drawings must be of sufficient quality so 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). The Office will accept color drawings in utility and design patent applications and statutory invention registrations only after granting a petition filed under this paragraph which explains why color drawings are necessary for the understanding of the claimed invention. Any such petition must include the following:

(i) The fee set forth in § 1.17(h);

(ii) Three (3) sets of color drawings; and

(iii) An indication that the specification contains or is being amended to contain the following language as the first paragraph in that portion of the brief description of the drawings:

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

(b) *Photographs*.—(1) *Black and white*. Photographs, including photocopies of photographs, are not ordinarily permitted in utility and design patent applications. The Office will accept photographs in utility and design patent applications, however, if photographs are the only practicable medium for illustrating the claimed invention. For example, photographs or photomicrographs of: electrophoresis gels, blots (e.g., immunological, western, Southern, and northern), autoradiographs, cell cultures (stained and unstained), histological tissue cross sections (stained and unstained), animals, plants, in vivo imaging, thin layer chromatography plates, crystalline structures, and, in a design patent application, ornamental effects, are acceptable. If the subject matter of the application admits of illustration by a drawing, the examiner may require a drawing in place of the photograph. The photographs must be of sufficient quality so that all details in the photographs are reproducible in the printed patent.

(2) *Color photographs*. Color photographs will be accepted in utility and design patent applications if the conditions for accepting color drawings and black and white photographs have been satisfied. See paragraphs (a)(2) and (b)(1) of this section.

(c) *Identification of drawings*. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

* * * * *

(j) *Views*. The drawing must contain as many views as necessary to show the invention. One of the views should be suitable for printing on the patent as the illustration of the invention. Views must not be connected by projection lines and must not contain center lines.

(k) *Scale*. The scale to which a drawing is made must be large enough to show the mechanism without crowding when the drawing is reduced in size to two-thirds in reproduction. Indications such as "actual size" or "scale 1/2" on the drawings are not permitted since these lose their meaning with reproduction in a different format.

* * * * *

(o) *Legends*. Suitable descriptive legends may be used subject to approval by the Office, or may be required by the examiner where necessary for understanding of the drawing. They should contain as few words as possible.

* * * * *

(x) *Holes*. No holes should be made by applicant in the drawing sheets.

(y) *Types of drawings*. See § 1.152 for design drawings, § 1.165 for plant drawings, and § 1.174 for reissue drawings.

36. Section 1.85 is revised to read as follows:

§ 1.85 Corrections to drawings.

(a) If a drawing meets the requirements of §§ 1.84(d), (e), and (f) and is suitable for reproduction, but is not otherwise in compliance with § 1.84, the drawing may be admitted for examination.

(b) The Office will not release drawings for purposes of correction. If corrections are necessary, new corrected drawings must be submitted within the time set by the Office.

(c) If a corrected drawing is required or if a drawing does not comply with § 1.84 at the time an application is allowed, the Office may notify the applicant and set a three month period of time from the mail date of the notice of allowability within which the applicant must file a corrected or formal drawing in compliance with § 1.84 to avoid abandonment. This time period is not extendable under § 1.136(a) or § 1.136(b).

37. Section 1.91 is amended by revising paragraph (a)(3)(i) to read as follows:

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

(a) * * *

(3) * * *

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

* * * * *

38. Section 1.96 is amended by revising paragraphs (b) and (c) to read as follows:

§ 1.96 Submission of computer program listings.

* * * * *

(b) *Material which will be printed in the patent*: If the computer program listing is contained in 300 lines or fewer, with each line of 72 characters or fewer, it may be submitted either as drawings or as part of the specification.

(1) *Drawings*. If the listing is submitted as drawings, it must be submitted in the manner and complying with the requirements for drawings as

provided in § 1.84. At least one figure numeral is required on each sheet of drawing.

(2) *Specification*. (i) If the listing is submitted as part of the specification, it must be submitted in accordance with the provisions of § 1.52.

(ii) Any listing having more than 60 lines of code that is submitted as part of the specification must be positioned at the end of the description but before the claims. Any amendment must be made by way of submission of a substitute sheet.

(c) *As an appendix which will not be printed*: Any computer program listing may, and any computer program listing having over 300 lines (up to 72 characters per line) must, be submitted on a compact disc in compliance with § 1.52(e). A compact disc containing such a computer program listing is to be referred to as a "computer program listing appendix." The "computer program listing appendix" will not be part of the printed patent. The specification must include a reference to the "computer program listing appendix" at the location indicated in § 1.77(b)(4).

(1) Multiple computer program listings for a single application may be placed on a single compact disc. Multiple compact discs may be submitted for a single application if necessary. A separate compact disc is required for each application containing a computer program listing that must be submitted on a "computer program listing appendix."

(2) The "computer program listing appendix" must be submitted on a compact disc that complies with § 1.52(e) and the following specifications (no other format shall be allowed):

(i) Computer Compatibility: IBM PC/XT/AT, or compatibles, or Apple Macintosh;

(ii) Operating System Compatibility: MS-DOS, MS-Windows, Unix, or Macintosh;

(iii) Line Terminator: ASCII Carriage Return plus ASCII Line Feed;

(iv) Control Codes: the data must not be dependent on control characters or codes which are not defined in the ASCII character set; and

(v) Compression: uncompressed data.

39. Section 1.97 is amended by revising paragraphs (a) through (e) and (i) to read as follows:

§ 1.97 Filing of information disclosure statement.

(a) In order for an applicant for a patent or for a reissue of a patent to have an information disclosure statement in compliance with § 1.98 considered by

the Office during the pendency of the application, the information disclosure statement must satisfy one of paragraphs (b), (c), or (d) of this section.

(b) An information disclosure statement shall be considered by the Office if filed by the applicant within any one of the following time periods:

(1) Within three months of the filing date of a national application other than a continued prosecution application under § 1.53(d);

(2) Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application;

(3) Before the mailing of a first Office action on the merits; or

(4) Before the mailing of a first Office action after the filing of a request for continued examination under § 1.114.

(c) An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, provided that the information disclosure statement is filed before the mailing date of any of a final action under § 1.113, a notice of allowance under § 1.311, or an action that otherwise closes prosecution in the application, and it is accompanied by one of:

(1) The statement specified in paragraph (e) of this section; or

(2) The fee set forth in § 1.17(p).

(d) An information disclosure statement shall be considered by the Office if filed by the applicant after the period specified in paragraph (c) of this section, provided that the information disclosure statement is filed on or before payment of the issue fee and is accompanied by:

(1) The statement specified in paragraph (e) of this section; and

(2) The fee set forth in § 1.17(p).

(e) A statement under this section must state either:

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

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

* * * * *

(i) If an information disclosure statement does not comply with either this section or § 1.98, it will be placed in the file but will not be considered by the Office.

40. Section 1.98 is revised to read as follows:

§ 1.98 Content of information disclosure statement.

(a) Any information disclosure statement filed under § 1.97 shall include:

(1) A list of all patents, publications, applications, or other information submitted for consideration by the Office;

(2) A legible copy of:

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

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

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

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

(3)(i) A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from applicant's specification or incorporated therein.

(ii) A copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c).

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

(2) Each listed U.S. application must be identified by the inventor, application number, and filing date.

(3) Each listed foreign patent or published foreign patent application 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.

(4) Each listed publication must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.

(c) When the disclosures of two or more patents or publications listed in an information disclosure statement are

substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications, provided that it is stated that these other patents or publications are cumulative.

(d) A copy of any patent, publication, pending U.S. application or other information, as specified in paragraph (a) of this section, listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless:

(1) The earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and

(2) The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.

41. Section 1.102 is amended by revising paragraph (d) to read as follows:

§ 1.102 Advancement of examination.

* * * * *

(d) A petition to make an application special on grounds other than those referred to in paragraph (c) of this section must be accompanied by the fee set forth in § 1.17(h).

* * * * *

42. Section 1.104 is amended by revising paragraph (a)(2) and (e) to read as follows:

§ 1.104 Nature of examination.

(a) * * *

(2) The applicant, or in the case of a reexamination proceeding, both the patent owner and the requester, will be notified of the examiner's action. The reasons for any adverse action or any objection or requirement will be stated in an Office action and such information or references will be given as may be useful in aiding the applicant, or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution.

* * * * *

(e) *Reasons for allowance.* If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning. The reasons shall be incorporated into an Office action rejecting other claims of the application or patent under reexamination or be the subject of a separate communication to the applicant or patent owner. The applicant or patent owner may file a

statement commenting on the reasons for allowance within such time as may be specified by the examiner. Failure by the examiner to respond to any statement commenting on reasons for allowance does not give rise to any implication.

43. A new § 1.105 is added to read as follows:

§ 1.105 Requirements for information.

(a)(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(i) *Commercial databases:* The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) *Search:* Whether a search of the prior art was made, and if so, what was searched.

(iii) *Related information:* A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) *Information used to draft application:* A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) *Information used in invention process:* A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) *Improvements:* Where the claimed invention is an improvement, identification of what is being improved.

(vii) *In use:* Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii) of this section may also be applied to such assignee.

(3) Any reply that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was

requested will be accepted as a complete reply.

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

44. Section 1.111 is amended by revising the heading and paragraphs (a) and (c) to read as follows:

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

(a)(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See §§ 1.135 and 1.136 for time for reply to avoid abandonment.

(2) A second (or subsequent) supplemental reply will be entered unless disapproved by the Commissioner. A second (or subsequent) supplemental reply may be disapproved if the second (or subsequent) supplemental reply unduly interferes with an Office action being prepared in response to the previous reply. Factors that will be considered in disapproving a second (or subsequent) supplemental reply include:

- (i) The state of preparation of an Office action responsive to the previous reply as of the date of receipt (§ 1.6) of the second (or subsequent) supplemental reply by the Office; and
- (ii) The nature of any changes to the specification or claims that would result from entry of the second (or subsequent) supplemental reply.

* * * * *

(c) In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.

45. Section 1.112 is revised to read as follows:

§ 1.112 Reconsideration before final action.

After reply by applicant or patent owner (§ 1.111) to a non-final action, the application or patent under reexamination will be reconsidered and again examined. The applicant or patent

owner will be notified if claims are rejected, or objections or requirements made, in the same manner as after the first examination (§ 1.104). Applicant or patent owner may reply to such Office action in the same manner provided in § 1.111, with or without amendment, unless such Office action indicates that it is made final (§ 1.113) or an appeal (§ 1.191) has been taken (§ 1.116).

46. A new § 1.115 is added to read as follows:

§ 1.115 Preliminary amendments.

(a) A preliminary amendment is an amendment that is received in the Office (§ 1.6) on or before the mail date of the first Office action under § 1.104.

(b)(1) A preliminary amendment will be entered unless disapproved by the Commissioner. A preliminary amendment may be disapproved if the preliminary amendment unduly interferes with the preparation of a first Office action in an application. Factors that will be considered in disapproving a preliminary amendment include:

- (i) The state of preparation of a first Office action as of the date of receipt (§ 1.6) of the preliminary amendment by the Office; and
- (ii) The nature of any changes to the specification or claims that would result from entry of the preliminary amendment.

(2) A preliminary amendment will not be disapproved if it is filed no later than:

- (i) Three months from the filing date of an application under § 1.53(b);
- (ii) The filing date of a continued prosecution application under § 1.53(d); or
- (iii) Three months from the date the national stage is entered as set forth in § 1.491 in an international application.

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

47. Section 1.121 is revised to read as follows:

§ 1.121 Manner of making amendments in applications.

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

(b) *Specification other than the claims and listings provided for elsewhere (§§ 1.96 and 1.825).*—(1) Amendment by instruction to delete, replace, or add a paragraph. Amendments to the specification, other than the claims and listings provided for elsewhere (§§ 1.96 and 1.825), may be made by submitting:

(i) An instruction, which unambiguously identifies the location, to delete one or more paragraphs of the specification, replace a deleted paragraph with one or more replacement paragraphs, or add one or more paragraphs;

(ii) Any replacement or added paragraph(s) in clean form, that is, without markings to indicate the changes that have been made; and

(iii) Another version of any replacement paragraph(s), on one or more pages separate from the amendment, marked up to show all the changes relative to the previous version of the paragraph(s). The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system. A marked up version does not have to be supplied for an added paragraph or a deleted paragraph as it is sufficient to state that a particular paragraph has been added, or deleted.

(2) *Amendment by replacement section.* If the sections of the specification contain section headings as provided in §§ 1.77(b), 1.154(b), or § 1.163(c), amendments to the specification, other than the claims, may be made by submitting:

(i) A reference to the section heading along with an instruction to delete that section of the specification and to replace such deleted section with a replacement section;

(ii) A replacement section in clean form, that is, without markings to indicate the changes that have been made; and

(iii) Another version of the replacement section, on one or more pages separate from the amendment, marked up to show all changes relative to the previous version of the section. The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system.

(3) *Amendment by substitute specification.* The specification, other than the claims, may also be amended by submitting:

(i) An instruction to replace the specification;

(ii) A substitute specification in compliance with § 1.125(b); and

(iii) Another version of the substitute specification, separate from the substitute specification, marked up to show all changes relative to the previous version of the specification. The changes may be shown by brackets (for deleted matter), or underlining (for added matter), or by any equivalent marking system.

(4) *Reinstatement:* Deleted matter may be reinstated only by a subsequent

amendment presenting the previously deleted matter.

(c) *Claims.*—(1) *Amendment by rewriting, directions to cancel or add:* Amendments to a claim must be made by rewriting such claim with all changes (e.g., additions, deletions, modifications) included. The rewriting of a claim (with the same number) will be construed as directing the cancellation of the previous version of that claim. A claim may also be canceled by an instruction.

(i) A rewritten or newly added claim must be in clean form, that is, without markings to indicate the changes that have been made. A parenthetical expression should follow the claim number indicating the status of the claim as amended or newly added (e.g., “amended,” “twice amended,” or “new”).

(ii) If a claim is amended by rewriting such claim with the same number, the amendment must be accompanied by another version of the rewritten claim, on one or more pages separate from the amendment, marked up to show all the changes relative to the previous version of that claim. A parenthetical expression should follow the claim number indicating the status of the claim, e.g., “amended,” “twice amended,” etc. The parenthetical expression “amended,” “twice amended,” etc. should be the same for both the clean version of the claim under paragraph (c)(1)(i) of this section and the marked up version under this paragraph. The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system. A marked up version does not have to be supplied for an added claim or a canceled claim as it is sufficient to state that a particular claim has been added, or canceled.

(2) A claim canceled by amendment (deleted in its entirety) may be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

(3) A clean version of the entire set of pending claims may be submitted in a single amendment paper. Such a submission shall be construed as directing the cancellation of all previous versions of any pending claims. A marked up version is required only for claims being changed by the current amendment (see paragraph (c)(1)(ii) of this section). Any claim not accompanied by a marked up version will constitute an assertion that it has not been changed relative to the immediate prior version.

(d) *Drawings.* Application drawings are amended in the following manner: Any change to the application drawings

must be submitted on a separate paper showing the proposed changes in red for approval by the examiner. Upon approval by the examiner, new drawings in compliance with § 1.84 including the changes must be filed.

(e) *Disclosure consistency.* The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(f) *No new matter.* No amendment may introduce new matter into the disclosure of an application.

(g) *Exception for examiner's amendments:* Changes to the specification, including the claims, of an application made by the Office in an examiner's amendment may be made by specific instructions to insert or delete subject matter set forth in the examiner's amendment by identifying the precise point in the specification or the claim(s) where the insertion or deletion is to be made. Compliance with paragraphs (b)(1), (b)(2) or (c)(1) of this section is not required.

(h) *Amendments in reissue applications.* Any amendment to the description and claims in reissue applications must be made in accordance with § 1.173.

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

(j) *Amendments in provisional applications:* Amendments in provisional applications are not normally made. If an amendment is made to a provisional application, however, it must comply with the provisions of this section. Any amendments to a provisional application shall be placed in the provisional application file but may not be entered.

48. Section 1.125 is amended by revising paragraphs (b)(2) and (c) to read as follows:

§ 1.125 Substitute specification.

* * * * *

(b) * * *

(2) A marked up version of the substitute specification showing all the changes (including the matter being added to and the matter being deleted from) to the specification of record. Numbering the paragraphs of the specification of record is not considered a change that must be shown pursuant to this paragraph.

(c) A substitute specification submitted under this section must be submitted in clean form without markings as to amended material. The paragraphs of any substitute specification, other than the claims, should be individually numbered in Arabic numerals so that any amendment to the specification may be made by replacement paragraph in accordance with § 1.121(b)(1).

* * * * *

49. Section 1.131 is amended by revising its heading and paragraph (a) to read as follows:

§ 1.131 Affidavit or declaration of prior invention.

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

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

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

* * * * *

50. 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, an oath or declaration may be submitted to traverse the rejection or objection. An oath or declaration may not be submitted under this section to traverse a rejection if the rejection is based upon a U.S. patent to another or others which claims the same patentable invention as defined in § 1.601(n).

51. Section 1.133 is amended by revising paragraph (a) to read as follows:

§ 1.133 Interviews.

(a)(1) Interviews with examiners concerning applications and other matters pending before the Office must be conducted on Office premises and within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Commissioner.

(2) An interview for the discussion of the patentability of a pending application will not occur before the first Office action, unless the application is a continuing or substitute application.

(3) The examiner may require that an interview be scheduled in advance.

* * * * *

52. Section 1.136 is amended by adding paragraph (c) to read as follows:

§ 1.136 Extensions of time.

* * * * *

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

(1) The period for submitting an oath or declaration in compliance with § 1.63; and

(2) The period for submitting formal drawings set under § 1.85(c).

53. Section 1.137 is amended by revising paragraph (c) to read as follows:

§ 1.137 Revival of abandoned application or lapsed patent.

* * * * *

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

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

(ii) The period extending beyond twenty years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an

earlier filed application(s) under 35 U.S.C. 120, 121, or 365(c), from the date on which the earliest such application was filed.

(2) Any terminal disclaimer pursuant to paragraph (c)(1) of this section must also apply to any patent granted on a continuing utility or plant application filed 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 (c)(1) of this section do not apply to applications for which revival is sought solely for purposes of copendency with a utility or plant application filed on or after June 8, 1995, or to lapsed patents.

* * * * *

54. Section 1.138 is revised to read as follows:

§ 1.138 Express abandonment.

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

(b) A written declaration of abandonment must be signed by a party authorized under § 1.33(b)(1), (b)(3), or (b)(4) to sign a paper in the application, except as otherwise provided in this paragraph. A registered attorney or agent, not of record, who acts in a representative capacity under the provisions of § 1.34(a) when filing a continuing application, may expressly abandon the prior application as of the filing date granted to the continuing application.

55. Section 1.152 is revised to read as follows:

§ 1.152 Design drawings.

The design must be represented by a drawing that complies with the requirements of § 1.84 and must contain a sufficient number of views to constitute a complete disclosure of the appearance of the design. Appropriate and adequate surface shading should be used to show the character or contour of the surfaces represented. Solid black surface shading is not permitted except when used to represent the color black as well as color contrast. Broken lines may be used to show visible environmental structure, but may not be used to show hidden planes and surfaces that cannot be seen through opaque materials. Alternate positions of

a design component, illustrated by full and broken lines in the same view are not permitted in a design drawing. Photographs and ink drawings are not permitted to be combined as formal drawings in one application. Photographs submitted in lieu of ink drawings in design patent applications must not disclose environmental structure but must be limited to the design claimed for the article.

56. Section 1.154 is revised to read as follows:

§ 1.154 Arrangement of application elements in a design application.

(a) The elements of the design application, if applicable, should appear in the following order:

(1) Design application transmittal form.

(2) Fee transmittal form.

(3) Application data sheet (see § 1.76).

(4) Specification.

(5) Drawings or photographs.

(6) Executed oath or declaration (see § 1.153(b)).

(b) The specification should include the following sections in order:

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

(2) Cross-reference to related applications (unless included in the application data sheet).

(3) Statement regarding federally sponsored research or development.

(4) Description of the figure or figures of the drawing.

(5) Feature description.

(6) A single claim.

(c) The text of the specification sections defined in paragraph (b) of this section, if applicable, should be preceded by a section heading in uppercase letters without underlining or bold type.

57. Section 1.155 is revised to read as follows:

§ 1.155 Expedited examination of design applications.

(a) The applicant may request that the Office expedite the examination of a design application. To qualify for expedited examination:

(1) The application must include drawings in compliance with § 1.84;

(2) The applicant must have conducted a preexamination search; and

(3) The applicant must file a request for expedited examination including:

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

(ii) A statement that a preexamination search was conducted. The statement must also indicate the field of search and include an information disclosure statement in compliance with § 1.98.

(b) The Office will not examine an application that is not in condition for examination (*e.g.*, missing basic filing fee) even if the applicant files a request for expedited examination under this section.

58. Section 1.163 is revised to read as follows:

§ 1.163 Specification and arrangement of application elements in a plant application.

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. For a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

(b) The elements of the plant application, if applicable, should appear in the following order:

- (1) Plant application transmittal form.
- (2) Fee transmittal form.
- (3) Application data sheet (see § 1.76).
- (4) Specification.
- (5) Drawings (in duplicate).
- (6) Executed oath or declaration (§ 1.162).

(c) The specification should include the following sections in order:

- (1) Title of the invention, which may include an introductory portion stating the name, citizenship, and residence of the applicant.
- (2) Cross-reference to related applications (unless included in the application data sheet).
- (3) Statement regarding federally sponsored research or development.
- (4) Latin name of the genus and species of the plant claimed.
- (5) Variety denomination.
- (6) Background of the invention.
- (7) Brief summary of the invention.
- (8) Brief description of the drawing.
- (9) Detailed botanical description.
- (10) A single claim.
- (11) Abstract of the disclosure.

(d) The text of the specification or sections defined in paragraph (c) of this section, if applicable, should be preceded by a section heading in upper case, without underlining or bold type.

59. Section 1.173 is revised to read as follows:

§ 1.173 Reissue specification, drawings, and amendments.

(a) *Contents of a reissue application.* An application for reissue must contain the entire specification, including the claims, and the drawings of the patent. No new matter shall be introduced into

the application. No reissue patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent, pursuant to 35 U.S.C. 251.

(1) *Specification, including claims.* The entire specification, including the claims, of the patent for which reissue is requested must be furnished in the form of a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper. If an amendment of the reissue application is to be included, it must be made pursuant to paragraph (b) of this section. The formal requirements for papers making up the reissue application other than those set forth in this section are set out in § 1.52. Additionally, a copy of any disclaimer (§ 1.321), certificate of correction (§§ 1.322 through 1.324), or reexamination certificate (§ 1.570) issued in the patent must be included. (See also § 1.178).

(2) *Drawings.* Applicant must submit a clean copy of each drawing sheet of the printed patent at the time the reissue application is filed. If such copy complies with § 1.84, no further drawings will be required. Where a drawing of the reissue application is to include any changes relative to the patent being reissued, the changes to the drawing must be made in accordance with paragraph (b)(3) of this section. The Office will not transfer the drawings from the patent file to the reissue application.

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

(1) *Specification other than the claims.* Changes to the specification, other than to the claims, must be made by submission of the entire text of an added or rewritten paragraph, including markings pursuant to paragraph (d) of this section, except that an entire paragraph may be deleted by a statement deleting the paragraph without presentation of the text of the paragraph. The precise point in the specification must be identified where any added or rewritten paragraph is located. This paragraph applies whether the amendment is submitted on paper or compact disc (*see* §§ 1.52(e)(1) and

1.821(c), but not for discs submitted under § 1.821(e)).

(2) *Claims.* An amendment paper must include the entire text of each claim being changed by such amendment paper and of each claim being added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," *etc.*, should follow the claim number. Each changed patent claim and each added claim must include markings pursuant to paragraph (d) of this section, except that a patent claim or added claim should be canceled by a statement canceling the claim without presentation of the text of the claim.

(3) *Drawings.* Any change to the patent drawings must be submitted as a sketch on a separate paper showing the proposed changes in red for approval by the examiner. Upon approval by the examiner, new drawings in compliance with § 1.84 including the approved changes must be filed. Amended figures must be identified as "Amended," and any added figure must be identified as "New." In the event that a figure is canceled, the figure must be surrounded by brackets and identified as "Canceled."

(c) *Status of claims and support for claim changes.* Whenever there is an amendment to the claims pursuant to paragraph (b) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (*i.e.*, pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes made to the claims.

(d) *Changes shown by markings.* Any changes relative to the patent being reissued which are made to the specification, including the claims, upon filing, or by an amendment paper in the reissue application, must include the following markings:

(1) The matter to be omitted by reissue must be enclosed in brackets; and

(2) The matter to be added by reissue must be underlined, except for amendments submitted on compact discs (§§ 1.96 and 1.821(c)). Matter added by reissue on compact discs must be preceded with "<U>" and end with "</U>" to properly identify the material being added.

(e) *Numbering of patent claims preserved.* Patent claims may not be renumbered. The numbering of any claim added in the reissue application must follow the number of the highest numbered patent claim.

(f) *Amendment of disclosure may be required.* The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(g) *Amendments made relative to the patent.* All amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing of the reissue application.

§ 1.174 [Reserved]

60. Section 1.174 is removed and reserved.

61. Section 1.176 is revised to read as follows:

§ 1.176 Examination of reissue.

(a) A reissue application will be examined in the same manner as a non-reissue, non-provisional application, and will be subject to all the requirements of the rules related to non-reissue applications. Applications for reissue will be acted on by the examiner in advance of other applications.

(b) Restriction between subject matter of the original patent claims and previously unclaimed subject matter may be required (restriction involving only subject matter of the original patent claims will not be required). If restriction is required, the subject matter of the original patent claims will be held to be constructively elected unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.

62. Section 1.177 is revised to read as follows:

§ 1.177 Issuance of multiple reissue patents.

(a) The Office may reissue a patent as multiple reissue patents. If applicant files more than one application for the reissue of a single patent, each such application must contain or be amended to contain in the first sentence of the specification a notice stating that more than one reissue application has been filed and identifying each of the reissue applications by relationship, application number and filing date. The Office may correct by certificate of correction under § 1.322 any reissue patent resulting from an application to which this paragraph applies that does not contain the required notice.

(b) If applicant files more than one application for the reissue of a single patent, each claim of the patent being reissued must be presented in each of the reissue applications as an amended,

unamended, or canceled (shown in brackets) claim, with each such claim bearing the same number as in the patent being reissued. The same claim of the patent being reissued may not be presented in its original unamended form for examination in more than one of such multiple reissue applications. The numbering of any added claims in any of the multiple reissue applications must follow the number of the highest numbered original patent claim.

(c) If any one of the several reissue applications by itself fails to correct an error in the original patent as required by 35 U.S.C. 251 but is otherwise in condition for allowance, the Office may suspend action in the allowable application until all issues are resolved as to at least one of the remaining reissue applications. The Office may also merge two or more of the multiple reissue applications into a single reissue application. No reissue application containing only unamended patent claims and not correcting an error in the original patent will be passed to issue by itself.

63. Section 1.178 is revised to read as follows:

§ 1.178 Original patent; continuing duty of applicant.

(a) The application for a reissue should be accompanied by either an offer to surrender the original patent, or the original patent itself, or if the original is lost or inaccessible, by a statement to that effect. The application may be accepted for examination in the absence of the original patent or the statement, but one or the other must be supplied before the application is allowed. If a reissue application is refused, the original patent, if surrendered, will be returned to applicant upon request.

(b) In any reissue application before the Office, the applicant must call to the attention of the Office any prior or concurrent proceedings in which the patent (for which reissue is requested) is or was involved, such as interferences, reissues, reexaminations, or litigations and the results of such proceedings (see also § 1.173(a)(1)).

64. Section 1.181 is amended by revising paragraph (f) to read as follows:

§ 1.181 Petition to the Commissioner.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as

untimely, except as otherwise provided. This two-month period is not extendable.

* * * * *

65. Section 1.193 is amended by revising paragraph (b)(1) to read as follows:

§ 1.193 Examiner's answer and reply brief.

* * * * *

(b)(1) Appellant may file a reply brief to an examiner's answer or a supplemental examiner's answer within two months from the date of such examiner's answer or supplemental examiner's answer. See § 1.136(b) for extensions of time for filing a reply brief in a patent application and § 1.550(c) for extensions of time for filing a reply brief in a reexamination proceeding. The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. A supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose.

* * * * *

66. Section 1.303 is amended by revising paragraph (a) to read as follows:

§ 1.303 Civil action under 35 U.S.C. 145, 146, 306.

(a) Any applicant or any owner of a patent involved in a reexamination proceeding dissatisfied with the decision of the Board of Patent Appeals and Interferences, and any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences may, instead of appealing to the U.S. Court of Appeals for the Federal Circuit (§ 1.301), have remedy by civil action under 35 U.S.C. 145 or 146, as appropriate. Such civil action must be commenced within the time specified in § 1.304.

* * * * *

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

§ 1.311 Notice of allowance.

* * * * *

(b) An authorization to charge the issue fee (§ 1.18) to a deposit account may be filed in an individual application only after the 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).

* * * * *

68. Section 1.314 is revised to read as follows:

§ 1.314 Issuance of patent.

If applicant timely pays the issue fee, the Office will issue the patent in regular course unless the application is withdrawn from issue (§ 1.313) or the Office defers issuance of the patent. To request that the Office defer issuance of a patent, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why it is necessary to defer issuance of the patent.

69. Section 1.322 is amended by revising paragraph (a) to read as follows:

§ 1.322 Certificate of correction of Office mistake.

(a)(1) The Commissioner may issue a certificate of correction pursuant to 35 U.S.C. 254 to correct a mistake in a patent, incurred through the fault of the Office, which mistake is clearly disclosed in the records of the Office:

(i) At the request of the patentee or the patentee's assignee;

(ii) Acting *sua sponte* for mistakes that the Office discovers; or

(iii) Acting on information about a mistake supplied by a third party.

(2)(i) There is no obligation on the Office to act on or respond to a submission of information or request to issue a certificate of correction by a third party under paragraph (a)(1)(iii) of this section.

(ii) Papers submitted by a third party under this section will not be made of record in the file that they relate to nor be retained by the Office.

(3) If the request relates to a patent involved in an interference, the request must comply with the requirements of this section and be accompanied by a motion under § 1.635.

(4) The Office will not issue a certificate of correction under this section without first notifying the patentee (including any assignee of record) at the correspondence address of record as specified in § 1.33(a) and affording the patentee or an assignee an opportunity to be heard.

* * * * *

70. Section 1.323 is revised to read as follows:

§ 1.323 Certificate of correction of applicant's mistake.

The Office may issue a certificate of correction under the conditions specified in 35 U.S.C. 255 at the request

of the patentee or the patentee's assignee, upon payment of the fee set forth in § 1.20(a). If the request relates to a patent involved in an interference, the request must comply with the requirements of this section and be accompanied by a motion under § 1.635.

71. Section 1.324 is amended by revising its heading and paragraph (b)(1) and adding paragraph (c) to read as follows:

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

* * * * *

(b) * * *

(1) Where one or more persons are being added, a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on his or her part;

* * * * *

(c) For correction of inventorship in an application see §§ 1.48 and 1.497, and in an interference see § 1.634.

72. Section 1.366 is amended by revising paragraph (c) to read as follows:

§ 1.366 Submission of maintenance fees.

* * * * *

(c) In submitting maintenance fees and any necessary surcharges, identification of the patents for which maintenance fees are being paid must include the patent number, and the application number of the United States application for the patent on which the maintenance fee is being paid. If the payment includes identification of only the patent number (*i.e.*, does not identify the application number of the United States application for the patent on which the maintenance fee is being paid), the Office may apply the payment to the patent identified by patent number in the payment or may return the payment.

* * * * *

73. Section 1.446 is amended by revising paragraph (a) and adding paragraph (b) to read as follows:

§ 1.446 Refund of international application filing and processing fees.

(a) Money paid for international application fees, where paid by actual mistake or in excess, such as a payment not required by law or treaty and its regulations, may be refunded. A mere change of purpose after the payment of a fee will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested and will not notify the payor of such amounts. If the payor or party requesting a refund does not provide the banking information necessary for

making refunds by electronic funds transfer, the Office may use the banking information provided on the payment instrument to make any refund by electronic funds transfer.

(b) Any request for refund under paragraph (a) of this section must be filed within two years from the date the fee was paid. If the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization under § 1.25(b), any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge and include a copy of that deposit account statement. The time periods set forth in this paragraph are not extendable.

* * * * *

74. Section 1.497 is amended by revising paragraph (b)(2) and adding paragraphs (d) and (e) to read as follows:

§ 1.497 Oath or declaration under 35 U.S.C. 371(c)(4).

* * * * *

(b) * * *

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

* * * * *

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

(1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;

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

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

(e) The Office may require such other information as may be deemed appropriate under the particular

circumstances surrounding the correction of inventorship.

* * * * *

75. Section 1.510 is amended by revising paragraphs (b)(4) and (e) to read as follows:

§ 1.510 Request for reexamination.

* * * * *

(b) * * *

(4) A copy of the entire patent including the front face, drawings, and specification/claims (in double column format) for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent. All copies must have each page plainly written on only one side of a sheet of paper.

* * * * *

(e) A request filed by the patent owner may include a proposed amendment in accordance with § 1.530.

* * * * *

76. Section 1.530 is amended by revising its heading and paragraph (d), and adding paragraphs (e) through (l) to read as follows:

§ 1.530 Statement; amendment by patent owner; inventorship change.

* * * * *

(d) *Making amendments in a reexamination proceeding.* A proposed amendment in a reexamination proceeding is made by filing a paper directing that proposed specified changes be made to the patent specification, including the claims, or to the drawings. An amendment paper directing that proposed specified changes be made in a reexamination proceeding may be submitted as an accompaniment to a request filed by the patent owner in accordance with § 1.510(e), as part of a patent owner statement in accordance with paragraph (b) of this section, or, where permitted, during the prosecution of the reexamination proceeding pursuant to § 1.550(a).

(1) *Specification other than the claims.* Changes to the specification, other than to the claims, must be made by submission of the entire text of an added or rewritten paragraph including markings pursuant to paragraph (f) of this section, except that an entire paragraph may be deleted by a statement deleting the paragraph, without presentation of the text of the paragraph. The precise point in the specification must be identified where any added or rewritten paragraph is located. This paragraph applies whether the amendment is submitted on paper or compact disc (see §§ 1.96 and 1.825).

(2) *Claims.* An amendment paper must include the entire text of each patent claim which is being proposed to be changed by such amendment paper and of each new claim being proposed to be added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," etc., should follow the claim number. Each patent claim proposed to be changed and each proposed added claim must include markings pursuant to paragraph (f) of this section, except that a patent claim or proposed added claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

(3) *Drawings.* Any change to the patent drawings must be submitted as a sketch on a separate paper showing the proposed changes in red for approval by the examiner. Upon approval of the changes by the examiner, only new sheets of drawings including the changes and in compliance with § 1.84 must be filed. Amended figures must be identified as "Amended," and any added figure must be identified as "New." In the event a figure is canceled, the figure must be surrounded by brackets and identified as "Canceled."

(4) The formal requirements for papers making up the reexamination proceeding other than those set forth in this section are set out in § 1.52.

(e) *Status of claims and support for claim changes.* Whenever there is an amendment to the claims pursuant to paragraph (d) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (*i.e.*, pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper.

(f) *Changes shown by markings.* Any changes relative to the patent being reexamined which are made to the specification, including the claims, must include the following markings:

(1) The matter to be omitted by the reexamination proceeding must be enclosed in brackets; and

(2) The matter to be added by the reexamination proceeding must be underlined.

(g) *Numbering of patent claims preserved.* Patent claims may not be renumbered. The numbering of any claims added in the reexamination proceeding must follow the number of the highest numbered patent claim.

(h) *Amendment of disclosure may be required.* The disclosure must be amended, when required by the Office,

to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(i) *Amendments made relative to patent.* All amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination.

(j) *No enlargement of claim scope.* No amendment may enlarge the scope of the claims of the patent or introduce new matter. No amendment may be proposed for entry in an expired patent. Moreover, no amendment, other than the cancellation of claims, will be incorporated into the patent by a certificate issued after the expiration of the patent.

(k) *Amendments not effective until certificate.* Although the Office actions will treat proposed amendments as though they have been entered, the proposed amendments will not be effective until the reexamination certificate is issued.

(l) *Correction of inventorship in a reexamination proceeding.* (1) When it appears in a patent being reexamined that the correct inventor or inventors were not named through error without deceptive intention on the part of the actual inventor or inventors, the Commissioner may, on petition of all the parties, including the assignees, and satisfactory proof of the facts and payment of the fee set forth in § 1.20(b), or on order of a court before which such matter is called in question, include in the reexamination certificate to be issued under § 1.570 an amendment naming only the actual inventor or inventors. The petition must be submitted as part of the reexamination proceeding, and must satisfy the requirements of § 1.324.

(2) Notwithstanding paragraph (l)(1) of this section, if a petition to correct inventorship satisfying the requirements of § 1.324 is filed in a reexamination proceeding, and the reexamination proceeding is terminated other than by a reexamination certificate under § 1.570, a certificate of correction indicating the change of inventorship stated in the petition will be issued upon request by the patentee.

77. Section 1.550 is amended by revising paragraphs (a) and (b) to read as follows:

§ 1.550 Conduct of reexamination proceedings.

(a) All reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch

within the Office. After issuance of the reexamination order and expiration of the time for submitting any responses thereto, the examination will be conducted in accordance with §§ 1.104, 1.105, 1.110 through 1.113, 1.115, and 1.116 and will result in the issuance of a reexamination certificate under § 1.570.

(b) The patent owner will be given at least thirty days to respond to any Office action. In response to any rejection, such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable.

* * * * *

78. Section 1.565 is amended by revising paragraph (a) to read as follows:

§ 1.565 Concurrent office proceedings.

(a) In any reexamination proceeding before the Office, the patent owner must call the attention of the Office to any prior or concurrent proceedings in which the patent is or was involved such as interferences, reissue, reexaminations or litigation and the results of such proceedings.

* * * * *

79. Section 1.666 is amended by revising paragraph (b) to read as follows:

§ 1.666 Filing of interference settlement agreements.

* * * * *

(b) If any party filing the agreement or understanding under paragraph (a) of this section so requests, the copy will be kept separate from the file of the interference, and made available only to Government agencies on written request, or to any person upon petition accompanied by the fee set forth in § 1.17(h) and on a showing of good cause.

* * * * *

80. Section 1.720 is amended by revising paragraphs (b) and (g) to read as follows:

§ 1.720 Conditions for extension of patent term.

* * * * *

(b) The term of the patent has never been previously extended, except for extensions issued pursuant to §§ 1.701, 1.760, or § 1.790;

* * * * *

(g) The term of the patent, including any interim extension issued pursuant to § 1.790, has not expired before the submission of an application in compliance with § 1.741; and

* * * * *

81. Section 1.730 is revised to read as follows:

§ 1.730 Applicant for extension of patent term; signature requirements.

(a) Any application for extension of a patent term must be submitted by the owner of record of the patent or its agent and must comply with the requirements of § 1.740.

(b) If the application is submitted by the patent owner, the application must be signed either by:

- (1) The patent owner in compliance with § 3.73(b) of this chapter; or
- (2) A registered practitioner on behalf of the patent owner.

(c) If the application is submitted on behalf of the patent owner by an agent of the patent owner (e.g., a licensee of the patent owner), the application must be signed by a registered practitioner on behalf of the agent. The Office may require proof that the agent is authorized to act on behalf of the patent owner.

(d) If the application is signed by a registered practitioner, the Office may require proof that the practitioner is authorized to act on behalf of the patent owner or agent of the patent owner.

82. Section 1.740 is amended by removing paragraphs (a)(16) and (17) and by revising its heading, the introductory text of paragraph (a), and paragraphs (a)(9), (a)(10), (a)(14), (a)(15), (b) and (c) to read as follows:

§ 1.740 Formal requirements for application for extension of patent term; correction of informalities.

(a) An application for extension of patent term must be made in writing to the Commissioner. A formal application for the extension of patent term must include:

* * * * *

(9) A statement that the patent claims the approved product, or a method of using or manufacturing the approved product, and a showing which lists each applicable patent claim and demonstrates the manner in which at least one such patent claim reads on:

(i) The approved product, if the listed claims include any claim to the approved product;

(ii) The method of using the approved product, if the listed claims include any claim to the method of using the approved product; and

(iii) The method of manufacturing the approved product, if the listed claims include any claim to the method of manufacturing the approved product;

(10) A statement beginning on a new page of the relevant dates and information pursuant to 35 U.S.C. 156(g) in order to enable the Secretary of Health and Human Services or the Secretary of Agriculture, as appropriate, to determine the applicable regulatory review period as follows:

(i) For a patent claiming a human drug, antibiotic, or human biological product:

(A) The effective date of the investigational new drug (IND) application and the IND number;

(B) The date on which a new drug application (NDA) or a Product License Application (PLA) was initially submitted and the NDA or PLA number; and

(C) The date on which the NDA was approved or the Product License issued;

(ii) For a patent claiming a new animal drug:

(A) The date a major health or environmental effects test on the drug was initiated, and any available substantiation of that date, or the date of an exemption under subsection (j) of Section 512 of the Federal Food, Drug, and Cosmetic Act became effective for such animal drug;

(B) The date on which a new animal drug application (NADA) was initially submitted and the NADA number; and

(C) The date on which the NADA was approved;

(iii) For a patent claiming a veterinary biological product:

(A) The date the authority to prepare an experimental biological product under the Virus-Serum-Toxin Act became effective;

(B) The date an application for a license was submitted under the Virus-Serum-Toxin Act; and

(C) The date the license issued;

(iv) For a patent claiming a food or color additive:

(A) The date a major health or environmental effects test on the additive was initiated and any available substantiation of that date;

(B) The date on which a petition for product approval under the Federal Food, Drug and Cosmetic Act was initially submitted and the petition number; and

(C) The date on which the FDA published a **Federal Register** notice listing the additive for use;

(v) For a patent claiming a medical device:

(A) The effective date of the investigational device exemption (IDE) and the IDE number, if applicable, or the date on which the applicant began the first clinical investigation involving the device, if no IDE was submitted, and any available substantiation of that date;

(B) The date on which the application for product approval or notice of completion of a product development protocol under Section 515 of the Federal Food, Drug and Cosmetic Act was initially submitted and the number of the application; and

(C) The date on which the application was approved or the protocol declared to be completed;

* * * *

(14) The prescribed fee for receiving and acting upon the application for extension (see § 1.20(j)); and

(15) The name, address, and telephone number of the person to whom inquiries and correspondence relating to the application for patent term extension are to be directed.

(b) The application under this section must be accompanied by two additional copies of such application (for a total of three copies).

(c) If an application for extension of patent term is informal under this section, the Office will so notify the applicant. The applicant has two months from the mail date of the notice, or such time as is set in the notice, within which to correct the informality. Unless the notice indicates otherwise, this time period may be extended under the provisions of § 1.136.

83. Section 1.741 is amended by revising its heading, the introductory text of paragraph (a) and paragraphs (a)(5) and (b) to read as follows:

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

(a) The filing date of an application for extension of a patent term is the date on which a complete application is received in the Office or filed pursuant to the procedures set forth in § 1.8 or § 1.10. A complete application must include:

* * * *

(5) Sufficient information to enable the Commissioner to determine under subsections (a) and (b) of 35 U.S.C. 156 the eligibility of a patent for extension, and the rights that will be derived from the extension, and information to enable the Commissioner and the Secretary of Health and Human Services or the Secretary of Agriculture to determine the length of the regulatory review period; and

* * * *

(b) If an application for extension of patent term is incomplete under this section, the Office will so notify the applicant. If applicant requests review of a notice that an application is incomplete, or review of the filing date accorded an application under this section, applicant must file a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(h) within two months of the mail date of the notice that the application is incomplete, or the notice according the filing date complained of. Unless the notice indicates otherwise, this time

period may be extended under the provisions of § 1.136.

84. Section 1.760 is revised to read as follows:

§ 1.760 Interim extension of patent term under 35 U.S.C. 156(e)(2).

An applicant who has filed a formal application for extension in compliance with § 1.740 may request one or more interim extensions for periods of up to one year each pending a final determination on the application pursuant to § 1.750. Any such request should be filed at least three months prior to the expiration date of the patent. The Commissioner may issue interim extensions, without a request by the applicant, for periods of up to one year each until a final determination is made. The patent owner or agent will be notified when an interim extension is granted and notice of the extension will be published in the *Official Gazette of the United States Patent and Trademark Office*. The notice will be recorded in the official file of the patent and will be considered as part of the original patent. In no event will the interim extensions granted under this section be longer than the maximum period for extension to which the applicant would be eligible.

85. Section 1.780 is revised to read as follows:

§ 1.780 Certificate or order of extension of patent term.

If a determination is made pursuant to § 1.750 that a patent is eligible for extension and that the term of the patent is to be extended, a certificate of extension, under seal, or an order granting interim extension under 35 U.S.C. 156(d)(5), will be issued to the applicant for the extension of the patent term. Such certificate or order will be recorded in the official file of the patent and will be considered as part of the original patent. Notification of the issuance of the certificate or order of extension will be published in the *Official Gazette of the United States Patent and Trademark Office*. Notification of the issuance of the order granting an interim extension under 35 U.S.C. 156(d)(5), including the identity of the product currently under regulatory review, will be published in the *Official Gazette of the United States Patent and Trademark Office* and in the **Federal Register**. No certificate of, or order granting, an extension will be issued if the term of the patent cannot be extended, even though the patent is otherwise determined to be eligible for extension. In such situations, the final determination made pursuant to § 1.750

will indicate that no certificate or order will issue.

86. Section 1.821 is amended by revising paragraphs (c), (e) and (f) to read as follows:

§ 1.821 Nucleotide and/or amino acid sequence disclosures in patent applications.

* * * *

(c) Patent applications which contain disclosures of nucleotide and/or amino acid sequences must contain, as a separate part of the disclosure, a paper or compact disc copy (see § 1.52(e)) disclosing the nucleotide and/or amino acid sequences and associated information using the symbols and format in accordance with the requirements of §§ 1.822 and 1.823. This paper or compact disc copy is referred to elsewhere in this subpart as the "Sequence Listing." Each sequence disclosed must appear separately in the "Sequence Listing." Each sequence set forth in the "Sequence Listing" must be assigned a separate sequence identifier. The sequence identifiers must begin with 1 and increase sequentially by integers. If no sequence is present for a sequence identifier, the code "000" must be used in place of the sequence. The response for the numeric identifier <160> must include the total number of SEQ ID NOs, whether followed by a sequence or by the code "000."

* * * *

(e) A copy of the "Sequence Listing" referred to in paragraph (c) of this section must also be submitted in computer readable form (CRF) in accordance with the requirements of § 1.824. The computer readable form must be a copy of the "Sequence Listing" and may not be retained as a part of the patent application file. If the computer readable form of a new application is to be identical with the computer readable form of another application of the applicant on file in the Office, reference may be made to the other application and computer readable form in lieu of filing a duplicate computer readable form in the new application if the computer readable form in the other application was compliant with all of the requirements of this subpart. The new application must be accompanied by a letter making such reference to the other application and computer readable form, both of which shall be completely identified. In the new application, applicant must also request the use of the compliant computer readable "Sequence Listing" that is already on file for the other application and must state that the paper or compact disc copy of the "Sequence Listing" in the

new application is identical to the computer readable copy filed for the other application.

(f) In addition to the paper or compact disc copy required by paragraph (c) of this section and the computer readable form required by paragraph (e) of this section, a statement that the "Sequence Listing" content of the paper or compact disc copy and the computer readable copy are the same must be submitted with the computer readable form, *e.g.*, a statement that "the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing."

* * * * *

87. Section 1.823 is amended by revising its heading and paragraph (a) to read as follows:

§ 1.823 Requirements for nucleotide and/or amino acid sequences as part of the application.

(a)(1) If the "Sequence Listing" required by § 1.821(c) is submitted on paper: The "Sequence Listing," setting forth the nucleotide and/or amino acid sequence and associated information in accordance with paragraph (b) of this section, must begin on a new page and must be titled "Sequence Listing." The pages of the "Sequence Listing" preferably should be numbered independently of the numbering of the remainder of the application. Each page of the "Sequence Listing" shall contain no more than 66 lines and each line shall contain no more than 72 characters. A fixed-width font should be used exclusively throughout the "Sequence Listing."

(2) If the "Sequence Listing" required by § 1.821(c) is submitted on compact disc: The "Sequence Listing" must be submitted on a compact disc in compliance with § 1.52(e). The compact disc may also contain table information if the application contains table information that may be submitted on a compact disc (§ 1.52(e)(1)(iii)). The specification must contain an incorporation-by-reference of the Sequence Listing as required by § 1.52(e)(5). The presentation of the "Sequence Listing" and other materials on compact disc under § 1.821(c) does not substitute for the Computer Readable Form that must be submitted on disk, compact disc, or tape in accordance with § 1.824.

* * * * *

88. Section 1.824 is revised to read as follows:

§ 1.824 Form and format for nucleotide and/or amino acid sequence submissions in computer readable form.

(a) The computer readable form required by § 1.821(e) shall meet the following requirements:

(1) The computer readable form shall contain a single "Sequence Listing" as either a diskette, series of diskettes, or other permissible media outlined in paragraph (c) of this section.

(2) The "Sequence Listing" in paragraph (a)(1) of this section shall be submitted in American Standard Code for Information Interchange (ASCII) text. No other formats shall be allowed.

(3) The computer readable form may be created by any means, such as word processors, nucleotide/amino acid sequence editors' or other custom computer programs; however, it shall conform to all requirements detailed in this section.

(4) File compression is acceptable when using diskette media, so long as the compressed file is in a self-extracting format that will decompress on one of the systems described in paragraph (b) of this section.

(5) Page numbering must not appear within the computer readable form version of the "Sequence Listing" file.

(6) All computer readable forms must have a label permanently affixed thereto on which has been hand-printed or typed: the name of the applicant, the title of the invention, the date on which the data were recorded on the computer readable form, the operating system used, a reference number, and an application number and filing date, if known. If multiple diskettes are submitted, the diskette labels must indicate their order (*e.g.* "1 of X").

(b) Computer readable form submissions must meet these format requirements:

(1) Computer Compatibility: IBM PC/XT/AT or Apple Macintosh;

(2) Operating System Compatibility: MS-DOS, MS-Windows, Unix or Macintosh;

(3) Line Terminator: ASCII Carriage Return plus ASCII Line Feed; and

(4) Pagination: Continuous file (no "hard page break" codes permitted).

(c) Computer readable form files submitted may be in any of the following media:

(1) Diskette: 3.50 inch, 1.44 Mb storage; 3.50 inch, 720 Kb storage; 5.25 inch, 1.2 Mb storage; 5.25 inch, 360 Kb storage.

(2) Magnetic tape: 0.5 inch, up to 24000 feet; Density: 1600 or 6250 bits per inch, 9 track; Format: Unix tar command; specify blocking factor (not "block size"); Line Terminator: ASCII Carriage Return plus ASCII Line Feed.

(3) 8mm Data Cartridge: Format: Unix tar command; specify blocking factor (not "block size"); Line Terminator: ASCII Carriage Return plus ASCII Line Feed.

(4) Compact disc: Format: ISO 9660 or High Sierra Format.

(5) Magneto Optical Disk: Size/Storage Specifications: 5.25 inch, 640 Mb.

(d) Computer readable forms that are submitted to the Office will not be returned to the applicant.

89. Section 1.825 is amended by revising paragraphs (a) and (b) to read as follows:

§ 1.825 Amendments to or replacement of sequence listing and computer readable copy thereof.

(a) Any amendment to a paper copy of the "Sequence Listing" (§ 1.821(c)) must be made by the submission of substitute sheets and include a statement that the substitute sheets include no new matter. Any amendment to a compact disc copy of the "Sequence Listing" (§ 1.821(c)) must be made by the submission of a replacement compact disc (2 copies) in compliance with § 1.52(e). Amendments must also be accompanied by a statement that indicates support for the amendment in the application, as filed, and a statement that the replacement compact disc includes no new matter.

(b) Any amendment to the paper or compact disc copy of the "Sequence Listing," in accordance with paragraph (a) of this section, must be accompanied by a substitute copy of the computer readable form (§ 1.821(e)) including all previously submitted data with the amendment incorporated therein, accompanied by a statement that the copy in computer readable form is the same as the substitute copy of the "Sequence Listing."

* * * * *

PART 3—ASSIGNMENT, RECORDING AND RIGHTS OF ASSIGNEE

90. The authority citation for 37 CFR Part 3 is revised to read as follows:

Authority: 15 U.S.C. 1123; 35 U.S.C. 2(b)(2).

91. Section 3.27 is revised to read as follows:

§ 3.27 Mailing address for submitting documents to be recorded.

Documents and cover sheets to be recorded should be addressed to the Commissioner, United States Patent and Trademark Office, Box Assignment, Washington, D.C. 20231, unless they are filed together with new applications or with a request under § 3.81.

92. Section 3.71 is revised to read as follows:

§ 3.71 Prosecution by assignee.

(a) *Patents—conducting of prosecution.* One or more assignees as defined in paragraph (b) of this section may, after becoming of record pursuant to paragraph (c) of this section, conduct prosecution of a national patent application or a reexamination proceeding to the exclusion of either the inventive entity, or the assignee(s) previously entitled to conduct prosecution.

(b) *Patents—Assignee(s) who can prosecute.* The assignee(s) who may conduct either the prosecution of a national application for patent or a reexamination proceeding are:

(1) *A single assignee.* An assignee of the entire right, title and interest in the application or patent being reexamined who is of record, or

(2) *Partial assignee(s) together or with inventor(s).* All partial assignees, or all partial assignees and inventors who have not assigned their right, title and interest in the application or patent being reexamined, who together own the entire right, title and interest in the application or patent being reexamined. A partial assignee is any assignee of record having less than the entire right, title and interest in the application or patent being reexamined.

(c) *Patents—Becoming of record.* An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.

(d) *Trademarks.* The assignee of a trademark application or registration may prosecute a trademark application, submit documents to maintain a trademark registration, or file papers against a third party in reliance on the assignee's trademark application or registration, to the exclusion of the original applicant or previous assignee. The assignee must establish ownership in compliance with § 3.73(b).

93. Section 3.73 is revised to read as follows:

§ 3.73 Establishing right of assignee to take action.

(a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment.

(b)(1) In order to request or take action in a patent or trademark matter, the

assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Commissioner. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment). The documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, *e.g.*, an officer of the assignee.

(c) For patent matters only:

(1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.

(2) If the submission under this section is by an assignee of less than the entire right, title and interest, such assignee must indicate the extent (by percentage) of its ownership interest, or the Office may refuse to accept the submission as an establishment of ownership.

94. Section 3.81 is revised to read as follows:

§ 3.81 Issue of patent to assignee.

(a) *With payment of the issue fee:* An application may issue in the name(s) of the assignee(s) consistent with the application's assignment where a request for such issuance is submitted with payment of the issue fee, provided the assignment has been previously recorded in the Office. If the assignment has not been previously recorded, the request should be accompanied by the assignment and either a direction to record the assignment in the Office

pursuant to § 3.28, or a statement under § 3.73(b).

(b) *After payment of the issue fee:* An application may issue in the name(s) of the assignee(s) consistent with the application's assignment where a request for such issuance along with the processing fee set forth in § 1.17(i) of this chapter is submitted after the date of payment of the issue fee, but prior to issuance of the patent, provided the assignment has been previously recorded in the Office. If the assignment has not been previously recorded, the request should be accompanied by the assignment and either a direction to record the assignment in the Office pursuant to § 3.28, or a statement under § 3.73(b).

(c) *Partial assignees.* (1) If one or more assignee(s) together with one or more inventor(s) hold the entire right, title, and interest in the application, the patent may issue in the names of the assignee(s) and the inventor(s).

(2) If multiple assignees hold the entire right, title, and interest to the exclusion of all the inventors, the patent may issue in the names of the multiple assignees.

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

95. 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.*; and the Nuclear Non Proliferation Act of 1978, 22 U.S.C. 3201 *et seq.*; and the delegations in the regulations under these Acts to the Commissioner (15 CFR 370.10(j), 22 CFR 125.04, and 10 CFR 810.7).

96. Section 5.1 is revised to read as follows:

§ 5.1 Applications and correspondence involving national security.

(a) All correspondence in connection with this part, including petitions, should be addressed to “Commissioner for Patents (Attention Licensing and Review), Washington, D.C. 20231.”

(b) Application as used in this part includes provisional applications filed under 35 U.S.C. 111(b) (§ 1.9(a)(2) of this chapter), nonprovisional applications filed under 35 U.S.C. 111(a) or entering the national stage from an international application after compliance with 35 U.S.C. 371 (§ 1.9(a)(3)), or international applications filed under the Patent

Cooperation Treaty prior to entering the national stage of processing (§ 1.9(b)).

(c) Patent applications and documents relating thereto that are national security classified (see § 1.9(i) of this chapter) and contain authorized national security markings (e.g., "Confidential," "Secret" or "Top Secret") are accepted by the Office. National security classified documents filed in the Office must be either hand-carried to Licensing and Review or mailed to the Office in compliance with paragraph (a) of this section.

(d) The applicant in a national security classified patent application must obtain a secrecy order pursuant to § 5.2(a). If a national security classified patent application is filed without a notification pursuant to § 5.2(a), the Office will set a time period within which either the application must be declassified, or the application must be placed under a secrecy order pursuant to § 5.2(a), or the applicant must submit evidence of a good faith effort to obtain a secrecy order pursuant to § 5.2(a) from the relevant department or agency in order to prevent abandonment of the application. If evidence of a good faith effort to obtain a secrecy order pursuant to § 5.2(a) from the relevant department or agency is submitted by the applicant within the time period set by the Office, but the application has not been declassified or placed under a secrecy order pursuant to § 5.2(a), the Office will again set a time period within which either the application must be declassified, or the application must be placed under a secrecy order pursuant to § 5.2(a), or the applicant must submit evidence of a good faith effort to again obtain a secrecy order pursuant to

§ 5.2(a) from the relevant department or agency in order to prevent abandonment of the application.

(e) A national security classified patent application will not be allowed pursuant to § 1.311 of this chapter until the application is declassified and any secrecy order pursuant to § 5.2(a) has been rescinded.

(f) Applications on inventions made outside the United States and on inventions in which a U.S. Government defense agency has a property interest will not be made available to defense agencies.

97. Section 5.2 is amended by adding a new paragraph (c) to read as follows:

§ 5.2 Secrecy order.

* * * * *

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

98. Section 5.12 is amended by revising paragraph (b) to read as follows:

§ 5.12 Petition for license.

* * * * *

(b) A petition for license must include the fee set forth in § 1.17(h) of this chapter, the petitioner's address, and full instructions for delivery of the requested license when it is to be delivered to other than the petitioner. The petition should be presented in letter form.

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PART 10—REPRESENTATION OF OTHERS BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE

99. The authority citation for 37 CFR Part 10 is revised to read as follows:

Authority: 5 U.S.C. 500, 15 U.S.C. 1123; 35 U.S.C. 2(b)(2), 31, 32, 41.

100. Section 10.23 is amended by revising paragraph (c)(11) to read as follows:

§ 10.23 Misconduct.

* * * * *

(c) * * *

(11) Except as permitted by § 1.52(c) of this chapter, knowingly filing or causing to be filed an application containing any material alteration made in the application papers after the signing of the accompanying oath or declaration without identifying the alteration at the time of filing the application papers.

* * * * *

Dated: August 9, 2000.

Q. Todd Dickinson,

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

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