

Changes to Patent Practice and Procedure - Final Rule

62 Fed. Reg. 53131 (October 10, 1997);
1203 Off. Gaz. Pat. Office 63 (October 21, 1997)

Detailed - Subject Matter Summary III

The final rule entitled "Changes to Patent Practice and Procedure" would adopt changes to the rules of patent practice and procedure to: (1) implement the Administration's program of reducing the regulatory burden on the American public; (2) make the rules of patent practice and procedure easier to comprehend for applicants and for Office personnel; (3) speed up processing of applications to decrease loss of patent term; and (4) reduce Office resources needed to process a patent application.

The following is a summary of the more significant changes grouped by subject matter rather than by numerical rule order:

I. Filing of Applications

The three rules under which an application can be filed, §§ 1.53, 1.60 and 1.62, have been consolidated into one rule, amended § 1.53. The new rule retains the benefits of the deleted rules, §§ 1.60 and 1.62, and eliminates problems caused by the deleted rules.

A) Elimination of Rules 60 and 62(FWC's)

Prior rules 60 and 62 have been deleted. All applications, including original, continuations, divisionals, continuations-in-part and a newly created class of continued prosecution applications (CPA's), are now to be filed under one rule, § 1.53.

The benefits from deleting §§ 1.60 and 1.62 are:

- Applicants need not have detailed knowledge of several rules for filing applications. When in doubt, or in a rush, applicants can merely cite to § 1.53 and the Office will process the application based on the actual papers submitted,
- § 1.53 has flexibility to provide remedies for imperfectly submitted applications:
 - if a specification is submitted with a request for a CPA, see § 1.53(d)(5),
 - if a submitted application references deleted § 1.60, the Office will ignore the reference and process it as an application with a copy of an executed oath or declaration from a prior application under

- § 1.53(b) and 1.63(d)(iv), if a submitted application is a continuation or divisional citing deleted § 1.62, the Office will treat the application as a CPA so long as the immediate prior application was filed on or after June 8, 1995; if not, the Office will handle it as a filing under § 1.53(b),
- common filing date problems and consequent delays are avoided, e.g.,:
 - former § 1.60 required a "true copy of prior application as filed," which was difficult to meet when one tried to generate a true copy years after the prior application was filed, e.g., as to extraneous markings whited out, and differences in pagination, and
 - former § 1.62 continuation applications were improperly filed with a specification.

The advantages of deleted rules 60 and 62 have been retained in amended § 1.53, but without their true copy and no specification requirements that frequently led to filing date problems:

- filing of a continuation or divisional application using a copy of the oath or declaration from the prior application is still permitted, §§ 1.53(b) and 1.63(d)(iv), and
- the ability to delete one or more inventors by a simple statement requesting deletion, such as when filing a divisional application, is still permitted, §§ 1.53(b)(1) and (d)(4).

One advantage of former § 1.62 that was not retained was the ability to file a CIP without a new specification. It is not possible to file a CIP-CPA application. However, the need to generate another copy of the specification by photocopying or by computer is not a great burden when balanced against the advantage of increased processing speed for CPAs made possible by the prohibition of new matter filings.

B) Filing of applications under new § 1.53(b)

All the types of applications that could be filed under the former rules for filing applications (§§ 1.53, 1.60 and 1.62) can all be filed under amended § 1.53, with the one exception of § 1.62 CIPs:

- continuation, divisional and continuation-in-part applications that are filed

with a new specification and a § 1.63 oath or declaration continue to be filed under § 1.53, § 1.53(b),

- provisional applications previously filed under § 1.53(b)(2) are now to be filed under § 1.53(c),
- continuation and divisional applications that are filed with a specification that contains no new matter and with a copy of an executed oath or declaration from a prior application (§ 1.63(d)(1)(iv)) are to now be filed under § 1.53(b) rather than under former § 1.60 (and should contain a sentence specifically incorporating the prior application by reference to guard against filing a specification copy that is missing a page), and
- the exception is continuation-in-part applications previously permitted under former § 1.62, with a new § 1.63 oath or declaration and only a preliminary amendment for the newly added subject matter, must now be filed under § 1.53(b), which requires that an entire specification rather than an amendment to a previous specification (and a new § 1.63 oath or declaration) be submitted.

C) Continued Prosecution Applications (CPA)

Newly created CPA applications, § 1.53(d), replace continuation and divisional applications under former § 1.62. A new specification and oath or declaration are not needed for a CPA.

Not permitted under CPA practice are:

- CIP applications, and
- applications that claim a priority benefit under 35 U.S.C. 120 where the immediate prior application was filed before June 8, 1995 (where there is an immediate prior application that was filed on or after June 8, 1995, then an earlier application in the chain can be one that was filed before June 8, 1995).

Attributes:

- CPA filings will be completely processed by the Group (the Office of Initial Patent Examination will not be involved with the processing of a CPA)
- a request for a CPA can be faxed directly to a Group, but the filing

date will be the date of receipt not the date of transmission should the two differ,

- a CPA will utilize the following materials from the prior application:
 - the same file jacket,
 - the same application number and the same filing date
 - the actual filing date of the CPA will be indicated on the file jacket by a Contents entry for the Request for filing, and
 - a patent issuing from a CPA will only indicate the application number and filing date of the prior parent application,
- a CPA can name the same or fewer than all the inventors named in the prior application,
- the prior application must be complete as defined by § 1.51(b), including an oath or declaration and filing fee,
- the CPA is a request to expressly abandon the prior application, but the abandoned status of the prior application will operate to make the file open to public inspection, 37 CFR 1.14(a)(3)(iv),
- must be timely filed,
- a specific reference to a prior application need not and should not be added to the first line of the specification of the CPA as the request for CPA filing is considered as the specific reference required by 35 U.S.C. 120,
- papers that carryover to the CPA from the prior application: Information Disclosure Statements, Terminal Disclaimers, affidavits under §§ 1.130, 1.131 and 1.132, § 3.73(b) certifications, unacted upon § 1.48 petitions where correction is still required, U.S. and foreign priority claims, general authorizations to charge a deposit account, and an election where the CPA is a continuation unless otherwise indicated, and
- papers that do not carryover to the CPA from the prior application: small entity status requests, and an election where the CPA is a division.

The creation of the CPA will also facilitate a virtually seamless transition to the

procedures for requesting further examination of an application, upon payment of a fee, set forth in pending legislation.

D) Oath or declaration

Paragraph (a)(3) of § 1.63 now requires that the post office address appear in the oath or declaration rather than elsewhere (§ 1.33), and that the oath or declaration contain the full name(s) of the inventor(s), a requirement which has been transferred from § 1.41(a).

Paragraph (d)(1)(iv) of § 1.63 permits the use of a copy of the executed oath or declaration from a prior application in a continuation or divisional application filed under § 1.53(b) that names the same as or fewer than all of the inventors named in the prior application. The copy must either show the signature or have some indication that it was signed.

Paragraph (d)(4) of § 1.63 provides where the power of attorney or correspondence address was changed in a prior application from that on the executed oath or declaration, the change must be identified in a continuation or divisional application.

E) Inventorship

The naming of the inventors is no longer required to obtain a filing date for an application as a result of amendments to §§ 1.41 and 1.53. The inventor's name was used to identify an application prior to issuance of a filing receipt (along with the Application No.) under the former rules. Thus, if an application is now filed under the amended rules without any identification of the inventors, an alphanumeric identifier should be supplied, § 1.41(a)(3), so that papers, e.g., information disclosure statements, submitted prior to issuance of the filing receipt can be matched with the file. The Office recommends that the inventors' names continue to be used as the application identifier.

For applications filed without an oath or declaration, the filing of an executed oath or declaration under § 1.63, will serve to set forth or correct the application's inventorship. 37 CFR 1.48(f). Thus, a whole class of § 1.48(a) petitions will be eliminated. Under the old rules, a petition was required if the later submitted executed oath or declaration identified a different inventive entity from the inventive entity originally set forth in the unexecuted application. New § 1.48(f) is not a petition remedy that must be requested; rather, it operates to automatically establish the inventorship.

II. Deceptive Intent Issues

The generation of partial facts simply to generate an incomplete record for later review by others is not seen as adequate justification for the effort to which applicants have been required to undergo. Thus, the burden on applicants is further reduced with respect to inquiries which bear

on deceptive intent issues.

A) Verification of statements

Under the old rules, statements of facts presented by practitioners were not required to be verified, e.g., § 1.68, due to the operation of Part 10 of the rules. However, all other persons were required to make an explicit verification with each statement presented. This has been changed so that the rules for both are now the same - that statements of facts need not be verified. Rules 1.4 and 10.18 have been amended to provide that any person (practitioner or *pro se*) presenting correspondence to the Office now makes the certifications previously made under 18 U.S.C. 1001 found in § 1.68, and additionally makes the certifications of Rule 11 of the Federal Rules of Civil Procedure. This allows the Office to eliminate separate verification requirements in §§ 1.6, 1.8, 1.10, 1.27, 1.28, 1.48, 1.52, 1.55, 1.69, 1.102, 1.125, 1.137, 1.377, 1.378, 1.804, 1.805, 3.26, and 5.4.

B) Reissue applications

The following changes have been made to § 1.175:

- (1) The requirement that the reissue oath particularly and distinctly specify all errors being corrected has been eliminated. Under the amended rule, the reissue oath need only:
 - identify at least one error in the original patent as the basis for reissue. § 1.175(a)(1).
- (2) The requirement that the reissue oath make a detailed showing of the facts describing how each error arose or occurred has been eliminated. Under the amended rule, the reissue oath requires only:
 - a general statement that the errors arose without deceptive intent. § 1.175(a)(2).
- (3) The requirement that a supplemental oath specifically identify all subsequent errors being corrected with every amendment has been eliminated. Under the amended rule:
 - a supplemental oath can now be filed prior to allowance that generally states that all errors being corrected, which were not covered by the original or a previously submitted oath, arose without deceptive intent. § 1.175(b)(1).

C) Petitions to correct inventorship

Detail9.wpd

37 CFR 1.48 (in applications) has been amended to exclude reissue applications, and to reduce the requirements for petitions under paragraphs (a)-(c):

- The following changes were made to § 1.48(a):
 - The diligence requirement was deleted,
 - The requirement that the petition include a factual showing of lack of deceptive intent has been deleted under the amended rule, a general statement as to a lack of deceptive intent is sufficient.
 - A verified statement is no longer required from each original named inventor. A non-verified statement from the inventor(s) to be deleted or added is now sufficient.
- The following change was made to § 1.48(b):
 - The diligence requirement was deleted.
- The following changes were made to § 1.48(c):
 - The diligence requirement was deleted.
 - The requirement that § 1.48(a) be followed has been deleted.
 - A verified statement is no longer required from each original named inventor. A non-verified statement from the person being added is now sufficient. This statement must:
 - recognize that the correction is being made in view of the claim amendment, and
 - state that the error occurred without deceptive intent on the part of the person being added.

37 CFR 1.324 (in patents) has also been amended to replace a nebulous "satisfactory proof of facts" standard with explicit simpler requirements:

- The diligence requirement was deleted.
- The requirement that the petition include a factual showing of a lack of deceptive intent has been replaced by a requirement for a general statement as to a lack of deceptive intent.

- The requirement of a verified statement of lack of deceptive intent from each of the original named inventors has been replaced with a requirement for:
 - a non-verified statement as to a lack of deceptive intent from each person being added or deleted, § 1.324(b)(1),
 - a non-verified statement from the current inventors not submitting a statement under paragraph (b)(1) of § 1.324 either agreeing to the requested change or stating that they have no disagreement with the requested change, § 1.324(b)(2).
- The former practice of requiring an executed oath or declaration under § 1.63 by the new inventive entity has been discontinued.

D) Small entity status

Section 1.28(a) provides that a new small entity statement is not required for a continuing application (including a CPA) or a reissue application.

Section 1.28(a) also provides that payment of the small entity basic filing fee in a continuing application (including a CPA) or in a reissue application will substitute for the required reference to the small entity statement in the prior application or in the patent being reissued.

Section 1.28(a) also clarifies that the filing of a continuing application (including a CPA) or a reissue application requires a new determination by applicant of entitlement to status.

Section 1.28(c) is amended to provide that an explanation for an erroneous payment of a small entity fee is no longer required; and that payment of a fee deficiency, *per se*, is deemed to constitute a representation that prior small entity status was requested in good faith.

E) Actions by assignee

Revised § 3.73(b) deletes the requirements that an assignee specifically state that the evidentiary documents have been reviewed, and certify that title is in the assignee seeking to take action.

Section 3.73(b) was also amended to provide for partial assignees submitting evidence of ownership (as partial assignees can act when they all join) by replacing the language "assignee of the entire right, title and interest" with "assignee."

III. Appeals

The appeal process has been modified so as to prevent extraneous matters, such as whether an examiner's answer with a new ground of rejection or entry of a reply brief are appropriate, from delaying a decision on the merits of the appeal, and to provide appellant with a more direct means for understanding a rejection by the BPAI of formerly allowed claims.

A) Notice of Appeal

Section 1.191(b) has deleted the former requirements that the appeal identify the rejected claim or claims appealed and that the appeal be signed.

B) Examiner's Answers

Section 1.193(a)(2) prohibits the inclusion of a new ground of rejection in an examiner's answer; the examiner must reopen prosecution to add a new ground of rejection. However, if an amendment under § 1.116 is approved for entry for appeal purposes and appellant was advised which rejection(s) set forth in the action appealed from would be used to reject the claims as amended, then appellant has given consent that the appeal proceed on the claims as amended under § 1.116 subject to one or more individual rejections set forth in the appealed action. Accordingly, the Brief must address the different rejection(s) as appellant was advised of, and the Examiner's Answer may include the different rejection(s).

C) Reply Briefs

Section 1.193(b)(1) provides appellant with the right to file a reply brief, if timely, regardless of whether the examiner's answer raises new points of argument. This gives the appellant the right to make the last submission prior to review by the BPAI. The examiner must enter the reply brief and either acknowledge its receipt and entry, or reopen prosecution to respond to new issues raised in the reply brief. While the examiner can reopen prosecution based on the latest submission from appellant, appellant must ultimately be given the right of a last submission.

Section 1.193(b)(2) provides that a supplemental brief, when accompanied by a request that the appeal be reinstated, is an appropriate response to an Office action reopening prosecution subsequent to the filing of an appeal brief, supplemental brief, or a reply brief.

D) Oral Hearings

Section 1.194(c) provides that appellant will be notified when a requested oral hearing is

unnecessary, such as when the application is to be remanded.

E) Rejection of allowed claims

Section 1.196(b) provides authority for the BPAI to enter a rejection of any pending claim, which now includes allowed claims that have not been appealed, in place of the former requirement for a binding recommendation to the examiner.

IV. Time Frames

Various time frames have been adjusted to provide increased flexibility for applicants.

A) Abandoned applications or lapsed patents

Section 1.137 has been amended to combine subject matter from § 1.139 (responses to requirements in provisional applications), § 1.155 (issue fees in design applications), § 1.316 (issue fees in utility or plant applications), and § 1.317 (payment of outstanding balances of issue fees).

Section 1.137(a)(3) clarifies that the time period for unavoidable delay is from the due date of the reply that was not submitted to the date of filing a grantable petition under this paragraph.

Section 1.137(b) no longer contains the one year filing limitation for petitions to revive for unintentional delay. However, it is clarified that the rule continues to require that the entire delay, from the due date for the reply that has not been submitted until the filing date of a grantable petition, has been unintentional for the applicant to obtain revival based upon "unintentional" delay. Unintentional delay petitions will now be considered on a case by case basis based on the merits rather than being artificially limited to a one year period.

The one-year period has had the effect of misleading practitioners into believing that delay for a year is acceptable (which it is not).

Section 1.137(c) expands the current terminal disclaimer requirement, from only being applicable to petitions for unavoidable delay under paragraph (a) of this rule, to petitions for unintentional delay under paragraph (b) of this rule. Terminal disclaimers will be required for all design applications, and for all utility and plant applications filed prior to June 8, 1995. The former six month grace period before which a terminal disclaimer was required has been eliminated.

B) Extension of time

Section 1.136(a)(1) now provides for paid extensions of time of up to five months

(formerly limited to four months), subject to any maximum statutory period for response.

Section 1.136(a)(3) permits a general authorization to treat any future reply requiring an extension of time as incorporating a request therefor. Any request or petition for an extension of time will be treated as requesting the appropriate length of time notwithstanding an inadvertent reference in the petition to a shorter period of time. Papers will be liberally interpreted as petitions for extensions of time. The mere submission of an extension of time fee will be interpreted as a constructive petition for an extension of time.

Section 1.136(a)(3) also treats a general authorization to charge all required fees or fees under § 1.17 as a constructive petition for an extension of time for a concurrent or future reply requiring an extension of time.

C) Incomplete replies

The one month time limit (or grace period) practice set forth in former § 1.135(c), for permitting the completion of a bona fide but incomplete reply, is eliminated. The time limit practice was a source of confusion both in the PTO and with its customers. Instead, amended § 1.135(c) provides that an action identifying the omissions and setting a new time period for reply will be mailed. Providing a new time period would permit extensions of such period under § 1.136(a) and clarify the date of abandonment in the event of a failure to reply. Rule 1.135(c) only applies to replies to non-final actions.

D) Filing of protests by the public

Section 1.291(c) eliminates the blanket prohibition of one protest per protester and allows for entry of additional prior art submissions. The change does not alter the need to submit the protest as soon as possible.

V. Miscellaneous

A) Amendments

The manner of making amendments in reissue applications, § 1.121(b), has been made consistent with the manner of making amendments in reexamination proceedings, § 1.530(d):

- provides for cancellation of an entire paragraph from the specification (without it being rewritten in brackets),
- hand-entry of five words or less is no longer permitted,

- each submission, which includes an amendment of the claims, must set forth the status, as of the date of the submission, of all patent claims and of all added claims, even those claims added but subsequently canceled, paragraph (b)(2)(ii), and
- each claim amendment, when originally submitted, must be accompanied by an explanation of the support in the disclosure of the patent for the amendment, paragraph (b)(2)(iii).

In reexamination proceedings, § 1.530 now provides for cancellation of an entire paragraph from the specification without it being rewritten in brackets.

B) Substitute specification

Paragraph (b) of § 1.125 now provides by rule a right to submit a substitute specification, in other than a reissue application, so long as the substitute specification is accompanied by a statement that new matter is not included and by a marked-up copy.

C) Design drawings

Paragraph (a)(2) of § 1.152 removes the blanket prohibition of color drawings and photographs in design applications. A petition procedure for their entry has been established in recognition of emerging new technologies.

Paragraph (b) of § 1.152 clarifies that all matter (color, indicia) in original informal drawings or photographs is an integral part of the disclosure and claim, and therefore cannot be removed without raising the issue of new matter, unless disclaimed in the original application papers as provided for in paragraph (b)(1).

D) Petitions to expunge

Petitions to expunge are now specifically provided for in Rule 1.59(b), and most may now be decided in the examining groups rather than in the Office of Petitions.

E) Access

A petition for access is no longer required to obtain a copy as filed of an application that has been incorporated by reference in a U.S. patent.