

of those” is corrected to read “May 24, 2005. The text of those”.

Cynthia E. Grigsby,

Acting Chief, Publications and Regulations Branch, Legal Processing Division, Associate Chief Counsel, (Procedure and Administration).

[FR Doc. 05-12138 Filed 6-20-05; 8:45 am]

BILLING CODE 4830-01-P

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

37 CFR Part 1

[Docket No.: 2004-P-038]

RIN 0651-AB79

Changes To Implement the Patent Search Fee Refund Provisions of the Consolidated Appropriations Act, 2005

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice of proposed rule making.

SUMMARY: Among other changes to patent and trademark fees, the Consolidated Appropriations Act, 2005 (Consolidated Appropriations Act), splits the patent application filing fee into a separate filing fee, search fee and examination fee. The Consolidated Appropriations Act also provides that the United States Patent and Trademark Office (Office) may refund part or all of the excess claim fee and the search fee in certain situations. This notice proposes changes to the rules of practice to implement the provisions for refunding the search fee for applicants who file a written declaration of express abandonment before an examination has been made of the application.

COMMENT DEADLINE DATE: To be ensured of consideration, written comments must be received on or before August 22, 2005. No public hearing will be held.

ADDRESSES: Comments should be sent by electronic mail message over the Internet addressed to AB79.Comments@uspto.gov. Comments may also be submitted by mail addressed to: Mail Stop Comments—Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, or by facsimile to (571) 273-7735, marked to the attention of Robert W. Bahr. Although comments may be submitted by mail or facsimile, the Office prefers to receive comments via the Internet. If comments are submitted by mail, the Office prefers that the comments be submitted on a DOS

formatted 3½ inch disk accompanied by a paper copy.

Comments may also be sent by electronic mail message over the Internet via the Federal eRulemaking Portal. See the Federal eRulemaking Portal Web site (<http://www.regulations.gov>) for additional instructions on providing comments via the Federal eRulemaking Portal.

The comments will be available for public inspection at the Office of the Commissioner for Patents, located in Madison East, Tenth Floor, 600 Dulany Street, Alexandria, Virginia, and will be available via the Office Internet Web site (address: <http://www.uspto.gov>). Because comments will be made available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included in the comments.

FOR FURTHER INFORMATION CONTACT:

Robert W. Bahr, Senior Patent Attorney, Office of the Deputy Commissioner for Patent Examination Policy, by telephone at (571) 272-8800, by mail addressed to: Mail Stop Comments—Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, or by facsimile to (571) 273-7735, marked to the attention of Robert W. Bahr.

SUPPLEMENTARY INFORMATION: Among other changes, the Consolidated Appropriations Act (section 801 of Division B) provides that 35 U.S.C. 41(a), (b), and (d) shall be administered in a manner that revises patent application fees (35 U.S.C. 41(a)) and patent maintenance fees (35 U.S.C. 41(b)), and provides for a separate filing fee (35 U.S.C. 41(a)), search fee (35 U.S.C. 41(d)(1)), and examination fee (35 U.S.C. 41(a)(3)) during fiscal years 2005 and 2006. The Consolidated Appropriations Act also provides that the Office may, by regulation, provide for a refund of: (1) Any part of the excess claim fee specified in 35 U.S.C. 41(a)(2) for any claim that is canceled before an examination on the merits has been made of the application under 35 U.S.C. 131; (2) any part of the search fee for any applicant who files a written declaration of express abandonment as prescribed by the Office before an examination has been made of the application under 35 U.S.C. 131; and (3) any part of the search fee for any applicant who provides a search report that meets the conditions prescribed by the Office. The Office is proposing to revise the rules of practice to implement the provisions for a refund of the search fee for any applicant who files a written declaration of express abandonment as prescribed by the Office before an

examination has been made of the application under 35 U.S.C. 131.

Discussion of Specific Rules

Title 37 of the Code of Federal Regulations, Part 1, is proposed to be amended as follows:

Section 1.138: Section 1.138(c) is amended to change “section” (*i.e.*, § 1.138) to “paragraph” (*i.e.*, § 1.138(c)) to clarify that a petition to expressly abandon an application to avoid publication of an application is filed under § 1.138(c) (rather than § 1.138).

Section 1.138 is also amended to include a new paragraph (d), which implements the provision in 35 U.S.C. 41(d)(1)(D) that the Office may provide for a refund of any part of the search fee “for any applicant who files a written declaration of express abandonment as prescribed by the Director before an examination has been made of the application under [35 U.S.C.] 131.” Section 1.138(d) specifically provides that an applicant seeking to abandon an application filed under 35 U.S.C. 111(a) and § 1.53(b) on or after December 8, 2004, to obtain a refund of any search fee paid in the application must submit a petition and declaration of express abandonment in sufficient time to permit the appropriate officials to recognize the abandonment before the application has been taken up for examination.

The Office will consider an application to be “taken up for examination” for purposes of 35 U.S.C. 41(d)(1)(D) and § 1.138(d) when the application is placed on the examiner’s docket for action. Since the patent fee provisions of the Consolidated Appropriations Act expire (in the absence of subsequent legislation) on September 30, 2006 (at the end of fiscal year 2006), the patent fee structure provided for in the Consolidated Appropriations Act will be in effect for less than two years (in the absence of subsequent legislation). Thus, the information technology investment necessary to permit an application to be considered “taken up for examination” at some later point in time (*e.g.*, based upon the anticipated time to first action in the class/subclass to which the application is assigned) for purposes of 35 U.S.C. 41(d)(1)(D) and § 1.138(d) is not warranted in the absence of the enactment of legislation which makes the patent fee structure provided for in the Consolidated Appropriations Act permanent.

A petition under § 1.138(d) will be granted when it is recognized in sufficient time to process the abandonment before the application has been taken up for examination and will

be denied when it is not recognized in sufficient time to process the abandonment before the application has been taken up for examination. This will avert the situation in which an applicant files a declaration of express abandonment to obtain a refund of the search fee, the request for a refund of the search fee is not granted because the declaration of express abandonment is not processed before the application has been taken up for examination, the applicant then wishes to rescind the declaration of express abandonment upon learning that the declaration of express abandonment was not processed before the application was taken up for examination, and the Office cannot revive the application (once the declaration of express abandonment is recognized) because the application was expressly and intentionally abandoned by the applicant.

The Patent Application Locating and Monitoring (PALM) system maintains computerized contents records of all patent applications and reexaminations. An application has been placed on the examiner's docket for action (*i.e.*, "taken up for examination" for purposes of § 1.138(d)) once the status of the application is "Case Docketed to Examiner in GAU" (has a status code of 030 or higher) as shown in PALM.

The Patent Application Information Retrieval (PAIR) system is a system that provides public access to PALM for patents and applications that have been published. The PAIR system does not provide public access to information concerning applications that are maintained in confidence under 35 U.S.C. 122(a). The private side of PAIR, however, can be used by an applicant to access confidential information about his or her pending application. To access the private side of PAIR, a customer number must be associated with the correspondence address for the application, and the user of the system must have a digital certificate. For further information, contact the Customer Support Center of the Electronic Business Center at (703) 305-3028 or toll free at (866) 217-9197.

Section 1.138(d) also provides that if a request for refund of any search fee paid in the application is not filed with the declaration of express abandonment under § 1.138(d) or within two months (not extendable) from the date on which the declaration of express abandonment under § 1.138(d) was filed, the Office may retain the entire search fee paid in the application. Finally, § 1.138(d) provides that if a declaration of express abandonment under § 1.138(d) is not filed in sufficient time to process the abandonment before the application has

been taken up for examination, the Office will not refund any part of the search fee paid in the application except as provided in § 1.26.

Rule Making Considerations

Regulatory Flexibility Act: For the reasons set forth herein, the Deputy General Counsel for General Law of the United States Patent and Trademark Office has certified to the Chief Counsel for Advocacy of the Small Business Administration that changes proposed in this notice will not have a significant economic impact on a substantial number of small entities. *See* 5 U.S.C. 605(b). This notice proposes changes to the rules of practice to implement the provisions for a refund of the search fee for any applicant who files a written declaration of express abandonment as prescribed by the Office before an examination has been made of the application under 35 U.S.C. 131. The changes proposed in this notice would not impose any additional fees or requirements on any patent applicant. Rather, the changes proposed in this notice would only provide for a refund of search fees for patent applicants (small or non-small entity) in certain situations.

Executive Order 13132: This rule making does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

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

Paperwork Reduction Act: This notice involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*). The changes proposed in this notice concern the procedures for refunding the search fee for any applicant who files a written declaration of express abandonment before an examination has been made of the application under 35 U.S.C. 131. The collections of information involved in this notice have been reviewed and previously approved by OMB under the following OMB control numbers: 0651-0031 and 0651-0032. The United States Patent and Trademark Office is resubmitting the information collections package to OMB for its review and approval because the changes in this notice do affect the information collection requirements associated with the information collection under these OMB control numbers.

The title, description and respondent description of the information collections under OMB control numbers 0651-0031 and 0651-0032 are shown below with estimates of the annual reporting burdens. Included in the estimates is the time for reviewing instructions, gathering and maintaining the data needed, and completing and reviewing the collection of information.

OMB Number: 0651-0031.

Title: Patent Processing (Updating).

Form Numbers: PTO/SB/08A, PTO/SB/08B, PTO/SB/17i, PTO/SB/17p, PTO/SB/21-27, PTO/SB/30-37, PTO/SB/42-43, PTO/SB/61-64, PTO/SB/64a, PTO/SB/67-68, PTO/SB/91-92, PTO/SB/96-97, PTO-2053-A/B, PTO-2054-A/B, PTO-2055-A/B, PTOL-413A.

Type of Review: Approved through July of 2006.

Affected Public: Individuals or households, business or other for-profit institutions, not-for-profit institutions, farms, Federal government and State, local and tribal governments.

Estimated Number of Respondents: 2,284,439.

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

Estimated Total Annual Burden Hours: 2,732,441 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 United States Patent and Trademark Office concerning the examination of a specific application. The specific information required or which may be submitted includes: Information Disclosures and citation, requests for extensions of time, the establishment of small entity status, abandonment and revival of abandoned applications, disclaimers, appeals, expedited examination of design applications, transmittal forms, requests to inspect, copy and access patent applications, publication requests, and certificates of mailing, transmittals, and submission of priority documents and amendments.

OMB Number: 0651-0032.

Title: Initial Patent Application.

Form Number: PTO/SB/01-07, PTO/SB/13PCT, PTO/SB/16-19, PTO/SB/29 and 29A, PTO/SB/101-110, Electronic New Utility and Provisional Application Forms.

Type of Review: Approved through July of 2006.

Affected Public: Individuals or households, Business or Other For-Profit Institutions, Not-for-Profit Institutions, Farms, Federal government, and state, local, or tribal governments.

Estimated Number of Respondents: 454,287.

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

Estimated Total Annual Burden Hours: 4,171,568 hours.

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

Interested persons are requested to send comments regarding these information collections, including suggestions for reducing this burden, to Robert J. Spar, Director, Office of Patent Legal Administration, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or to the Office of Information and Regulatory Affairs, Office of Management and Budget, New Executive Office Building, Room 10235, 725 17th Street, NW., Washington, DC 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 in 37 CFR Part 1

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

For the reasons set forth in the preamble, 37 CFR Part 1 is proposed to be amended as follows:

PART 1—RULES OF PRACTICE IN PATENT CASES

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

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

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

§ 1.138 Express abandonment.

* * * * *

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

(d) An applicant seeking to abandon an application filed under 35 U.S.C. 111(a) and § 1.53(b) on or after December 8, 2004, to obtain a refund of any search fee paid in the application must submit a declaration of express abandonment by way of a petition under this paragraph in sufficient time to permit the appropriate officials to recognize the abandonment before the application has been taken up for examination. If a request for refund of any search fee paid in the application is not filed with the declaration of express abandonment under this paragraph or within two months from the date on which the declaration of express abandonment under this paragraph was filed, the Office may retain the entire search fee paid in the application. This two-month period is not extendable. If a petition and declaration of express abandonment under this paragraph are not filed and granted before the application has been taken up for examination, the Office will not refund any part of the search fee paid in the application except as provided in § 1.26.

Dated: June 15, 2005.

Jon W. Dudas,

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

[FR Doc. 05-12198 Filed 6-20-05; 8:45 am]

BILLING CODE 3510-16-P

DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Part 1

[Docket No.: 2005-P-062]

RIN 0651-AB91

Acceptance, Processing, Use and Dissemination of Chemical and Three-Dimensional Biological Structural Data in Electronic Format

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Advance notice of proposed rule making.

SUMMARY: This advance notice of proposed rule making is to inform the public that the United States Patent and Trademark Office (USPTO) is considering amending its rules of practice to require submission of chemical and three-dimensional (3-D) biological structural data in electronic format. The USPTO anticipates that requiring submission of chemical and 3-D biological structural data in electronic format in patent applications will improve the processing and examination of patent applications that include such data, as well as the dissemination of such data to searchable public databases. The purpose of this notice is to encourage comments on this topic, in the form of responses to the questions posed in this notice, from industry, academia, the patent bars, and members of the public.

Comment Deadline Date: To be ensured of consideration, written comments must be received on or before August 22, 2005. No public hearing will be held.

ADDRESSES: Comments should be sent by electronic mail message over the Internet addressed to *AB91.Comments@uspto.gov*. Comments may also be submitted by mail addressed to: Mail Stop Comments—Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, or by facsimile to (571) 273-3373, marked to the attention of Lisa J. Hobbs, Ph.D., Search Systems Project Manager, Search and Information Resources Administration, Office of the Deputy Commissioner for Patent Resources and Planning. Although comments may be submitted by mail or facsimile, the Office prefers to receive comments via the Internet. If comments are submitted by mail, the Office prefers that the comments be submitted on a DOS formatted 3½ inch disk accompanied by a paper copy.