



Federal Register

**Tuesday,
September 21, 2004**

Part II

Department of Commerce

Patent and Trademark Office

**37 CFR Parts 1, 5, 10, 41, and 104
Changes To Support Implementation of
the United States Patent and Trademark
Office 21st Century Strategic Plan; Final
Rule**

DEPARTMENT OF COMMERCE**Patent and Trademark Office****37 CFR Parts 1, 5, 10, 41, and 104**

[Docket No.: 2003-P-020]

RIN 0651-AB64

Changes To Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan**AGENCY:** United States Patent and Trademark Office, Commerce.**ACTION:** Final rule.

SUMMARY: The United States Patent and Trademark Office (Office) has established a 21st Century Strategic Plan to transform the Office into a quality-focused, highly productive, responsive organization supporting a market-driven intellectual property system. The noteworthy changes in this final rule are: Providing for an alternative signature on a number of submissions; adjusting the fees for a number of patent-related petitions to reflect the actual cost of processing these petitions; codifying the current incorporation by reference practice and also providing the conditions under which a claim for priority or benefit of a prior-filed application would be considered an incorporation by reference of the prior-filed application; expanding the submissions that can be filed on a compact disc; eliminating the requirement for copies of U.S. patents or U.S. patent application publications cited in an information disclosure statement for all applications; providing that a request for information may contain interrogatories or requests for stipulations seeking technical factual information actually known by the applicant; providing that supplemental replies will no longer be entered as a matter of right; providing for the treatment of preliminary amendments present as of the filing date of an application as part of the original disclosure; and eliminating the requirement in a reissue application for the actual physical surrender by applicant of the original Letters Patent.

DATES: Effective October 21, 2004, except that: The changes to 37 CFR 1.4, 1.6, 1.10, 1.27, 1.57(a), 1.78, 1.84, 1.115, 1.137, 1.178, and 1.311, and new 37 CFR 1.57(a)(1) and (a)(2) are effective September 21, 2004; and the changes to 37 CFR 1.12, 1.14, 1.17, 1.19, 1.47, 1.53, 1.57(a)(3), 1.59, 1.84(a)(2), 1.103, 1.136, 1.182, 1.183, 1.291, 1.295, 1.296, 1.377, 1.378, 1.550, 1.741, 1.956, 5.12, 5.15,

5.25, and 41.20 are effective November 22, 2004.

FOR FURTHER INFORMATION CONTACT:

Hiram H. Bernstein, Senior Legal Advisor, by telephone at (703) 305-8713 or Robert J. Spar, Director, Office of Patent Legal Administration (OPLA), at (703) 308-5107, or by facsimile to (703) 305-1013, marked to the attention of Mr. Bernstein, or by mail addressed to: Mail Stop Comments—Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

SUPPLEMENTARY INFORMATION: The Office has conducted a “top to bottom” review of the patent application and examination process (among other processes) as part of the 21st Century Strategic Plan. The 21st Century Strategic Plan is available on the Office’s Internet Web site (www.uspto.gov). While many of the changes to the patent application and examination process necessary to support the 21st Century Strategic Plan require enabling legislation (and implementing rule changes), the Office has determined that a number of initiatives can be implemented under the Office’s current rulemaking and patent examination authority set forth in 35 U.S.C. 2(b)(2), 131, and 132. This final rule revises the rules of practice in title 37 of the Code of Federal Regulations (CFR) to improve the patent application and examination process by promoting quality enhancement, reducing patent pendency, and using information technology to simplify the patent application process.

This final rule specifically makes changes to the following sections of title 37 CFR: 1.4, 1.6, 1.8, 1.10, 1.12, 1.14, 1.17, 1.19, 1.27, 1.47, 1.52, 1.53, 1.57, 1.58, 1.59, 1.63, 1.69, 1.76, 1.78, 1.83, 1.84, 1.85, 1.91, 1.94, 1.98, 1.102, 1.103, 1.105, 1.111, 1.115, 1.121, 1.131, 1.136, 1.137, 1.165, 1.173, 1.175, 1.178, 1.179, 1.182, 1.183, 1.215, 1.291, 1.295, 1.296, 1.311, 1.324, 1.377, 1.378, 1.550, 1.741, 1.956, 5.12, 5.15, 5.25, 10.18, 41.20, and 104.3. This final rule also amends title 37 CFR by adding new § 1.57 and removing § 1.179. The Office is not proceeding with the proposed changes to §§ 1.55, 1.116, 1.138, 1.502, 1.530, 1.570, 1.902, 1.953, 1.957, 1.958, 1.979, and 1.997 in this final rule. In addition, the Office adopted proposed changes §§ 1.704 and 1.705 in a separate rule making. See *Revision of Patent Term Extension and Patent Term Adjustment Provisions*, 69 FR 21704 (Apr. 22, 2004), 1282 *Off. Gaz. Pat. Office* 100 (May 19, 2004) (final rule).

The following legal advisors and staff of the Office of Patent Legal

Administration may be contacted directly for the matters indicated:

Hiram Bernstein (703) 305-8713: § 1.136 and 1.324.

Joni Chang (703) 308-3858: §§ 1.8, 1.10, 1.91, 1.94, 1.98 and 1.111.

Jeanne Clark (703) 306-5603: §§ 1.55 and 1.98.

Terry Dey (703) 308-1201: § 1.178.

Elizabeth Dougherty (703) 306-3156: § 1.121.

James Engel (703) 308-5106: §§ 1.12, 1.14, 1.17, 1.53, 1.59, 1.102, 1.103, 1.131, 1.182, 1.183, 1.291, 1.295, 1.296, 1.377, 1.378, 1.741, 5.12, 5.15, 5.25, 41.20, 104.3.

Karin Ferriter (703) 306-3159: § 1.6, 1.19, 1.47, 1.52 (other than (e)(1)(iii) and (e)(3)), 1.58(a) and (c) (other than landscape), 1.63, 1.69, 1.83, 1.84, 1.85, and 1.165.

Anton Fetting (703) 305-8449: §§ 1.17, 1.53, 1.59, 1.103, 1.105, 1.182, 1.183, 1.295, 1.296, 1.377, 1.378, 1.741, 5.12, 5.15, 5.25, 41.20, 104.3.

Kery Fries (703) 308-0687: §§ 1.76, 1.704, and 1.705.

Eugenia Jones (703) 306-5586: §§ 1.8, 1.10, 1.27, 1.55, 1.57(a), 1.78, 1.91, and 1.94.

Michael Lewis (703) 306-5585: §§ 1.4, 1.19, 1.52(e)(1)(iii) and (e)(3), 1.57(b)-(f), 1.58(b) and (c) (landscape), and 10.18.

Cynthia Nessler (703) 305-0271: § 1.311.

Mark Polutta (703) 308-8122: §§ 1.213, and 1.215.

Kenneth Schor (703) 308-6710: §§ 1.137, 1.173, 1.175, 1.179, 1.550, and 1.956.

Fred Silverberg (703) 305-8986: § 1.115.

The Office published a proposed rule proposing changes to the rules of practice to improve the patent application and examination process by promoting quality enhancement, reducing patent pendency, and using information technology to simplify the patent application process. See *Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan*, 68 FR 53816 (Sept. 12, 2003), 1275 *Off. Gaz. Pat. Office* 23 (Oct. 7, 2003) (proposed rule). The Office received thirty written comments (from intellectual property organizations, law firms, businesses, and patent practitioners) in response to this notice of proposed rule making. The comments and the Office’s responses to those comments are included in the discussion of the specific rule to which the comment relates. Comments generally in support of a change are not discussed.

Discussion of Specific Rules

Section 1.4: Existing § 1.4(d)(1) sets forth the requirements for personal signatures (meaning handwritten signatures) for most correspondence with the Office and indicates that original signatures, or direct or indirect copies of such signatures, are permitted.

Section 1.4(d)(1) is amended to specifically indicate that the signatures covered under § 1.4(d)(1) are all handwritten signatures (except for the type of correspondence submitted pursuant to paragraph (e) of § 1.4) and that dark ink or its equivalent must be used. Section 1.4(d)(2) is rewritten to provide for the signing of correspondence by use of an S-signature, which is defined as a signature between forward slash marks, but not a handwritten signature as defined in §§ 1.4(d)(1) or (e) depending on the type of correspondence the signature is applied to. An S-signature includes any signature made by electronic or mechanical means, and any mode of making or applying a signature not covered by either a personally signed handwritten signature permitted under §§ 1.4(d)(1) or (e), or an Electronic Filing System (EFS) character coded signature permitted under § 1.4(d)(3). The S-signature of § 1.4(d)(2) can be utilized with correspondence filed in the Office in paper, by facsimile transmission as provided in § 1.6(d), or via the Office Electronic Filing System as an EFS Tag(ged) Image File Format (TIFF) attachment, for a patent application, patent, or a reexamination proceeding. Paragraphs (d)(2)(i) through (d)(2)(iii) of § 1.4 set forth the specific requirements for S-signatures. Paragraph (d)(3) of § 1.4 sets forth the requirements for electronic signatures on correspondence filed via the Office Electronic Filing System in character coded form. Thus, any signature other than a personally applied handwritten signature (which is covered by paragraphs (d)(1) or (e) of this section) is covered by the provisions of (d)(2) and (d)(3) of § 1.4. Former paragraph (d)(2) has been redesignated as new paragraph (d)(4)(i) of § 1.4 in view of the provision of new paragraphs (d)(2) and (d)(3) of § 1.4 for S-signature and EFS character coded signature signed documents. Paragraph (d)(4)(ii), certifications as to the signature, has been added to include paragraphs (d)(4)(ii)(A) (Of another), (d)(4)(ii)(B) (Self certification), and (d)(4)(ii)(C) (Sanctions). Paragraph (d)(4)(ii)(A) requires that a person submitting a document signed by another under paragraphs (d)(2) or (d)(3) of this section is obligated to have a reasonable basis

to believe that the signature of the person present on the document was actually inserted by that person, and should retain evidence of authenticity of the signature. Paragraph (d)(4)(ii)(B) requires that a person inserting a signature under paragraphs (d)(2) or (d)(3) of this section in a document submitted to the Office certifies that the inserted signature appearing in the document is his or her own signature. Paragraph (d)(4)(ii)(C) provides that violations of the certifications as to the signature of another or a person's own signature, set forth in paragraphs (d)(4)(ii)(A) and (B) of this section, may result in the imposition of sanctions under §§ 10.18(c) and (d). Section 1.4(e) has a conforming amendment based on the changes made for § 1.4(d)(1) regarding a signature that is handwritten and the use of permanent ink that is dark or its equivalent. Provision is also made, § 1.4(h), for the requirement of ratification or confirmation (which includes submission of a duplicate document) or evidence of authenticity of a signature where the Office has reasonable doubt as to its authenticity or where it does not clearly identify the person signing.

Requirements of Signatures: Section 1.4(d)(1) has always been defined to cover all handwritten signatures, except for the signatures on the type of correspondence submitted under paragraph (e) of § 1.4. See *Changes in Signature and Filing Requirements for Correspondence Filed in the Patent and Trademark Office*, 57 FR 36034, 36035 (Aug. 12, 1992), 1142 *Off. Gaz. Pat. Office* 8, 9 (Sept. 1, 1992). Section 1.4(d)(1) has been amended to confirm this definition and to make it clear that handwritten signatures are not covered by §§ 1.4(d)(2) or (d)(3). The term "handwritten" has been added both as a title for, and in the text of, § 1.4(d)(1) to specifically indicate the type of signature covered by the paragraph. Additionally, the permanent ink requirement of the paragraph has been clarified by reference to "dark ink or its equivalent" in accord with § 1.52(a)(1)(iv). Section 1.4(d)(1) has additionally been amended to indicate (by specifically excluding §§ 1.4(d)(2) and (d)(3)) that a handwritten signature may not be provided under the S-signature provisions of new paragraph (d)(2) of § 1.4 and the EFS character coded signature provisions of new paragraph (d)(3) of § 1.4.

Section 1.4(d)(2) creates an S-signature, which is defined as a signature inserted between forward slash marks, but not a handwritten signature as defined by §§ 1.4(d)(1) or (e). An S-signature includes any

signature made by electronic or mechanical means, and any other mode of making or applying a signature not covered by either a personally signed handwritten signature permitted under §§ 1.4(d)(1) or (e), or an Electronic Filing System (EFS) character coded signature permitted under § 1.4(d)(3). The S-signature of § 1.4(d)(2) can be utilized with correspondence filed in the Office in paper, by facsimile transmission as provided in § 1.6(d), or via the Office Electronic Filing System as an EFS Tag(ged) Image File Format (TIFF) attachment, for a patent application, patent, or a reexamination proceeding. The S-signature must be in permanent dark ink or its equivalent.

Section 1.4(d)(2)(i) requires that an S-signature must be in letters, or Arabic numerals, or both. Appropriate spaces and punctuation (*i.e.*, commas, periods, apostrophes, or hyphens) may be used with the letters and numbers. The person signing must personally insert the S-signature between two forward slashes (/ * * /).

Section 1.4(d)(2)(ii) requires that if the S-signature is that of a registered practitioner of record signing pursuant to § 1.33(b)(1), or a registered practitioner not of record signing pursuant to § 1.33(b)(2), the practitioner must provide his or her registration number as part of, or adjacent to, the S-signature. A number character (#) may only be used as part of the S-signature when appearing before a practitioner's registration number; otherwise, the number character may not be used in an S-signature.

Section 1.4(d)(2)(iii)(A) requires that in addition to the S-signature, a printed or typed name of a signer must be provided preferably immediately below or adjacent to the person's S-signature.

Section 1.4(d)(2)(iii)(B) requires that the printed or typed name must be reasonably specific enough so it can readily be ascertained who has made the S-signature.

Section 1.4(d)(3) establishes the use of an EFS character coded signature, which is an electronic signature, for correspondence submitted via EFS in character coded form for a patent application, or an assignment cover sheet signed consistent with § 3.31. The electronic signature must consist only of letters of the English alphabet, or Arabic numerals, or both, with appropriate spaces and commas, periods, apostrophes, and hyphens as punctuation. Letters of the English alphabet are the upper and lower case letters A through Z.

Section 1.4(d)(4)(i) establishes that the presentation to the Office (whether by signing, filing, submitting, or later

advocating) of any paper by a party, whether a practitioner or non-practitioner, constitutes a certification under § 10.18(b) of this chapter.

Section 1.4(d)(4)(ii)(A) establishes certifications as to the signature of another for a person submitting a document signed by another under paragraphs (d)(2) or (d)(3) of this section. Thus, the submitting person is obligated to have a reasonable basis to believe that the person whose signature is present on the document actually inserted the signature on the document, and the submitting person should retain evidence of authenticity of the signature.

Section 1.4(d)(4)(ii)(B) establishes that a person inserting a signature under paragraphs (d)(2) or (d)(3) of this section in a document submitted to the Office certifies that the inserted signature appearing in the document is his or her own signature.

Section 1.4(d)(4)(ii)(C) establishes that violations of the certifications as to the signature of another or a person's own signature, set forth in paragraphs (d)(4)(ii)(A) and (B) of this section, may result in the imposition of sanctions under §§ 10.18(c) and (d).

Section 1.4(e) has been amended to clarify that "personally signed" refers to a handwritten signature and that permanent dark ink or its equivalent is required.

Paragraph 1.4(h) provides for a ratification, confirmation, or evidence of authenticity of a signature handwritten pursuant to §§ 1.4(d)(1) and (e), and S-signature pursuant to § 1.4(d)(2) and an EFS character coded signature pursuant to § 1.4(d)(3), such as where the Office has reasonable doubt as to the authenticity (veracity) of the signature.

Correspondence which is filed using the EFS TIFF image form is defined to be a black and white image at 300 dots per inch (dpi), either uncompressed or with CCITT Group 4 compression.

Discussion of signature requirements: The rule change is intended to facilitate movement of documents between practitioners, applicants, and the Office. The rule change does *not* create the ability to file Official correspondence by electronic mail messages (e.g., e-mail) over the Internet to the Office. Pilot programs such as the program at the Board of Patent Appeals and Interferences (BPAI) are not affected by this rule change (see standing orders at the URL: <http://www.uspto.gov/web/offices/dcom/bpai/standing2003May.pdf>).

Although the Office will now accept correspondence with S-signatures or EFS character coded signatures, the Office can only authenticate what is in

the Office records. Applicants and practitioners must be cognizant of the issues of changed document appearance and content and take appropriate steps to ensure that their records, if in electronic form, can be rendered and authenticated at some later time as being the unaltered S-signature or EFS character coded signed original document.

Section 1.4(d)(1) covers all handwritten signatures, except for the handwritten signatures on the types of correspondence covered by § 1.4(e). The requirement in § 1.4(d)(1) of permanent dark ink or its equivalent relates to whether a handwritten signature is compliant and is not limiting on the type of handwritten signature that is covered by § 1.4(d)(1). Thus, § 1.4(d)(1) would cover handwritten signatures in red ink or in pencil; although, under § 1.4(d)(1) neither would be acceptable since red ink is not dark, and pencil is not permanent. A scanned image of a handwritten signature filed via the Office's EFS is permitted as a copy under § 1.4(d)(1)(ii).

A signature applied by an electric or mechanical typewriter directly to paper is not a handwritten signature, which is applied by hand. Accordingly, if a typewriter applied signature is used, it must meet the requirements of § 1.4(d)(2). Adding forward slashes to a handwritten (or hand-printed) ink signature that is personally applied will not cause the signature to be treated under § 1.4(d)(2). Thus, such a signature will be treated under §§ 1.4(d)(1) or (e) with the slashes ignored. The end product from a manually applied hand stamp or from a signature replication or transfer means (such as by pen or by screen) appears to be a handwritten signature, but is not actually handwritten, and would therefore be treated under § 1.4(d)(2).

Paragraph 1.4(d)(2)(i) defines the content of an S-signature for correspondence submitted to the Office in paper or by facsimile transmission or via the Office EFS as a TIFF attachment. The Office is adopting a standard of only letters, Arabic numerals, or both, with appropriate spaces and punctuation (i.e., commas, periods, apostrophes, or hyphens) as the S-signature. "Letters" include English and non-English alphabet letters, and text characters (e.g., Kanji). Non-text, graphic characters (e.g., a smiley face created in the True Type Wing Dings font) are not permitted. "Arabic numerals" are the numerals 0, 1, 2, 3, 4, 5, 6, 7, 8, and 9, which are the standard numerals used in the United States.

The Office recognizes that commas, periods, apostrophes, and hyphens are often found in names and will therefore be found in many S-signatures. These punctuation marks and appropriate spaces may be used with letters and Arabic numerals in an S-signature. A sample S-signature including punctuation marks and spaces, between two forward slashes, is: /John P. Doe/. Punctuation marks, per se, are not punctuation and are not permitted without proper association with letters and Arabic numerals. An S-signature of only punctuation marks would be improper (e.g., /----/). In addition, punctuation marks, such as question marks (e.g., /???/), are often utilized to represent an intent not to sign a document and may be interpreted to be a non-bona fide attempt at a signature, in addition to being improper.

The S-signature must be placed between two forward slashes. This is consistent with the rule adopted in the Trademark Office, and the international standard. See PCT Annex F, section 3.3.2. The S-signature between two forward slashes cannot contain any additional forward slashes. The presentation of just letters and Arabic numerals as an S-signature without the S-signature being placed between two forward slashes will be treated as an unsigned document. Script fonts are not permitted for any portion of a document except the S-signature. See § 1.52(b)(2)(ii). Presentation of a typed name in a script font without the typed name being placed between the required slashes does not present the proper indicia manifesting an intent to sign and will be treated as an unsigned document.

To avoid processing delays, the Office needs to readily determine whether a document has been signed. The filing of a document does not imply that the document has been signed. The Office does not want to investigate as to whether a mark (e.g., extraneous marks or a non-permanent ink presentation of a name) comprises a signature. Therefore, the Office will only interpret the data presented between two forward slashes as an S-signature. Hence, documents intended to be unsigned should be very clear that any data presented between forward slashes is not intended to be a signature and must avoid placement of any letters or Arabic numerals between two forward slashes in a signature area.

To accommodate as many varieties of names as possible, a signer may select any combination of letters, Arabic numerals, or both, for his or her S-signature under § 1.4(d)(2)(i).

Paragraph 1.4(d)(2)(i) also defines who can insert an S-signature into a document. Section 1.4(d)(2)(i) requires that a person, which includes a practitioner, must insert his or her own signature using letters and/or Arabic numerals, with appropriate commas, periods, apostrophes, or hyphens as punctuation and spaces. The “must insert his or her own signature” requirement is met by the signer directly typing his or her own signature on a keyboard. The requirement does not permit one person (e.g., a secretary) to type in the signature of a second person (e.g., a practitioner) even if the second person directs the first person to do so. A person physically unable to use a keyboard, however, may, while simultaneously reviewing the document for signature, direct another person to press the appropriate keys to form the S-signature.

The person signing the correspondence must insert his or her own S-signature with a first single forward slash mark before, and a second single forward slash mark after, the S-signature (e.g., /Dr. John P. Doe, Jr./). Additional forward slashes are not permitted as part of the S-signature.

For consistency purposes, and to avoid raising a doubt as to who has signed, the same S-signature should be utilized each time, with variations of the signature being avoided. The signer should review any indicia of identity of the signer in the body of the document, including any printed or typed name and registration number, to ensure that the indicia of identity in the body of the document is consistent with how the document is S-signed. Knowingly adopting an S-signature of another is not permitted.

While an S-signature need not be the name of the signer of the document, the Office strongly suggests that each signer use an S-signature that has his or her full name. The Office expects that where persons do not sign with their name it will be because they are using an S-signature that is the usual S-signature for that person, which is his or her own signature, and not something that is employed to obfuscate or misidentify the signer. Titles may be used with the signer’s S-signature and must be placed between the slash marks (e.g., /Dr. John Doe/), or with the printed or typed version of the name.

Paragraph 1.4(d)(2)(ii) requires that a practitioner signing pursuant to §§ 1.33(b)(1) or 1.33(b)(2) of this part must place his or her registration number, either as part of, or adjacent, his or her S-signature. A number character (#) may only be used in an S-signature if it is prior to a practitioner’s

registration number that is part of the S-signature. When a practitioner is signing as an assignee, or as an applicant (inventor) pursuant to §§ 1.33(b)(3) or 1.33(b)(4), a registration number is not required and should not be supplied to avoid confusion as to which basis the practitioner is signing, e.g., as a practitioner or as the assignee.

The requirement that an S-signature for practitioners be accompanied by a registration number is consistent with Article 9(1) of the Patent Law Treaty (June 1, 2000) (PLT) and § 1.34.

The space provided for a registration number and a printed/typed signer’s name on some Office (fillable) forms is above the space provided for a signature. The space provided for the registration number and printed/typed signer’s name is compliant with the “adjacent” requirements of § 1.4(d)(2)(ii) discussed above, and § 1.4(d)(2)(iii) discussed below.

To ensure that it will always be clear who has made the S-signature, § 1.4(d)(2)(iii) requires that the signer’s printed or typed name (i.e., William Jones) always must be presented adjacent or below (preferred) the S-signature (§ 1.4(d)(2)(iii)(A)), and that it be reasonably specific enough so that the identity of the signer can be readily recognized (§ 1.4(d)(2)(iii)(B)).

Paragraph 1.4(d)(2)(iii)(A) sets forth the requirement that the signer’s name must be presented in printed or typed form either immediately below (preferred) or adjacent to the S-signature. The printed or typed name requirement is intended to describe any manner of applying the signer’s name to the document, including by a typewriter or machine printer. It could include a printer (mechanical, electrical, optical, etc.) associated with a computer or a facsimile machine but would not include manual or hand printing. See § 1.52(a)(1)(iv). The printed or typed name may be inserted before or after the S-signature is applied, and it does not have to be inserted by the S-signer.

A printed or typed name appearing in the letterhead or body of a document is not acceptable as the presentation of the name of the S-signer. To accommodate as many S-signatures as possible, a signer may select any combination of letters, Arabic numerals, or both for his or her signature. The flexibility in selecting combinations of letters and/or Arabic numerals for S-signatures means that the identity of the signer may not be clear from the S-signature if it is not a name. For example, a collection of letters/numbers when presented for the first time without a full printed or typed name that does not appear to be a person’s name (e.g., /123456XYZ/) does

not identify any person as the signer. This is so even where the signer has submitted a previous document with such S-signature and an identification of the name of the signer. Similarly, where the S-signature, if it is not the signer’s name, appears to represent an identifiable person with a name different in some respect from the signer, the identity of the signer would not be known. For example, a practitioner named “William Jones” S-signs an amendment “/B. Jones/” which also has a certificate of transmission signed by a paralegal with the name and signature “Bob Jones.” In this situation, the S-signature on the amendment would not clearly identify “William Jones” as the S-signer.

In view of the flexibility allowed by the S-signature, the requirement of § 1.4(d)(2)(iii)(B), that the printed or typed name of § 1.4(d)(iii)(A) must be reasonably specific enough so that the identity of the signer can be readily recognized, becomes very significant. While the § 1.4(d)(2)(iii)(B) requirement is also intended to provide some flexibility (e.g., Bob may possibly be used instead of Robert), the ultimate issue is whether the Office can clearly identify who S-signed the document and, if not, § 1.4(h) may be triggered.

The proposed requirements relating to the usage of a signer’s actual name, or complete name, or the capitalization of only the family name have not been included in the final rule because the underlying requirement relating to the presentation of a name is already addressed in the existing rules dealing with the document that is being signed, and therefore, such requirements are not necessary in § 1.4. For example, the requirements for a declaration under § 1.63 have not been changed, nor are any changes in § 1.4 intended to supersede the requirements of § 1.63. An S-signature may be used to sign a declaration under § 1.63 if all of the requirements of § 1.63 are met.

As with signatures to be treated under § 1.4(d)(2), signatures to be treated under § 1.4(d)(3) must be placed within forward slash marks.

In § 1.4(d)(3), the “Character coded” form is the terminology of PCT Annex F used to describe an EXtensible Markup Language (XML) document created by filling in an EFS menu. The reason that the Office is limiting the electronic signature for correspondence in character coded text form submitted via the EFS to only letters of the English alphabet, or Arabic numerals, or both (with appropriate spaces and commas, periods, apostrophes, and hyphens as punctuation) is that if the correspondence containing non-English

letters or characters is opened by the Office, these non-English letters or characters when rendered may appear as a “box” or translated to a character in a different font and language if the character setting used by the author of the correspondence is not compatible with the character setting used by the Office.

Thus, the content requirements that letters in an electronic signature for correspondence submitted via the EFS in character coded text form under § 1.4(d)(3) (must be in the English language) is more stringent than the letter requirements (letters in any language are permitted) under § 1.4(d)(2). Note that S-signatures on attachments in TIFF images submitted via the EFS are governed by § 1.4(d)(2) rather than § 1.4(d)(3).

The electronic signature permitted for EFS in § 1.4(d)(3), however, does not have a requirement for the presentment of the signer’s name in printed or typed form as set forth in § 1.4(d)(2)(iii)(A) and is therefore less stringent in that respect. This is because the EFS preparation protocol for creating a document in EFS requires one to insert information (an electronic signature) into a data field on a screen but there may be no accompanying data field for inserting a name either “adjacent or immediately below” the electronic signature, and therefore such a requirement has not been made. There is a field in a screen in EFS, however, for typing in the name of the electronic signature signer so it is not necessary to include a separate requirement for it in the rule.

Documentation about the EFS and a description of electronically signing an EFS document is in the *EFS Submission User Manual—ePAVE for New Utility* which is available at: <http://www.uspto.gov/ebc/efs/downloads/document.htm>.

Section 1.4(d)(4)(i) contains the previous reference to § 10.18 certifications regarding certifications made on presenting a paper to the Office.

For paper documents utilizing an S-signature, the previous mode of authenticating handwritten signatures, such as by comparing handwritten signatures, is not available.

The question may be raised as to whether a person’s S-signature was in fact inserted in a document by that person or some other person. To address this authentication concern, the rule has been revised to include §§ 1.4(d)(4)(ii)(A) and (B) which set out certifications that apply to persons inserting an S-signature, or an EFS character coded signature, as well as to persons who submit documents with

such signatures inserted by another person. Section 1.4(d)(4)(ii)(A) also includes a provision for retention of evidence of authenticity.

Section 1.4(d)(4)(ii)(A) adds the requirement that a person submitting a document signed by another under §§ 1.4(d)(2) and (3) is obligated to have a reasonable basis to believe that the person whose signature is present on the document was actually inserted by that person. Such reasonable basis does not require an actual knowledge but does require some reason to believe the signature is appropriate. For example, where a practitioner e-mails a § 1.63 declaration to an inventor for signature by the inventor and receives an executed declaration by the inventor in return from the inventor, reasonable basis would exist. Where an assignee was involved in the transmission of the declaration form and/or the executed declaration, an additional showing of chain of custody (e.g., e-mail chain with attached documents from the inventor to the assignee to the practitioner filing the declaration) involving the assignee would be required. Additionally, evidence of authenticity should be retained. This may involve retaining the e-mails sent to the inventor and any cover letter or e-mail (with the signed document as an attachment) back to the practitioner from the inventor in the example relating to execution of a § 1.63 declaration.

Section 1.4(d)(4)(ii)(B) adds the requirement that the person inserting a signature under paragraphs (d)(2) or (d)(3) certifies that the inserted signature appearing in the document is his or her own signature. This is meant to prohibit a first person from requesting a second person to insert the first person’s signature in a document. While the certification is directed at the person inserting another’s signature, the person requesting the inappropriate insertion may also be subject to sanctions.

Section 1.4(d)(4)(ii)(C) provides that violations of the certification as to the signature set forth in paragraphs (d)(4)(ii)(A) and (B) of this section, may result in the imposition of sanctions under §§ 10.18(c) and (d).

Section 1.4(e) has been amended to conform to the changes made to § 1.4(d)(1) in regard to the signature being handwritten and the permanent ink being a dark ink or its equivalent.

Pursuant to § 1.4(h), the Office may additionally inquire in regard to a signature so as to identify the signer and clarify the record where the identity of the signer is unclear. The inquiries concerning evidence of authenticity (veracity) of a signature are consistent with PLT Article 8(4)(c) and Rules 7(4),

15(4), 16(6), 17(6), and 18(4). An example of when ratification or confirmation of a signature may be required is when there are variations in a signature or whenever a name in an S-signature is not exactly the same as the name indicated as an inventor, or a practitioner of record. Hence, whatever signature is adopted by a signer, that signature should be consistently used on all documents. Also addressed is the treatment of variations in a signature or where a printed or typed name accompanies the S-signature or the EFS character coded signature but the identity of the signer is unclear. In such cases, the Office may require ratification or confirmation of a signature. Ratification requires the person ratifying to state he/she personally signed the previously submitted document as well as, if needed, the submission of a compliant format of the signature. Confirmation includes submitting a duplicate document, which is compliantly signed if the previous signature was noncompliant (as opposed to unclear).

In lieu of ratification, the Office may require a resubmission of a properly signed duplicate document. Resubmission of a document may be required, for example, where ratification alone is inappropriate, such as where the image of the signature is of such poor quality (e.g., illegible font) that the Office is unable to store or reproduce the document with the signature image.

Ratification or confirmation alone does not provide a means for changing the name of a signer. For example, when an inventor changes her/his name and the inventor desires to change her/his name in the application, such change must be accompanied by a petition under § 1.182 and, preferably, an Application Data Sheet (ADS). See *Manual of Patent Examining Procedure* § 605.04(c)(8th. ed. 2001) (Rev. 2, May 2004) (MPEP) and *Advance Notice of Change to MPEP 605.04(b), (c) and (f)—Application Data Sheets Are Strongly Recommended When Inventor Information is Changed*, 1281 *Off. Gaz. Pat. Office* 54 (Apr. 13, 2004).

In addition, the Office may require evidence of authenticity where the Office has reasonable doubt as to the authenticity (veracity) of the signature. Evidence of authenticity may include evidence establishing a chain of custody of a document from the person signing the document to the person filing the document. Proper evidence of a chain of custody will aid in avoiding the impact of repudiation of a signature.

Where there has been a bona fide attempt to follow the rule, but where there is some doubt as to the identity of

the signer of a signed document, the Office may require ratification of the signature. Note, ratification would only be an effective remedy if the signer was a proper party to have executed the document to be ratified. For example, a practitioner of record may ratify his or her signature on an amendment, but not the signature of a secretary who is not a practitioner or inventor in the application. A registered practitioner may, however, ratify the amendment made by another registered practitioner but may not ratify a document required to be signed by an inventor, such as a § 1.63 declaration. Similarly, an inadvertent typographical error or simple misspelling of a name will be treated as a bona fide attempt to follow the rule, which would require ratification only where there is some doubt as to the identity of the signer rather than be treated as an unsigned paper requiring resubmission. Where there is an obvious typographical error so that the Office does not have some doubt as to the identity of the signer (and therefore notification to applicant is not needed), further action by applicant would not be required and, where appropriate, the obvious error will be noted in the record.

The inadvertent failure to follow the format and content of an S-signature will be treated as a bona fide attempt at a signature but the paper will be considered as being unsigned correspondence. Examples of correspondence that will be treated as unsigned are: (1) the S-signature is not enclosed in forward slashes; (2) the S-signature is composed of non-text graphic characters (e.g., a smiley face) and not letters and numerals; and (3) the S-signature is not a name and there is no other accompanying name adjacent or below the S-signature so that the identity of the signer cannot be readily recognized.

Treating the document as being unsigned could have varying results dependent on the nature of the document. For example, in new applications, treating an improperly signed § 1.63 oath or declaration as a missing part could result in the imposition of a surcharge and a two-month period for reply (with extensions of time possible) to supply a properly signed new oath or declaration. Ratification, in this instance, would not be appropriate. See § 1.53(f)(1). Other correspondence, such as amendments, could be treated under the procedures for unsigned amendment documents set forth in MPEP §§ 714.01 and 714.01(a) and a one-month time period for reply be given for either ratification or

submission of a duplicate amendment which is properly signed.

If the signer, after being required to ratify or resubmit a document with a compliant signature, repeats the same S-signature in reply without appropriate correction, the reply will not be considered to be a bona fide attempt to reply, and no additional time period will be given to submit a properly signed document.

Existing § 10.18(a) directed towards certifications made upon the signing of a document submitted to the Office is focused narrowly on the "personally signed" documents containing the handwritten signature defined in § 1.4(d)(1). As the intent of the Office is to provide an equivalent alternative means for signing a document by the use of S-signatures and EFS character coded signatures, the Office is herein promulgating a conforming change to § 10.18(a) to cover S-signatures.

Comment 1: One comment suggested broadening the rule to permit additional documents to be electronically signed.

Response: The comment is not adopted. The comment is interpreted to mean that electronic mail messages should be permitted as a mode of correspondence with the Office, which is not a signature issue. Electronic mail messages are not generally permitted, but this is for a number of reasons, with the requirement for signature not being a significant factor. Among the issues which remain unresolved with respect to accepting electronic mail messages are secure transmission, compatible character/font sets and file formats for proper rendering of the message and receipt of documents infected with a virus. Documents that are required by statute to be in a particular form, such as an oath, cannot be authorized by a rule change to be in a different form, e.g., a notarized oath changed to an electronic signature. Because § 1.4 makes no provision for an electronic notarization, an oath will not be able to be executed as a result of these changes to § 1.4. A declaration that does not require notarization, however, can be electronically signed.

Comment 2: One comment suggests that the Office allow for electronic mail message submissions with simultaneous verification by postal mail.

Response: The comment is not adopted. The manner of submitting correspondence such as by electronic mail message, is not addressed by this rule. Electronic submission of documents is being addressed in guidelines related to the electronic filing system. In any event, having to match and compare duplicate submissions (paper and electronic mail) would create

a significant processing and analysis burden on the Office.

Comment 3: One comment suggests clear demarcation of electronic signature (now referred to as an S-signature) by statement rather than use of back-slashes, etc.

Response: The comment is not adopted. The comment proposal requires analysis of text beyond simple inspection of a document for the presence or absence of a signature. It is not clear from the comment what is a "clear" statement of signature or how typing a statement that a typed name is a signature can be less burdensome than typing slashes. Further, the signature format employing slash characters is the standard adopted by the PCT and the Office intends to be consistent with international standards.

Comment 4: One comment suggests the Office should afford the public more flexibility with respect to the format and content of an electronic signature (now referred to as an S-signature).

Response: The comment is adopted in-part. The comments requested more flexibility in the format (e.g., not being limited to slashes, capitalization), and less onerous consequences for deviations from the specified format. The Office will not adopt any changes with respect to permitting a format that does not include slashes so as to be consistent with the PCT standard for electronic signatures and which can be readily identified as an S-signature. The final rule, however, does not contain a requirement for the identification of first and family names, and capitalization will not be required to indicate the family name, even though what is a family name may vary in different cultures. Also, the format of providing the signer's name is made less restrictive (e.g., there will not be a requirement to separately indicate the actual name when typed or printed) to also reduce the possibility for format errors.

The final rule also adopts a more flexible approach that allows both practitioners and non-practitioners to sign any combination of letters and Arabic numerals. The flexibility for practitioners to deviate from their registered name will be permitted. Similarly, the requirement for the signature to contain an actual complete name has not been adopted, just like there will not be a requirement to identify the first and family names by capitalization as discussed for format in the previous comment. The less restrictive content requirements reduce the possibility for content errors.

Comment 5: One comment suggests the Office should allow a time period to

correct an incorrect electronic signature (now referred to as a S-signature) without penalty. There is a concern that failure to adhere to an electronic signature format will result in treatment as an unsigned paper.

Response: The comment is adopted in-part. The comments expressed the concern that an S-signature that was made with a good faith effort but fails to conform to an actual or complete name may be treated as unsigned with significant adverse consequences. The final rule has been modified to permit deviations from an actual or complete name where the identity of the signer can still be readily determined.

Examples of such deviations are where a first name of "Bob" is substituted for an actual name of "Robert," "Peggy" for an actual name of "Margaret," "Mike" for an actual name of "Michael." In the absence of some other source of confusion, the mere transposition of letters, or the presence or absence of a letter in a name will not be treated as a nonconforming signature. Similarly, where a practitioner's registration number contains a transposition of numerals or a single erroneous digit, and the identity of the practitioner can be determined from the name and the balance of the registration number, the S-signature will not be treated as an improper S-signature.

Where a document is treated as being unsigned, the granting of any period for curing the defect will be handled under existing Office practices for unsigned documents.

Comment 6: One comment suggests that "actual name" versus "complete name" in proposed § 1.4(d)(1)(iv)(A) is confusing.

Response: The comment is adopted. The rule is clarified by removing "actual" and "complete" from the name requirement. Any special requirements for the presentation of a name are already addressed by the underlying document and rules pertaining thereto, e.g., oath or declaration, see § 1.63(a)(2).

Comment 7: One comment suggests the requirement to "personally insert" electronic signature (now referred to as an S-signature) should permit insertion under practitioner's direction/control.

Response: The comment is not adopted. The requirement that the person signing must insert his or her own S-signature is essentially the same as the "personally insert" requirement of Rule 10.18 (which is not being amended by this rule making) and § 1.4(d)(1) for handwritten signatures.

Comment 8: One comment suggests that the USPTO should dictate order of names not capitalization. Another comment suggests that the USPTO

should set a standard for the presentation of a name as a preference not a requirement.

Response: The comment is adopted in part. The capitalization requirement is not included in the final rule and any requirement for the order of names is addressed by the rules pertaining to the underlying document, e.g., oath or declaration under § 1.63.

Comment 9: One comment suggests that the proposed rule is detailed, burdensome, and easily inadvertently violated, having draconian penalties.

The rule should merely require applicant to make certain that the document has been signed.

Response: The comment is adopted in part. As explained in the response to the comments above, the detailed requirements for family name and capitalization have not been included in the final rule to reduce the possibility of inadvertent violation. The signature is not required to be the signer's name and the printed or typed name need only be reasonably specific enough to identify the signer. The comment that "applicant make certain that the document has been signed" is more burdensome on an applicant than the proposed rule and final rule. The final rule includes certification requirements as to the signature but does not require an investigation as to the actual signing where there is reasonable basis to believe the document has been signed appropriately by the person whose signature is on the document. For example, a practitioner receiving an electronic mail message from an inventor with a declaration S-signed by the inventor attached to the e-mail may satisfy the certification requirements in the final rule, whereas if the comment were adopted (in whole), the attorney would have needed to investigate further before it could be submitted.

Comment 10: One comment suggests that in some countries individuals do not have both a family and a given name, e.g., India.

Response: The comment is adopted. The requirements with respect to specifying the first and family names is not included in the final rule. Any special requirements for the presentation of a name are already addressed by the underlying document and rules pertaining thereto, e.g., oath or declaration, see § 1.63(a)(2).

Comment 11: One comment suggests a more detailed procedure is necessary for the inventor to change his/her name on the record.

Response: The comment is not adopted. The rule change does not affect current practice with respect to name

changes, which are addressed in MPEP §§ 605.04(c), 719.02(b).

Comment 12: One comment suggests opposition to all e-initiatives.

Response: The comment is not adopted. The change is in support of the Administration's e-government initiatives and principles espoused in the Government Paperwork Elimination Act (GPEA) to promulgate procedures for electronic signatures. See Pub. L. 105-277, §§ 1701 through 1710, 112 Stat. 2681, 2681-749 through 2681-751 (1998).

Section 1.6: Section 1.6(d)(4) is amended to provide that black and white drawings in patent applications may be transmitted to the Office by facsimile in order to provide more flexibility to applicants for filing individual papers in applications that contain drawings. Although the rules of practice will now permit the submission of black and white drawings by facsimile, photographs or drawings with detail should not be transmitted by facsimile. Furthermore, color drawings must continue to be hand-carried or mailed to the Office instead of being submitted by facsimile. In addition, the Office will publish drawings that are received as long as they can be scanned, and will not, in general, require replacement drawings to replace drawings transmitted by facsimile, even if the facsimile transmission process results in the drawings being less sharp than the original drawings. Applicants should note that the use of facsimile submission of drawings will not cause the submission to be processed faster than the Office would process a paper drawing received on the same day as the facsimile submission. The facsimile submission must first be rendered into paper form and then processed as would a submission initially made in paper.

Section 1.6(e) is removed and reserved because the provisions of § 1.6(e) are deemed more appropriately placed in § 1.10. This is because the "Express Mail" provisions of § 1.10 are the only means by which correspondence can be accorded a filing date other than the actual date of receipt in the Office. Thus, the provisions of § 1.6(e) have been transferred to § 1.10 along with some changes. Situations in which "Express Mail" is returned or refused by the United States Postal Service (USPS) have been specifically addressed in § 1.10(g) and (h). Section 1.10(i) is similar to § 1.6(e) and addresses situations where there is a designated interruption or emergency in "Express Mail" service.

Comment 13: Several comments asked the Office to identify what drawings would be acceptable when transmitted

by facsimile, whether applicants would be informed when a facsimile transmission of a drawing was unacceptable, and whether there would be any adverse term adjustment consequences of transmitting a drawing with too much detail to the Office.

Response: The Office cannot predict what drawings will be acceptable when transmitted by facsimile, but can provide applicants with a simple self test. If an applicant is not certain that a drawing submitted by facsimile will be of an acceptable quality, the applicant can test the quality of the drawing either by transmitting by facsimile the drawing to themselves, or by photocopying the drawing. If the facsimile-transmitted or copier drawing looks the same as the original, and the original was legible, then the drawing is extremely likely to be acceptable when transmitted by facsimile to the Office. Facsimile-transmitted and photocopied photographs generally bear little resemblance to the document intended to be submitted, and transmitting photographs by facsimile should be avoided. Drawings such as flow charts, on the other hand, generally do reproduce well, and may be accurately transmitted by facsimile.

If the Office receives drawings that do not have satisfactory reproduction characteristics (§ 1.84(l)), or that are illegible once scanned, the Office will inform the applicant that the drawings do not comply with § 1.84. If the Office action in which applicant is required to supply corrected drawings is a Notice of Allowability, and drawings are filed after the mailing date of the Notice of Allowance (which is generally mailed with the Notice of Allowability), any patent term adjustment will be reduced pursuant to § 1.704(c)(10).

Comment 14: One comment noted that the proposed rule contained text that had been previously removed from § 1.6(d)(4) (*Reorganization of Correspondence and Other Provisions*, 68 FR 48286 (Aug. 13, 2003), 1274 *Off. Gaz. Pat. Office* 59 (Sept. 9, 2003) (final rule)), and suggested that “Drawings submitted under §§ 2.51, 2.52, or 2.72 and” be deleted.

Response: The suggestion has been adopted.

Section 1.8: Section 1.8(a) is amended to clarify that the provisions of this section do not apply to time periods or situations set forth in sections that have been expressly excluded from § 1.8 as well as situations enumerated in § 1.8(a)(2). The amendment to § 1.8(a) clarifies that the list enumerated in § 1.8(a)(2) is not exhaustive, and the provisions of § 1.8 do not apply to the time periods or situations that have

been explicitly excluded from § 1.8. For example, provisions of § 1.8(a) do not apply to time periods and situations set forth in §§ 1.217(e) and 1.703(f) because the exceptions are provided explicitly in § 1.217(e), “[t]he provisions of § 1.8 do not apply to the time periods set forth in this section” and § 1.703(f), “[t]he date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in [patent term adjustment] calculation.”

Section 1.8(b) is also amended to permit notifying the Office of a previous mailing, or transmitting, of correspondence, when “a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence.” Recently, many applicants experienced substantial delays in delivery of their correspondence by the USPS to the Office. These applicants did not wish to wait until the application was held to be abandoned before notifying the Office of the previous mailing of the correspondence and supplying a duplicate copy of the correspondence and requisite statement in accordance with § 1.8(b)(3).

With the amendment to § 1.8(b), in the event that correspondence may be considered timely filed because it was mailed or transmitted in accordance with § 1.8(a), but was not received in the Office after a reasonable amount of time had elapsed (*e.g.*, more than one month from the time the correspondence was mailed), applicants would not be required to wait until the end of the maximum extendable period for reply set in a prior Office action (for the Office to hold the application to be abandoned) before informing the Office of the previously submitted correspondence, and supplying a duplicate copy and requisite statement attesting on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the person signing the statement did not sign the certificate of mailing, then the person signing the statement should explain how they have firsthand knowledge of the previous timely mailing or transmission. Such a statement should be filed promptly after the person becomes aware that the Office has not received the correspondence. Thus, although a statement attesting to the previous timely mailing or transmission of the correspondence is required, filing a petition to withdraw the holding of abandonment would not be necessary in such circumstance. The amendment to § 1.8(b) provides applicants an expedited procedure to resolve delayed mail problems.

Before notifying the Office of a previously submitted correspondence that appears not to have been received by the Office, applicants are encouraged to check the private Patent Application Information Retrieval (PAIR) System (which can be accessed over the Office’s Internet Web site) to see if the correspondence has been entered into the application file. The private PAIR system is a system which enables applicants to read the Office’s electronic records, including the Image File Wrapper (IFW), for a patent application or patent. Private PAIR is available to applicants who have a customer number associated with the correspondence address for an application and who have acquired the access software (Entrust Direct Software and a PKI certificate). Applicants may contact the Electronic Business Center (EBC) at (703) 305-3028 for more information on private PAIR.

The Office proposed to amend §§ 1.8(b), 1.17, 1.116, 1.137, 1.502, 1.570, 1.902, 1.953, 1.957, 1.958, 1.979, and 1.997 (and relevant subheadings) to make clear the distinction between termination of a reexamination proceeding and the conclusion or limiting of prosecution in a reexamination proceeding and to make other technical changes to the reexamination rules. The Office is not proceeding with these changes in this final rule; however, these changes continue to be considered as to a future final rule making directed to miscellaneous technical reexamination rule changes.

Comment 15: One comment asked what date would be used as the date of receipt, when a duplicate copy of the paper was filed with a showing under § 1.8. The comment continued to ask what date would be used if the original paper was subsequently found. In addition, the Office was asked how the applicant would know whether the paper was received.

Response: The date of receipt that would be entered into Office records would be the actual date of receipt of the duplicate paper, unless applicant established that the papers were actually received on an earlier date with a post card receipt or other evidence. If the Office accepts a paper pursuant to § 1.8, and the original paper later is located (as where the original paper was originally placed in the wrong application file), then the original paper will be treated as a duplicate paper and will not control the timing of subsequent actions such as the timing of the filing of an appeal brief. Any applicant having a doubt about the due date of an appeal brief should either assume that the brief is due on the

earlier date, or confirm with the examiner that a later date is appropriate. When applicants use private PAIR to view the image file wrapper, applicants will have generally the same information about the patent application that the examiner has. Accordingly, an applicant can know about the same time as an examiner when a paper has been received. Applicants can also include post card receipts or use facsimile transmissions in order to obtain additional information about when a paper is received by the Office. The procedure of § 1.8 is available not just when the Office did not receive a paper, but when the paper has not been received in the appropriate location (e.g., where applicant transposes digits in the application number on the application papers, and the Office does not recognize the error).

Section 1.10: Section 1.10 is amended to add paragraphs (g), (h), and (i) to address the effects of interruptions or emergencies in USPS "Express Mail" service. For example, Friday, November 16, 2001, the USPS issued a memorandum temporarily and immediately suspending "Express Mail" service to Washington, DC zip codes 202xx through 205xx. The suspension included service to the zip code for certain correspondence mailed to the Office (20231).

Applicants frequently rely on the benefits under § 1.10 to obtain a particular filing date for a new application. The filing date accorded to an application is often critical. For example, applicants who do not file their applications in the United States within one year from when their invention was first described in a printed publication or in public use or on sale in this country are not entitled to a patent. See 35 U.S.C. 102(b). Furthermore, to be able to claim the benefit of a provisional application or to claim priority to a foreign application, the nonprovisional application claiming benefit or priority must be filed within one year from the filing of the provisional application or foreign application. Therefore, the procedures by which applicants may remedy the effects of an interruption or emergency in USPS "Express Mail" service, which has been so designated by the Director, should be specifically addressed in the rules of practice.

The Office published a notice on October 9, 2001, that provides procedures for the situation in which a post office refuses to accept the deposit of mail for delivery by "Express Mail" Service and the situation in which "Express Mail" is deposited into an "Express Mail" drop box and given an

incorrect "date-in." See *United States Postal Service Interruption and Emergency*, 1251 *Off. Pat. Office* 55 (Oct. 9, 2001). The procedure for remedying the situation where the United States Postal Service (USPS) refuses to accept the deposit of mail for delivery by "Express Mail" as contained in the notice has now been incorporated into § 1.10(h).

The Office's prior framework to address postal emergencies was detailed in § 1.6(e), "Interruptions in U.S. Postal Service." Section 1.6(e) provided that if interruptions or emergencies in the USPS which have been so designated by the Director occur, the Office will consider as filed on a particular date in the Office any correspondence which is: (1) promptly filed after the ending of the interruption or emergency; and (2) accompanied by a statement indicating that the correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the USPS.

The provisions of § 1.6(e) are more appropriate in § 1.10 since "Express Mail" is the only means by which correspondence filed in accordance with § 1.1(a) can be accorded a filing date other than the actual date of receipt in the Office. Thus, the provisions of § 1.6(e) are transferred to § 1.10 along with some changes. Sections 1.10(g) and (h) specifically address situations in which "Express Mail" is returned or refused by the USPS due to an interruption or emergency in "Express Mail." Section 1.10(i), as revised, is similar to § 1.6(e) and addresses situations where there is a Director designated interruption or emergency in "Express Mail" service.

Section 1.10(g) is added to provide that any person who mails correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS, but has the correspondence returned by the USPS due to an interruption or emergency in "Express Mail" service, may petition the Director to consider the correspondence as filed on a particular date in the Office. This procedure does not apply where the USPS returned the "Express Mail" for a reason other than an interruption or emergency in "Express Mail" service such as the address was incomplete or the correspondence included insufficient payment for the "Express Mail" service. The petition must be filed promptly after the person becomes aware of the return of the correspondence and the number of the "Express Mail" mailing label must have been placed on the paper(s) or fee(s) that

constitute the correspondence prior to the original mailing by "Express Mail." The petition must also include the original correspondence or a copy of the original correspondence showing the number of the "Express Mail" mailing label thereon and a copy of the "Express Mail" mailing label showing the "date-in." Furthermore, the petition must include a statement, which establishes to the satisfaction of the Director, the original deposit of the correspondence and that the correspondence or the copy is the original correspondence or a true copy of the correspondence originally deposited with the USPS on the requested filing date. The Office may require additional evidence to determine if the correspondence was returned by the USPS due to an interruption or emergency in "Express Mail" service. For example, the Office may require a letter from the USPS confirming that the return was due to an interruption or emergency in the "Express Mail" service.

Section 1.10(h) is added to provide that any person who attempts to mail correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS, but has the correspondence refused by an employee of the USPS due to an interruption or emergency in "Express Mail" service, may petition the Director to consider the correspondence as filed on a particular date in the Office. This procedure does not apply where the USPS refused the "Express Mail" for a reason other than an interruption or emergency in "Express Mail" service such as the address was incomplete or the correspondence included insufficient payment for the "Express Mail" service. In addition, this procedure does not apply because an "Express Mail" drop box is unavailable or a Post Office facility is closed. The petition must be filed promptly after the person becomes aware of the refusal of the correspondence and the number of the "Express Mail" mailing label must have been placed on the paper(s) or fee document(s) that constitute the correspondence prior to the attempted mailing by "Express Mail." The petition must also include the original correspondence or a copy of the original correspondence showing the number of the "Express Mail" mailing label thereon. In addition, the petition must include a statement by the person who originally attempted to deposit the correspondence with the USPS which establishes, to the satisfaction of the Director, the original attempt to deposit the correspondence and that the

correspondence or the copy is the original correspondence or a true copy of the correspondence originally attempted to be deposited with the USPS on the requested filing date. The Office may require additional evidence to determine if the correspondence was refused by an employee of the USPS due to an interruption or emergency in "Express Mail" service. For example, the Office may require a letter from the USPS confirming that the refusal was due to an interruption or emergency in the "Express Mail" service.

Section 1.10(i) is added to provide that any person attempting to file correspondence by "Express Mail" that was unable to be deposited with the USPS due to an interruption or emergency in "Express Mail" service which has been so designated by the Director may petition the Director to consider such correspondence as filed on a particular date in the Office. This material is transferred from § 1.6. The petition must be filed in a manner designated by the Director promptly after the person becomes aware of the designated interruption or emergency in "Express Mail" service. The petition must also include the original correspondence or a copy of the original correspondence, and a statement which establishes, to the satisfaction of the Director, that the correspondence would have been deposited with the USPS but for the designated interruption or emergency in "Express Mail" service. In addition, the petition must indicate that the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally attempted to be deposited with the USPS on the requested filing date.

Section 1.10(i) applies only when the Director designates an interruption or emergency in "Express Mail" service. It is envisioned that in the notice designating the interruption or emergency the Director would provide guidance on the manner in which petitions under § 1.10(i) should be filed. When "Express Mail" was suspended in November of 2001, applicants were advised that if the USPS refused to accept correspondence for delivery to the Office by "Express Mail" they should mail the correspondence by registered or first class mail with a statement by the person who originally attempted to deposit the correspondence with the USPS by "Express Mail" and any future postal emergencies will be handled similarly, with the Office providing procedures for applicants to follow.

Comment 16: One comment suggested that the Office amend § 1.10(i) to read

"Any person attempting to file correspondence by Express Mail who was unable to deposit the correspondence due to any emergency or interruption of "Express Mail" service may petition the Director to consider such correspondence as filed on the date applicant attempted to file."

Response: The suggestion has not been adopted. 35 U.S.C. 21(a) provides that the "Director may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Director." The Director previously designated an emergency or interruption in the "Express Mail" service by publishing a notice in the Official Gazette Notices, and by posting the announcement on the Office's Internet Web site (www.uspto.gov). See, e.g., *United States Postal Service Interruptions and Emergency Terminated*, 1274 *Off. Gaz. Pat. Office* 105 (Sept. 16, 2003), *United States Postal Service Interruptions*, 1251 *Off. Gaz. Pat. Office* 55 (Oct. 9, 2001), *United States Postal Service Interruption and Emergency in Connecticut*, 1245 *Off. Gaz. Pat. Office* 16 (Apr. 13, 2001), *United States Postal Service Interruption and Emergency in the State of California*, 1176 *Off. Gaz. Pat. Office* 74 (July 18, 1995), and *United States Postal Service Interruption and Emergency in Los Angeles*, 1160 *Off. Gaz. Pat. Office* 39 (Mar. 8, 1994). The Office is amending § 1.10 to provide that the Director is designating certain events as a postal service interruption or emergency by rule (§ 1.10(g) or (h)). The Director will also continue to designate any other emergency or interruption in the "Express Mail" service on a case-by-case basis by publishing a notice in the Official Gazette Notices (§ 1.10(i)), and by posting the announcement on the Office's Internet Web site (www.uspto.gov). The Office does not consider amending the rules as suggested to be appropriate because 35 U.S.C. 21(a) requires that the postal service interruption or emergency be designated by the Director.

Section 1.12: Section 1.12(c)(1) is amended to refer to the petition fee set forth in § 1.17(g) for consistency with the change to § 1.17. See discussion of § 1.17. This amendment to § 1.12 was omitted from the notice of proposed rule making; however, the Office proposed to amend § 1.17 to make the petition fee specified in § 1.17(g) applicable to petitions under § 1.12 for access to an assignment record in the notice of

proposed rule making. See *Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan*, 68 FR at 53822, 53847, 1275 *Off. Gaz. Pat. Office* at 28, 50.

Section 1.14: Section 1.14(h)(1) is amended to refer to the petition fee set forth in § 1.17(g) for consistency with the change to § 1.17. See discussion of § 1.17 for comments related to the increase of the petition fees.

Comment 17: One comment did not respond to the change proposed for § 1.14, but instead proposed that the rule be amended to provide that an application that is incorporated by reference be available to the public rather than become available to the public only once abandoned.

Response: A copy of the originally filed application papers of a pending application that has been incorporated by reference is available to the public pursuant to § 1.14(a)(1)(vi), although the file contents of such an application are not available to the public. The Office currently has systems that permit a copy of the application as originally filed to be made available to the Office of Public Records for sale to the public without interference with the examination of the patent application. Copying of the entire application file contents will, unless the application has an image file, interfere with examination or printing of the application as a patent, unless the application has become abandoned. As a result, the Office does not permit the file of an application that has been incorporated by reference to be made available to the public. Once the Office's computer systems provide for access to the public at the same time that the patent application is being examined, the Office may provide access to the entire application file, however, the Office does not currently have a mechanism to provide the public with access to the image file wrapper of an application that has been incorporated by reference.

Section 1.17: Section 1.17 is amended to adjust petition fees required to be established under 35 U.S.C. 41(d) to more accurately reflect the Office's cost of treating petitions. The Office is directed by 35 U.S.C. 41(d) to set fees for services not set under 35 U.S.C. 41(a) or (b) so as to recover the average costs of performing the processing or service. Under amended § 1.17, petition fees established pursuant to 35 U.S.C. 41(d) are provided for in new § 1.17(f) (\$400) and (g) (\$200) and amended § 1.17(h) (\$130). Paragraphs (f), (g) and (h) of amended § 1.17 replace former § 1.17(h).

The Office conducted an activity-based-accounting cost (ABC) analysis of

the Office's cost of treating the various petitions previously enumerated in former § 1.17(h), which petitions are now enumerated in § 1.17(f) through (h). The Office determined that a single \$130.00 petition fee does not recover the Office's costs of treating many of these types of petitions. The Office also determined that there is a significant difference in the Office's costs for treating these types of petitions. Therefore, § 1.17(f) through (h) separate petition types into three groups, and provide separate petition fees for each of the three groups to more accurately reflect the cost of treating petitions within these three groups. In those instances in which a petition seeks action under more than one rule, the petition fee will be that of the rule with the highest fee under which the petition seeks action.

The highest cost group of petitions is covered by new § 1.17(f), which specifies a petition fee of \$400. The petitions in this group are: (1) Petitions under § 1.53(e) to accord a filing date; (2) petitions under § 1.57(a) to accord a filing date; (3) petitions under § 1.182 for decision on a question not specifically provided for; (4) petitions under § 1.183 to suspend the rules; (5) petitions under § 1.378(e) for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent; (6) petitions under former § 1.644(e) in an interference; (7) petitions under former § 1.644(f) for requesting reconsideration of a decision on petition in an interference; (8) petitions under former § 1.666(b) for access to an interference settlement agreement; (9) petitions under former § 1.666(c) for late filing of an interference settlement agreement; and (10) petitions under § 1.741(b) to accord a filing date to an application under § 1.740 for extension of a patent term. Petitions in this first group incur the highest costs because they require analysis of complex and unique factual situations and evidentiary showings. Often a petition in this group will involve an issue of first impression requiring review and approval of a course of action by senior Office officials.

The intermediate cost group of petitions is covered by new § 1.17(g), which specifies a petition fee of \$200. The petitions in this group are: (1) Petitions under § 1.12 for access to an assignment record; (2) petitions under § 1.14 for access to an application; (3) petitions under § 1.47 for filing by persons other than all the inventors or a person not the inventor; (4) petitions under § 1.59 for expungement of information; (5) petitions under

§ 1.103(a) to suspend action in an application; (6) petitions under § 1.136(b) to review requests for extension of time when the provisions of § 1.136(a) are not available; (7) petitions under § 1.295 for review of a refusal to publish a statutory invention registration; (8) petitions under § 1.296 to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued; (9) petitions under § 1.377 for review of a decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent; (10) petitions under § 1.550(c) for patent owner requests for extension of time in *ex parte* reexamination proceedings; (11) petitions under § 1.956 for patent owner requests for extension of time in *inter partes* reexamination proceedings; (12) petitions under § 5.12 for expedited handling of a foreign filing license; (13) petitions under § 5.15 for changing the scope of a license; and (14) petitions under § 5.25 for a retroactive license. Petitions in this second group incur intermediate costs because, although they also require analysis of factual situations and evidentiary showings, the factual situations and evidentiary showings for this second group of petitions often fall into recognizable patterns. On occasion, however, a petition in this second group will involve an issue of first impression requiring review and approval of a course of action by senior Office officials.

The remaining group of petitions is covered by § 1.17(h), which continues to specify the current petition fee of \$130. The petitions in this group are: (1) Petitions under § 1.19(g) to request documents in a form other than that provided in this part; (2) petitions under § 1.84 for accepting color drawings or photographs; (3) petitions under § 1.91 for entry of a model or exhibit; (4) petitions under § 1.102(d) to make an application special; (5) petitions under § 1.138(c) to expressly abandon an application to avoid publication (6) petitions under § 1.313 to withdraw an application from issue; and (7) petitions under § 1.314 to defer issuance of a patent. Petitions in this third group incur the least costs, as they require review for compliance with the applicable procedural requirements, but do not often require analysis of varied factual situations or evidentiary showings.

Section 1.17(i) is also amended to reflect the required processing fee of § 1.291(c)(5) for a second or subsequent protest by the same real party in interest.

Comment 18: One comment objected to the proposed change in that switching from one petition fee to three petition fees under § 1.17(f), (g) and (h) will cause applicants unfamiliar with the three new petition fees to make petition fee payment errors that will lead to additional work.

Response: The Office has determined that the benefits of recovering the costs of responding to petitions, in a stratified scheme, outweigh the costs of potential errors in administration of the fees. The fees for the petitions grouped under § 1.17(f) through (h) are not set by 35 U.S.C. 41(a) and (b). Rather, the fees for these petitions are among the fees required to be established under 35 U.S.C. 41(d) in order to recover the estimated average cost to the Office. The Office conducted an activity-based-accounting cost (ABC) analysis of the Office's cost of treating the petitions grouped under § 1.17(f) through (h) and determined that there is a significant difference in the Office's costs for treating these petitions. A less administratively burdensome approach would have been for the Office to have simply raised the fee under former § 1.17(h) based on a lump sum average cost of treating all the petition fees which must be established pursuant to 35 U.S.C. 41(d). The Office decided against lumping all these petitions together due to the significant cost difference for treating these petitions. The Office determined that actual costs could be fairly recovered based on three groups of petition fees without overly complicating petition fee payment and processing, particularly because each rule section for which a petition fee is associated has a single fee assigned. It is noted that 35 U.S.C. 41(a) and (b) set different fees for various other types of petitions including three groups of petition fees for extensions of time. Furthermore, the various patent fees specified in 35 U.S.C. 41(a) and (b) are generally changed each fiscal year. The Office minimizes any confusion resulting from fee changes and fee groupings by publishing fee changes under 35 U.S.C. 41(a) and (b) in the Official Gazette for Patents, on the Office's Internet Web site, and in various communications sent to practitioners and applicants. In keeping with this practice, the Office will similarly publish the petition fees under § 1.17(f) through (h) which have been established pursuant to 35 U.S.C. 41(d).

Comment 19: Some comments argued that the \$400 fee for petitions under § 1.17(f) is excessive, noting that this amount is comparable to the basic small entity patent application filing fee.

Response: The \$400 fee is based on an activity-based-accounting cost analysis of the Office's cost of treating the petitions grouped under new § 1.17(f). The argument that comparing the basic small entity filing fee to the § 1.17(f) petition fee suggests the § 1.17(f) petition fee to be excessive fails to recognize that filing fees set under 35 U.S.C. 41(a) do not recover the cost of patent application processing and examination. A larger portion of this cost recovery is attributable to patent maintenance fees, as well as the other fees provided under 35 U.S.C. 41, rather than the filing fee alone.

Comment 20: One comment stated that the fee under new § 1.17(f) is satisfactory for petitions to accord a filing date provided the Office will refund the fee when the failure to originally accord the requested filing date was the result of Office error (e.g., lost papers in the Office). Another comment which argued that the fee under new § 1.17(f) is excessive, also stated that the petition fee should be refunded when a granted petition was required to correct an Office error.

Response: In keeping with Office practice when former § 1.17(h) applied to filing date petitions, the petition fee under new § 1.17(f) will be refunded where a petition to accord an application filing date was required to correct solely an Office error. In addition, for an application filed in accordance with § 1.10, there is no fee required to accord the application a filing date under § 1.10(c), (d) or (e).

Comment 21: One comment suggested that the petition fees under § 1.17(f) through (h) apply only to large entities and that no petition fee be charged to any small entity.

Response: This suggestion cannot be adopted. As set forth in 35 U.S.C. 41(h), small entity fee reduction only applies to fees charged under 35 U.S.C. 41(a) or (b). As the petition fees under § 1.17(f) through (h) are required to be established under 35 U.S.C. 41(d), small entity fee reduction does not apply. Further, where small entity fee reduction is available, it is only available for a fifty percent reduction of fees.

Comment 22: One comment suggested that petitions for express abandonment to avoid patent application publication under § 1.138(c) should fall under § 1.17(h) where the petition fee is \$130.00, rather than under § 1.17(g) where the petition fee is \$200.00.

Response: The suggested change has been adopted.

Section 1.19: Section 1.19 is amended to rewrite former paragraph (b) in order to provide for different fees for copies of

patent application documents, according to the medium or means by which the copy is provided. In paragraph (b) of § 1.19, "certified and uncertified" has been removed as unnecessary since all copies provided under this paragraph will be certified. Lastly, paragraph (g) is added to require a petition to obtain copies of documents in a form other than provided for in the patent rules. Such a petition was originally proposed as paragraph (h), and paragraph (g) was proposed to provide for at cost copies of documents. The previously proposed paragraph (g) has been determined to be unnecessary in view of § 1.21(k). Accordingly, the paragraph proposed as (h) will be designated as paragraph (g).

Section 1.19 is amended to clarify that copies of documents may be provided to the public in whole, or in part, in electronic image form at the Office's option. In view of the ever-increasing size of submissions, many of the Office official records need to, and will, be received, stored and maintained in electronic form. As a result of the Office's migration to electronic storage of documents and the IFW system, § 1.19 has been amended to reflect that the Office may, at its option, provide copies of documents in an electronic form (e.g., on compact disc, or other physical electronic medium, or by electronic mail, if an electronic mail address is given). A request for a document in another form (e.g., a voluminous document on paper) that would impair service to other users would be complied with on a case-by-case basis as provided in new § 1.19(g). Hence, although the rule provides a fee for ordering copies of Office documents in various forms, the Office, at its option, may elect to supply the requested copies on paper, or in an electronic form, as determined to be appropriate by the Director, depending upon which is most expedient and cost-effective from an Office perspective.

In amending § 1.19(b), former paragraphs (b)(1) through (b)(3) have been rewritten as paragraphs (b)(1) and (b)(2), while removing the seven-day requirement of former § 1.19(b)(1) for processing copy requests.

Paragraph (b)(1) of § 1.19 sets forth the fees for a copy of a patent application as filed, or a patent-related file wrapper and contents, that is stored in paper in a paper file wrapper, or in an image format in an image file wrapper. In paragraph (b)(1) of § 1.19, three sets of fees are set forth. Paragraph § 1.19(b)(1)(i) sets forth the fees for documents supplied on paper, with different fees for an application as filed, a file wrapper and contents of a patent

application up to 400 pages, an additional fee for each set of additional pages of a file wrapper and contents, and an individual document. Paragraph 1.19(b)(1)(ii) sets forth the fees for documents supplied on compact disc, or on another physical electronic medium, with different fees for an application as filed, and for a file wrapper and contents of a patent application. Pursuant to § 1.19(b)(1)(ii)(C), if the file wrapper and contents or the individual document requires more than a single electronic medium (e.g., a compact disc) to hold all the pages in a single order, then a fee of \$15.00 will be required for each continuing electronic medium. Paragraph 1.19(b)(1)(iii) sets forth the fees for documents supplied electronically other than on compact disc or other physical electronic medium. Paragraph 1.19(b)(1)(iii) fees would apply to copies supplied by electronic mail, or otherwise over the Internet. Lengthy documents, however, will not be transmitted electronically. For example, a document over one hundred megabytes, or a document that will take longer than twenty minutes to transmit over a slow speed transfer, will not be transmitted, but will, instead, be provided on physical electronic media, by mail.

The addition of § 1.19(b)(1)(ii)(B) permits the Office to supply the file wrapper and contents including the prosecution history of an application on a compact disc for \$55 rather than on paper for the paper rate of \$200 for the first 400 pages and additional amounts for extra pages.

A "document" according to paragraph 1.19(b)(1)(i)(D) would include the transmittal paper for an Information Disclosure Statement (IDS) and the list of references cited (e.g., PTO-SB08 or 1449 form), but the individual references included with the IDS would be separate documents. Also, each individual volume of a multi-volume reference would be a separate document. U.S. patent and U.S. patent application publication references are not stored in the IFW as part of the application file and would not be included with an order for a copy of the file contents, but can be purchased separately, with the fee set forth in § 1.19(a). Individual documents maintained in the electronic file, other than the patent application as filed, are not available to be purchased electronically because individual documents in the electronic file may be different, and much smaller, documents than in the paper file (an amendment would be one document in paper, but separated into different documents, "Remarks", "spec" and "claims", e.g.,

in the electronic file), and the different definition of the documents would lead to confusion. In addition, since the fees charged for electronic documents are much smaller than for paper documents, requiring the entire file wrapper to be purchased for \$55.00 is more efficient than allowing one or two documents to be purchased from a large file.

Paragraph 1.19(b)(2) sets forth the fees for patent-related file wrapper contents that were submitted on compact disc, or in electronic form, and not stored in paper in a paper file wrapper, or in an image format in an IFW. Such patent-related file wrapper contents that are not stored in paper, or in an image format, include a Computer Readable Form (CRF) of a Sequence Listing, a table, or a computer program listing submitted on a compact disc pursuant to § 1.52(e)(1). Such items are stored in an Artifact Folder which is associated with a patent application. In paragraph 1.19(b)(2)(i) a fee is set forth for a copy of such an item if provided on a compact disc, and in paragraph 1.19(b)(2)(ii) a fee is set forth for a copy of such an item is provided electronically (*e.g.*, by electronic mail) other than on a physical electronic medium. Paragraph 1.19(b)(2) does not apply to other documents that are stored in an Artifact Folder, and not stored in an IFW in image form, such as documents (blueprints and other oversized documents, or documents that are illegible) that could not be scanned. The fee for such documents is set forth in § 1.21(k).

Prior §§ 1.19(b)(1) and (2) did not provide for supplying copies of the non-paper (or image) portion of a file wrapper (*e.g.*, compact discs or electronically filed applications). Under prior practice, for example, copies of compact discs associated with a file wrapper would have been ordered under prior § 1.19(b)(3) and were not provided with an order for the paper portion of a file wrapper under prior §§ 1.19(b)(1) or 1.19(b)(2). Nothing in these rule changes will change the practice of a separate order being required for documents or materials not maintained in the paper file wrapper or IFW, except that the fee is now set forth in § 1.19(b)(2). Paragraph (D) is added to § 1.19(b)(1)(i) to provide for copies of an individual document instead of an entire file wrapper. The fee for copies of other items not in the IFW portion of a file wrapper (*e.g.*, blueprints or documents that cannot be scanned, microfiche, and video cassettes) is an at-cost fee as set forth in § 1.21(k). In the event the Office cannot fill an order solely from the IFW, and must complete an order in part by copying a document

in an Artifact Folder or paper file, the fee under § 1.21(k) (*e.g.*, at cost for blueprints) will apply, except that the fee for compact disc copies under § 1.19(b)(2) will apply to any copies of compact discs maintained in the Artifact Folder corresponding to the IFW, or paper application file.

Patent applications and patents should reference any compact discs that are a part of the application specification. The public should therefore review the specification to determine if an order for compact discs should be included with an order to obtain the contents of an application or file wrapper. Other items or materials associated with a file wrapper (*e.g.*, blueprints, video cassettes, compact discs, or exhibits which are not part of the specification) may not be referenced in the specification of an application or patent. Apart from an Artifact Sheet, the Office does not maintain an index of other items or materials associated with any specific file wrapper. Accordingly, the public should carefully review the contents of a file wrapper to determine if other items or materials associated with a file wrapper need to be separately ordered. If the application is maintained in the IFW system, then documents that cannot be scanned will be maintained in an Artifact Folder, and the fee for obtaining copies of such documents is set forth in either § 1.19(b)(2) (copies of compact discs) or § 1.21(k). For example, an application that is not filed on the appropriate size paper, or that cannot be scanned, will not be added to the IFW and will be treated as an artifact, and maintained in a separate "Artifact Folder." The fee for obtaining a copy of such a document that could not be scanned is set forth in § 1.21(k) (at cost). In order to avoid significant delays and expense in obtaining a certified copy of an application as originally filed, applicants should ensure that application papers are legible and may be accurately reproduced.

Although neither paragraph (b)(1)(iii) nor paragraph (b)(2)(ii) of § 1.19 expressly contains a size limitation for high speed transmission, *e.g.*, DSL or cable connectivity, or a time limitation for slower connectivity, the Office is concerned about the ability to maintain a connection for a larger file size or longer transmission period. Currently, 100 MB is the limit adopted for the Office's EFS software. Accordingly, if the document has a file size of, for example, 100 MB or greater, the document will not be transmitted electronically, and instead will be copied onto a compact disc or other physical electronic media and mailed to

the requester. The Office does not want to tie up Office resources for long unreliable file transfer transmissions.

The subject matter of former paragraph 1.19(b)(3) has been moved to paragraph (b)(2)(i), except that a copy provided on a physical medium such as a compact disc is no longer limited to information that was originally submitted on a compact disc. Former paragraph 1.19(b)(4) has been reworded as "Copy of Office records, except copies available under (1) or (2) of this paragraph" to clarify that records such as a part of an application's image file wrapper that can be purchased pursuant to paragraph 1.19(b)(1) or (2) must be ordered pursuant to those paragraphs, and renumbered as paragraph 1.19(b)(3). Paragraph 1.19(b)(5) has been renumbered as paragraph 1.19(b)(4).

Section 1.19(g) had been proposed to be added to provide for copying items or material that is not image scanned, but the new paragraph has not been added because the fee has been determined to already be set forth in § 1.21(k). Items such as large blueprints, microfiche, and video cassettes cannot be scanned as electronic image equivalents, and an average cost for pricing cannot be computed in advance, because the demand for such copies is so infrequent. Furthermore, documents that were too light to be scanned or that provide insufficient contrast to be scanned will not be added to the IFW system because they would not be useful in the IFW system. In addition, the Office will not conduct special processing of documents to put the documents into IFW, but will instead require applicants to resubmit the documents in compliance with Office rules. The Office will charge the actual cost of the special processing required to copy these items or materials pursuant to § 1.21(k).

Section 1.19(g) provides for a mechanism for requesting copies of documents in a form other than that normally provided by the Office. The copies are provided at cost. For example, the Office will normally provide copies of documents that are over 20 pages, if the application has an IFW, on an electronic medium such as a compact disc, even if paper was requested. If the Office-stored documents are in paper, rather than image form, paper will generally be provided unless the document is voluminous. A petition would be required for the order to be filled in paper, and in such an instance either an at cost fee, or the fee set forth in 35 U.S.C. 41(d)(2), would be required, as appropriate. Another example is the instance where a copy of an application

is so voluminous that many boxes of compact discs are required to fill the order. If compact discs are the normal electronic medium in which such an order would be filled, a requester could petition that the order be filled on another media such as a DVD media. Such petitions would be decided under § 1.19(g) based upon the ability of the Office to provide the requested service and the adverse impact to the Office and the public from diverting resources to fulfilling the order.

Comment 23: A comment noted that the rule change preamble indicates that this is a clarification that the Office will provide copies of documents in electronic image form at the Office's option but that the rule itself fails to reflect this.

Response: The comment has been adopted and § 1.19(b) now explicitly provides that documents are to be provided in paper or in electronic form as determined by the Director.

Comment 24: A comment noted that the Office was considering eliminating additional page fees and adopting a single fee concept for copies but the comment refused to endorse the idea without a numerical analysis of the costs and fees.

Response: Since the Office did not receive support for eliminating the additional page fees for copies of application files provided on paper that exceed 400 pages, the additional fee was retained.

Comment 25: One comment requests that the contents of applications be available on the Office's Internet Web site at no cost.

Response: The Office now provides free electronic access to many electronic records for published applications, and applications that have issued as patents through the public PAIR system. In the summer of 2004, this access will be expanded to include access to the IFW (excluding non-patent literature) of any application that is available through public PAIR. A private version of this tool already provides access to IFW applications.

Comment 26: One comment observes that the rule making does not provide the cost basis for the fees and contends that fees should be lower for making copies from IFW.

Response: The fee provisions have been revised to base the fee on how the copy is supplied instead of how the copy is obtained from Office records. Thus, the provisions of § 1.19(b) are linked to supplying copies on paper (§ 1.19(b)(1)(i)), or electronically (§§ 1.19(b)(1)(ii) or 1.19(b)(1)(iii)). This is because the Office expects to have converted most of its pending paper

application files to IFW by September 2004. As indicated, the Office intends to supply a copy in electronic or paper form based upon the factors of expediency and cost-effectiveness, and applicants are expected to, on the whole, be paying lower fees for copies as copies will generally be supplied in electronic form, which have lower fees than paper copies. In addition, since the fee for certification of a document has been eliminated, customers will be spared that fee as well. All documents provided pursuant to § 1.19(b) will be certified.

Comment 27: One comment urged a trial period for the electronic form of documents and methods of reducing costs by changing the way documents are stored.

Response: The comment was not adopted. As the Office becomes more experienced with the IFW system, and accustomed to providing documents electronically, the Office does not object to revising the rules and practices to reflect any reduced costs.

Comment 28: One comment stated that electronic files are unusable.

Response: The Office experience is that electronic image files are usable provided that the user employs appropriate hardware and software which is readily available in the marketplace. Users who attempt to use electronic files with hardware and software not adapted to the task of viewing electronic image files will of course have difficulty.

Section 1.27: Section 1.27 is amended to make certain clarifying changes. The changes clarify that: (1) a security interest held by a large entity is not a sufficient interest to bar entitlement to small entity status unless the security interest is defaulted upon; (2) the requirements for small business concerns regarding non-transfer of rights and the size standards of the Small Business Administration are additive; and (3) business concerns are not precluded from claiming small entity status merely because they are located in or operate primarily in a foreign country.

Section 1.27(a) is amended to add a new paragraph (a)(5) which states that a security interest does not involve an obligation to transfer rights in the invention unless the security interest is defaulted upon. Questions have arisen as to whether a security interest held by a large entity in a small entity's application or patent is a sufficient interest to prohibit claiming small entity status. For example, an applicant or patentee may take out a loan from a large entity banking institution and the loan may be secured with rights in a

patent application or patent of the applicant or patentee, respectively. The granting of such a security interest to the banking institution is not a currently enforceable obligation to assign, grant, convey, or license any rights in the invention to the banking institution. Only if the loan is defaulted upon will the security interest permit a transfer of rights in the application or patent to the banking institution. Thus, where the banking institution is a large entity, the applicant or patentee would not be prohibited from claiming small entity status merely because the banking institution has been granted a security interest, but if the loan is defaulted upon, there would be a loss of entitlement to small entity status. Pursuant to § 1.27(g), notification of the loss of entitlement due to default on the terms of the security interest would need to 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 small entity status is no longer appropriate.

Section 1.27 was proposed to be amended to revise paragraphs (a)(1), (a)(2)(i), and (a)(3)(i) to change "obligation" to "currently enforceable obligation." In view of a comment that was received, § 1.27 is not being amended to revise paragraphs (a)(1), (a)(2)(i), and (a)(3)(i) to change "obligation" to "currently enforceable obligation." Instead, § 1.27(a) is amended to add new paragraph (a)(5) which states that a security interest does not involve an obligation to transfer rights in the invention unless the security interest is defaulted upon. The addition of paragraph (a)(5) is intended to clarify that a security interest in an application or patent held by a large entity would not be a sufficient interest to bar entitlement to small entity status unless the security interest is defaulted upon. The change does not result in any change to the standards for determining entitlement to small entity status.

A few additional examples will further clarify when small entity status is or is not appropriate.

Example 1: On January 2, 2002, an application is filed with a written assertion of small entity status and the small entity filing fee is paid. Applicant is entitled to claim small entity status when the application is filed. Thereafter, the application is allowed and the small entity issue fee is timely paid on October 1, 2002. On October 2, 2002, applicant signs a license agreement licensing rights in the invention to a large entity. On October 1, 2002, applicant had not transferred any rights in the invention, and was

under no obligation to transfer any rights in the invention, to any other party who would not qualify for small entity status.

Analysis: The payment of the small entity issue fee would be proper as long as the applicant was under no obligation on October 1, 2002, to sign the license agreement with the large entity.

Example 2: An applicant, who would otherwise qualify for small entity status, executes an agreement with a large entity. The agreement requires the applicant to assign a patent application to the large entity sixty days after the application is filed. Thereafter, the application is filed.

Analysis: Since the applicant is under an existing obligation to assign the application to a large entity, the applicant would not be entitled to claim small entity status. The applicant would need to pay the large entity filing fee even though the actual assignment of the application to the large entity may not occur until after the date of payment of the filing fee.

Section 1.27(a)(1) is amended to omit the comma after “invention)” in the first sentence. The second sentence of § 1.27(a)(1) has been amended to add the phrase “in the invention to one or more parties” after the first occurrence of “rights.”

Furthermore, § 1.27 is amended to change the period at the end of paragraph (a)(2)(i) to “; and” to clarify that paragraphs (a)(2)(i) and (a)(2)(ii) are additive requirements and a party seeking to qualify as a small business must meet the requirement as to transfer of rights as well as the Small Business Administration size standards.

Section 1.27(a)(2)(ii) is amended to change “[m]eets the standards set forth in 13 CFR part 121” to “[m]eets the size standards set forth in 13 CFR 121.801 through 121.805 to be eligible for reduced patent fees.”

Questions have also arisen as to whether a small business concern must have a place of business located in the United States, and operate primarily within the United States, or make a significant contribution to the United States economy through the payment of taxes or use of American products, materials or labor (13 CFR 121.105) to be eligible to pay reduced patent fees under 35 U.S.C. 41(h). When the provisions of 35 U.S.C. 41(h) (Public Law 97–247, 96 Stat. 317 (1982)) were implemented in 1982, a suggestion that foreign concerns not be eligible to pay reduced patent fees under 35 U.S.C. 41(h) was considered and rejected because excluding foreign concerns would violate United States treaties in the patent area. *See Definition of Small*

Business for Paying Reduced Patent Fees Under Title 35, United States Code, 47 FR 43272 (Sept. 30, 1982), 1023 *Off. Gaz. Pat. Office* 27 (Oct. 19, 1982) (final rule). Specifically, a provision that foreign concerns are not eligible to pay reduced patent fees under 35 U.S.C. 41(h) would violate Article 2 of the Paris Convention for the Protection of Industrial Property, which provides that nationals of any Paris Convention country shall, as regards the protection of industrial property, enjoy in all the other Paris Convention countries the advantages that their respective laws grant to nationals of that country. Therefore, a business concern which meets the small business size standards set forth in 13 CFR 121.801 through 121.805 and complies with applicable Office procedures is and continues to be eligible to pay reduced patent fees under 35 U.S.C. 41(h), even if the business concern is located in or operates primarily in a foreign country.

Comment 29: One comment stated that the Office should draft its own rules for small business concerns so that they would be easier to find and follow and thus allow for a clearer understanding of the qualifications and standards that are required.

Response: Public Law 97–247 gave the Small Business Administration (SBA) the authority to establish the definition of a small business concern. 35 U.S.C. 41(h)(1) states that “[f]ees charged under subsection (a) or (b) shall be reduced by 50 percent with respect to their application to any small business concern as defined under section 3 of the Small Business Act, and to any independent inventor or nonprofit organization as defined in regulations issued by the Director.” Thus, the Office does not have the statutory authority to draft its own rules for small business concerns. Reproducing the pertinent SBA regulations in patent materials would be unduly burdensome upon the Office, particularly as it would need to constantly monitor SBA rule changes.

Comment 30: One comment stated that the change from “standards” to “size standards” should be made retroactive to the effective date of the first small entity regulations. The comment stated that if the amendment is not made retroactive, “it would imply that the amendment is a change of law, not a clarification of the existing law.”

Response: This rule change is a clarification of existing practice regarding the requirements to claim small entity status, and is not a change in practice.

Comment 31: One comment requested that the Office explicitly confirm that it

is not necessary for a business entity that does not operate primarily within the United States to make a significant contribution to the U.S. economy through payment of taxes or use of American products, materials or labor as set forth in 13 CFR 121.105(a) in order to be considered a small business concern.

Response: As indicated above, a business concern only has to meet the small business requirements set forth in 13 CFR 121.801 through 121.805 and comply with applicable Office procedures. Therefore, it is not necessary for a business entity that does not operate primarily within the United States to make a significant contribution to the U.S. economy through payment of taxes or use of American products, materials or labor as set forth in 13 CFR 121.105(a) in order to be considered a small business concern.

Comment 32: One comment stated that the Office should waive for a limited time the three-month time limit in § 1.28(a) for refund requests made by an applicant who transferred U.S. rights to a foreign business entity that met the size standards in 13 CFR 121.801 through 121.805, but who did not claim small entity status because the foreign business entity was not a business concern as defined in 13 CFR 121.105(a). The waiver is deemed justified since whether a foreign business concern made a significant contribution to the U.S. economy never did affect eligibility to pay reduced patent fees and applicants may have been misled by previous statements by the Office to the contrary. *See Changes to Implement the Patent Business Goals*, 65 FR 54603, 54612 (Sept. 8, 2000), 1238 *Off. Gaz. Pat. Office* 77, 85 (Sept. 19, 2000) (final rule).

Response: The suggestion is not adopted. If an applicant disagreed with the Office’s interpretation of the small business provisions, the applicant should have challenged it at the time of fee payment. By paying the fees in the large entity amount, applicant acquiesced in the position that was held by the Office at that time.

Comment 33: One comment stated that adding the phrase “currently enforceable obligation” appears to have consequences beyond removing a security interest from being an obligation to transfer rights. As an example, the comment stated that an agreement that provided that an employee was obligated to assign the entire right, title and interest in the invention to an employer on or after the date of issue of the patent would not be enforceable before the patent was issued, and thus the inventor would be

able to claim small entity status regardless of whether the employer was a small business concern.

Response: The comment has been adopted. The Office only intends to address the issue of security interests and does not want to unintentionally cover other situations. Therefore, as indicated above, § 1.27(a) has not been amended to include the phrase “currently enforceable obligation” as was originally proposed. Instead, a new paragraph (a)(5) has been added which states that a security interest does not involve an obligation to transfer rights in the invention for the purposes of paragraphs (a)(1) through (a)(3) unless the security interest is defaulted upon. In the example provided in the comment, the inventor would not be able to claim small entity status if the employer was a large business concern. This is because the employee would be under an existing obligation to assign the entire right, title and interest in the invention to the employer, even though the employee would not have to do so until after the patent has issued.

Comment 34: One comment suggested that the comma after “invention” in the first sentence of § 1.27(a)(1) should be omitted since the comma appears out of place.

Response: The suggestion has been adopted.

Comment 35: One comment stated that the punctuation of the second sentence of proposed § 1.27(a)(1) seems awkward. Alternative suggestions to reword the sentence were made. One suggestion was to place the second comma after the second occurrence of “rights.” The other suggestion was to add the phrase “in the invention to one or more parties” after the first occurrence of “rights.”

Response: The suggestion to reword the second sentence has been adopted. The phrase “in the invention to one or more parties” has been added after the first occurrence of “rights” in the second sentence.

Comment 36: Two comments requested that the Office clarify whether or not an applicant is entitled to small entity status where the invention is software and applicant licenses the software to a large entity through shrink-wrap licenses or otherwise. One of these comments also asked whether “rights in the invention” only constitute the exclusionary rights that a patent provides or whether it also includes a right to use the embodiments of the invention.

Response: As stated in MPEP § 509.02, “[r]ights in the invention include the right to exclude others from making, using, offering for sale, or

selling the invention throughout the United States or importing the invention into the United States.” MPEP § 509.02 also states that “[i]mplied licenses to use and resell patented articles purchased from a small entity * * * will not preclude the proper claiming of small entity status.” Thus, a distinction exists between rights in the application or patent and the use of the patented product. The use of a patented product by a large entity does not affect small entity status. On the other hand, rights in an application or patent by a large entity would preclude the claiming of small entity status. If the shrink-wrap license only licenses the use of a patented product by a large entity and does not grant any ownership rights in the patent to the large entity, then it would not preclude the claiming of small entity status.

Section 1.47: Section 1.47(a) and (b) are amended to refer to the petition fee set forth in § 1.17(g) for consistency with the change to § 1.17. See discussion of § 1.17 for comments related to the changes in the petition fees.

Section 1.52: Section 1.52, paragraphs (b)(2)(ii) and (e), are amended.

Section 1.52, paragraphs (b)(1)(ii) and (d)(1) were proposed to be amended to require that the statement that the translation is accurate be signed by the individual who made the translation, but these proposed changes have not been included in the final rule as the changes are not deemed to be necessary in view of the requirements of § 10.18, as explained below. See also §§ 1.55(a)(4), 1.69(b) and 1.78(a)(5)(iv).

Section 1.52(e)(1)(iii) is amended to allow greater flexibility in filing tables on compact disc, so that compact disc files may be used instead of paper where the total number of pages collectively occupied by all the tables in an application exceeds one hundred. Also, § 1.52(e)(1)(iii) is clarified to be consistent with tables submitted on paper as to what constitutes a page. Section § 1.52(e)(3)(i) is amended to recite that CD-R discs should be finalized so that they are closed to further writing. Finally, § 1.52(e)(3)(ii) is clarified to indicate that landscape orientation of a table is an example of special information needed to interpret a table that is to be provided on a transmittal letter.

Section 1.52(b)(2)(ii) is revised to recommend that the font size of text be at least a font size of 12, which is approximately 0.166 inches or 0.422 cm. high. Section 1.52(b)(2)(ii) requires that the text be in a lettering style that is at least 0.08 inches high, which is the font size set forth in Patent Cooperation

Treaty (PCT) Rule 11.09. A font size of only 0.08 inches, however, leads to difficulty in capturing text with optical character recognition technology and may not be reproducible as required by § 1.52(a)(1)(v) (and PCT Rule 11.2(a)). A font size of 12 (0.422 cm. or 0.166 inch high) is significantly more reproducible. Accordingly, § 1.52(b)(2)(ii) is amended to indicate a preference for a larger font size. See § 1.58(c) for a similar change.

Section 1.52(e)(1)(iii) is amended to allow tables of any size when there are multiple tables on compact disc if the total number of pages of tables exceeds one hundred pages. Since permitting the filing of tables on compact disc, the Office has received voluminous applications having large numbers of tables, each of which are under 50 pages in length. Applicants have indicated that it would be less burdensome filing these small tables on compact disc (CD). Accordingly, the rule is being liberalized while balancing the convenience of the Office and the public to view the document with the least burden imposed by dual media (*i.e.*, paper specification and tables on compact disc). The extra bulk of a few extra pages of paper specification is usually less burden than having to go to a CD for the additional pages.

Section 1.52(e)(1)(iii) is also amended to clarify what constitutes an electronic page so as to determine compliance with the fifty- and one hundred-page requirement for submission of tables on compact disc.

Further clarification is provided in § 1.52(e)(3)(i) as to what is a permanent CD. Recordable CDS can be made for recording in a single recording session or in multiple recording sessions. To further assure the archival nature of the discs, the requirement that recordable CDS be finalized so that they are closed to further recording is added to § 1.52(e)(3)(i). Further, many older CD-ROM drives and audio CD players have compatibility problems with unfinalized CDS. This change will ensure that the public and the Office will be able to use identical copies of any CDS filed with older CD-ROM drives.

The Office is actively investigating allowing the submission of other file formats, such as the Continuous Acquisition and Life-Cycle Support (CAL) XML format, in addition to the current ASCII format. Before allowing the use of a particular file format, the Office must verify that applicants will have the tools to create files easily that are of archival format and quality, and can be rendered to be viewable both by the Office users and later by the public when the application is published. Problems involving file size limitations,

software display, and availability of adequate table creation software are delaying implementation at this time. The Office intends to broaden § 1.52 to allow at least CALS format tables when these problems are resolved. Technical specifications and a discussion of operability issues for the CALS table format may be found at the OASIS, *i.e.*, Organization for the Advancement of Structured Information Standards, Web site pages <http://www.oasis-open.org/cover/tr9502.html> and <http://www.oasis-open.org/specs/a501.htm>.

The Office is also reviewing the acceptability of DVD media. At present, there are several different types of recordable DVD media and it is unclear which, if any, will become a standard archival format. Also, the Office is upgrading its capabilities to include the ability to read at least some types of DVD media. It does not appear, however, that any DVD readers can be procured that will be able to read all of the different types of DVD media that are now in the marketplace. The Office is considering allowing submissions on at least some types of DVD media when it becomes clear which types of DVD media are to be recognized as being an archival quality and are compatible with Office hardware and software.

Section § 1.52(e)(3)(ii) is clarified to indicate that landscape orientation of a table is an example of special information needed to interpret a table that should be provided on a transmittal letter. The Office has received several patent applications which had tens of thousands of pages of a landscape table that was inaccurately rendered in portrait mode because the page orientation was not identified. Most tables filed with patent applications are intended to be rendered in portrait mode. Accordingly, filings without an identification of landscape mode will continue to be rendered as portrait mode tables.

Comment 37: Many comments indicated the proposed requirement was unnecessary and impractical, particularly where the translation is of an oath or declaration form, and the person who made the original translation is no longer available.

Response: The suggestion to not include the proposed revision to § 1.52(b)(1)(ii) and (d)(1) has been adopted. On reconsideration, the Office determined that the existing requirement that the statement that the translation is accurate is subject to the provisions of § 10.18, and as a result, such a statement would only be made if the statement was known to be true, or believed to be true, and such a conclusion would only be made after an

inquiry, reasonable under the circumstances, was made.

Comment 38: One comment stated that there is much confusion between correlating font size in points to size of capital letters in inches. When a font is referred to in points, the points measure the height from the top of the ascenders to the bottom of the descenders. Often, this can be measured by printing “fg” and measuring the height in inches from the top of the “f” to the bottom of the “g”. Thus, a capital A in Times New Roman in 12 point font has a height of about 0.125, not 0.166 in.

Response: The suggestion has been adopted and 0.166 has been changed to 0.125, and 0.422 changed to 0.3175. The Office agrees that there is much confusion about how to measure font sizes and notes that the ascenders and descenders rule is not always followed. A point in font size corresponds to $\frac{1}{72}$ of an inch (Webster’s Ninth New Collegiate Dictionary defines point as “a unit of measurement of about $\frac{1}{72}$ inch used especially to measure the size of the type”). The comment is correct in that the measurement is generally taken from the top of an “f” to the bottom of a “g,” and that for a 12-point font this measurement should be $\frac{12}{72}$ of an inch or 0.166 inch. A 12-point font is a font size that can be chosen on most word processing software, and will result in a reproducible specification, whereas 5- and 6-point fonts are generally not legible.

Comment 39: It was requested that the Office encourage the submission of tables in electronic form by eliminating the page length requirement of § 1.52(e)(1)(iii) since they cannot be accurately scanned.

Response: The comment was not adopted. The final rule page limits apply to tables submitted on compact disc as part of a paper application. Tables submitted electronically via the Office’s EFS are not subject to the page limits of the final rule.

The proposed lower page limit was carried forward in the final rule for compact disc filings to encourage filing of tables in electronic form when the overall size of the filing is large. A complete elimination of a lower page limit was not adopted for several reasons. First, certain small tables in paper, such as an index to the tables on a compact disc, make patent documents and the electronic files more usable than if all tables are on the compact disc. Second, it is difficult to quantify a benefit that justifies forcing the public to incur the additional cost and effort to review an application with a small number of tables stored as electronic tables on compact disc. Similarly, there

is an additional cost with no apparent savings for the Office to process and store the compact discs when an application contains only a few small tables.

Comment 40: One comment indicated that the proposed clarification of page size does not give guidance as to whether the table is intended for landscape or portrait rendering. It was suggested that the few landscape tables that are filed be identified in the transmittal letter.

Response: The comment was adopted. The existing rule in § 1.52(e)(3)(ii) requires the transmittal letter to contain any special information necessary to interpret the tables. This section has been clarified to give landscape orientation as an example of special information needed to interpret the tables, that may be required by the Office if not initially supplied.

Section 1.53: Section 1.53(e)(2) is amended to refer to the petition fee set forth in § 1.17(f) for consistency with the change to § 1.17. See discussion of § 1.17 for comments related to the increase of the petition fees.

Section 1.57: Section 1.57 is added to provide for incorporation by reference. Section 1.57(a) provides that, if all or a portion of the specification or drawing(s) is inadvertently omitted from an application, but the application contains a claim under § 1.55 for priority of a prior-filed foreign application, or § 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application, that was present on the filing date of the application, and the inadvertently omitted portion of the specification or drawing(s) is completely contained in the prior-filed application, the claim for priority or benefit would be considered an incorporation by reference of the prior-filed application as to the inadvertently omitted portion of the specification or drawings. Sections 1.57(b) through (e) treat incorporation by reference into an application of essential and nonessential material by: (1) providing a definition of essential and nonessential material; (2) defining specific language that must be used to trigger an incorporation by reference; (3) codifying the incorporation by reference practice as set forth in MPEP § 608.01(p), with a few changes to reflect the eighteen-month publication of applications. Section 1.57(f) treats how any insertion of previously incorporated by reference material must be added to the specification or drawings of an application. Section 1.57(g) codifies the treatment of a noncompliant incorporation by reference.

It has been held that the mere reference to another application is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure under 35 U.S.C. 112, ¶ 1. See MPEP §§ 201.06(c) and 608.01(p), and *In re de Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). Newly added § 1.57(a), however, now allows for all or a portion of the specification or drawings that is inadvertently omitted from an application containing a priority claim for a prior-filed foreign application, or a benefit claim for a prior-filed provisional, nonprovisional, or international application, to be added to the application by way of a later filed amendment if the inadvertently omitted portion of the specification or drawings is completely contained in the prior-filed application even though there is no explicit incorporation by reference of the prior-filed application. The phrase "completely contained" in § 1.57(a) requires that the material to be added to the application under § 1.57(a) must be expressly (as opposed to implicitly) disclosed in the prior application. *Cf.* PLT Rule 2(4)(iv). The claim for priority or benefit must be present on the filing date of the application in order for it to be considered an incorporation by reference of the prior-filed application under § 1.57(a). Furthermore, the material to be added to the application under § 1.57(a) must be completely contained in the prior-filed application as filed since it is the prior application as filed which is being incorporated under § 1.57(a). The nonprovisional application claiming benefit can be a continuation, divisional, or continuation-in-part of the prior application for which benefit is claimed. The purpose of § 1.57(a) is to provide a safeguard for applicants when a page(s) of the specification, or a portion thereof, or a sheet(s) of the drawing(s), or a portion thereof, is inadvertently omitted from an application, such as through clerical error.

Section 1.57(a)(1) provides that, if all or a portion of the specification or drawing(s) is inadvertently omitted from an application, the application must be amended to include the inadvertently omitted portion of the specification or drawing(s) within any time period set by the Office (should the omission first be noticed by the Office and applicant informed thereof), but in no case later than the close of prosecution as defined by § 1.114(b), or the abandonment of the application, whichever occurs earlier (should applicant be the first to notice the omission and the Office informed thereof). The phrase "or the

abandonment of the application" is included in § 1.57(a)(1) to address the situations where an application is abandoned prior to the close of prosecution, *e.g.*, the situation where an application is abandoned after a non-final Office action, as well as, the situation where an international application is abandoned without entering the national stage in favor of a continuing application under 35 U.S.C. 111(a) claiming the benefit under 35 U.S.C. 120 of the international application, and thus prosecution was never closed in the international application as defined by § 1.114(b) prior to abandonment of the international application. In order for the omitted material to be included in the application, and hence considered to be part of the disclosure, the application must be amended to include the omitted portion. While an amendment to include inadvertently omitted material may be submitted in reply to a final Office action or rejection which first raises the issue of the omitted material, such an amendment does not have a right of entry as it would be considered as an amendment under § 1.116.

In addition, § 1.57(a)(1) also requires the applicant to supply a copy of the prior-filed application, except where the prior-filed application is an application filed under 35 U.S.C. 111; to supply an English-language translation of any prior-filed application that is in a language other than English; and to identify where the inadvertently omitted portion of the specification or drawings can be found in the prior-filed application.

Section 1.57(a)(2) provides that any amendment to an international application pursuant to § 1.57(a) would be effective only as to the United States and shall have no effect on the international filing date of the application. In addition, no request to add the inadvertently omitted portion of the specification or drawings in an international application designating the United States will be acted upon by the Office prior to the entry and commencement of the national stage (§ 1.491) or the filing of an application under 35 U.S.C. 111(a) which claims benefit of the international filing date. This language in § 1.57(a)(2) as to when the Office may act upon an amendment under § 1.57(a) is necessary in order to provide for timely processing of the amendment by the Office in the event that commencement of the U.S. national phase occurred prior to the expiration of the time limit under PCT Article 22(1) of (2), or Article 39(1)(a), pursuant to 35 U.S.C. 371(f), or that an application

claiming benefit of the international application was filed well prior to such time limit.

Section 1.57(a)(3) provides that, if an application is not entitled to a filing date under § 1.53(b), the amendment must be by way of a petition accompanied by the fee set forth in § 1.17(f). 35 U.S.C. 363 provides that "[a]n international application designating the United States shall have the effect, from its international filing date under Article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office * * *" Accordingly, the international filing date of an international application is its international filing date under PCT Article 11. Consequently, the language of § 1.57(a) makes it clear that the incorporation by reference relief provided therein shall have no effect on the international filing date of the international application and cannot be relied upon to either accord an international filing date to an international application that is not otherwise entitled to a filing date under PCT Article 11, or to alter the international filing date under Article 11 of an international application.

Section 1.57(a) is similar to the practice under MPEP § 201.06(c), where there is an explicit incorporation by reference of a prior U.S. application contained in the specification, or in the application transmittal letter of a continuation or divisional application filed under § 1.53(b). See MPEP § 201.06(c). Section 1.57(a) is also consistent with Patent Law Treaty (PLT) Article 5(6)(b) and Rule 2(3) and (4).

Of course, applicants may continue to explicitly incorporate by reference a prior application or applications by including, in the body of the specification as filed, a statement that the prior application or applications is "hereby incorporated by reference." Such an explicit incorporation by reference would not be limited to inadvertent omissions as in § 1.57(a). Accordingly, applicants are encouraged to explicitly incorporate by reference a prior application or applications by including such a statement in the body of the specification, if incorporation is desired and appropriate.

Sometimes applicants intentionally omit material from a prior-filed application when filing an application claiming priority to, or benefit of, a prior-filed application. As discussed, § 1.57(a) only permits material that was inadvertently omitted from the application to be added to the application if the omitted material is completely contained in the prior-filed application. Therefore, applicants can

still intentionally omit material contained in the prior-filed application from the application containing the priority or benefit claim without the material coming back in by virtue of the incorporation by reference of § 1.57(a). Applicants can maintain their intent by simply not amending the application to include the intentionally omitted material. Thus, there should be no impact from § 1.57(a) in continuing applications where material from the prior application has been intentionally omitted. Therefore, under § 1.57(a), the application claiming benefit of a prior U.S. application could be a continuation-in-part application (as well as a continuation or divisional) depending upon the effect of omitting the material.

Example 1: A nonprovisional application was filed after the effective date of § 1.57 with a specification that refers to Figures 1–4, but only Figures 1, 2, and 4 were submitted on filing. Figure 3 was inadvertently omitted from the application on filing due to a clerical error. The nonprovisional application contained a claim for the benefit of an application filed prior to the effective date of § 1.57 (under either § 1.55 or § 1.78) that was present on the filing date of the nonprovisional application, and the prior-filed application contains omitted Figure 3.

Analysis: Applicant may rely on the incorporation by reference provided by § 1.57(a) to amend the nonprovisional application to add Figure 3, but must do so within the time period set forth in § 1.57(a)(1).

Example 2: A continuing application is filed which included a claim for the benefit of a prior U.S. application on filing. The continuing application refers to Figures 1–3 and corresponding Figures 1–3 were submitted on filing. The prior-filed application contained Figures 1–4. In filing the continuing application, the specification and drawings of the prior application were changed by omitting Figure 3 and renumbering Figure 4 as Figure 3 and omitting the portion of the specification that described Figure 3 of the prior application.

Analysis: If applicant submits an amendment in the continuing application to add Figure 3, and its corresponding description, from the parent application relying on the incorporation by reference provisions of § 1.57(a), it should be expected that the Office would question whether the omission was inadvertent.

Example 3: A continuation application is filed with a benefit claim in the first sentence of the specification to the prior application that acts as an

incorporation by reference by virtue of § 1.57(a) as to inadvertently omitted material. Inadvertently omitted material is submitted in the continuation by a preliminary amendment filed subsequent to the filing date of the continuation application.

Analysis: A § 1.67 supplemental oath or declaration specifically referring to the preliminary amendment would not be required.

Section 1.57(a) does not apply to any applications (having inadvertently omitted material) filed before the effective date of the instant rule. Section 1.57(a) is prospective only since to apply the rule retroactively would result in changing the expectations regarding incorporation by reference by applicants when the applications were filed. Thus, an application that inadvertently omits material must have been filed on or after the effective date of the rule in order for the rule to apply. Applicants may, however, rely on prior-filed applications filed before the effective date of the rule to supply inadvertently omitted material to applications filed on or after the effective date of the rule.

Section 1.57(b) clarifies what is acceptable language that perfects an incorporation by reference for essential and non-essential matter, as opposed to incorporation by reference of material as the result of a priority or benefit claim under §§ 1.55 and 1.78 as set forth in § 1.57(a). Applicants sometimes refer to other applications, patents, and publications, including patent application publications, using language which does not clearly indicate whether what is being referred to is incorporated by reference or is just an informational reference. Section 1.57(b)(1) limits a proper incorporation by reference (except as provided in § 1.57(a)) to instances only where the perfecting words “incorporated by reference” or the root of the words “incorporate” (*e.g.*, incorporating, incorporated) and “reference” (*e.g.*, referencing) appear. The Office is attempting to bring greater clarity to the record and provide a bright line test as to where something being referred to is an incorporation by reference. The Office intends to treat references to documents that do not meet this “bright line” test as noncompliant incorporations by reference and may require correction pursuant to § 1.57(g). If a reference to a document does not clearly indicate an intended incorporation by reference, examination will proceed as if no incorporation by reference statement has been made and the Office will not expend resources trying to determine if an incorporation by reference was intended.

The Office considered the alternative of making any mention of a document an automatic incorporation by reference of the document. Patent applications frequently contain a discussion of prior art documents when discussing the background of the invention, wherein the prior art documents are not intended to be incorporated by reference. The necessity for § 1.57(b) is that applicants who fail to clearly link certain disclosures to means-plus-function language risk having their claims interpreted too narrowly or held unenforceable. Clarifying when material is incorporated by reference during examination by use of specific trigger language is considered an aid to applicants when they invoke 35 U.S.C. 112, ¶ 6. Applicants would be aided by avoiding narrowed claim construction as a result of a number of court decisions which would not look for equivalents outside of the application. *See Atmel Corp. v. Info. Storage Devices Inc.*, 198 F.3d 1374, 53 USPQ2d 1225 (Fed. Cir. 1999), and *B. Braun Medical Inc. v. Abbott Lab.*, 124 F.2d 1419, 43 USPQ2d 1896 (Fed. Cir. 1997). Treating these documents as automatically incorporated might result in unintended consequences such as when a claim contains a means-plus-function limitation under 35 U.S.C. 112, ¶ 6.

Although the final rule permits incorporation by reference of material for 35 U.S.C. 112, ¶ 6 purposes, it does not relieve an applicant from providing a written description within an application that an element disclosed in the document is an equivalent for the purpose of 35 U.S.C. 112, ¶ 6. To the extent that applicants must provide a written description within an application, the final rule is considered consistent with *Atmel Corp.*

Similarly, applicants would be aided by not having their claims found unpatentable by a mere reference to outside material unintentionally incorporating material that contained equivalents that would broaden their claims to encompass the prior art. Automatic incorporation by reference would create a trap for applicants and practitioners by creating unintentional equivalents for 35 U.S.C. 112, ¶ 6, thus causing language broadening claims to be unpatentable. Additionally, as claims are generally read in light of the specification, what is actually incorporated into the specification can affect the scope of the claims independent of 35 U.S.C. 112, ¶ 6.

The Office considered expanding language that would be suitable for a bright line test but no other language that did not have the root of the words

“incorporate” and “reference” was identified.

Paragraph (b)(2) of § 1.57 requires that an incorporation by reference include a clear identification of the referenced patent, application, or publication. See § 1.98(b)(1) through (b)(5) and MPEP § 602 for examples of ways to clearly identify a patent, application, or publication. The Office recommends that particular attention be directed to specific portions of referenced documents where the subject matter incorporated may be found if large amounts of material are incorporated. Guidelines for situations where applicant is permitted to fill in a number for Application No.

_____ left blank in the application as filed can be found in *In re Fouché*, 439 F.2d 1237, 169 USPQ 429 (CCPA 1971). Commonly assigned abandoned applications less than 20 years old can be incorporated by reference to the same extent as copending applications; both types are available to the public upon the referencing application being published as a patent application publication or issuing as a patent. See § 1.14(a)(1)(iv) and (vi).

Section 1.57(c) codifies the practice in MPEP § 608.01(p), except that § 1.57(c) is limited to U.S. patents or U.S. patent application publications. According to past practice, an attempt to incorporate by reference essential material found in a foreign patent or non-patent literature is improper. The Office has eliminated the practice of incorporating by reference essential material found in unpublished applications in which the issue fee has been paid but the application has not yet issued as a patent. Delays in issuance or the possibility of withdrawal from issue of an allowed unpublished application put in doubt that an application incorporated by reference will be available to the public when a patent incorporating the other application issues. The Office now permits incorporating by reference essential material found in a U.S. patent application publication. This provision permitting only the incorporation of the publication document of an application is intended to preclude incorporation by reference of material found only in the original patent application used to produce a redacted portion of a published patent application, as well as where the subject matter has been cancelled by amendment prior to publication, and as a result, such subject matter is not reflected in the patent application publication.

The effect of § 1.57(c) is to change the prior practice of permissible

incorporation by reference in two situations. First, prior practice permitted holding in abeyance correction of material incorporated by reference from unpublished U.S. applications that have not issued as patents until allowance of the application containing the incorporation by reference. Publication of such applications which contain an incorporation by reference, however, means that the public will need access to the material incorporated by reference prior to an application being issued as a patent. Where the incorporation is from an unpublished application that has not issued as a patent, such application may not be readily available and thus would impair the public's access to the needed information. Therefore, holding the correction of an incorporation by reference in abeyance until allowance will no longer be permitted. Applicants should, therefore, correct any ineffective incorporation(s) by reference prior to publication of their applications. Second, the Office considered but rejected including unpublished abandoned applications which are open to the public under § 1.14(a)(iv) as acceptable documents to incorporate by reference since the text of abandoned applications is not published on the Internet after abandonment in a text searchable form.

The Office is considering how to make previously unpublished applications to which the public is currently permitted access or a copy pursuant to: (1) § 1.14(a)(iv) (*i.e.*, unpublished abandoned application that are identified), or (2) § 1.14(a)(vi) (*i.e.*, pending applications that are incorporated by reference), available through the public PAIR system in the Office's Internet Web site. The Office may reconsider this position in the two situations when the text of such applications is made available on the Office's Internet Web site.

Section 1.57(c)(1) through (c)(3) defines essential material as those items required by 35 U.S.C. 112, ¶¶ 1, 2, and 6.

Section 1.57(d) defines the scope of incorporation by reference practice for other (nonessential) subject matter. The Director has considerable discretion in determining what may or may not be incorporated by reference in a patent application. See *General Electric Company v. Brenner*, 407 F.2d 1258, 159 USPQ 335 (D.C. Cir. 1968). Through the Office's incorporation by reference policy, the Office ensures that reasonably complete disclosures are published as U.S. patents and U.S. application publications. An

incorporation by reference by hyperlink or other form of browser executable code is not permitted. Hyperlinked sources are not a reliable source for material due to the constant changes in links and linked contents. Similarly, executable code is not a reliable source for material to be incorporated by reference. As computers and operating systems change, executable code may not function on computers of the future and the material incorporated by reference would be inaccessible, or improperly interpreted. Executable code also poses security issues with respect to automated systems that the Office cannot control.

The limits on incorporation of essential or nonessential material under §§ 1.57(c) or (d) do not extend to other requirements for incorporation by reference set forth by the Office, such as under § 1.52(e)(5).

Other Office requirements for incorporation by reference, such as § 1.52(e)(5) for compact discs containing computer program listings or sequence requirements, are independent of the incorporation by reference requirements under §§ 1.57(c) or (d).

Additionally, the information added by the Office to its database for patents, for example, noting that for a particular patent a lengthy sequence listing is not reproduced in the text search database but can be found at a web link, is not governed by the prohibition in § 1.57(d). As the Office controls the content and the link addresses of the database, the problems associated with applicant supplied URLs are averted.

Section 1.57(e) is added so that it is clear that a copy of the incorporated by reference material may be required to be submitted to the Office even if the material is properly incorporated by reference. The examiner may require a copy of the incorporated material simply to review and to understand what is being incorporated or to put the description of the material in its proper context. Another instance where a copy of the reference may be required is where the material is being inserted by amendment into the body of the application to replace an improper incorporation by reference statement so that the Office can determine that the material being added by amendment in lieu of the incorporation is the same material as was attempted to be incorporated.

Section 1.57(f) addresses corrections of incorporation by reference by inserting the material previously incorporated by reference. A noncompliant incorporation by reference statement may be corrected by an amendment per § 1.57(f). Nothing in

§ 1.57(f) authorizes the insertion of new matter into an application and a statement that any amendment contains no new matter is required. Incorporating by reference material that was not incorporated by reference on filing of an application may be introducing new matter. The Office is concerned that improper incorporation by reference statements and late corrections thereof require the expenditure of unnecessary examination resources and slows the prosecution process. Applicants know (or should know) whether they want material incorporated by reference, and must timely correct any incorporation by reference errors. Corrections must be done within the time period set forth in § 1.57(g). Improper incorporations such as where a document cannot be identified cannot be corrected. See the discussion of § 1.57(g)(2).

Section 1.57(g) states that an incorporation by reference that does not comply with paragraph (b), (c), or (d) of this section is not effective to incorporate such material unless corrected within any time period set by the Office (should the noncompliant incorporation by reference be first noticed by the Office and applicant informed thereof), but in no case later than the close of prosecution as defined by § 1.114(b) (should applicant be the first to notice the noncompliant incorporation by reference and the Office informed thereof), or abandonment of the application, whichever occurs earlier. The phrase "or the abandonment of the application" is included in § 1.57(g) to address the situations where an application is abandoned prior to the close of prosecution, e.g., the situation where an application is abandoned after a non-final Office action.

Section 1.57(g)(1) authorizes the correction of noncompliant incorporation by reference statements that do not use the root of the words "incorporate" and "reference" in the incorporation by reference statement. This correction cannot be made when the material was merely referred to and there was no clear specific intent to incorporate it by reference. Incorporating by reference material that was not incorporated by reference on filing of an application may be new matter.

Section 1.57(g)(2) states that a citation of a document can be corrected where the document is sufficiently described to uniquely identify the document. Correction of a citation for a document that cannot be identified as the incorporated document may be new matter and is not authorized by this paragraph. An example would be where

applicant intended to incorporate a particular journal article but supplied the citation information for a completely unrelated book by a different author, and there is no other information to identify the correct journal article. Since it cannot be determined from the citation originally supplied what article was intended to be incorporated, it would be improper (e.g., new matter) to replace the original incorporation by reference with the intended incorporation by reference. A citation of a patent application by attorney docket number, inventor name, filing date and title of invention may sufficiently describe the document, but even then correction should be made to specify the application number.

A petition under § 1.183 to suspend the time period requirement set forth in § 1.57(g) will not be appropriate. After the application has been abandoned, applicant must file a petition to revive under § 1.137 for the purpose of correcting the incorporation by reference. After the application has issued as a patent, applicant may correct the patent by filing a reissue application. Correcting an improper incorporation by reference with a certificate of correction is not an appropriate means of correction because it may alter the scope of the claims. The scope of the claims may be altered because § 1.57(g) provides that an incorporation by reference that does not comply with paragraph (b), (c), or (d) is not an effective incorporation. For example, an equivalent means omitted from a patent disclosure by an ineffective incorporation by reference would be outside the scope of the patented claims. Hence, a correction of an incorporation by reference pursuant to this section may alter the scope of the claims by adding the omitted equivalent means. Changes involving the scope of the claims should be done via the reissue process. Additionally, the availability of the reissue process for corrections would make a successful showing required under § 1.183 unlikely. The following examples show when an improper incorporation by reference is required to be corrected:

Example 4: The Office of Initial Patent Examination (OIPE) noticed that Figure 3 was omitted from the application during the initial review of the application although the specification included a description on Figure 3. The application as originally filed contained a claim under § 1.78 for the benefit of a prior-filed application that included the appropriate Figure 3. OIPE mailed a Notice of Omitted Items notifying the applicant of the omission of Figure 3

and providing a two-month period for reply.

Analysis: Applicant may rely on the incorporation by reference provided by § 1.57(a) to amend the application to add Figure 3. Applicant, however, must file the amendment to add the inadvertently omitted drawing figure in compliance with § 1.57(a) within the time period set forth in the Notice of Omitted Items.

Example 5: Upon review of the specification, the examiner noticed that the specification included an incorporation by reference statement incorporating essential material disclosed in a foreign patent. In a non-final Office action, the examiner required the applicant to amend the specification to include the essential material.

Analysis: In reply to the non-final Office action, applicant must correct the incorporation by reference by filing an amendment to add the essential material disclosed in the foreign patent in compliance with § 1.57(f) within the time period for reply set forth in the non-final Office action.

Example 6: Applicant discovered that the last page of the specification is inadvertently omitted after the prosecution of the application has been closed (e.g., a final Office action, an *Ex Parte Quayle* action, or a notice of allowance has been mailed to the applicant). The application, as originally filed, contained a claim under § 1.78 for the benefit of a prior-filed application that included the last page of the specification.

Analysis: If applicant wishes to amend the specification to include the inadvertently omitted material, applicant must reopen the prosecution by filing a Request for Continued Examination (RCE) under § 1.114 accompanied by the appropriate fee and an amendment in compliance with § 1.57(a) within the time period for reply set forth in the last Office action (e.g., prior to the payment of issue fee, unless applicant also files a petition to withdraw the application from issue).

Example 7: Upon review of the specification, the examiner determined that the subject matter incorporated by reference from a foreign patent was "nonessential matter" (see § 1.57(d)) and, therefore, did not object to the incorporation by reference. In reply to a non-final Office action, applicant filed an amendment to the claims to add a new limitation that was supported only by the foreign patent. The amendment filed by the applicant caused the examiner to re-determine that the incorporated subject matter was "essential matter" under § 1.57(c). The

examiner rejected the claims that include the new limitation under 35 U.S.C. 112, ¶ 1, in a final Office action.

Analysis: Since the rejection under 35 U.S.C. 112, ¶ 1, was necessitated by the applicant's amendment, the finality of the Office action is proper. If the applicant wishes to overcome the rejection under 35 U.S.C. 112, ¶ 1, by filing an amendment per § 1.57(f) to add the subject material disclosed in the foreign patent into the specification, applicant may file the amendment as an after final amendment in compliance with § 1.116. Alternatively, applicant may file an RCE under § 1.114 accompanied by the appropriate fee, and an amendment per § 1.57(f) within the time period for reply set forth in the final Office action.

Example 8: Applicant filed a (third) application that includes a claim under § 1.78 for the benefit of a (second) prior-filed application and a (first) prior-filed application. The second application was a continuation application of the first application and the second application was abandoned after the filing of the third application. Subsequently, the applicant discovered the last page of the specification was inadvertently omitted from the third application and the second application.

Analysis: If the benefit of the filing date of first application for the omitted subject matter is required (for example, the omitted material is required to provide support for the claimed subject matter of the third application and there is an intervening reference that has a prior art date prior to the filing date of the third application, but after the filing date of the first application), applicant must amend the specification of the second application and the specification of the third application to include the inadvertently omitted material in compliance with § 1.57(a) (**note:** the second and third applications must be filed on or after the effective date of § 1.57(a)). Since the second application is abandoned, applicant must file a petition to revive under § 1.137 in the second application only for the purpose of correcting the specification under § 1.57(a) along with the amendment in compliance with § 1.57(a).

Comment 43: Several comments suggested that the rule should not be limited to inadvertent omissions but instead should be available for any material that was omitted.

Response: The suggestion is not adopted. If the rule were not limited to inadvertent omissions, then applicants would not be able to intentionally omit material contained in a prior-filed application from an application claiming benefit or priority to that prior

application since the material would be automatically incorporated into the later filed application by virtue of the incorporation by reference provided by the rule. Furthermore, if any material contained in a prior-filed application were considered as being automatically incorporated, it would be extremely burdensome on the examiner and on members of the public to determine what was included in the disclosure of the application as well as what was encompassed by any means-plus-function claims, particularly when benefit or priority of many prior-filed applications was being claimed. Additionally, if the provision was not limited to inadvertent omissions it could lead to submarining of subject matter. Specifically, applicants could intentionally mislead third parties into thinking that patent protection was no longer being pursued for subject matter found in a prior application by intentionally omitting that subject matter from a later filed application, or a series of later filed applications, and then reinstating that subject matter and any claims pertaining thereto at a later date.

Comment 44: One comment requested clarification regarding whether applicant must prove that a particular omission was inadvertent at the time of filing of the application. Another comment asked whether a declaration must accompany the amendment which states that the omission was inadvertent.

Response: There is no requirement for applicant to submit a declaration stating that the omission was inadvertent or to submit proof that a particular omission was inadvertent at the time of filing of the application. Of course, if applicant submits an amendment to add the omitted material pursuant to § 1.57(a), it would constitute a certification under § 10.18(b) that the omission was inadvertent. The Office, however, may inquire as to inadvertence where the record raises such issue.

Comment 45: One comment asked how far back in the chain of priority can one reach to find the omitted matter. The comment noted that there is no limit in the rule and this opens the possibility of obtaining patent protection for something disclosed but not claimed in a patent that issued many years ago.

Response: There is no limit in the rule as to how far back in a chain one may go. The rule, however, is not retroactive to any applications having inadvertently omitted material filed before the effective date of the rule. An application that inadvertently omits material must have been filed on or after the effective date of the rule in order for the rule to

apply but applicants may rely on prior-filed applications filed before the effective date of the rule to add inadvertently omitted material to applications filed on or after the effective date of the rule. Even though it may be possible for an applicant to rely on an application that was patented many years ago for material that was inadvertently omitted from an application claiming benefit of that prior-filed application through a chain of applications, it should be noted that if the omitted material is not present in any of the intervening applications, then the later-filed application is only entitled to the filing date of the later-filed application for the inadvertently omitted subject matter. The claimed subject matter in the later-filed application is only entitled to the benefit of the filing date of an earlier application if that subject matter is disclosed in every intervening application relied upon to establish a chain of copendency. See *In re de Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973), and *In re Schneider*, 481 F.2d 1350, 179 USPQ 46 (CCPA 1973). Where, however, intervening applications are filed after the effective date of the rule, it may be possible to correct a gap in the intervening chain if the intervening application(s) that also inadvertently omitted the material are pending and prosecution is not closed. A petition to revive an application under § 1.137 and/or a request for continued examination under § 1.114 may be filed, as appropriate, in order to restore the application to pending status and/or reopen prosecution in the application. If, however, an application has been patented, a certificate of correction or a reissue application could not be used to add inadvertently omitted material to that patent via § 1.57(a).

Comment 46: One comment stated that the restriction that the omitted material must be "completely contained" in the prior application, which is defined as material that is "expressly (as opposed to implicitly) disclosed in the prior application," is unnecessary and that applicant should be able to rely on any material that is explicitly, implicitly, or inherently disclosed in the prior-filed application. It was also argued that this requirement is inappropriate since the requirements of 35 U.S.C. 112 are satisfied by explicit and implicit disclosure in the application and such inconsistent treatment of 35 U.S.C. 112 issues would lead to confusion, inequity, and added burden to the Office and applicants.

Response: The purpose of the rule is to provide a safeguard for applicants

when a page(s) of the specification (or portion thereof) or a sheet(s) of drawing(s) (or a portion thereof) is inadvertently omitted from an application. For example, sometimes, as a result of a clerical error, a page of the specification or a page of drawing(s) is omitted from the application when it is filed or a portion of a page or a portion of a drawing is omitted due to a copying error. This is the type of error that the rule is intended to remedy. The rule is not intended to permit applicants to bring in any material for which there may arguably be support for in a prior-filed application. It would be a burden on the Office if applicants were permitted to bring in material that was implicitly disclosed in the prior application. Therefore, the rule is limited to inadvertently omitted material that is expressly, as opposed to implicitly, disclosed in the prior application.

Comment 47: One comment asked whether the deadline specified in § 1.57(a)(1) is the close of prosecution before an RCE is filed or whether it includes the close of prosecution after the last RCE in an application has been filed.

Response: Section 1.57(a)(1) merely relies on the definition of the close of prosecution provided in § 1.114(b). If a proper RCE is filed, it reopens prosecution in the application. The rule permits the application to be amended to include the omitted material even after the filing of an RCE as long as prosecution in the application is still open.

Comment 48: One comment stated that it would appear to be possible to convert an inherent incorporation by reference under paragraph (a) into an explicit incorporation by reference under paragraph (b) by amending the application to include an explicit incorporation by reference statement since a prior filed application would be inherently incorporated by reference when the provisions of § 1.57(a) are satisfied.

Response: It would not be possible to convert an inherent incorporation by reference under paragraph (a) to an explicit incorporation by reference under paragraph (b). The incorporation by reference provided by paragraph (a) is limited to inadvertently omitted material. Furthermore, such inadvertently omitted material is not included in the application, and thus not considered part of the disclosure, unless the application is amended to include the omitted material. As stated in MPEP § 201.11, under the heading "Reference To Prior Application(s)," "when a benefit claim is submitted after

the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. See *Dart Indus. v. Banner*, 636 F.2d 684, 207 USPQ 273 (D.C. Cir. 1980)." This is because no new matter can be added to an application after its filing date. Therefore, an explicit incorporation by reference statement cannot be added to an application after filing, even if material was inadvertently omitted from the application and § 1.57(a) is applicable.

Comment 49: One comment asked for clarification as to whether § 1.57(a) would allow for correction of translational and/or typographical errors which are not obvious when looking only at the application that contains the error and which distinguish the subject matter disclosed in that application from the priority document.

Response: The comment has been adopted in that it is explained that in certain situations it may be possible to correct translational and/or typographical errors via § 1.57(a). For example, if a particular word is explicitly disclosed in the prior foreign application for which priority is claimed, but the translation of the foreign application resulted in the U.S. application being filed with a different word in its place, it would be permissible to correct this error via § 1.57(a). It must be clear on its face that the error was a translational or typographical error in order for the error to be corrected by this procedure. It would not be permissible to argue over the interpretation of a particular word or expression used in the foreign application or to argue that language in the foreign application that is directed to a species provides support for the genus.

Comment 50: One comment questioned the Office's authority to bind courts by § 1.57. The comment noted that 35 U.S.C. 2 only gives the Office authority to make procedural rules.

Response: The Office has the authority to promulgate § 1.57 since the rule is a procedural rule. The Office already has a similar procedure in place. See MPEP § 201.06(c). The Office's transmittal form for filing a utility patent application includes an incorporation by reference statement for continuation or divisional applications that can be relied upon when a portion has been inadvertently omitted from the application. The rule is merely an extension of the existing procedure.

Comment 51: One comment asked what would be the effect of adding a priority claim after initial filing.

Response: The rule requires the priority claim or benefit claim to be present on the filing date of the application. Therefore, if a priority claim is added after the application is accorded a filing date, there would be no incorporation of the prior application provided by § 1.57. Furthermore, as noted above, if a benefit claim is submitted after the filing date of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application.

Comment 52: One comment asked whether this issue would be better resolved by bilateral negotiations.

Response: The Office does not think that this issue would be better resolved by bilateral negotiations since relief via the new rule is more immediate and was generally supported.

Comment 53: One comment suggested that a priority claims section be added to the Office's application transmittal letter (PTO/SB/05) that allows an applicant to list all "parent" applications (foreign, U.S., or provisional) and include an "incorporated by reference" check box for each "parent" application.

Response: The suggestion is not adopted. A check box on the transmittal letter is unnecessary for purposes of § 1.57(a) since the rule operates as an automatic incorporation by reference for inadvertently omitted material completely contained in a prior-filed application for which priority or benefit is claimed. If applicants were required to affirmatively check a box on a form in order for a prior application to be considered as being incorporated by reference, it would result in many applicants not being able to bring in material that was inadvertently omitted because they failed to check the box on the form or because they used their own transmittal form which did not contain any check boxes. The automatic incorporation provided by § 1.57(a) is a more superior safeguard than if applicants were required to affirmatively check a box on the transmittal letter. Furthermore, if applicants want to incorporate by reference any prior applications for more than inadvertently omitted material, they would need to include a proper incorporation by reference statement in the specification of the application as provided in § 1.57(b), not in the application transmittal letter, and thus a check box on the transmittal letter would not accomplish this objective.

Comment 54: One comment requested that the Office indicate that when applicants intentionally omit material

from a prior-filed application when filing an application claiming priority to, or benefit of, the prior-filed application, the continuing application should be designated as a continuation-in-part application.

Response: The omission of material from a prior-filed application may or may not be considered new matter relative to the prior-filed application depending on what is being claimed. Therefore, the Office cannot indicate that such continuing applications should be designated as continuation-in-part applications since it is possible that some of these applications would be properly considered continuation applications.

Comment 55: One comment stated that § 1.57(a) should be expressly made effective only for applications filed on or after the effective date of the rule.

Response: The comment has been adopted to the extent that the preamble to the rule does indicate that the rule does not apply to add inadvertently omitted material to any applications filed before the effective date of the rule. The effective date of a rule is generally not included in the text of the rule itself.

Comment 56: Many comments stated that § 1.57(b) should not preclude the use of other language to make an incorporation by reference. Variations of this comment suggest that the Office provide guidance on language which it considers acceptable, but accept any language where applicant manifests an intent to incorporate the content of a document by reference; clear intent.

Response: The comment is adopted in part. While many commentators requested more flexibility, none suggested any equivalent phrase that did not have the root words "incorporate" and "reference." The language of the final rule will allow variations that contain the words at least as stem words "incorporate" and "reference." Some of the comments included an example of a reference to a document as being an incorporation by reference of the document. Mere reference to a document is not under existing law or practice an incorporation by reference. Whether the examples of the comment demonstrate a clear intent to incorporate a document by reference is a matter of substantive law that is fact dependent and not addressed by the final rule. The language of the rule is not intended to change existing law or practice in this respect and would permit, where there is clear intent to incorporate a document by reference, correction of incorrect incorporation language. The procedure in paragraph (f) is intended to ensure that any issue with respect to whether the material is

incorporated by reference is timely resolved.

Comment 57: A comment stated that the requirements set forth in proposed § 1.57(f) are too restrictive and the consequences of a failed incorporation by reference are too severe (*i.e.*, any post filing corrections are new matter).

Response: The comment is adopted in part. The correction required, which is now set forth in paragraph (g), has been liberalized in the final rule to permit insertion of the incorporated material and clarifies that the improper terminology can be corrected, *e.g.*, no loss of filing date. Paragraph (g) is not intended to preclude any correction where there is a clear intent to incorporate a document by reference but incorrect incorporation language was used or a reference was made to a document that is not a suitable type for incorporation by reference. This provision is merely a codification of existing law. The courts have long held an improper incorporation must be corrected in a timely manner, *e.g.*, prior to the issuance of a patent to be effective. Similarly, a patentee trying to enforce rights emanating from a patent application publication is expected to have corrected these problems prior to publication to be timely. *See also Atmel Corp.* (improper incorporation is noted as being of no effect).

Comment 58: A comment stated that the rule is rigid and inflexible. The comment recommended that each document listed below be presumed to be incorporated by reference unless the applicant states that it is not incorporated by reference: (1) All disclosure in provisional, utility, PCT and foreign applications from which the application in question descends; (2) all disclosure in U.S. and foreign patents referred in the specification of the application in question and all other documents identified in the specification and in existence at the time of filing; and (3) all disclosure in references included in an Information Disclosure Statement filed at the same time as the application in question.

Response: The comment is not adopted. The majority of references in an application today, especially when including references cited in an IDS, are not incorporated by reference. With respect to presuming all identified references be incorporated by reference unless positively disclaimed would appear to create a larger burden on patent applicants than the converse. Similarly, the automatic addition of all these additional sources of potential equivalents for means-plus-function claims would greatly increase the examination burden and prolong

prosecution of an application. While it is stated in the comments that the incorporation by reference will make applications smaller and require less time for examiners to review, it is not stated how much additional time will be required for examiners to find and review the incorporated references for equivalents. The suggested change would also require a change in the oath/declaration practice, since an IDS is not part of the application. An applicant would have to review and understand all of the IDS materials in addition to the specification to understand the scope of the application and claims at the time the applicant signed an oath or declaration. This is a more difficult standard for an applicant to meet than is required by § 1.56.

Comment 59: The comment viewed post filing corrections to incorporation by reference language as new matter.

Response: The comment is adopted in part. The correction provision of § 1.57(g) is not intended to change the current law with respect to what is new matter. Material that is merely referenced under current law is not incorporated by reference. If changing a referenced document to an incorporation by reference under existing law would be new matter, changing the reference to an incorporation by reference statement under § 1.57(g) would be new matter and paragraph (g) is not applicable. Where, however, there is a clear intent to incorporate material but a formal problem with the language or identification of the document, utilization of remedial paragraph (g) will not make the correction "new matter."

Section 1.57(g) has been clarified to remove any confusion as to what corrections are contemplated. Where there is a clear specific intent to incorporate by reference paragraph (f) will permit correction of language of incorporation, and document identity corrections that do not involve new matter.

Comment 60: The comment suggested that an explicit statement that simply identifying an incorporated patent or publication does not necessarily "immunize" any future amendment of the disclosure against new matter, particularly when subject matter is selectively incorporated from the cited document on the basis of a generic or "blanket" incorporation statement.

Response: The comment is not adopted. The proposed changes are intended to address the format of an incorporation by reference claim, not substantive law regarding "new matter." Mere reference to a document under

existing case law is not an incorporation by reference. Hence, what was not incorporated by reference before the rule change will not be treated differently under the rule change.

Where there was clear specific intent to attempt to incorporate an identifiable document for which a correction was not new matter before the rule change will not be new matter after the rule change.

Comment 61: Some comments favored the restrictions in § 1.57(c) while there were other sets of comments that had three criticisms. The first criticism was that by eliminating the ability to incorporate commonly owned unpublished applications by reference, the usefulness of incorporation by reference practice will be severely curtailed. The comment states that access is available under the access rules or can be obtained from applicant. The second criticism was that § 1.57(c)(2) is confusing and appears to say claims can be incorporated by reference. The third criticism was that it is unwise to further confuse 35 U.S.C. 112, ¶ 6, by making a specific rule allowing language supporting a means-plus-function element to be incorporated by reference. The comments suggested that the Office should limit rule implementation to MPEP language.

Response: The comment is not adopted. The Office recognizes that the usefulness of incorporation by reference will be reduced by barring unpublished applications, and will reconsider this position when access to these applications is generally available on the Office's Internet Web site. Access to pending applications at this time is only by ordering a copy and paying the appropriate fee. Paragraph (c)(2) is part of the definition of "essential subject matter" and is not seen to say or imply that claims can be incorporated by reference. The deletion of the reference to 35 U.S.C. 112, ¶ 6, from the provision is also not adopted. This provision merely codifies existing practice, in MPEP § 608.01(p), which states that material may be incorporated by reference to "describe the claimed invention." The comment that the law is sufficiently confusing in requiring a link between the specification and claim for 35 U.S.C. 112, ¶ 6, that the change will cause more confusion is not seen to be a problem if the incorporation by reference language of the rule is used (see also the discussion of *Atmel Corp.* that incorporation by reference does not relieve an applicant of providing a proper written description of equivalence).

Comment 62: Section 1.57(b) should not require more than the minimum amount of information needed for a skilled person to uniquely identify the document. The incorporation by reference standard should not be tied to § 1.98.

Response: The comment is adopted.

Comment 63: A comment stated that the true holding of *Atmel Corp.* should not be ignored or glossed over by practitioners or the Office, and that there is no basis for 35 U.S.C. 112, ¶ 1, written description incorporation by reference in case law, so it should be barred.

Response: The comment is not adopted. Section 1.57(c) as noted in the above discussion of the MPEP is a codification of existing practice which includes providing support for language found in the claims. The improper incorporation by reference in *Atmel Corp.* does not appear to bar this practice. Although the final rule permits incorporation by reference of material for 35 U.S.C. 112, ¶ 6 purposes, it does not relieve an applicant from providing a written description within an application that an element disclosed in the document is an equivalent for the purpose of 35 U.S.C. 112, ¶ 6. To the extent that applicants must provide a written description within an application, the final rule is considered consistent with 35 U.S.C. 112, ¶ 1, and *Atmel Corp.*

Section 1.58: Section 1.58(a) is amended to provide that the same table not be included in both the drawings as a figure and in the body of the specification of an application. Section 1.58(b) is also amended to clarify that correct visual alignment of rows and columns of chemical and mathematical formulae and tables is retained when the electronic file is rendered by opening and displaying the electronic file at the Office using a text viewer program. Section 1.58(c) is additionally amended to recommend that the font size of text be at least 0.166 inches or 0.422 cm. and to eliminate a reference to elite type font.

Section 1.58(a) is amended because applicants have been causing voluminous applications to become even larger by including the same table as both a drawing figure and as text in the body of an application. Filing duplicate copies of the same table requires additional review by the Office to determine if the drawing table and the text table are duplicates and to identify differences, if any exist. Moreover, the duplicate inclusion is causing the number of pages of the application to increase, thereby causing increased scanning, storage and

reproduction costs. In addition, the burden on the public to copy and review a published application or patent is also increased. Applications filed under 35 U.S.C. 371 are excluded from the prohibition from having the same tables in both the description portion of the specification and drawings.

See § 1.83 for a similar proposed change involving tables and sequence listings.

Section 1.58(b) is amended by adding the word "visually" to make it clear that the data in the electronic file is appropriately formatted so that the alignment of rows and columns is maintained in the table when the file is opened for viewing at the Office. The Office has found that some filers have only been providing markers to identify rows and columns in table data. When the table is viewed at the Office, the markers do not cause the rows and columns of data to be visually aligned. Unless each entry in a table is surrounded with an appropriate number of spaces, the visual spatial alignment of the table is not maintained: *i.e.*, the rows and cells are misaligned. A way to provide the proper alignment is to insert space characters in each cell so that the overall number of characters in each cell is the same, and to maintain a constant font width for all characters.

Many programs that are used to generate tables allow the user to provide additional spaces manually when typing data. Many of these programs also provide an automated way to pad the cells with space characters, and create an ASCII file with spatially aligned data. This feature is generally invoked by a command that is often called printing to a "formatted text" format or "prn" file. The program feature formats the table as it would appear on paper, padding the cells with spaces to provide proper alignment of the cell entries.

A review of different versions of one software product and similarly, of different software products showed no consistency in the menu language used for the formatting command noted above. With the constant change in software versions, the Office is not able to provide a list of all the menu variations necessary to create a formatted text format. A person knowledgeable with software used to create tabular data, however, should be able to find the commands to invoke this feature in the selected software.

Section 1.58(c) is amended for the same reason that § 1.52(b)(2)(ii) is amended. Section 1.58(c) previously required that the text be in a lettering style that is at least 0.08 inches high, which is the minimum font size set forth in Patent Cooperation Treaty (PCT)

Rule 11.9. Text having a font size only 0.08 inches high is difficult to capture with optical character recognition technology and may not be reproducible as required by § 1.52(a)(1)(v) (and PCT Rule 11.2(a)). A font size of 12 (12/72 inch or 0.166 inch (0.422 cm.) high) is significantly more reproducible than a font size of 6 (6/72 inch or 0.08 inch (0.211 cm.) high). Accordingly, § 1.58(c) is amended to indicate a preference for a larger font size. In addition, the reference to elite type is deleted as it was inconsistent with the size given. Elite type is a typewriter type that runs 12 characters to the inch. Instead of referencing elite type, the rule references font size which should be more meaningful to most patent applicants (most word processing software programs have an option to choose a font and a font size).

Section 1.59: Section 1.59 is amended to refer to the petition fee set forth in § 1.17(g) for consistency with the change to § 1.17. See discussion of § 1.17 for comments related to the changes in the petition fees.

Section 1.63: Section 1.63(d)(4) is amended to delete “(or authorization of agent)”.

Section 1.69: Section 1.69(b) is amended by deleting the words “or approved” as unnecessary, and possibly leading to confusion and the mistaken assumption that the Office has a procedure for the approval of applicant-generated forms, where no such procedure exists. See *Changes to Implement the Patent Business Goals*, 64 FR 53771, 53777 (Oct. 4, 1999), 1228 *Off. Gaz. Pat. Office* 15, 20 (Nov. 2, 1999) (proposed rule) (declining to adopt a review service for applicant-created forms).

PCT Rule 4.17(iv) provides for the submission of declarations of inventorship in the international phase of an international application as part of the PCT Request form. Such declarations may be accepted as satisfying the requirement under 35 U.S.C. 371(c)(4) for an oath or declaration of the inventor in the U.S. national phase. See § 1.497(a). WIPO has translated the text for the PCT Rule 4.17(iv) declaration form into languages other than English and has made such forms available to applicants, for example, by downloading the declaration form from WIPO's Web site at <http://www.wipo.int/pct/en/forms/index.htm>. Accordingly, § 1.69(b) is being further revised to make it clear that PCT Rule 4.17(iv) declarations are not subject to the translation requirements set forth in that section.

Paragraph (b) of § 1.69 was proposed to be amended to require that the

statement that the translation is accurate be signed by the individual who made the translation. The Office will not proceed with this additional amendment. See § 1.52(b)(1)(ii) for a discussion. See also §§ 1.52(d)(1), 1.55(a)(4) and 1.78(a)(5)(iv).

Section 1.76: Section 1.76(a) is amended to require that any application data sheet (ADS) contain the seven headings listed in § 1.76(b) and all appropriate data for each section heading. As revised, § 1.76 also requires that the ADS be titled “Application Data Sheet.” Any label (e.g., the label “Given Name” in the “Applicant Information” heading) that does not contain any corresponding data will be interpreted by the Office to mean that there is no corresponding data for that label anywhere in the application. By requiring an ADS to contain all seven section headings, and any appropriate data for the sections, the accuracy of bibliographic data in patent applications will be enhanced and the need for corrected filing receipts related to Office errors will be reduced.

Section 1.76(b)(4) is amended to delete “authorization of agent” and to change the cross-reference from § 1.34(b) to § 1.32.

Section 1.76(c)(2) is amended to require a supplemental application data sheet to be titled “Supplemental Application Data Sheet” and to also contain all of the seven section headings listed in § 1.76(b) with all appropriate data for each heading, rather than only identifying the information that is being changed (added, deleted, or modified) in the supplemental ADS. Requiring a supplemental ADS to contain all of the information from the ADS, but with the changes indicated, is consistent with the ADS guide posted on the Office's Internet Web site at: <http://www.uspto.gov/web/offices/pac/dapp/sir/doc/patappde.html>. A supplemental ADS containing only new or changed information is likely to confuse the record, create unnecessary work for the Office, and would not comply with § 1.76. If no ADS was originally filed, but applicant wants to submit an ADS to correct, modify, or augment the original application data, the ADS, even though it is the first-filed ADS, must be titled “Supplemental Application Data Sheet.” When submitting a supplemental ADS after the initial filing of the application to correct, modify, or augment the original application data included in a previously filed ADS or oath or declaration pursuant to § 1.63 or § 1.67, the following applies: (1) The supplemental ADS must be titled “Supplemental Application Data Sheet” (while the title “Supplemental

Application Data Sheet” is preferred, “Supp. ADS,” “Supplemental ADS” or other variations thereof will be accepted); (2) the supplemental application data sheet must be a full replacement copy of the original ADS, if any, with each of the seven section headings, and with all appropriate data for the section headings; and (3) the supplemental ADS must be submitted with all changes indicated, preferably with insertions or additions indicated by underlining, and deletions, with or without replacement data, indicated by strike-through or brackets. A supplemental ADS that is being used to correct data shown in an oath or declaration, such as foreign priority or residence information for an inventor, would then show the original incorrect information with strike-through or brackets, and the new information with underlining, as if an ADS had originally been used to submit the information. For example, if the original oath or declaration included a foreign priority claim, in order to delete the claim, applicant should provide a supplemental ADS showing the foreign priority claim with strike-through or brackets to ensure that the patent will reflect such change.

Applicants are reminded that use of an application data sheet is strongly encouraged when there is a change in the spelling of an inventor's name pursuant to MPEP 605.04(b), or the inventor changes his or her name pursuant to § 1.182, or there is a correction of inventorship under § 1.48. See *Advance Notice of Change to MPEP 605.04(b), (c) and (f)—Application Data Sheets Are Strongly Recommended When Inventor Information is Changed*, 1281 *Off. Gaz. Pat. Office* 54 (Apr. 13, 2004).

Section 1.76(d) is amended to clarify that if an ADS is inconsistent with information provided in another document that was submitted at the same time or previous to the ADS submission, the ADS will control. The title of § 1.76(d) is amended by replacing “oath or declaration” with “other documents” to reflect the amendments to paragraphs (d)(1) and (d)(2) of § 1.76. Section 1.76(d)(1) and 1.76(d)(2) are amended to add an amendment to the specification, a designation of a correspondence address, in order to emphasize other documents that may have inconsistent information with an ADS.

In addition, § 1.76(d)(4) is amended to delete “initially” from the first sentence, and “, an oath or declaration under § 1.63 or 1.67, or a letter pursuant to § 1.33(b)” from the last sentence thereof. In addition, § 1.76(d)(4) is amended to

add “, for example,” to the second sentence, and to clarify the last sentence. The Office captures bibliographic data from the ADS, so if an ADS has been provided, the ADS needs to be accurate. A separate letter indicating an error, for example in the spelling of an inventor’s name in a prior-filed oath or declaration or ADS, is likely to be overlooked and the error likely to be duplicated if the application issues as a patent. Accordingly, if applicants have made an error in an ADS, a supplemental (corrected) ADS needs to be submitted with any request for a corrected filing receipt, or a request to correct the inventorship in the patent application (and any required new oath or declaration showing the correct inventorship). If the error was included in a declaration under § 1.63, and no ADS was filed, a supplemental declaration pursuant to § 1.67 remains an acceptable mechanism to correct the defect in the original declaration. If the error was included in an originally filed ADS, a supplemental ADS is required because a supplemental declaration is not an acceptable mechanism to correct a defect in an ADS.

Comment 64: One comment stated that the Office had not explained why a supplemental application data sheet was being required to contain bibliographic data that was not being changed, and also requested that the rule indicate the manner in which changes should be shown. Another comment indicated that the ePAVE software in EFS for generating Application Data Sheets does not permit underlining or strike-through.

Response: The suggestion to indicate in the rule how changes should be shown has been adopted. In a supplemental ADS, all changes must be indicated, with insertions or additions preferably shown by underlining, and deletions preferably shown by brackets or strike-through. The Office is trying to encourage applicants to submit ADSs and supplemental ADSs that are useful to the Office, but not difficult for applicants to prepare. Accordingly, while the Office suggests underlining and brackets or strike-through to show changes on an ADS, or a supplemental ADS, other clear indications of changes may be used as well. As to why a supplemental ADS should contain the material that is not being changed, application data sheets are used in printing the patent, and it is useful and most efficient for the printer to have a single document from which to extract data. The Office anticipates that an applicant may file several supplemental ADSs, and searching through the file to find all such documents and comparing

the documents is unreliable and is not an efficient use of Office resources. As to ePAVE, this feature of EFS assists applicants in creating an ADS for filing with an initial filing of an application. EFS cannot currently be used to submit a Supplemental ADS, and as a result, ePAVE (part of EFS) does not provide a mechanism to show insertions or deletions. An applicant who initially created an ADS using ePAVE would need to retype the ADS to create a supplemental ADS.

Section 1.78: Section 1.78(a)(1) is amended to delete an unnecessary alternate condition to permit a claim for the benefit of a prior-filed application. Sections 1.78(a)(2)(iii) and (a)(5)(iii) are amended to permit the required reference to the prior application(s) to be in multiple sentences, forming a continuous string, at the beginning of the specification, rather than being limited to the first sentence of the specification. The multiple sentences must begin as the first sentence after the title, and the second, or any additional, sentence including a benefit claim must follow the first sentence and not be separated from the first sentence by any other sentence not making a benefit claim. Section 1.78(c) is amended to clarify that the prior art exception under 35 U.S.C. 103(c) does not apply to double patenting rejections.

Section 1.78(a)(1) sets forth the conditions under which a nonprovisional application may claim the benefit of one or more prior-filed copending U.S. nonprovisional applications or international applications designating the United States of America. Where the prior-filed application is a nonprovisional application (filed under 35 U.S.C. 111(a)), one of the conditions under § 1.78(a)(1) is met when the prior-filed application satisfied any one of paragraphs (ii), (iii) or (iv) of § 1.78(a)(1). To satisfy paragraph (ii), the prior-filed application must be “[c]omplete as set forth in § 1.51(b).” To satisfy paragraph (iii), the prior-filed application must be “[e]ntitled to a filing date as set forth in § 1.53(b) or § 1.53(d) and include the basic filing fee set forth in § 1.16.” Considering that paragraph (iii) is less restrictive than paragraph (ii), paragraph (ii) is deleted, with paragraphs (iii) and (iv) being redesignated as paragraphs (ii) and (iii), respectively, as paragraph (ii) is unnecessary because any prior-filed application that would satisfy paragraph (ii) would also satisfy paragraph (iii).

Sections 1.78(a)(2)(iii) and (a)(5)(iii) are amended to change the word “sentence” to “sentence(s).” The change permits the required reference to the

prior application(s) to be in more than one sentence, forming a continuous string, at the beginning of the specification. In some situations, it would be easier and clearer to set forth the relationship between prior applications if more than one sentence were permitted. For example, where there is a provisional application and multiple intermediate nonprovisional applications, the required identification in the latest nonprovisional application as to which intermediate nonprovisional application(s) claims benefit to the provisional application (*i.e.*, is within one year of the provisional application’s filing date), could be set forth in a clearer manner using multiple sentences.

Section 1.78(a)(5)(iv) was proposed to be amended to require that the statement that the translation is accurate be signed by the individual who made the translation. This proposed change has not been included in the final rule as the changes are not deemed to be necessary in view of the requirements of § 10.18, as explained in regard to § 1.52(b)(1)(ii). *See also* §§ 1.52(d)(1), 1.55(a)(4) and 1.69(b).

Section 1.78(c) is amended to clarify that the prior art exception under 35 U.S.C. 103(c) does not apply to double patenting rejections by the addition of a new final sentence, which states “Even if 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 conflicting claims may be rejected under the doctrine of double patenting in view of such commonly owned or assigned applications or patents under reexamination.” Therefore, § 1.78(c) emphasizes that double patenting rejections should still be made, when appropriate, even if a reference is disqualified from being used in a rejection under 35 U.S.C. 103(a) via the prior art exclusion under 35 U.S.C. 103(c). This clarification codifies patent policy regarding double patenting rejections and the prior art exclusion under 35 U.S.C. 103(c) as set forth in the notice *Guidelines Concerning the Implementation of Changes to 35 U.S.C. 102(g) and 103(c) and the Interpretation of the Term “Original Application” in the American Inventors Protection Act of 1999*, 1233 *Off. Gaz. Pat. Office* 54 (Apr. 11, 2000)) and MPEP § 706.02(l)(1). Thus, applicants, pursuant to § 1.56, must disclose all relevant applications for which a double patenting rejection would be appropriate. Additionally, the first sentence of § 1.78(c) is amended by changing the word “party” to “person”

in order to use terminology consistent with 35 U.S.C. 103(c).

Section 1.83: Section 1.83(a) is amended to provide that tables and sequence listings that are included in the specification are not permitted to be reprinted in the drawings. Applicants should not be obliged to include tables or the sequence listing in the drawings due to the current requirement of § 1.83(a) that all claimed features must be shown in the drawings. Accordingly, as amended, if the specification includes a sequence listing or a table, such a sequence listing or table would not be permitted to be reprinted in the drawings. As a result, if a sequence listing as shown in the drawings has more information than is contained in the specification, the sequence listing could be included in the specification and the drawings, but a sequence listing in the specification would not be permitted to be duplicated in the drawings. Applications filed under 35 U.S.C. 371 are excluded from the prohibition from having the same tables and sequence listings in both the description portion of the specification and drawings. This is because such format requirements for the specification and drawings of PCT applications (including national stage applications under 35 U.S.C. 371) are provided for in PCT Rule 11.

See § 1.58(a) for a similar proposed change to require that tables be included in only one of either the drawings or the specification.

Section 1.84: Section 1.84 is amended by removing former § 1.84(a)(2)(iii) to eliminate the requirement for submission of a black and white copy of any color drawings or photographs. Section 1.84(a)(2)(iv) is redesignated as (a)(2)(iii). Section 1.84(c) is amended to clarify that identification (labeling) of the drawing is recommended, but not required. If identification (of the application for which the drawing is related to) is provided it must be placed on the front of the sheet within the top margin. Section 1.84(c) is clarified to add an informational reference to § 1.121(d) relating to the requirement to identify the type of change represented by drawings submitted after the filing date of an application.

Section 1.84(a)(2) is amended to remove the requirement in former paragraph (a)(2)(ii) for a black and white copy of a color drawing or photograph. This requirement has already been waived. See *Interim Waiver of Parts of 37 CFR 1.84 and 1.165, and Delay in the Enforcement of the Change in 37 CFR 1.84(e) to No Longer Permit Mounting of Photographs*, 1246 *Off. Gaz. Pat. Office* 106 (May 22, 2001).

Section 1.84(c) is amended to be consistent with the requirements set forth in § 1.121(d). Each drawing sheet submitted after the filing date of an application must be identified as either "Replacement Sheet" or "New Sheet" so that the Office will recognize how to treat such a drawing sheet for entry into the application. If a marked-up copy of any amended drawing figure, including annotations indicating the changes made, is filed, such marked-up copy must be clearly labeled as "Annotated Sheet." Although the amendment to add the identification of "New Sheet" requirement was not set forth in the notice of proposed rule making and was not previously in § 1.121(d), the amendment is merely made to provide a means of identification ("New Sheet") for presenting an additional figure. The absence of an identification for a new sheet of drawing (as opposed to a replacement sheet of drawings) has caused applicants to inquire about the appropriate label for such situation.

Section 1.84(c) is clarified by the addition of references to § 1.121(d) to alert applicants to the need to identify the type of changes represented by drawings submitted after the filing date of an application. Each drawing sheet submitted after the filing date of an application must be identified as either "Replacement Sheet" or "New Sheet" so that the Office will recognize how to treat such a drawing sheet for entry into the application. If a marked-up copy of any amended drawing figure including annotations indicating the changes made is filed, such marked-up copy must be clearly labeled as "Annotated Sheet."

Section 1.85: Section 1.85(c) is clarified by deleting the phrase "or formal." Although the instant amendment was not set forth in the notice of proposed rule making, the amendment is merely made for the purpose of conformity to current terminology and does not represent a change in practice. The concept of a "formal" drawing is no longer applicable in that the focus is on whether a drawing can be scanned by the Office.

Section 1.91: Section 1.91 is amended to add a paragraph (c), which provides that a model or exhibit must be accompanied by photographs that show multiple views of the material features of the model or exhibit and that substantially conform to the requirements of § 1.84. Material features are considered to be those features which represent that portion(s) of the model or exhibit forming the basis for which the model or exhibit has been submitted. Since the Office generally

returns or otherwise disposes of models or exhibits when they are no longer necessary for the conduct of business before the Office (§ 1.94), such photographs are necessary for the file of the application or proceeding to contain an adequate record of the model or exhibit submitted to the Office. Models, exhibits or specimens not in compliance with § 1.52 and those in compliance that cannot be scanned will be stored by the Office in an artifact file until they can be disposed of. Section 1.91(c) provides that this requirement does not apply if the model or exhibit substantially conforms to the requirements of § 1.52 or § 1.84, since a model or exhibit that substantially conforms to the requirements of § 1.52 or § 1.84 can itself be retained in the file wrapper of the application or proceeding.

In applications where the exhibit is not intended to display the medium of submission (e.g., video tapes, DVDs, and compact discs) but the content of the submission, the requirement that the photographs be of the substantive content is included in this paragraph. Video tapes, DVDs, and compact discs are usually submitted with movies or multimedia images. The requirement that the photographs submitted should show the material features that were being exhibited is intended to require that the photograph be that of the content of the material, not a photograph of the medium of submission. Hence, if video or multimedia submission is contained on a tape or disc, the corresponding photograph should be a still image single frame of a movie, and not a submission of a photograph of a video cassette, DVD disc or compact disc.

A video or DVD is not the type of model or exhibit that would substantially conform to the requirements of §§ 1.52 or 1.84. The Office does not intend to store bulky items, such as videos, particularly as the Office is moving toward IFW. See *Changes To Implement Electronic Maintenance of Official Patent Application Records*, 68 FR 38611 (June 30, 2003), 1272 *Off. Gaz. Pat. Office* 197 (July 29, 2003) (final rule). Accordingly, where a video or DVD or similar item is submitted as a model or exhibit, the requirement of § 1.91(c) for supplying photographs of what is depicted in the video or DVD, pursuant to § 1.84, would need to be met.

Section 1.94: Section 1.94 is amended to be divided into paragraphs (a) through (c). Paragraph (a) provides that once notification is sent to applicant, arrangements must be made by applicant for the return of the model, exhibit, or specimen at applicant's

expense, in response to such notification. The Office may return the model, exhibit, or specimen, at any time once it is no longer necessary for the conduct of business and need not wait until the close of prosecution or later. Applicant is required to retain the returned model, exhibit or specimen for the enforceable life of any patent resulting from the application for which it was submitted pursuant to paragraph (b) of § 1.94. Accordingly, applicant may be called upon to resubmit such returned model, exhibit, or specimen under appropriate circumstances, such as where a continuing application is filed. Where the model, exhibit or specimen is a perishable, the Office will be presumed to have permission to dispose of the item without notice to applicant, unless applicant notifies the Office upon submission of the item that a return is desired and arrangements are promptly made for the item's return upon notification by the Office.

Paragraph (b) provides that applicant is responsible for retaining the actual model, exhibit, or specimen for the enforceable life of any patent resulting from the application. Section 1.94 also provides that its provisions do not apply: (1) If the model or exhibit substantially conforms to the requirements of § 1.52 or § 1.84, since a model or exhibit that substantially conforms to the requirements of § 1.52 or § 1.84 can itself be retained in the file wrapper of the application or proceeding; (2) where a model, exhibit, or specimen has been described by photographs that conform to § 1.84; or (3) where the model, exhibit, or specimen is perishable.

Paragraph (c) provides that the notification to applicant will set a time period within which applicant must make arrangements for a return of a model, exhibit, or specimen, with extensions of time available under § 1.136, except in the case of perishables. The time period is one month from the mailing date of the notification for applicant to make arrangements for a return, unless the item is a perishable, in which case the time period will be shorter. Failure by applicant to establish that arrangements for the return of a model, exhibit or specimen have been made within the time period set in the notice will result in the item being discarded by the Office.

Section 1.98: Section 1.98(a) is amended by revising paragraph (a)(1) to require: (1) A specified format/identification for each page of an Information Disclosure Statement (IDS), and that U.S. patents and U.S. patent application publications be listed in a

section separately from citations of other documents; (2) a column that provides a space next to each document listed to permit the examiner's initials; and (3) a heading that the list is an IDS. Section 1.98(a)(1) is specifically amended to require that U.S. patents and U.S. patent application publications be listed separately from the citations of other documents. The separation of citations will permit the Office to obtain the U.S. patent numbers and the U.S. patent application publication numbers by optical character recognition (OCR) from the scanned documents such that the documents can be made available electronically to the examiner to facilitate searching and retrieval of the cited U.S. patents and U.S. patent application publications from the Office's search databases. Applicants will comply with this requirement if they use forms PTO/SB/08A and 08B (or the more commonly used PTO-1449), which provide a separate section for listing U.S. patents and U.S. patent application publications. Applicants who do not use these forms for submitting an IDS must make sure that the U.S. patents and U.S. patent application publications are listed in a separate section from citations of other documents. Section 1.98(a)(2)(i) is amended to eliminate the requirement in paragraph (a)(2)(i) for a copy of each U.S. patent or U.S. patent application publication listed in an IDS in a patent application regardless of the filing date of the application. Section 1.98(a)(2)(ii) is also amended to add the phrase "other than U.S. patents and U.S. patent application publications unless required by the Office." Section 1.98(c) is amended to add the phrase "as specified in paragraph (a)" to be consistent with the changes to § 1.98(a)(2). Section 1.98(e) is deleted as unnecessary.

Section 1.98(a)(1) previously did not require the use of a form such as the PTO/SB/08A and 08B because the Office wished to provide applicants the flexibility to use other types of lists. The Office, however, has experienced problems associated with lists that do not properly identify the application in which the IDS is being submitted: e.g., when applicants submit a list that includes copies of PTO-1449 or PTO-892 forms from other applications. Even though the IDS transmittal letter had the proper application number, each page of the list did not include the proper application number, but instead had the application numbers of the other applications. If the pages of the list became separated, the Office could not associate the pages with the proper application. Therefore, the rule is

amended to also require that each page of the list must clearly identify the application number of the application in which the IDS is being submitted.

Section 1.98(a)(1) is also amended to require that the list must include a column that provides a space next to each document listed in order to permit the examiner to enter his or her initials next to the citations of the documents that have been considered by the examiner. This provides a notification to the applicant and a clear record in the application to indicate which documents have been considered by the examiner in the application. Applicants are strongly discouraged from submitting a list that includes copies of PTO/SB/08 (PTO-1449) or PTO-892 forms from other applications. A completed PTO/SB/08 or PTO-1449 form from another application may already have initials of an examiner and the application number of another application. This information will likely confuse the record. Furthermore, when the spaces provided on the form have initials of an examiner, there are no spaces available next to the documents listed for the examiner of the subsequent application to provide his or her initials, and the previously relevant initials may be erroneously construed as being applied for the current application, which can be particularly confusing if the application is being handled by the same examiner.

Section 1.98(a)(1) is also amended to require that each page of the list include a heading that clearly indicates that the list is an IDS. Since the Office treats an IDS submitted by the applicant differently than information submitted by a third-party (e.g., the Office may discard any non-compliant third-party submission under § 1.99), a heading on each page of the list to indicate that the list is an IDS would promote proper treatment of the IDS submitted by the applicant and reduce handling errors.

Section 1.98(a)(2) is amended to eliminate the requirement for a copy of each U.S. patent or U.S. patent application publication listed in an IDS, unless required by the Office. The Office had provided a waiver for the former requirement in § 1.98(a)(2)(i) for a copy of each cited U.S. patent or U.S. patent application publication in IDSs submitted in U.S. national patent applications filed after June 30, 2003, and international applications that have entered the national stage under 35 U.S.C. 371 after June 30, 2003, because these applications are stored in electronic form in the Office's IFW system. *See Information Disclosure Statements May Be Filed Without Copies of U.S. Patents and Published*

Applications in Patent Applications filed after June 30, 2003, 1273 Off. Gaz. Pat. Office 55 (Aug. 5, 2003).

Information disclosure statements submitted for electronic applications are processed by Office staff to create an electronic link which permits cited U.S. patents and U.S. patent application publications to be conveniently viewed by examiners through the Office's electronic search system. This feature enables the Office to avoid scanning these documents into IFW, obviating the need for a copy of the cited U.S. patent documents. By October 2004, the Office will store almost all pending U.S. nonprovisional patent applications in electronic form in the IFW system. Accordingly, it will no longer be necessary to require a copy of each cited U.S. patent or U.S. patent application publication in an IDS regardless of the filing date of the application or the national stage entry date under 35 U.S.C. 371, unless it is required by the Office. In exceptional circumstances, such as where the application had not been converted into IFW, or the IDS includes a large number of cited U.S. patent documents, the Office may require a copy of the cited U.S. patent documents because entering a large number of cited U.S. patent documents into the Office system to create the electronic link places a significant burden on the Office and the Office cannot guarantee the accuracy of the electronic link created by the Office staff due to data entry errors. Applicants are encouraged to file an e-IDS that is submitted in compliance with the Office's EFS requirements, and may do so to avoid supplying copies of U.S. patent documents. The Office will continue to not require a copy of any cited U.S. patent documents listed in an e-IDS that is submitted in compliance with the Office's EFS requirements.

Section 1.98(c) is amended to add the phase "as specified in paragraph (a)" to be consistent with the changes to § 1.98(a)(2). Section 1.98(e) is deleted as unnecessary. Previously, one could avoid the need to supply a copy of the U.S. patent documents of former paragraph (a)(2)(i) by using the Office's EFS. This exception is not necessary because the requirement for copies of U.S. patent documents has been deleted.

Section 1.102: Section 1.102(c) is amended to provide, by rule, for a petition to make an application special without a fee when the application materially relates to a counter-terrorism invention. Prior to amending this rule, the Office accorded "special" status to patent applications relating to counter-terrorism technology so long as the fee under § 1.17(h) was included with the

petition. Amending § 1.102(c) to cover applications relating to counter-terrorism inventions will eliminate the requirement for a fee.

Under the previous § 1.102(c), there were two types of inventions that qualified as a basis for making an application special without a fee (other than on the basis of an applicant's age or health), namely: (1) inventions that will materially enhance the quality of the environment; and (2) inventions that will materially contribute to the development or conservation of energy resources. Previously, petitions to accelerate examination of inventions countering terrorism were governed by § 1.102(d) requiring a petition fee. Amended § 1.102(c) now provides that inventions that will materially contribute to countering terrorism are a third type of invention that qualify as a basis for making an application special without a fee under § 1.102(c). As set forth in MPEP § 708.02, XI (Inventions For Countering Terrorism), the types of technology for countering terrorism include, but are not limited to, systems for detecting/identifying explosives, aircraft sensors/security systems, and vehicular barricades/disabling systems. Removal of the petition fee is appropriate considering that such inventions may help maintain homeland security. In view of meeting this significant national objective, the basis for making applications relating to counter-terrorism technology special is transferred from § 1.102(d) to § 1.102(c).

Pursuant to the amendment, § 1.102(c) sets forth two bases for making an application special: (1) Applicant's age or health; or (2) that the invention is one of the three qualifying types of inventions (*i.e.*, the invention is one that will materially enhance the quality of the environment, materially contribute to the development or conservation of energy resources, or materially contribute to countering terrorism). In view of the divergent subject matter covered by § 1.102(c)(1) and (c)(2), a petition under § 1.102(c)(1) or (c)(2) must identify the particular basis under which applicant is petitioning for special status so that the Office can determine how to evaluate an application's entitlement to special status.

Where the petition is filed under § 1.102(c)(2), qualification for advanced examination is based upon the invention materially contributing as one of three qualifying types of inventions. For inventions countering terrorism, MPEP § 708.02, XI states that the petition "should be accompanied by a statement explaining how the invention contributes to countering terrorism."

Such a statement is required where the application disclosure is not clear on its face that the claimed invention is materially directed to countering terrorism. The materiality standard does not permit an applicant to speculate as to how a hypothetical end-user might specially apply the invention in a manner that could counter terrorism. Nor does such standard permit an applicant to enjoy the benefit of advanced examination merely because some minor aspect of the claimed invention may be directed to countering terrorism. Also, the application claiming an invention materially contributing to countering terrorism need not include words such as "counter terrorism", "explosives" or "security" to qualify for special status as there may be a concern how a computer-based word search could be used to identify such applications.

MPEP § 708.02, XI, Inventions For Countering Terrorism, will be amended to better reflect the standard that the invention materially contribute to countering terrorism, and to indicate that the fee requirement has been eliminated.

Applicants are reminded that any identification of a basis for requesting special status and a statement of compliance with the technology specific requirement for special status must be based upon a good faith belief that the invention in fact qualifies for special status. *See* §§ 1.56 and 10.18.

Comment 65: The Office has received internal comments expressing concern that some applicants may view the lack of a petition fee as an inducement to file petitions where the nexus between the invention and the countering of terrorism is "strained."

Response: The comment has been adopted in part. The discussion of the rule amendment has focused on the need for applicants to recognize the "material" aspect of the claimed invention's relationship to countering terrorism, which will be further addressed in an MPEP revision. In view of such discussion, applicants should not expect to have their petitions granted without a clear demonstration that the claimed invention is materially related to countering terrorism.

Section 1.103: Section 1.103(a) is amended to refer to the petition fee set forth in § 1.17(g) for consistency with the change to § 1.17. See discussion of § 1.17 for comments related to the changes in the petition fees.

Section 1.105: Section 1.105(a) is amended to revise and redesignate former paragraph (a)(3) as new paragraph (a)(4), and add new paragraphs (a)(1)(viii) and (a)(3). Section

1.105(a)(1)(viii) adds pertinent, factual, technical information that is known to the applicant as an additional example of information that might be required under § 1.105.

Section 1.105(a)(3) also expresses the Office's authority to require information in any appropriate manner, and gives, as examples, a requirement for factual information known to applicant (not involving an interrogatory or stipulation) (paragraph (a)(3)(i)); interrogatories regarding applicant's factual knowledge (paragraph (a)(3)(ii)); and stipulations as to facts with which applicant may agree or disagree (paragraph (a)(3)(iii)). Section 1.105(a)(4) contains the former § 1.105(a)(3) requirements relating to the acceptance of replies to requirements for information. The § 1.105(a)(4) recitation of safe harbor replies, that the information sought is either unknown or not readily available is set forth in a clearer manner. In addition, the characterization in § 1.105(a)(4) of the Office's acceptance of replies is changed from "will" to "may" be accepted to more accurately reflect the Office's authority to ask follow-up questions.

The provisions of existing §§ 1.105(a)(1)(i) through (a)(1)(vii) set forth non-exhaustive examples of the types of documents that may be required from applicants under § 1.105. Section 1.105(a)(1)(viii) sets forth an additional (non-exhaustive) example, technical information that is known to applicant, which may be required of applicants. This may include factual information concerning: (1) Art related to applicant's invention; (2) applicant's disclosure; (3) the claimed subject matter; (4) other factual information pertinent to patentability; or (5) the accuracy of the examiner's stated analysis of such items.

Section 1.105(a)(3)(i) provides that a requirement for information may be used to ask for factual information known to applicant. An accompanying interrogatory or stipulation is not required. Section 1.105(a)(3)(ii) provides that interrogatories may be used to ask specific questions seeking applicant's factual knowledge. Such a requirement for information may include an inquiry as to the existence of a particular document or other piece of information and a requirement that such information be supplied if it is known to exist and is readily available. Section 1.105(a)(3)(iii) provides that a stipulation may be used as to facts with which applicant may agree or disagree in order to clarify the record about uncontroverted matters. The terms "factual" and "facts" are included in the rule to make it clear that it is facts,

and factual information, that are known to applicant, or readily obtained after reasonable inquiry by applicant, that are being sought, and that requirements under § 1.105(a)(3) are not requesting opinions that may be held or would be required to be formulated by applicant. Factual technical information subject to a requirement is that factual information that is known to, or readily ascertained after making reasonable inquiry by, applicant. Where the factual information requested relates to the subject application, and details thereof, applicant would be expected to make a reasonable inquiry under the circumstances to find the factual information requested (§ 10.18(b)(2)). Applicant need not, however, derive or independently discover a fact, such as by experimentation, in response to a requirement for information. The purpose of § 1.105 is to improve patent quality, and render better decisions, and not to put applicants in jeopardy of meeting their duties of candor and good faith in their replies to a requirement for information. Requirements for stipulations and interrogatories under § 1.105 are a means to clarify prosecution history, thereby enhancing quality and reducing patent pendency, key objectives of the Office's 21st Century Strategic Plan.

Section 1.105(a)(4) replaces former § 1.105(a)(3) and provides two types of safe harbor replies to requirements for information that may be accepted as a complete reply to a requirement for information. Section 1.105(a)(4) applies not only to previously existing § 1.105(a)(1)(i)-(vii), but also to new § 1.105(a)(1)(viii), as well as any other type of information requested under § 1.105 that is not explicitly set forth in the examples of § 1.105(a)(1)(i)-(viii). Section 1.105(a)(4) indicates that the Office may accept, as a reply, a statement from applicant that the required information is "either unknown or is not readily available" (providing both alternatives) to the party or parties from which it was requested. There is seen to be no need for applicants to distinguish between whether the required information is unknown or is not readily available. Thus, if information remains unknown after a reasonable inquiry is made (MPEP § 704.12(b)), applicant may simply reply that the requested information is either unknown or is not readily available rather than be required to take a categorical position either that the information is unknown to applicant, or that the information is not readily available to applicant.

A reply under § 1.105(a)(4) that the information inquired about is unknown

may only be used after applicant has made a good faith attempt to obtain the information based on a reasonable inquiry. Applicants, however, should also be aware that the absence of some kinds of information may adversely affect the prosecution of an application. For example, to be compliant with 35 U.S.C. 112, ¶ 6, there must be a clear correlation and identification of what structure set forth in the specification would be capable of carrying out a function recited in a claim. *See Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1211, 1212, 68 USPQ2d 1263, 1268, 1269 (Fed. Cir. 2003) ("[t]he requirement that a particular structure be clearly linked with the claimed function in order to qualify as corresponding structure is also supported by the requirement" of 35 U.S.C. 112, ¶ 2, and "[t]he correct inquiry is to look at the disclosure of the patent and determine if one of skill in the art would have understood that disclosure to encompass software * * * and been able to implement such a program, not simply whether one of skill in the art would have been able to write such a software program"). A purpose for the current addition of § 1.105(a)(viii), below, is the encouragement of inquiry into the support found in the disclosure for means- or step-plus-function limitations recited in the claims (35 U.S.C. 112, ¶ 6). If it is not apparent to the examiner where in the specification and drawings there is support for a particular claim limitation reciting a means to accomplish a function, and if an inquiry by the examiner for such support is met by a stated lack of knowledge thereof by applicant, the examiner could very well conclude that there is no such support and make appropriate rejections under, e.g., 35 U.S.C. 112, ¶ 1 (written description) and 35 U.S.C. 112, ¶ 2. MPEP section 2181. This is to be distinguished from the requirement of § 1.75(d), which may be invoked to make clearer, by amending the specification, the original presence of the corresponding support.

Section 1.105 is simply an express statement of the Office's (and the examiner's) inherent authority under 35 U.S.C. 131 and 132 to require information that is reasonably necessary to properly examine or treat a matter in an application. *See Changes to Implement the Patent Business Goals*, 65 FR 54603, 54633 (Sept. 8, 2000), 1238 *Off. Gaz. Pat. Office* 77, 103 (Sept. 19, 2000) (final rule); *see also Jaskiewicz v. Mossinghoff*, 822 F.2d 1053, 1061, 3 USPQ2d 1294, 1301 (Fed. Cir. 1987) (practitioners have a duty to honestly

and forthrightly answer requirements for information from the Office). Requirements for information are not routinely made. They are to be used only where there is an absence of necessary information within the record. Any such requirement should be tailored to treat specific issues on a case-by-case basis.

Section 1.105(a)(4) has also been revised to state that the Office "may" (rather than "will") accept a reply to a requirement for information that states that the required information is either unknown or is not readily available. Such revision is intended to better reflect present practice where the Office has stated that such a reply will "generally" be accepted, but that the Office can ask follow-up questions, such as where it is clear that applicant did not understand the requirement, or the reply was ambiguous and a more specific answer is possible. MPEP § 704.12(b).

Examples where stipulations and interrogatories may be used to elicit technical factual information reasonably necessary for examination include applicant's actual knowledge: (1) Of the common technical features shared among all claims, or admission that certain groups of claims do not share any common technical features; (2) about the support found in the disclosure for means- or step-plus-function claims (35 U.S.C. 112, ¶ 6); (3) of precisely which portion(s) of the disclosure provide the written description and enablement support for specific claim element(s); (4) of the meaning of claim limitations or terms used in the claims, such as what teachings in the prior art would be covered by particular limitations or terms in a claim and which dictionary definitions would define a particular claim term, particularly where those terms are not used *per se* in the specification; (5) of which portions of each claim correspond to any admitted prior art in the specification; (6) of the specific utility provided by the claimed subject matter on a claim-by-claim basis; (7) as to whether a dependent claim element is known in the prior art based on the examiner having a reasonable basis for believing so; (8) of support for added limitations in an amended claim; and (9) of facts related to public use or sale situations. Other situations where it would be appropriate to use interrogatories or stipulations will be determined on a case-by-case basis. The intent of requirements for information in the form of interrogatories and stipulations is to obtain facts pertinent to examination or treatment of a matter. For example, applicant may be

questioned about the use of a particular claim expression as to applicant's factual knowledge of what the particular expression would cover so that an appropriate search of the prior art can be made and to determine whether alternative expressions used in the prior art are in fact equivalent teachings.

As with the initial implementation of § 1.105, the Office will train its employees on the appropriate use of the revised rule. See *Changes to Implement the Patent Business Goals*, 65 FR at 54634, 1238 *Off. Gaz. Pat. Office* at 104. Every requirement for information using stipulations or interrogatories, for an initial break-in period, will be reviewed by management in the appropriate Technology Center. More specific guidance will be provided to examiners on the treatment of replies to interrogatories and stipulations. While the Office does not currently plan to develop standard form paragraphs for interrogatories or stipulations, as interrogatories or stipulations are expected to be used on a case-by-case basis, generic form paragraphs may be developed if a need for them develops in the future.

There were many comments submitted on the proposed amendments to § 1.105, with all comments either strongly opposed to the rule change, or expressing significant concerns similar to the comments received during the rule making in which § 1.105 was initially promulgated. Some comments express almost the exact same concerns as were expressed in the original rule making (e.g., that it may be used to shift the burden of examination from the examiner to the applicant). These comments, however, do not indicate that there have actually been any problems in the three-year history of this section.

Comment 66: Several comments suggested that the Office hold public hearings prior to implementation of the changes that had been proposed to § 1.105, e.g., to permit a full airing of views and exploration of the consequences of the changes.

Response: The comment has not been adopted. The three comments that urged such a course of action did not explain what specific additional gains were to be achieved from a public hearing over what could be learned from written public comments in response to the proposed amendment to § 1.105. The Office has received a number of comments in regard to the details of the proposed changes and has adopted a number of them in an attempt to balance "improving patent quality without imposing undue burden on applicants" (statement in comment).

Comment 67: Several comments criticized the adoption of "litigation" techniques, such as interrogatories and stipulations, on the grounds that examiners are not legally trained to draft interrogatories and stipulations, in such a manner as not to be overly broad and produce useful results. A representative comment notes that "Interrogatories and stipulations are proposed to be used to elicit information as to numerous legally based categories of information. As any litigator will attest, the crafting of interrogatory questions or statements for stipulation is one that requires a fair amount of time, training and skill in considering the formulations of such and the significant verbiage of both the questions and consequences of the answers. This expanded requirement for information places the examiner, who may not be legally trained, in the role of one presumed to be experienced in litigation."

Response: To the extent that such comments are directed toward the elucidation of opinions and legal conclusions, the comments are adopted and the rule has been amended to remove the term "opinion." As to the use of interrogatories and stipulations to elicit factual information, the examiners will be given training to avoid overly broad requests and to tailor requirements to elicit specific information. Hence, examiners will endeavor to draft requirements for information that are focused and adequately convey what factual information is required.

Comment 68: Several comments state that the use of interrogatories and stipulations will be an expensive, time-consuming process, and will require applicant to expend a large amount of resources to avoid creating unnecessary estoppels.

Response: The comment has been adopted to the extent that such criticism was based on the use of interrogatories and stipulations to obtain opinions.

Comment 69: Several comments expressed concern that responses to interrogatories and stipulations will lead to additional charges of inequitable conduct.

Response: The comments are adopted in that such fears were apparently based on the use of interrogatories and stipulations to obtain opinions, which use is not reflected in the final rule.

Comment 70: Several comments strongly opposed the use of interrogatories and stipulations to elicit an opinion on the level of ordinary skill in the art. The comments say that applicants are generally not knowledgeable in that regard, examiners have greater knowledge, and in

litigation, expert witnesses are used to determine such information.

Response: The comment has been adopted in that Office guidelines will indicate that requirements for information should generally not seek opinions on the level of ordinary skill in the art, and an example thereto in the notice of proposed rule making has been deleted.

Comment 71: Several comments have expressed concern that interrogatories and stipulations may be employed as a means to shift the burden of examination to applicants.

Response: The comment is not adopted. Similar comments were made in the original rule making establishing § 1.105 (as noted above) but no commentator to this proposed rule making has indicated any instance of where § 1.105, as actually used, shifted the burden of examination to applicant. With proper training of examiners, and supervisory review of stipulations or interrogatories used during an initial period, there should not be any sound reason to be concerned.

Comment 72: Several comments are directed at the need for examiners to be trained in the drafting of interrogatories and stipulations and the need for their requirements to be reviewed by attorneys.

Response: The comment is adopted to the extent that interrogatories and stipulations should not be used to ask for opinions, and that examiners will receive training in the drafting of concise, focused interrogatories and stipulations. For an initial period after adoption of the rule, stipulations and interrogatories will be reviewed.

Comment 73: Several comments have been received seeking a mechanism for further review of interrogatories and stipulations as to their propriety, scope and clarity, faster than a petition to the Director would take.

Response: The comment has not been adopted. The current petition remedy under § 1.181 is sufficient. Applicant may petition under § 1.181 to have a requirement for information modified or withdrawn. During the three-year existence of § 1.105, there is no evidence to date that has demonstrated the need for a different means for review, or that the current means of review would not be handled expeditiously.

Comment 74: One comment asked if applicant could request clarification of the requirement for information.

Response: Clarifications may be requested but would not toll the period for reply. Tolling would lead to unnecessary prolonging of prosecution. Where applicant has made a bona fide

attempt to reply to a requirement for information but has misunderstood what was being requested, the reply will not be held to be incomplete and applicant may be given additional time to reply. Where a requirement for information cannot be answered at all or in part absent clarification, applicant should petition pursuant to § 1.181 that the requirement for information be clarified and remailed starting a new period for reply. Of course, applicant may informally contact the examiner requesting clarification without a need to remail and restart the date for reply.

Comment 75: Several comments sought clarifications for responses to the various types of information that may be required to be submitted to determine possible safe harbor responses other than the submission of the required information. In one example, it is posited that rather than ask about the distinctions among claims, the examiner could simply read the claims. A proposed "predictable and accurate response to such an interrogatory would be to recite the words used in the first independent claim, then to discuss any words that are different in any subsequent independent claims and provide technical or lay definitions for each of the different words." It is concluded that such reply would provide no more information than "the Examiner could and should have acquired on his own during the first examination."

Response: The comment is not adopted. Claims frequently contain differing generic language or convoluted syntax. Whether a single word may be misunderstood is not at issue. This may be easily remedied by reference to a standard dictionary. Rather, where different expressions are used in different independent claims to apparently describe the same function, process, product, result, etc., is the type of issue to be addressed. To the extent that applicant is aware of the fact that one expression may be broader or represent an altogether different limitation, the examiner, as well as the public, would benefit from such knowledge during prosecution rather than during infringement litigation.

Comment 76: One comment has suggested additional items of technical information that would be useful for the Office to obtain. For example, "[i]nformation that helps ensure the examiner searches and examines the 'right' invention, preferably prior to the first official action on the merits." Specific examples of such information included "meaning of claim terms," identification of "structure or steps that correspond to a functional claim

limitation," seeking to clarify "results-obtained limitations," identification of utility if not evident, and the "ability to request linkage between identified claim terms and the drawings and/or specification." It was noted that such information would improve "examination efficiency," and also benefit "the public by providing a more certain claim scope."

Response: The comment has been adopted in some of the examples set forth above.

Comment 77: Several comments suggested that the proposed amendment to § 1.105 would be particularly onerous on *pro se* inventors.

Response: The comment has been adopted to the extent that the comments were directed towards requiring submission of opinion evidence, e.g., the level of ordinary skill in the art. Thus, this final rule making clarifies that "opinion evidence" shall not be encouraged to be sought by a § 1.105 requirement. It is not seen that such comments would be equally applicable towards a requirement to submit factual information that applicants are aware of, or could readily determine after making a reasonable inquiry.

Comment 78: Comments have requested the inclusion of a provision "clarifying that confidential and protected information cannot be requested under Rule 105." It is noted in the comments that "an agency cannot routinely request such information to be produced without first meeting heightened burdens, specific to each type of information requested, to show why such information is necessary." It is argued that a standard of "reasonably necessary" is a "much lower burden" than "substantial need," which is the standard required to obtain an attorney work product.

Response: The comment is not adopted. The argument that the standard of "reasonably necessary to properly examine or treat" a matter would not suffice is not accepted. Where applicant is being asked to submit what it believes to be trade secret, proprietary, and/or protective order materials, applicant can make use of, at the time the material is submitted, the provisions of § 1.59 for expungement of information where applicable. Additionally, applicant can petition under § 1.181 that the trade secret, proprietary, and/or protective order materials being requested to be submitted are unnecessary.

Comment 79: A comment seeks to have the Office specifically provide in Rule 105 that "the record must provide support for the proposition that the particular information being requested

is reasonably necessary to further examination of the application.”

Response: The comment is not adopted. A review of MPEP §§ 704.11 and 704.11(a), relating to determining if information is reasonably necessary, reveals that the need for such information should be based on the presence, or *absence*, of information in the record of the application.

Comment 80: A comment seeks to have a provision in § 1.105 “clarifying that the examiner making the request for information must explicitly articulate, based on specific facts in the record, the reason why the information is reasonably necessary.”

Response: The comment is not adopted. As a practical matter, specific guidance exists in examples in § 1.105, in this final rule, and the MPEP. All this guidance clearly dictates that requirements for information are made only when reasonably necessary.

Comment 81: One comment requested that “the examiner be required under the rule to provide a reasoned statement in the record as to why the request for information does exhibit a reasonable likelihood of being readily fulfilled by the applicant.” It was also requested that examples be given of “what types of requests would not exhibit such a reasonable likelihood of being fulfilled by the applicant.”

Response: Examples are provided to examiners as to the types of information that can be required to be submitted. The examples relate to factual information that is “reasonably necessary to properly examine or treat the matter.” Moreover, § 1.105(a)(4) provides that the Office may accept as a complete reply that the factual information requested is unknown or is not readily available. In appropriate situations the Office can ask follow-up questions. It is not seen to be productive to develop negative examples where information would not be readily be available.

Comment 82: One comment asks for clarification as to whether equivalents need also be specified when replying to a requirement for information as to support in the disclosure for a means-or step-plus-function limitation.

Response: Equivalents by their nature are items not specifically disclosed in the specification as corresponding to the function in the claim, but are equivalents of what are so disclosed. Hence, a requirement for information requiring only identification of what structure or steps in the specification are taught as corresponding with the claimed function would not require disclosure of equivalents. An examiner may, however, inquire as to what

applicant knows to be equivalents to what is disclosed if such information would be reasonably necessary for purposes of search or prior art application and therefore necessary to properly examine the application. In such case, applicant would be required to identify all equivalents of which applicant has actual knowledge.

Comment 83: A comment asks “[w]here applicant intends a claim term to be afforded its accustomed meaning, would it be a complete and proper response to merely indicate the intention? If not, must a dictionary definition be given * * * as only one example of a term’s accustomed meaning?” The comment goes on to question the need for such requirement as the examiner is “presumed to be skilled in the field of the invention” and has “access to dictionaries and treatises to the same extent as applicant. * * *”

Response: A requirement as to the scope or definition of a claim term would be because the record was unclear in such matter. A reply that the term be given its ordinary meaning would be sufficient, provided general publication dictionaries define such term. Where applicant is relying upon a specialized treatise for the definition of a term, it may be that the examiner does not have access to such treatise and a more specific reply, such as identification of the treatise and a copy of the pertinent page, may be required.

Comment 84: One comment states stipulations and interrogatories to elicit information about claim terms are unnecessary as applicant’s interpretation is “totally irrelevant, as claims are given their broadest reasonable meaning absent a clear definition in the specification.”

Response: Interrogatories will not be used to seek applicant’s opinion about claim terms. Examiners, however, need to appreciate the meaning of claims prior to giving them the broadest reasonable interpretation. The meaning of words, phrases and terms is often opaque and clarification would be highly desirable. To the extent that an applicant has some factual information as to what is meant by a particular word or phrase, it is appropriate that applicant supply such information. For example, it may be that a portion of the specification has given a special definition to the term, which is not apparent to the examiner. Moreover, it may not be apparent to an examiner how broad a particular limitation may in fact be read, *e.g.*, where the claim term or expression lends itself to a variety of meanings or it is particularly opaque. Thus, applicant’s factual knowledge is relevant and necessary to

properly examine the application. Additionally, a stipulation may be useful in seeking agreement with what the examiner believes to be the proper definition of a claim term or phrase. The failure to reach agreement would in itself provide valuable prosecution history.

Comment 85: One comment, in discussing the example of identification of a specific utility supporting the claimed subject matter, requests that the examiner be required to indicate a reason to doubt the objective truth of the statements in the disclosure of a specific utility.

Response: The comment is not adopted. Example 7 in the notice of proposed rule making includes the situation where there is a disclosure of more than one utility, some of which are incredible, and at least one claim where it is not specified which utilities support that claim. *See Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan*, 68 FR at 53832, 1275 *Off. Gaz. Pat. Office* at 37. In such instance, it is appropriate for the examiner to question which utility supports which claims so as to determine if any claims are supported by only incredible utilities. Where a utility is believed to be incredible and it is the only one that is identified in the specification as supporting a particular claim, Office policy directs the examiner to reject the claim and provide reasons why the utility is believed to be incredible. The issue of the examiner doubting the objective truth of the statements in the disclosure of a specific recited utility is not reached under the purpose contemplated for § 1.105. Section 1.105 is to be utilized to identify a utility asserted to support a claim. Once that is established, should the examiner doubt that such utility supports a particular claim, a rejection, not a requirement for information, would be made.

Comment 86: Two comments suggested that the use of a rejection rather than a requirement for information is more appropriate, such as if the examiner cannot comprehend the technology. A response to the rejection can either direct the examiner to teachings in the disclosure or the prior art, or amend the specification and/or claims if applicant agrees that the examiner’s confusion is caused by the application. Information about precisely which portions of the disclosure provide written description supporting the enablement of the claim is unnecessary as claims are presumed enabled. Such information is “not reasonably necessary to examination

until the Office makes a prima facie case of lack of written description or nonenablement.”

Response: The comments are not adopted. The type of information contemplated under § 1.105 may affect the type of search done by the examiner and may therefore be beneficial to have prior to a first Office action on the merits. A distinction will be made in the implementation instructions regarding compliance with § 1.75(d)(1) vs. 35 U.S.C. 112, ¶ 2. If the examiner is convinced that the claim's metes and bounds lack sufficient definition in the specification, a rejection under 35 U.S.C. 112, ¶ 2, would be appropriate. If, on the other hand, the examiner is not certain that there is compliance with § 1.75(d)(1) between the claims and the specification, rather than require amendment to achieve conformance, which may have implications under *Festo v. Shoketsu Kinzoku Kogyo*, 535 U.S. 722, 62 USPQ2d 1705 (2002), the record may be clarified by a reply to a requirement for information rather than by amendment.

Comment 87: One comment characterizes the rule as overly broad in not limiting the amount of discovery requests that could be made.

Response: The comment is not adopted. The Office does not envision multiple sequential requirements for information being made, except for limited situations, such as where it appears that applicant did not understand the requirement, or the reply was ambiguous and a more specific answer is possible.

Comment 88: One comment states that stipulations are unnecessary because if “an Examiner's assertion is not controverted, the record stands for the Examiner's assertion under the doctrine of file wrapper estoppel.”

Response: The comment is not adopted. Silence on part of the applicant to a statement made by the examiner does not necessarily establish an estoppel.

Comment 89: One comment suggests that Rule 105 should be “directed to applicants, or to the assignee if the assignee has excluded the rights of the applicants.”

Response: The comment is not adopted. The suggestion would exclude the inventors from being questioned where the assignee has taken over prosecution. The fact that the assignee has taken over prosecution of an application does not shield the inventors from their duties, such as executing a § 1.63 declaration, or providing material information to the Office. To the extent that one or more inventors can no longer be located or

refuse to cooperate, such would support a reply that the information is not readily available, if they are the only ones with such information.

Section 1.111: Section 1.111(a)(2) is amended to provide that a reply that is supplemental to a § 1.111(b) compliant reply will not be entered as a matter of right, with the exception that a supplemental reply will be entered if it is filed within the period when action by the Office is suspended under § 1.103(a) or (c) (suspensions requested by the applicant). Section 1.111(a)(2) is also amended to provide that the Office may enter a supplemental reply if the supplemental reply is clearly limited to: (1) Cancellation of a claim(s); (2) adoption of the examiner suggestion(s); (3) placement of the application in condition for allowance; (4) reply to an Office requirement made after the first reply was filed; (5) correction of informalities (e.g., typographical errors); or (6) simplification of issues for appeal. When a supplemental reply is filed in sufficient time to be entered into the application filed before the examiner considers the prior reply, the examiner may approve the entry of a supplemental reply if, after a cursory review, the examiner determines that the supplemental reply is limited to meeting one or more of the conditions set forth in § 1.111(a)(2)(i). The new practice replaces the prior practice for disapproving a second or subsequent supplemental reply set forth in § 1.111(a)(2).

A supplemental reply which has not been approved for entry, and therefore, not entered, will not be entered when a reply to a subsequent Office action is filed, even if there is a specific request for its entry in the subsequent reply. If applicants wish to have the (not entered) supplemental reply considered by the examiner, applicants must include the contents of the (not entered) supplemental reply in a proper reply under § 1.111, 1.116, or 1.312 in response to the next Office action. If the reply under § 1.111, 1.116, or 1.312 includes any amendments to the specification including claims, or drawings, the reply must be filed in compliance with § 1.121. If the next Office action is a final rejection or a notice of allowance, applicants may file an RCE in compliance with § 1.114 (i.e., having a submission and a fee) and include the contents of such (not entered) supplemental reply in the submission.

A supplemental reply will be entered if it is filed within the period during which action is suspended by the Office under § 1.103(a) or (c). For example, if test data is required to overcome a

rejection under 35 U.S.C. 103(a) and the applicant needs more time to conduct an experiment and collect the test data, the applicant may file a first reply to the Office action (as the Office will not grant a suspension of action if there is an outstanding Office action awaiting a reply by the applicant) and a petition for suspension of action with a showing of good and sufficient cause under § 1.103(a). If the suspension is granted by the Office, applicant may submit the test data in a supplemental reply during the suspension period. In addition, if an applicant is filing an RCE after a final rejection accompanied by a submission which is a reply to the final Office action, and needs more time to prepare a supplemental reply (e.g., an affidavit), applicant may consider filing a request for suspension of action under § 1.103(c) along with the RCE (and submission) because any supplemental reply filed during the suspension period will be entered. See § 1.111(a)(2)(ii). A supplemental reply, however, will not be entered if it is filed during a suspension of action initiated by the Office under § 1.103(e), (f) or (g). Amendments filed within the period during which action is suspended under § 1.103(b) (note: continued prosecution applications (CPAs) for designs can still be filed) or § 1.103(d) are not considered supplemental replies under § 1.111 because they are preliminary amendments per § 1.115. Information disclosure statements under § 1.97 and § 1.98 are also not considered supplemental replies under § 1.111.

Section 1.111(a)(2) will not change the impact of the submission of a supplemental reply on patent term adjustment, in that the submission of any supplemental reply will continue to cause a reduction of any accumulated patent term adjustment under § 1.704(c)(8).

Comment 90: Several comments suggested that the Office should not require that a supplemental reply must be filed within the statutory period. The comments further suggested that a supplemental reply should be entered if it is filed and associated with the application file before the examiner begins considering the original reply. One of the comments also suggested that the Office should adopt a guideline similar to the PCT Regulation 66.4bis which states “[a]mendments or arguments need not be taken into account by the International Preliminary Examining Authority for the purposes of a written opinion or the international preliminary examination report if they are received after that Authority has begun to draw up that opinion or report.”

Response: Most of these suggestions have been adopted. Section 1.111(a)(2)(i) will not require that a reply that is supplemental to a § 1.111(b) compliant reply must be filed within the statutory period. While a supplemental reply does not have to be filed within the statutory period for reply, if applicant wishes to have a supplemental reply considered for entry, applicant should file the supplemental reply in sufficient time to be entered into the application file before the examiner considers the prior reply.

Comment 91: Several comments suggested that the prior disapproval practice that permits the Office to disapprove a second or subsequent supplemental reply when a substantial amount of work has already been conducted by the examiner would appear sufficient to safeguard the interests of the Office in maintaining the efficiency of the examination process. A few comments further suggested that the Office should apply the disapproval practice to the first supplemental reply.

Response: These suggestions have not been adopted. The disapproval practice did not address the pendency problems associated with first supplemental replies. The Office receives a significantly larger number of first supplemental replies than second (or subsequent) supplemental replies. The procedures for disapproving a second (or subsequent) supplemental reply were too time-consuming for examiners to use for the large number of first supplemental replies in determining whether a substantial amount of work has already been conducted on the date the Office receives the first supplemental reply. Furthermore, when the examiner wished to disapprove a supplemental reply, the examiner had to request the Office technical support to unenter the amendment, change the system records, and send the applicant an Office communication to document the reasons for the disapproval. The revised § 1.111(a)(2) will provide a single simplified procedure for handling all supplemental replies, which will reduce processing delays and save Office resources.

Comment 92: A few comments suggested that there may be justifiable reasons for filing a supplemental reply other than the specific reasons identified in the proposed § 1.111(a)(2)(i), such as a supplemental amendment to correct inadvertent errors, to reduce the issues for an appeal following an interview by the examiner, to file a complete written statement of the reasons presented at the interview as warranting favorable action under

§ 1.133(b), or to take into consideration the teachings of new prior art.

Response: Most of these suggestions have been adopted. Section 1.111(a)(2)(i) includes three more conditions where a supplemental reply may be entered, which are: Reply to an Office requirement made after the first reply was filed; correction of informalities (e.g., typographical errors); and simplification of issues for appeal. See § 1.111(a)(2)(i)(D) through (a)(2)(i)(F).

Comment 93: A few comments requested clarification on whether applicants may request entry of a supplemental reply in response to a final Office action without filing an RCE under § 1.114, although it is recognized that there would be no entry of such an amendment as a matter of right without filing the RCE.

Response: The Office would like to clarify that an applicant may include the contents of a supplemental reply that has previously not been approved for entry in a reply under § 1.116 in response to a final Office action. Entry of the reply, however, would be unlikely as the standard for entry under § 1.116 is similar to the standard for entry under § 1.111(a)(2)(i). Furthermore, applicants cannot simply request the entry of a supplemental reply in a subsequent reply. If applicants wish to have a (not entered) supplemental reply considered by the examiner, applicants must include the contents of the (not entered) supplemental reply in a proper reply under § 1.111, 1.116, or 1.312, or an RCE submission under § 1.114(c). If the reply or submission includes any amendments to the specification including claims, or drawings, the reply must be filed in compliance with § 1.121.

Comment 94: A comment suggested that a submission in reply to a requirement under § 1.105 should not be considered as a reply under § 1.111 because applicants should be allowed to file a supplemental reply to a requirement under § 1.105.

Response: If applicant wishes to file additional information after submitting a reply to a requirement under § 1.105, applicant may file the additional information in a supplemental reply to the requirement under § 1.105, although such reply will not be entered as a matter of right. Applicant may also submit the additional information in accordance with § 1.97 and § 1.98.

Comment 95: A comment suggested that the Office should provide the examiner discretionary authority to enter a supplemental amendment filed before the mailing of a subsequent

Office action and provide substantial guidance indicating exemplary circumstances in which the Office believes that examiners should exercise their discretion to enter the supplemental amendments. Another comment sought clarification whether the examiner has the discretionary authority to enter and consider supplemental amendments that are not listed in § 1.111(a)(2)(i).

Response: The suggestions have been adopted. Section 1.111(a)(2)(i) will not require that a reply that is supplemental to a § 1.111(b) compliant reply must be filed within the statutory period. Section 1.111(a)(2)(i) provides that such a supplemental reply will not be entered as matter of right except as provided in § 1.111(a)(2)(ii). Section 1.111(a)(2)(i) provides six exemplary circumstances where an examiner can exercise discretion to enter a supplemental reply. Examiners may enter and consider other supplemental amendments that are not listed in § 1.111(a)(2)(i).

Comment 96: A comment suggested that the Office should provide a procedure for filing an RCE under § 1.114 in applications that have not been finally rejected.

Response: The comment is not adopted. Filing an RCE is not necessary if prosecution in the application is not closed. Applicant may include the contents of the (previously not entered) supplemental reply in a proper reply to the next Office action.

Comment 97: A comment indicated that there would be disagreement between the applicant and the examiner on whether a supplemental amendment would place the application in condition for allowance. The comment further indicated that since such determination can only be made after the supplemental reply has been entered and considered, it would be illogical to deny entry at that time.

Response: The comment is not adopted. The examiner is not required to give full consideration to the supplemental reply before not approving the entry of the supplemental reply. The examiner has the discretion not to approve the entry of a supplemental reply if, after a cursory review, the examiner determines that the supplemental reply does not place the application in condition for allowance and no other conditions set forth in § 1.111(a)(2)(i) applies.

Section 1.115: Section 1.115(a) is amended to provide that the patent application publication may include preliminary amendments. For more details, see § 1.215(a). Section 1.115(a)(1) is added to provide that a preliminary amendment that is present

on the filing date of an application is part of the original disclosure of the application. Section 1.115(a)(2) is added to provide that a preliminary amendment filed after the filing date of the application is not part of the original disclosure of the application. Section 1.115(b) is amended to include the first sentence of § 1.115(b)(1) to read “[a] preliminary amendment in compliance with § 1.121 will be entered unless disapproved by the Director.” The rest of original § 1.115(b)(1) is redesignated as § 1.115(b)(2). Section 1.115(b)(2) is redesignated as § 1.115(b)(3). Section 1.115(b)(1) is amended to provide that a preliminary amendment seeking cancellation of all claims without presenting any new or substitute claims will be disapproved. Section 1.115(c) is redesignated as § 1.115(b)(4) and is amended to change the reference to paragraph (b)(2) to paragraph (b)(3) because paragraph (b)(2) is redesignated as paragraph (b)(3).

The Office will treat any preliminary amendment under § 1.115(a)(1) that is present on the filing date of the application automatically as part of the original disclosure. Under the prior practice, a preliminary amendment that was present on the filing date of an application may be considered a part of the original disclosure if it was referred to in a first filed oath or declaration in compliance with § 1.63. If the preliminary amendment was not referred to in the oath or declaration, any request to treat the preliminary amendment as a part of the original disclosure was by way of petition under § 1.182 requesting that the original oath or declaration be disregarded and that the application be treated as an application filed without an executed oath or declaration under § 1.53(f). Any such petition must have been accompanied by the \$130.00 petition fee, a newly executed oath or declaration (which identified the application and referred to the preliminary amendment), and the requisite surcharge under § 1.16(e).

Section 1.115(a)(1) will provide a consistent way of treating preliminary amendments that are present on the filing date of the application as part of the original disclosure and eliminates the need for filing a petition under § 1.182, the petition fee, and the surcharge under § 1.16(e) when applicant files a supplemental oath or declaration that refers to the preliminary amendment.

If a preliminary amendment is present on the filing date of an application, and the oath or declaration under § 1.63 does not also refer to the preliminary amendment, the normal operating

procedure is to not screen the preliminary amendment to determine whether it contains subject matter not otherwise included in the specification or drawings of the application as filed (*i.e.*, subject matter that is “new matter” relative to the specification and drawings of the application). As a result, it is applicant’s obligation to review such a preliminary amendment to ensure that it does not contain subject matter not otherwise included in the specification or drawings of the application as filed, otherwise a supplemental oath or declaration under § 1.67 referring to such preliminary amendment must be filed in the application. The failure to submit a supplemental oath or declaration under § 1.67 referring to a preliminary amendment that contains subject matter not otherwise included in the specification or drawings of the application as filed removes safeguards that are implied in the oath or declaration requirements that the inventor review and understand the contents of the application, and acknowledge the duty to disclose to the Office all information known to be material to patentability as defined in § 1.56.

Applicants can avoid the need to file an oath or declaration referring to any preliminary amendment by incorporating any desired amendments into the text of the specification including a new set of claims when filing the application instead of filing a preliminary amendment, even where the application is a continuation or divisional application of a prior-filed application. Furthermore, applicants are strongly encouraged to avoid submitting any preliminary amendments so as to minimize the burden on the Office in processing preliminary amendments and reduce delays in processing the application.

During examination, if an examiner determines that a preliminary amendment that is present on the filing date of the application includes subject matter not otherwise supported by the originally filed specification and drawings, and the oath or declaration does not refer to the preliminary amendment, the examiner may require the applicant to file a supplemental oath or declaration under § 1.67 referring to the preliminary amendment. In response to the requirement, applicant must submit (1) An oath or declaration that refers to the preliminary amendment, (2) an amendment that cancels the subject matter not supported by the originally filed specification and drawings, or (3) a request for reconsideration.

Section 1.115(a)(2) is added to provide clarification that a preliminary amendment filed after the filing date of the application is not part of the original disclosure of the application.

Preliminary amendments filed after the filing date of the application cannot include new matter, (*i.e.*, subject matter not supported by the original disclosure of the application). See 35 U.S.C. 132.

Example 1 (supplemental declaration): Practitioner has received an application for filing along with an executed § 1.63 declaration by the inventors. Practitioner has drafted a preliminary amendment and would like to file the amendment along with the application but is uncertain whether the amendment contains subject matter not otherwise supported by the application as executed by the inventors. Practitioner should file the application along with the executed declaration and preliminary amendment. As a precaution, the inventors should execute and thereafter the practitioner should submit a supplemental declaration under § 1.67 that refers to the preliminary amendment.

Example 2 (incorporation by reference): A preliminary amendment is present as of the filing date of an application. The preliminary amendment contains an incorporation by reference to a U.S. patent. The incorporated material represents subject matter not otherwise present in the specification of the application. A § 1.63 oath or declaration specifically referring to the preliminary amendment is required.

Section § 1.115(b)(1) is amended to provide that a preliminary amendment seeking cancellation of all the claims without presenting any new or substitute claims will be disapproved.

Before June of 1998, it was the practice of the Office to treat an application filed with an amendment (preliminary amendment) canceling all of the claims and presenting no new or substitute claims by denying entry of the amendment. See MPEP §§ 711.01 and 714.19 (7th ed. 1998). In *Baxter Int’l Inc. v. McGaw Inc.*, 149 F.3d 1321, 47 USPQ2d 1225 (Fed. Cir. 1998), the Federal Circuit held that a divisional application that included instructions to cancel all of the claims in the specification, without presenting any new claims, and did not contain at least one claim as required by 35 U.S.C. 112, ¶2, was not entitled to a filing date under 35 U.S.C. 111(a) until the date an amendment including at least one claim was filed in the application. Following *Baxter*, the Office changed its practice and no longer accorded a filing date to any application that was accompanied

by a preliminary amendment which canceled all claims and failed to simultaneously submit any new claims. See *Any Application Filed With Instructions to Cancel All of the Claims in the Application is Not Entitled to a Filing Date*, 1216 *Off. Gaz. Pat. Office* 46 (Nov. 10, 1998).

Subsequently, in *Exxon Corp. v. Phillips Petroleum Co.*, 265 F.3d 1249, 60 USPQ2d 1368 (Fed. Cir. 2001), the Federal Circuit affirmed that the Office may refuse to enter an improper amendment that would cancel all of the claims in an application to avert harm (loss of a filing date) to an applicant. The Federal Circuit distinguished its decision in *Baxter*, since in *Baxter* the Office did enter the amendment that canceled all of the claims in the application, thus resulting in the application not being entitled to a filing date. In contrast, in *Exxon* the Office refused to enter the amendment and thus the claims were never canceled.

Consistent with *Exxon Corp. v. Phillips Petroleum Co.* and MPEP §§ 711.01 and 714.19, the Office will disapprove entry of any amendment (whether submitted prior to, on or after the filing date of the application) that seeks cancellation of all claims but does not present any new or substitute claims. Also see *Treatment of Amendments that if Entered Would Cancel All of the Claims in an Application*, 1255 *Off. Gaz. Pat. Office* 827 (Feb. 5, 2002). For fee calculation purposes, however, the Office will treat such an application as containing a single claim. For example, if an applicant files a preliminary amendment seeking cancellation of all the claims without presenting any new or substitute claims and the claims in the application have not been paid for, such amendment will be disapproved for entry and the Office of Initial Patent Examination (OIPE) will initially treat the application as containing a single claim for fee calculation purposes. In most cases, such an amendment would not contain a complete claim listing and would not comply with § 1.121. Therefore, OIPE will notify the applicant and require a preliminary amendment in compliance with § 1.121. When the applicant files a preliminary amendment in compliance with § 1.121, OIPE will take the preliminary amendment in compliance with § 1.121 into account in determining the appropriate filing fee due.

Comment 98: One comment suggested that the Office should not adopt the second sentence of proposed § 1.115(b): “[i]f a preliminary amendment is determined to contain matter not otherwise included in the contents of

the originally filed specification, including claims, and drawings, and the preliminary amendment is not specifically referred to in the oath or declaration under § 1.63, a new oath or declaration in compliance with § 1.63 will be required.”

Response: The second sentence of proposed § 1.115(b) is not adopted in the final rule. If a preliminary amendment is present on the filing date of an application, and the oath or declaration under § 1.63 does not also refer to the preliminary amendment, the normal operating procedure is to not screen the preliminary amendment to determine whether it contains subject matter not otherwise included in the specification or drawings of the application as filed (*i.e.*, subject matter that is “new matter” relative to the specification and drawings of the application). As a result, it is applicant’s obligation to review such a preliminary amendment to ensure that it does not contain subject matter not otherwise included in the specification or drawings of the application as filed, otherwise a supplemental oath or declaration under § 1.67 referring to such preliminary amendment must be filed in the application. The failure to submit a supplemental oath or declaration under § 1.67 referring to a preliminary amendment that contains subject matter not otherwise included in the specification or drawings of the application removes safeguards that are implied in the requirements that the inventor review and understand the contents of the application, and acknowledge the duty to disclose to the Office all information known to be material to patentability as defined in § 1.56.

Comment 99: A few comments suggested that if the Office adopts the second sentence of proposed § 1.115(b), applicant should have the option to cancel the subject matter that is not otherwise supported in the originally filed specification and drawings, or request for reconsideration, rather than submitting a new oath or declaration referring to a preliminary amendment filed on or before the filing date of the application.

Response: The second sentence of proposed § 1.115(b) is not adopted in the final rule. During examination, however, if the examiner determines that a preliminary amendment that is present on the filing date of the application contains subject matter not otherwise supported by the specification and drawings of the application as filed, the examiner may require a supplemental oath or declaration under § 1.67 referring to

such preliminary amendment. In response to the requirement, the applicant must submit: (1) A supplemental oath or declaration under § 1.67 referring to such preliminary amendment, (2) an amendment to cancel the subject matter that is not otherwise supported in the originally filed specification and drawings, or (3) a request for reconsideration.

Comment 100: A few comments suggested that the second sentence of proposed § 1.115(b) should be amended to read “if such a preliminary amendment submitted on or prior to the filing date of an application is determined * * *” for purposes of clarity.

Response: This proposed sentence is not adopted in the final rule. It is, however, applicant’s obligation to review any preliminary amendment that is present on the filing date of the application to ensure that it does not contain subject matter not otherwise supported by the originally filed specification and drawings. Otherwise, applicant must file an oath or declaration referring to such preliminary amendment.

Comment 101: One comment requested clarification on what subject matter constitutes part of the “original disclosure” as opposed to “originally filed specification, including claims, and drawing.”

Response: The “original disclosure” of the application includes application papers (*e.g.*, the specification, including claims, any drawings, and any preliminary amendment) that are present on the filing date of the application. The phrase “originally filed specification, including claims, and drawing” includes the specification, including claims, and drawings that are present on the filing date of the application, but it does not include any preliminary amendment.

Comment 102: One comment indicated that the automatic inclusion of preliminary amendments filed on or before the filing date of the application as part of the original disclosure could have substantial adverse effects where an applicant intends not to add new disclosure, but the examiner nonetheless holds that the amendment presents “new matter” relative to the specification and drawings of the application as filed. The disagreement could lead to substantial administrative delays in prosecution.

Response: Section 1.115(a)(1) codifies the prior practice, but eliminates the requirement for filing a petition under § 1.182, the petition fee, and the surcharge under § 1.16(e). The elimination of the petition requirement

will reduce any delays in prosecution caused by the filing and processing of the petition. Thus, no additional delays in prosecution due to the changes in § 1.115(a)(1) are expected.

Comment 103: One comment questioned the Office's authority to bind courts by § 1.115. The comment noted that 35 U.S.C. 2 only gives the Office authority to make procedural rules.

Response: The Office has the authority to promulgate § 1.115 since the rule is a procedural rule. The Office already has a similar procedure in place. Section 1.115(a)(1) codifies the prior practice, but eliminates the requirement for a petition under § 1.182.

Comment 104: One comment suggested that if a new oath or declaration referring to a preliminary amendment cannot be executed by all of the inventors, applicants may file a petition, similar to a petition under § 1.47, for the Office to accept an oath or declaration signed by other available inventors.

Response: The current practice set forth in MPEP § 603 provides that if an inventor who executed the original declaration is refusing or cannot be found to execute a required supplemental declaration, the requirement for that inventor to sign the supplemental declaration may be suspended or waived in accordance with § 1.183. All available joint inventors must sign the supplemental declaration on behalf of themselves, if appropriate, and on behalf of the nonsigning inventor. See MPEP sections 603 and 409.03.

Comment 105: One comment suggested that § 1.115(b)(2)(ii) should be amended to delete the reference to continued prosecution application (CPA) under § 1.53(d) because the CPA practice has been eliminated.

Response: This suggestion is not adopted. Continued prosecution applications (CPA) under § 1.53(d) can be filed in design applications. See § 1.53(d)(1). The CPA practice was eliminated only as to utility and plant patent applications. See *Elimination of Continued Prosecution Application Practice as to Utility and Plant Patent Applications* 68 FR 32376 (May 30, 2003) 1271 *Off. Gaz. Pat. Office* 43 (June 24, 2003) (final rule).

Comment 106: One comment suggested that the time periods set forth in § 1.115(b)(2) should be extended.

Response: The Office did not propose changes to § 1.115(b)(2) which has been redesignated as § 1.115(b)(3).

Comment 107: One comment asked the Office to clarify whether a preliminary amendment or an information disclosure statement should

be filed within three months of the filing date or to wait until after receiving the official filing receipt.

Response: Applicants are strongly encouraged not to file preliminary amendments. Applicants should incorporate any desired changes into the specification and drawings when filing the application. If an applicant wishes to file a preliminary amendment or an information disclosure statement (IDS), the preliminary amendment or IDS may be filed as soon as applicant receives an Office communication that provides the application number assigned to the application so that the amendment or IDS can be properly identified with the application number.

Section 1.121: Section 1.121(d) is clarified by adding a sentence that any new sheet of drawings containing an additional figure must be labeled in the top margin as "New Sheet." Although the instant amendment was not set forth in the notice of proposed rule making, the amendment is merely made to provide a means of identification, "New Sheet," for presenting an additional figure, a type of drawing change identification previously omitted, which is in addition to the replacement figure identification that was previously provided for.

Section 1.121(d)(1) is clarified by replacing the phrase "Annotated Marked-up Drawings" with "Annotated Sheet." Although the instant amendment was not set forth in the notice of proposed rule making, the amendment is merely made for the purpose of conformity with § 1.121(d), which utilizes the word "sheet" rather than drawing.

Section 1.131: Section 1.131(b) is amended for correction of a typographical error that was inadvertently introduced in the final rule *Miscellaneous Amendments of Patent Rules*, 53 FR 23728 (June 23, 1988) (final rule). The typographical error that is corrected is contained in the text at the end of the second (and last) sentence of § 1.131(b), which pertains to exhibits or records needed to substantiate an oath or declaration of prior invention swearing behind a reference applied in a rejection of a claim. Specifically, the text "of their absence satisfactorily explained" should read "or their absence satisfactorily explained" (emphasis added). Thus, § 1.131(b) is amended to clarify that for any oath or declaration under § 1.131 lacking original exhibits of drawings or records in support thereof, the absence of such original exhibits of drawings or records must be satisfactorily explained.

Section 1.136: Section 1.136(b) is amended to add a petition fee

requirement. Paragraph 1.136(a)(2), for example, specifically refers to § 1.136(b) for extensions of time to file replies under §§ 1.193(b), 1.194, 1.196 or 1.197 after a notice of appeal is filed. Section 1.136(a) is not available for extending the period of replies under §§ 1.193(b), 1.194, 1.196 or 1.197. Applicant may, however, still be able to make the "sufficient cause" showing under § 1.136(b). To evaluate whether a showing of "sufficient cause" exists, decisions on § 1.136(b) requests require a thorough evaluation of facts and circumstances on a case-by-case basis. Furthermore, requests under § 1.136(b) are generally treated expeditiously by the deciding official. At MPEP § 710.02(e), it is recommended that requests under § 1.136(b) be filed in duplicate with a stamped return-address envelope to assist the Office in processing these requests with special dispatch. To reflect the Office's cost of deciding requests under § 1.136(b), a requirement for a petition fee is added to § 1.136(b). Evaluation of a request for an extension of time under § 1.136(b) for sufficient cause is analogous to evaluation of a request for the Office to suspend action for sufficient cause pursuant to § 1.103(a). See discussion of § 1.17 for comments related to the changes in the petition fees.

Section 1.137: Section 1.137(d) is amended to clarify that when reviving a reissue application pursuant to § 1.137 a terminal disclaimer is not required. Section 1.137(d)(3) is amended to clarify that the terminal disclaimer requirements of paragraph (d)(1) do not apply to reissue applications. Pursuant to 35 U.S.C. 251, a patent is reissued "for the unexpired part of the term of the original patent." Hence, any period of abandonment of a reissue application, should the reissue application become revived and serve to reissue the patent, will result in a loss of patent term for the period that the reissue application was abandoned. Accordingly, there is no need to impose an additional penalty on patentee to terminally disclaim the entire period of abandonment of a reissue application. This rationale accords with the exclusion of the terminal disclaimer requirement when petitioning for revival of nonprovisional applications filed on or after June 8, 1995, pursuant to § 1.137(d)(1).

Current Office practice does not require a terminal disclaimer as a condition precedent for revival of an abandoned reissue application, no matter when the application was filed, where revival is otherwise appropriate.

In order to codify current practice, § 1.137(d)(3) is amended by inserting "to reissue applications" to provide a

blanket exception for reissue applications. Regardless of when the reissue application was filed, applicant is not required to file an accompanying terminal disclaimer with a petition to revive under § 1.137.

Section 1.165: Section 1.165(b) is amended to remove the requirement for a black and white copy of a color drawing or photograph. This requirement has already been waived. See *Interim Waiver of Parts of 37 CFR 1.84 and 1.165, and Delay in the Enforcement of the Change in 37 CFR 1.84(e) to No Longer Permit Mounting of Photographs*, 1246 Off. Gaz. Pat. Office 106 (May 22, 2001).

Section 1.173: Section 1.173(b) is amended to clarify that paragraphs (b)(1), (b)(2) and (b)(3) are directly related to, and should be read with, paragraph (b).

Section 1.175: Section 1.175 is amended by adding a new paragraph (e), which requires a new oath or declaration which identifies an error not corrected in an earlier reissue application be filed in any continuing reissue application that does not replace its parent reissue application.

Section 1.175 was previously interpreted to require any continuing reissue application whose parent application has not been abandoned to include an oath or declaration identifying at least one error being corrected, which error is different from the error(s) being corrected in the parent reissue (or an earlier reissue). Such interpretation is now clarified by the addition of paragraph (e) to § 1.175. Ordinarily, a single reissue application is filed to replace a single original patent and corrects all of the errors recognized by the applicant at the time of filing of the (single) reissue. If, during the prosecution of the reissue application, applicant (patentee) recognizes additional errors needing corrections, such corrections could, and should, be made in the same application. If, however, after the close of prosecution and up until the time that the first reissue issues, applicant recognizes a further error which needs correction and files a continuing reissue application, § 1.175(e) now explicitly requires applicant to include an oath or declaration which identifies an error which was not corrected in the parent reissue application or in an earlier reissue application, e.g., a grandparent reissue application.

Section 1.178: Section 1.178 is amended to eliminate the requirement for physical surrender of the original letters patent (i.e., the "ribbon copy" of the original patent) in a reissue application, and to make surrender of

the original patent automatic upon the grant of the reissue patent. The reissue statute provides in part that:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent.

See 35 U.S.C. 251, ¶ 1 (emphasis added).

While 35 U.S.C. 251, ¶ 1, requires a "surrender" of the original patent, it neither requires a physical surrender of the actual letters patent, nor a statement that the patent owner surrenders the patent. Physical surrender by submission of the letters patent (i.e., the copy of the original patent grant) was previously required by rule via § 1.178; however, such submission was only symbolic because the patent right exists independently of physical possession of the letters patent.

It is the right to the original patent that must be surrendered upon grant of the reissue patent, rather than any physical document. Thus, where the letters patent is not submitted during the prosecution of the reissue application because it is stated in the reissue that the letters patent copy of the patent is lost or inaccessible, there is no evidence that any stigma is attached to the reissue patent by the public. Further, there was no case law treating such a reissue patent adversely due to the failure to submit the letters patent. In fact, there is no legal reason to retain the requirement for physical surrender of the letters patent. Conversely, it is beneficial to eliminate the requirement for physical surrender of the letters patent.

It is beneficial to both the Office and the public to establish that the surrender of the original patent is automatic upon the grant of the reissue patent to thereby eliminate the requirement for a physical submission of the letters patent or the filing of a paper offering to physically surrender the letters patent (§ 1.178(a)).

Previously, the requirement for submission of the patent document compelled the patent owner (seeking reissue) to try to obtain the letters patent copy of the patent. If the document was lost or misplaced, the patent owner had to search for it. If it was in the hands of a former employee, the patentee had to make an effort to secure it from that employee (who might not be on friendly

terms with the patentee). If the letters patent was obtained, it then had to be physically submitted without losing or destroying it. If the letters patent could not be obtained, the patent owner had to make a statement of loss (Form PTO/SB/55) or explain that it could not be obtained from the party having physical possession of it. The revision of § 1.178 eliminates these burdens, and the requirement for use of form PTO/SB/55 or its equivalent.

The requirement for submission of the letters patent copy of the patent previously provided an unnecessary drain on Office processing and storage resources in dealing with the submitted letters patent document. Further, in the event the reissue was not granted, the Office had to return the letters patent to the applicant where such was requested. The revision does away with the burden on the Office of processing, storing, and returning letters patent.

The previous requirement for submission of the original patent (the letters patent), or a statement as to its loss, resulted in a "built in" delay in the prosecution while the Office awaited submission of the letters patent or the statement of loss, which was often submitted only after an indication of allowance of claims. The revision reduces reissue application pendency because the Office no longer needs to delay prosecution while waiting for the letters patent or the statement of loss. Thus, the complete elimination of the requirement for an affirmative act (of surrender) by the patent owner puts reissue in step with other post patent proceedings for changes of patents which have no requirement for a statement of surrender (e.g., reexamination certificate, certificate of correction).

Amended § 1.178 applies retroactively to all pending applications. For those applications with an outstanding requirement for the physical surrender of the original letters patent, applicant must timely reply that the requirement is moot in view of the implementation of the instant amended rule. Such a reply will be considered a complete reply to any requirement directed toward the surrender of the original letters patent. It is to be noted that the Office will not conduct a search to withdraw Office actions where the only outstanding requirement is compliance with the physical surrender of the original letters patent.

Example 1: An Office action issues prior to the effective date of the amendment to § 1.178 with only a requirement for a return of the original letters patent to the Office. Applicant fails to timely reply to the Office action,

relying on the amendment to § 1.178 as mooted the requirement for physical surrender of the original letters patent. In this instance the application would be abandoned for failure to timely respond to the Office action because no response was filed.

Example 2: An Office action issues prior to the effective date of the amendment to § 1.178 with the only requirement for a return of the original letters patent to the Office. Applicant fails to reply to the Office action within the two-month period set in the Office action, relying on the amendment to § 1.178 as mooted the requirement for physical surrender of the original letters patent. In reviewing the reissue application in connection with a related application, the examiner notes the omission prior to the expiration of the six-month statutory period for reply. In this instance, the examiner may telephone the applicant, and remind applicant of the need to file a timely reply.

Example 3: An Office action issues prior to the effective date of the amendment to § 1.178 with the only requirement being a return of the original letters patent to the Office. Applicant timely replies to the Office that it should vacate/withdraw the requirement, or otherwise indicates that return of the original letters patent is now unnecessary. In this instance, a complete reply would have been filed, and the requirement would be withdrawn and the application passed to issue.

Example 4: An Office action issues prior to the effective date of the amendment to § 1.178 with both a requirement to return the original letters patent to the Office and a rejection of the claims under 35 U.S.C. 103. Applicant timely responds to the Office action addressing only the rejection under 35 U.S.C. 103 (but not the need for physical surrender of the original letters patent). In this instance, the reply would be accepted as complete, and the Office would withdraw the requirement for physical surrender of the original letters patent. (The requirement was proper when made, so the Office would not vacate the action in regard to submission of the original letters patent.)

Return of original letters patent: Where the patentee has submitted the original letters patent in a reissue application subject to § 1.178 as it is now amended, the Office may, in response to a timely request, return the original letters patent, when it can be readily retrieved from where it is stored, namely, the paper application file, or the artifact storage area for an IFW file.

Any request for return of the letters patent which is submitted after the issue fee has been paid will require a petition pursuant to § 1.59(b) to expunge from the file and return the original letters patent. Where the original letters patent cannot be readily retrieved, or in the rare instance that it has been subsequently misplaced, the Office will not be able to return the original letters patent and will not create a new one.

Example 5: In an application filed after the effective date of the amendment to § 1.178, applicant has mistakenly submitted the original letters patent and later seeks its return. In this instance, provided applicant timely requests the return of the original letters patent, the Office would return the patent provided it can be readily retrieved.

Example 6: A reissue application was pending at the time of the effective date of the amendment to § 1.178 and an original letters patent was submitted. Applicant requests return of the original letters patent, although the application is abandoned at the time the request for return is made. In this instance, the Office would return the original letters patent if it is readily retrievable. If the reissue application was abandoned at the time of the effective date of the amendment to § 1.178, the Office would also return the original letters patent.

Example 7: Same as Example 6, except that the reissue application is pending, and the issue fee has been paid for the reissue application at the time the request for return of the original letters patent is made. In this instance, the Office may similarly return the original letters patent, but only if the request is accompanied by a petition under § 1.59(b).

Example 8: Same as Example 7, except that the reissue application has issued as a reissue patent at the time the request for return of the original letters patent is made. Once again, the Office may return the original letters patent, but only if the request is accompanied by a petition under § 1.59(b).

Example 9: A reissue application issued as a reissue patent prior to the effective date of the amendment to § 1.178. Applicant requests return of the original letters patent that was submitted in the reissue application. In this instance, the Office will not return the original letters patent. The original letters patent was submitted in reply to a requirement that was in effect throughout the pendency of the reissue application.

Section 1.179: Section 1.179 is removed and reserved as no longer being necessary. The information provided by this rule, *i.e.*, notification to

the public in the patent file that a reissue application has been filed for a particular patent, is now available through other means, such as public PAIR on the Office's Internet home page. This source of information can be accessed through the Office's Internet Web site at <http://pair.uspto.gov/cgi-bin/final/home.pl> wherein the user can enter the original patent number, click on "Search," and then click on "Continuity Data." Any post-issuance filings (*e.g.*, reissues, reexamination proceedings) will be identified by scrolling to "Child Continuity Data." To identify an application under "Child Continuity Data" as a reissue, the user simply clicks on the desired application number and searches through the file contents screen for "Notice of Reissue Published in Official Gazette." The Inventors Assistance Center (IAC) Help desk (telephone number: 800-786-9199) can also provide information to the public on reissue filings. Removal of the provision that the Office place a separate paper in the patent file stating that a reissue has been filed eliminates several processing steps within the Office and contributes to overall efficiency. Similarly, public PAIR will indicate termination of the reissue examination, and, therefore, placing a second separate paper notice to that effect in the patent file is unnecessary. Additionally, Office personnel can internally through the PALM database access information regarding reissue filings, and therefore, do not rely on the presence or absence of the notice in the patent file as determinative of reissue status.

Section 1.182: Section 1.182 is amended to refer to the petition fee set forth in § 1.17(f) for consistency with the change to § 1.17. See discussion of § 1.17 for comments related to the increase of the petition fees.

Section 1.183: Section 1.183 is amended to refer to the petition fee set forth in § 1.17(f) for consistency with the change to § 1.17. See discussion of § 1.17 for comments related to the increase of the petition fees.

Section 1.213: The proposed changes to § 1.213 are not being adopted in this final rule. These changes are deemed unnecessary as they are merely reflective of what is already required by statute (35 U.S.C. 122(b)(2)(B)(i)-(iv)) and regulation (§ 10.18). The Office proposed to amend § 1.213 to highlight to applicants and practitioners what 35 U.S.C. 122(b)(2)(B)(i)-(iv) and § 10.18 currently require. Specifically, the Office's position is that 35 U.S.C. 122(b)(2)(B)(i)-(iv) and § 10.18 require that, prior to the submission of a nonpublication request, one must make

an actual inquiry (consistent with § 10.18) as to the intent to file a foreign counterpart application, and that at the time any nonpublication request is submitted, there must be an affirmative intent by applicant that the application will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications at eighteen months.

Similarly, the Office will not include the amendments to § 1.213 that highlight the distinctions between a rescission of a previously filed nonpublication request and the requirement for a notification of foreign filing, which is required by 35 U.S.C. 122(b)(2)(B)(iii), the non-applicability of § 1.8 to filings under §§ 1.213(b) and (c), and the inquiry obligations before a request to rescind a nonpublication request is filed (§ 1.213(b)). The Office plans to revise the MPEP to further clarify and to emphasize its position as set forth in this final rule, the notice of proposed rule making, and in the notice *Clarification of the United States Patent and Trademark Office's Interpretation of the Provisions of 35 U.S.C. § 122(b)(2)(B)(ii)-(iv)*, 1272 *Off. Gaz. Pat. Office* 22 (July 1, 2003).

Section 1.213(d) was proposed to be added to provide that if an applicant who has submitted a nonpublication request under § 1.213(a), subsequently files a request under § 1.213(b) to rescind a nonpublication request or files a notice of a filing in another country, or under a multilateral international agreement, under § 1.213(c), the application shall be published as soon as is practical after the expiration of a period of eighteen months from the earliest filing date for which a benefit is sought under title 35, United States Code, as required by 35 U.S.C. 122(b)(2)(B)(ii). The Office will continue its practice to proceed with the publication of an application as soon as practical, as required by statute where a request to rescind has been filed notwithstanding the lack of amendment of the rules to reflect such practice.

While the Office is not including any of the proposed changes to § 1.213 in this final rule, the comments received and the Office's responses thereto reflect the Office's interpretation which will be included in a future revision of the MPEP.

Comment 108: One comment stated that the requirement that applicant must have an affirmative intent not to file a counterpart application that would be subject to eighteen-month publication, and not just the absence of any intent or plan concerning the filing of any counterpart application, is believed to

be extreme, not based on statute and would be unduly burdensome. The comment further stated that the intent of the applicant at the time of signing the nonpublication request should be irrelevant, that the Office's interpretation of the statute requires an applicant to formulate an intent whether to foreign file a year before the foreign filing must be made, and that often the time frame envisioned by the Office is much too early for intent to be decided, particularly if applicant is waiting for money from investors or licensees. The comment stated that one should look at whether the application has been subject to the activity that requires publication (which apparently is meant to be limited to an actual foreign filing of a counterpart application). One comment stated that the Office's view regarding the existence of an actual intent not to foreign file a counterpart application is "not required by the letter or spirit of the statute," and pointed out that where a decision has not been made as to foreign filing at the time of U.S. filing, under the Office's view, applicant could not file a nonpublication request, but if later a decision was made not to foreign file, the original U.S. application would have to be abandoned and refiled with a nonpublication request thereby adding senseless costs and unnecessary filing burdens on both the Office and applicants. The comment also stated that the Office's position would impact small entities the most as their limited resources hamper their ability to form an intent about foreign filing at the time the U.S. application is filed.

Response: The procedure for filing a nonpublication request, whereby applicant must have a current intent at the time of filing the request not to foreign file may not be to the liking of certain applicants and practitioners; however, Congress has spoken and indicated a strong preference for the publication of applications unless a very specific exception can be met. That exception includes the requirement that a certification be made at the time of filing the nonpublication request that the invention "has not and will not be the subject" of a foreign-filed counterpart application. It is significant that Congress has stated both "has not" and "will not" in defining its exception. The comments received decrying the Office's narrow interpretation of the statute are merely an attempt to read out of the statute the "will not" part of the exception. An applicant simply cannot make a certification that the application will not be foreign filed if there is no current intent not to foreign file the application. To argue that the absence of

any intent regarding the future foreign filing of the application can amount to a certification that the application will not be foreign filed is a specious argument. That hardship may be caused by a requirement of a current intent not to future foreign file was recognized by Congress by providing the ability to later change one's mind and foreign file provided timely notice is given of the foreign filing and a rescission of the nonpublication request is filed. On the other hand, as to the hardship pointed out by needing to abandon an application where it was later decided not to foreign file so that the application could be refiled with a nonpublication request, that is not an unforeseen consequence as § 1.138(c) has been provided to allow for express abandonment in these situations. That applicants would need to go to this length is merely a result of the overriding desire by Congress in favor of publication of applications.

Comment 109: The question is posed "If applicant does not have the resources for foreign filing, but would file abroad if additional funds were discovered during the year, does the applicant have an 'intent' to file abroad?"

Response: The comment is one of many possibilities that would need to be answered on a case-by-case basis depending on the particular facts and will be addressed on as general a basis as possible. Where applicant makes a decision not to later foreign file because of lack of funds, there is no intent to foreign file, provided that decision is based on a current determination that funds will not be available later to foreign file. If there is a desire to later foreign file and it is foreseeable that funds may be available, e.g., ongoing license negotiations, then there is no current intent not to foreign file.

Comment 110: One comment suggested that there be an exception to performing an actual inquiry before filing a nonpublication request for every application where the attorney has received "a single written statement from a client that, by default, all U.S. applications should be filed with a nonpublication request and that the client understands that there are limitations on filing foreign applications."

Response: It is possible that a client would have a current intention not to "foreign file" any applications, especially if the client has never filed an application in another country, or under a multilateral international agreement, that requires publication of applications at eighteen months after filing. In this case, the client could inform its counsel of that intent and a nonpublication

request could be routinely filed with each application without separately checking the intent to "foreign file" as to that application. It must be emphasized that the instant advice is given based on the facts of no intent to ever foreign file an application, based on a consistent past history. Variations in the facts given may alter the result as to the permissible use of a blanket default. There would, however, be a duty by applicant to timely change its advice to counsel should the facts change.

Section 1.215: Section 1.215(a) is amended to provide that the patent application publication may also be based upon certain amendments, codifying the Office's current practice. See *Patent Application Publications May Now Include Amendments*, 1281 *Off. Gaz. Pat. Office* 53 (Apr. 13, 2004). Specifically, the patent application publication may be based upon amendments to the specification (other than the abstract or the claims) that are reflected in a substitute specification under § 1.125(b), amendments to the abstract under § 1.121(b), amendments to the claims that are reflected in a complete claim listing under § 1.121(c), and amendments to the drawings under § 1.121(d), provided that such substitute specification or amendment is submitted in sufficient time to be entered into the Office file wrapper of the application before technical preparations for publication of the application have begun. Technical preparations for publication of an application generally begin four months prior to the projected date of publication. Section 1.215(a) is also amended to provide that the patent application publication of an application that has entered the national stage under 35 U.S.C. 371 may also include amendments made during the international stage. Accordingly, the publication under 35 U.S.C. 122(b) of an application that has entered the national stage may include amendments under Article 34 and 19, and other amendments made to the international application during the international stage (e.g., rectifications, corrections of physical defects under PCT Rule 26, and an abstract rewritten by the International Searching Authority).

The Office is scanning application papers including amendments into electronic image files and maintaining all the records associated with patent applications in the IFW system replacing the standard paper processing of patent applications. See *Changes to Implement Electronic Maintenance of Official Patent Application Records* 68 FR 38611 (June 30, 2003), 1272 *Off. Gaz.*

Pat. Office 197 (July 29, 2003)(final rule). The implementation of the IFW system and the current amendment practice under § 1.121 permits the Office to include certain amendments (e.g., a complete claim listing in compliance with § 1.121(c), substitute specification in compliance with § 1.125, drawings in compliance with § 1.84 and § 1.121(d), and amendments made during the international stage of an international application) in the patent application publication.

If applicant files an amendment that includes a complete claim listing in compliance with § 1.121(c) and the amendment is scanned into the IFW system before technical preparations for publication of the application have begun, the Office may publish the amended claims in the complete claim listing instead of the originally filed claims. For example, if applicant files a preliminary amendment that includes cancellation of claims to reduce the amount of claims fees due in response to a Notice To File Missing Parts of Application, the Office may publish only the pending claims and not the canceled claims. The Office may also publish an amended specification instead of the originally filed specification if applicant files a substitute specification in compliance with § 1.125(b) and the substitute specification is scanned into the IFW system before the publication process has begun. Similarly, the Office may publish replacement drawings instead of the originally filed drawings if applicant files the replacement drawings in compliance with § 1.84 and § 1.121(d) and the replacement drawings are scanned into the IFW system before the publication process has begun.

The Office cannot guarantee that the latest amendment or any particular amendment will be included in the patent application publication. Applicants should incorporate any desired amendments into the text of the specification including a new set of claims when filing the application, even where the application is a continuation or divisional application of a prior-filed patent application. Submitting applications without any accompanying preliminary amendment reduces the processing required of the Office, and may preclude Office errors in processing of the amendments. Although the Office may include amendments in patent application publications, applicants desiring to ensure that a patent application publication reflects an amendment should submit the application, as amended, to the Office in compliance with § 1.215(c) by using EFS. See also *Helpful Hints Regarding*

Publication of Patent Applications, 1249 *Off. Gaz. Pat. Office* 83 (August 21, 2001). In situations when the publication does not reflect an amendment that includes applicant's desired changes, applicant may request a republication of the application under § 1.221(a). Any such request for corrected publication under § 1.221(b), however, will not be accepted.

Preliminary amendment that is present on the filing date of the application: Since a preliminary amendment that is present on the filing date of the application is part of the original disclosure of the application under § 1.115(a)(1), the Office will require such an amendment to be filed in a format that can be included in the patent application publication. Thus, if a preliminary amendment under § 1.115(a)(1) is filed in a format that cannot be included in the publication, the Office of Initial Patent Examination (OIPE) will issue a notice requiring the applicant to submit the amendment in a format useable for publication purposes. The patent application publication may not reflect a preliminary amendment under § 1.115(a)(1) if applicant includes the amendment in a place that is difficult to find (e.g., a transmittal letter) or files the amendment separately from the application so that it would be difficult to match the amendment with the application. In order for the patent application publication to include all of applicant's desired changes, applicants should either incorporate the desired changes into the specification and the claims filed with the application, or file the preliminary amendment with the application and clearly present the preliminary amendment on a separate paper in compliance with § 1.121.

Replacement Drawings: The Office proposed changes to § 1.215(a) that provided that any replacement drawings received with the processing fee set forth in § 1.17(i) within the period set forth in proposed § 1.215(c) will be included in the patent application publication. See *Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan*, 68 FR at 53839-40, 53855, 1275 *Off. Gaz. Pat. Office* at 43, 57. Since § 1.215(a) is amended to provide that the patent application publication may also be based upon certain amendments including amendments to drawings under § 1.121(d), this proposed change is not adopted in the final rule. If an applicant wishes to submit better quality drawings or amended drawings for publication purposes, applicant should file the replacement drawings in compliance

with § 1.84 and § 1.121(d) before the technical preparations for publication of the application have begun (generally four months prior to the projected publication date). The Office may include any replacement drawings filed in compliance with § 1.84 and § 1.121(d) if the replacement drawings are scanned into IFW system before the publication process for the application has begun. Applicant is not required to submit the processing fee set forth in § 1.17(i). Accordingly, the procedure for submitting replacement drawings by filing a petition under § 1.182 and a petition fee set forth in § 1.17(h) is eliminated. Furthermore, Mail Stop PGPUB Drawings is being eliminated. Applicants may submit any replacement drawings and preliminary amendments that are filed in response to an OIPE preexamination notice to "Mail Stop Missing Parts".

Section 1.215(c) is amended to provide that applicant has until the later of: (1) one month after the mailing date of the first Office communication that includes a confirmation number for the application; or (2) fourteen months after the earliest filing date claimed under title 35, United States Code, to file an amended version of an application through EFS, for publication purposes, codifying the Office current practice. *See Assignment of Confirmation Number and Time Period for Filing a Copy of an Application by EFS for Eighteen-Month Publication Purposes*, 1241 *Off. Gaz. Pat. Office* 97 (Dec. 26, 2000).

Section 1.291: Section 1.291(b)(1) now provides for the submission of a protest after publication or the mailing of the notice of allowance when the protest is accompanied by the written consent of the applicant. Section 1.291(b)(2) now requires a protest to include a statement that it is the first protest submitted in the application by the real party interest who is submitting the protest; or the protest must comply with the requirements relating to subsequent protests by the same real party in interest. Section 1.291(c)(5) has been added to eliminate the ability of a single protestor to submit cumulative prior art in a subsequent protest by requiring a subsequent protest to be directed at significantly different issue(s), and also requiring an explanation as to how the issue(s) raised are significantly different and why the different issues were not presented in the earlier protest. A processing fee is also required. Finally, § 1.291 has been essentially rewritten and restructured for clarity. Section 1.291(a) clarifies that matching of the protest to the intended application is dependent upon adequate

identification of the intended application and that if the protest is inadequately identified, the protest may not be matched at all or not timely matched, in which case, the protest may be returned where practical, or, if return is not practical, discarded. Section 1.291(b) now recites the service requirements and time frame for submitting a protest. Section 1.291(g) clarifies that protests which do not comply with paragraph (b), or (c) may be returned, or discarded.

It was proposed to amend § 1.291 to require the naming of the real party in interest, or privy thereof, when a protest is filed in any application, *i.e.*, both reissue and non-reissue applications. The purpose of the proposal was to eliminate potential for harassment of the prosecution process via multiple filings of protests in any type of application by persons serving the same interest. Such abuse of protest practice has occurred, for example, by the filing of multiple piecemeal protests (raising a slightly different issue in each protest submission) in a single application by practitioners of the same firm, with a different practitioner signing each protest, and similarly, by any of the inventors and/or assignees. Essentially the same grounds of protest were presented in each of the protests.

Upon reconsideration based on comments received, the Office has determined that the stated objectives of the proposed rule can be achieved in a simpler manner. Specifically, § 1.291(b)(2) requires a statement accompanying any protest in an application that the protest is the first protest submitted in the application by the real party in interest submitting the protest; or the protest must comply with the requirements relating to subsequent protests by the same real party in interest, which are discussed in regard to paragraph (c)(5) of § 1.291. Section 1.291(b)(2) does not apply to the first protest filed in an application. This approach eliminates the issue of how to adequately identify the real party in interest. Where a protestor desires not to identify the real party in interest on behalf of whom the protest is being filed, the protestor may still retain anonymity. Where a protest is not the first protest by the real party in interest, § 1.291(b)(2) requires compliance with paragraph (c)(5) of § 1.291 without a need for a specific statement that this is a subsequent protest by a real party in interest or identification of the real party in interest.

As amended, § 1.291 is structured as follows: Paragraph (a) sets forth the need for adequate identification of the application to which a protest is

directed to permit matching of the protest with the application and the consequences of inadequate identification not permitting a matching or a timely matching. Paragraph (b) sets forth service upon applicant and timeliness requirements for submitting the protest. Paragraph (b)(1) makes provision for the written consent of the applicant as an exception to the timeliness requirements of paragraph (b). Paragraph (b)(2) relates to the submission of multiple protests along with paragraph (c)(5). Paragraph (c) sets forth content requirements for a protest. Paragraphs (c)(1) through (c)(4) substantively repeat the content requirements of former § 1.291(b)(1) through (b)(4). The content requirement for subsequent protests in the last sentence of former paragraph (c) is now present in current paragraph (c)(5). Paragraphs (d) and (f) of the amended rule are material moved from prior paragraph (c). Paragraph (e) of the amended rule is material moved from prior paragraph (b). Paragraph (g) clarifies how the Office can treat protests that fail to comply with paragraphs (b) and (c) of the rule.

Section 1.291(a): In order for a protest submission to be matched with an application, it must include sufficient information to adequately identify the application for which the submission is being made.

Where possible, the protest should specifically identify the application to which the protest is directed by application number and filing date. If, however, the protestor is unable to specifically identify the application to which the protest is directed by application number and filing date, but, nevertheless, believes such an application to be pending, the protest should be directed to the attention of the Office of Petitions, along with as much identifying data for the application as is possible, such as the name of an inventor.

If a protest is timely submitted within the time frames of § 1.291(b) and the other requirements of paragraphs (b) and (c) of § 1.291 are complied with, but the protest is not matched or not timely matched with the intended application to permit review by the examiner during prosecution of the application due to inadequate identification of the intended application as defined in § 1.291(a), the Office may or may not enter the protest. If not entered, the protest may be returned to the party that submitted it where practical, or, if not practical to return, discarded.

If a protest includes adequate identification, is timely submitted within the time frames of § 1.291(b) and

timely matched with the intended application (during prosecution of the application), and where the protest further complies with paragraphs (b) and (c) of § 1.291, it will be "entered" into the file (*i.e.*, it has an entry right) and it will be considered by the examiner. If a protest includes adequate identification, is timely submitted as defined in § 1.291(b), but not timely matched during prosecution of the application (*e.g.*, the protest is submitted a day before a notice of allowance is mailed), the protest will be entered of record and the examiner may or may not consider it. The seemingly disparate treatment in § 1.291(a) where an untimely match may result in non-entry of the protest is due to the protestor's failure to adequately identify the intended application under § 1.291(a) (versus adequate identification but other problems in timely matching under § 1.291(b)).

Section 1.291(b): The language of § 1.291(b) includes the timeliness and service provisions of former §§ 1.291(a)(1) and (a)(2) and makes compliance with these provisions, as well as those in paragraph (c), a condition for entry of the protest in the record of the intended application, except for the timeliness provisions of protests filed with the consent of the applicant. Entry of a protest in the record does not ensure that the protest will be considered by the examiner. For example, a first protest by a real party in interest (along with the required statement pursuant to § 1.291(b)(2)) may be timely submitted, *e.g.*, prior to publication of the application, yet the application may be issued as a patent prior to the actual matching of the protest with the intended application. Where a protest is timely submitted, includes adequate identification, and is otherwise compliant with §§ 1.291(b), (b)(2) and (c), the Office will endeavor to consider the protest even if it is matched with the intended file after prosecution is closed.

Section 1.291(b)(1) provides that a protest may be filed at any time if it is accompanied by the written consent of the applicant to the filing of the protest being submitted as it specifically excludes the timeliness requirements of paragraph (b). While § 1.291(b)(1) ensures that any (adequately identified) protest filed with the written consent of the applicant will be entered into the record of the intended application (if there is also compliance with paragraph (c)), paragraph (b)(1) makes clear that the protest must be matched with the intended application during prosecution to ensure consideration by the examiner. For example, where the

protest is submitted close to publication of the patent, it is doubtful that the examiner would have time to review the protest, although the protest would be made of record. Even if not timely matched, the examiner may still decide to consider the protest should there be sufficient time to do so.

35 U.S.C. 122(c) permits the filing of a protest in an application after the application has been published if there is express written consent of the applicant. In order to file protests after publication of patent applications, § 1.291(b)(1) requires that the protest after publication (of an application) be accompanied by the written consent of the applicant. The written consent should indicate that applicant is consenting to the specific protest being submitted. Applicant may choose to provide a blanket consent to: any protests filed, protests filed by a particular real party in interest, a single protest by a particular party in interest (*e.g.*, a protest that party Smith has informed me that he will be submitting during the week of November 26th), a protest involving a particular piece of prior art, or a particular protest that has been reviewed and applicant is willing to have considered by the Office. Where a protest is permitted only by consent of applicant, the Office will abide by the terms of the consent. The Office may, however, as discussed later in regard to § 1.291(g), choose to consider a piece of prior art permitted under the terms of the consent, but noncompliant with some requirement of §§ 1.291(b), or (c).

Section 1.291(b)(2), as discussed earlier, requires either a statement that the protest is the first protest submitted in the application by the real party in interest who is submitting the protest or that the protest must also comply with paragraph (c)(5) of § 1.291. In addition, § 1.291(b)(2) does not apply to the first protest in an application. A protestor may not know if a protest has already been filed (by another), and may have no way of checking (non-reissue application for which public PAIR would not be available). Should the protest (inadvertently or otherwise) fail to include the statement that the protest is the first protest by the real party in interest filing the current protest and fail to comply with paragraph (c)(5) of § 1.291, if, in fact, the protest is the first filed protest in an application, it will be considered where all other conditions have been met.

Section 1.291(c): Where the protest adequately identifies a pending application and is otherwise compliant with paragraph (b) of § 1.291, the protest will be "entered" into the application and considered by the examiner, if the

protest includes: (1) a listing of patents, publications, or other information relied upon; (2) a concise explanation of the relevance of each listed patent, publication and other item of information; (3) a copy of each listed patent, publication, or other item of information in written form, or at least pertinent portions thereof; (4) an English language translation of all the necessary and pertinent parts of any non-English language patent, publication, or other item of information relied upon; and (5) if the protest is a second or subsequent protest in the case by a single real party in interest, an explanation as to why the issues presented are significantly different from those raised in an earlier protest and why they were not presented earlier, and a processing fee under § 1.17(i). Where there is noncompliance with any item of information required by § 1.291(c)(1) through (c)(5), the protest may not be entered and will be treated pursuant to § 1.291(g), except where the examiner determines to review an item of information and decides to make that item of record as an examiner citation. See the discussion of § 1.291(g) below.

Section 1.291(c)(5) sets forth additional content requirements that now apply to subsequent protest submissions. As opposed to former § 1.291(c), new § 1.291(c)(5) does not permit the submission of additional (cumulative) prior art. Section 1.291(c)(5) requires that any subsequent protest must present significantly different issues and sets forth an explicit requirement that a second or subsequent protest must be accompanied by an explanation as to why the issue(s) raised in the second or subsequent protest are significantly different from those raised earlier and, further, why the significantly different issue(s) were not presented earlier. In complying with the requirement to distinguish a subsequent protest from one previously submitted, the protestor should identify with particularity the prior submitted protest, such as by date submitted and information supplied.

Section 1.291(e): This paragraph is added to reiterate and confirm the Office's long-standing practice to enter protests raising inequitable conduct issues without comment on such issues. *See* MPEP § 1901.02.

Section 1.291(f): This paragraph represents material carried over from former § 1.291(c).

Section 1.291(g): This paragraph is added to make clear that protests which do not comply with paragraph (b), or (c) may be returned, or discarded at the sole discretion of the Office as the

protest is not in fact entered of record. This is a different standard than that of 1.291(a) in that the preference the Office has for returning, rather than discarding, protests not adequately identifying a pending patent application does not exist for protests not complying with paragraphs (b) or (c). Such preference is reflected by § 1.291 in that paragraph (a) states protests not adequately identifying a pending patent application will be returned “where practical” and that no such practicality consideration is present in paragraph (g). The reason the Office prefers to return protests not adequately identifying a pending patent application is that this gives the protestor the chance to resubmit the protest with adequate patent application identifying information.

Where a protest is partially noncompliant with §§ 1.291(b), or (c), such as four of the five submitted items of prior art do not have a concise explanation of their relevance pursuant to § 1.291(c)(2), those items will not be entered of record in the file and may be returned, or discarded. If the fifth prior art item is fully compliant with §§ 1.291(a), (b), and (c), the fifth item (having a concise explanation) will be made of record and considered by the examiner.

Where a protest is entirely noncompliant with §§ 1.291(b), or (c), the prior art will not be made of record and the protest may be returned, or discarded at the Office’s option. Alternatively, the examiner may choose to consider any or all of the prior art submitted, in which case the examiner may choose to make certain of the prior art considered of record by citing it as an examiner’s citation of prior art. The examiner need not make any prior art actually considered from a noncompliant § 1.291 protest of record.

The examiner may always look at, or consider any documents submitted in an application, under amended § 1.291. This is the same as in the past. An examiner will attempt to consider a second protest filed on behalf of the same real party in interest (subject to the time frames set forth in § 1.291(b) and the caveat that the protest can be timely matched and considered prior to issuance of the patent) if the second protest includes: (1) new issue(s) significantly different from issue(s) presented earlier; (2) an explanation of why the new issue(s) are significantly different; and (3) an explanation why such new issue(s) could not have been earlier presented. See § 1.291(c)(5). Raising of new issue(s) may be done by the submission of new, non-cumulative prior art. This substantive amendment to prior § 1.291(c) was made to no longer permit the submission of just

“additional prior art” in view of the previously stated experience of the Office receiving subsequent protests by the same real party in interest with essentially the same grounds. Prior § 1.291(c) permitted a further submission of “additional prior art” so long as a concise explanation was provided pursuant to prior § 1.291(b)(2). As noted in the proposed rulemaking, applicants would present “essentially the same grounds of protest * * * in each of the protests” as “there was no explicit bar in the rule against multiple piecemeal protest submissions,” such as by utilization of the alternative of submitting prior art that was essentially cumulative to that submitted in the previous protest, or by utilizing a different person (representing the same real party in interest) to submit essentially the same protest. See the notice of proposed rulemaking at page 53840.

Once a protest has been matched with an application, the examiner is always free to look at, or consider, any document(s) or other information submitted in that protest whether or not the protest complies with § 1.291. Section 1.291 exists as a matter of administrative convenience for the Office; thus, a third party’s failure to comply with any of the requirements of § 1.291 does not vest the applicant with any “right” to preclude consideration by the examiner of information set forth/presented in a non-compliant protest. The noncompliant protest, however, will not be made of record and may be returned, or discarded (§ 1.291(g)) after consideration of the information contained therein should the examiner desire to do so.

Comment 111: One comment stated that the Office provided no statistics or other evidence showing a need for the originally proposed amendment to § 1.291 to require the naming of the real party in interest whenever any protest is filed. The comment suggested that it would be better to amend § 1.291 to require the party submitting the protest to identify any prior protests the party has filed, or to certify that it has not filed any prior protest. The comment also suggested amending § 1.291 to permit the filing of protests in published applications.

Response: The comment is adopted in part. The Office has reconsidered the need for identification of the real party in interest and has determined that a statement as to prior protests is sufficient. Thus, rather than amend § 1.291 to require the naming of the real party in interest whenever any protest is filed, as originally proposed, § 1.291(b)(2) provides that a statement

that the protest is the first by the real party in interest be made or the protest must comply with § 1.295(c)(5). A further exception is made where the protest turns out to be the first protest in the application.

The suggestion to amend § 1.291 to permit the filing of protests in published applications cannot be adopted as 35 U.S.C. 122(c) statutorily prohibits the filing of a protest in published applications without the express written consent of the applicant. This statutory provision is reflected by the language now contained in § 1.291(b)(1). As reissue applications are not published under 35 U.S.C. 122, the requirement for the express written consent of the applicant never applies to reissue applications. Although protests in published applications cannot be filed without the express written consent of the applicant, § 1.99 provides for third-party submissions of prior art and other information in published applications provided, *inter alia*, the submission is timely submitted (§ 1.99(e)) and it does not include any explanation of the material being submitted (§ 1.99(d)).

Section 1.295: Section 1.295(a) is amended to refer to the petition fee set forth in § 1.17(g) for consistency with the change to § 1.17. See discussion of § 1.17 for comments related to the increase of the petition fees.

Section 1.296: Section 1.296 is amended to refer to the petition fee set forth in § 1.17(g) for consistency with the change to § 1.17. See discussion of § 1.17 for comments related to the increase of the petition fees.

Section 1.311: Section 1.311(b) is amended to provide that the submission after the mailing of a notice of allowance of either: (1) an incorrect issue fee or publication fee; or (2) a fee transmittal form (or letter) for payment of issue fee or publication fee, will operate as a valid request to charge the correct issue fee, or any publication fee due, to any deposit account identified in a previously filed authorization to charge such fees. Additionally, use of issue and publication fee forms, which are not supplied by the Office, are permitted. It is also clarified that for previous authorizations to be effective under the exceptions provided for, the previous authorizations must cover the issue and publication fees to be charged.

Prior to this amendment, § 1.311(b) set forth that an authorization to charge the issue fee or other post-allowance fees (such as any publication fee due) to a deposit account may be filed only after the mailing of a notice of allowance in part to encourage the use (return) of the PTOL-85B form since that form contains important information, such as

the name of the assignee. The last sentence of § 1.311(b) prior to this amendment, however, provided an exception for charging the issue fee to a deposit account identified in a previously filed authorization if the applicant submitted either an incorrect issue fee or an Office-provided fee transmittal form (*i.e.*, Part B—Fee(s) Transmittal of a Notice of Allowance and Fee(s) Due, form PTOL–85). The amendment to § 1.311(b) extends the exception to any publication fee due and expands the exception to apply where an applicant's own fee transmittal form or letter for submitting issue fee or publication fee is submitted. Further, the term “such” is added before “fees” in the last line of section 1.311(b) to clarify that the previously filed authorization must be an authorization to charge the appropriate fee due to an identified deposit account. For example, if the previously filed fee authorization only authorizes the Office to charge the issue fee, the Office will not be able to charge any publication fee due to the identified deposit account in the previously filed authorization even when the applicant submitted an issue fee transmittal form. For such authorization, the Office will only charge the correct issue fee to the identified deposit account. Furthermore, if the previously filed fee authorization only authorized the Office to charge any fees due under §§ 1.16 or 1.17, the Office would not be able to charge either the issue fee (§ 1.18(a) through (c)) or the publication fee (§ 1.18(d)).

The phrase “A completed Office-provided issue fee transmittal form (where no issue fee has been submitted)” in the last sentence of § 1.311(b) is changed to “A fee transmittal form (or letter) for payment of issue fee or publication fee” to provide that a submission of an Office-provided fee transmittal form (*i.e.*, Part B of the form PTOL–85), or applicant's own fee transmittal form or letter for submitting issue fee or publication fee, (either complete, or incomplete but for a fee authorization) operates as a request to charge the correct issue fee due, or any publication fee due, to any deposit account identified in a previously filed authorization to charge such fees, even if the issue fee has been previously submitted. Submission of an Office-provided fee transmittal form, or applicant's own fee transmittal form or letter, will not operate as a request to charge the issue fee or publication fee due to a deposit account if neither the fee transmittal document nor a previous authorization includes an authorization to charge fees due under § 1.18.

Where an issue fee has been previously submitted, and the application is withdrawn from issue and is allowed again, since November 13, 2001, the Notice of Allowance has indicated the current amount due as the difference between the previously paid issue fee and the current amount for an issue fee. In such situations, a payment of only the difference, or a response to the notice where there is no issue fee due (or only the return of the Part B—Fee(s) Transmittal of form PTOL–85 as the current issue fee is the same amount as previously paid), will be treated as a ratification of the Office's decision to apply the previously paid issue fee. If the fee was paid in a different application (*e.g.*, the parent application of a continued prosecution application under § 1.53(d) (CPA)), the fee indicated in the notice as due is the current issue fee. The issue fee paid in the parent application cannot be refunded, or applied, to the notice of allowance mailed in the CPA.

Section 1.324: Sections 1.324(a) and (b) are amended to provide an informational reference to 35 U.S.C. 256 and to replace “petition” with “request.”

Section 1.324(a) is amended by adding an explicit reference to 35 U.S.C. 256 and its requirement in order to clarify that the inventorship of a patent may be changed only by way of a request from *all* of the inventors together with assignees of the entire interest, or on order of a court. The Office will then issue a certificate naming the correct inventors. 35 U.S.C. 256 requires that there be agreement among all parties (inventors and existing assignees), or that a court has issued an order so directing the inventorship change. The previous reference in § 1.324 to a petition was eliminated in order to conform the rule language to earlier changes made to § 1.20(b).

Section 1.377: Section 1.377 is amended to refer to the petition fee set forth in § 1.17(g) for consistency with the change to § 1.17. *See* discussion of § 1.17 for comments related to the increase of the petition fees. Section 1.377 retains the provision that the petition fee may be refunded if an Office error created the need for the petition.

Section 1.378: Section 1.378(e) is amended to refer to the petition fee set forth in § 1.17(f) for consistency with the change to § 1.17. *See* discussion of § 1.17 for comments related to the increase of the petition fees.

Section 1.550: Section 1.550(c) is amended to add a \$200 petition fee requirement pursuant to § 1.17(g) in *ex parte* reexamination proceedings for

requests for extensions of time, which requests are based upon sufficient cause. Extensions of time under § 1.136(a) are not permitted in *ex parte* reexamination proceedings because the provisions of 35 U.S.C. 41(a)(8) and § 1.136(a) apply only to an “application” and not to a reexamination proceeding (*ex parte or inter partes*). Additionally, 35 U.S.C. 305 requires that *ex parte* reexamination proceedings “will be conducted with special dispatch.” Accordingly, extensions of time in *inter partes* reexamination proceedings are provided for in § 1.550(c) only “for sufficient cause and for a reasonable time specified.” To evaluate whether a showing of “sufficient cause” exists and whether a “reasonable time” is specified, decisions on § 1.550(c) requests require a thorough evaluation of the facts and circumstances on a case-by-case basis. Furthermore, requests under § 1.550(c) are generally treated expeditiously by the deciding official since the statute requires “special dispatch” for reexamination proceedings. To reflect the Office's cost of deciding requests under § 1.550(c), *i.e.*, the cost of evaluating whether a showing of “sufficient cause” exists and whether a “reasonable time” is specified, a requirement for a petition fee is added to § 1.550(c).

The revision of the rule tracks the above-discussed rule revisions to require a petition fee for the decision on § 1.136(b) and § 1.956 extension of time requests, and the criteria for granting of an extension of time under § 1.550(c) is analogous to that for § 1.136(b) and § 1.956.

Section 1.741: Section 1.741(b) is amended to refer to the petition fee set forth in section 1.17(f) for consistency with the change to § 1.17. *See* discussion of § 1.17 for comments related to the increase of the petition fees.

Section 1.956: Section 1.956 is amended to add a \$200 fee requirement pursuant to § 1.17(g) in *inter partes* reexamination proceedings for requests for extensions of time, which requests are based upon sufficient cause. Extensions of time under § 1.136(a) are not permitted in *inter partes* reexamination proceedings because the provisions of 35 U.S.C. 41(a)(8) and § 1.136(a) apply only to an “application” and not to a reexamination proceeding (*ex parte or inter partes*). Additionally, 35 U.S.C. 314 requires that *inter partes* reexamination proceedings “will be conducted with special dispatch.” Accordingly, extensions of time in *inter partes* reexamination proceedings are

provided for in § 1.956 only “for sufficient cause and for a reasonable time specified.” To evaluate whether a showing of “sufficient cause” exists and whether a “reasonable time” is specified, decisions on § 1.956 requests require a thorough evaluation of facts and circumstances on a case-by-case basis. Furthermore, requests under § 1.956 are generally treated expeditiously by the deciding official, especially so in reexamination since the statute requires “special dispatch.” To reflect the Office’s cost of deciding requests under § 1.956, *i.e.*, the cost of evaluating whether a showing of “sufficient cause” exists and whether a “reasonable time” is specified, a requirement for a fee is added to § 1.956.

The present amendment tracks the above-discussed amendments to require a fee for the decision on § 1.136(b) and § 1.550(c) extension of time requests, and the criteria for granting of an extension of time under § 1.956 is analogous to that for § 1.136(b) and § 1.550(c).

Section 5.12: Section 5.12(b) is amended to refer to the petition fee set forth in § 1.17(g) for consistency with the change to § 1.17. *See* discussion of § 1.17 for comments related to the increase of the petition fees.

Section 5.15: Section 5.15(c) is amended to refer to the petition fee set forth in § 1.17(g) for consistency with the change to § 1.17. *See* discussion of § 1.17 for comments related to the increase of the petition fees.

Section 5.25: Section 5.25 is amended to refer to the petition fee set forth in § 1.17(g) for consistency with the change to § 1.17. *See* discussion of § 1.17 for comments related to the increase of the petition fees.

Section 10.18: Section 10.18 is amended to align the signature requirements of this section with the changes to the signature requirements for patents, § 1.4(d), and to add a reference to the signature requirements for trademarks, § 2.193(c)(1).

Section 10.18 required that signatures by practitioners on correspondence submitted to the Office in patent, trademark, and other non-patent matters conform to the requirements of personally signed signatures set forth in § 1.4(d)(1). In view of the amendments to § 1.4(d) creating S-signatures, § 1.4(d)(2), and creating EFS character coded signatures, § 1.4(d)(3), § 10.18 has been amended to align the reference to § 1.4 from solely paragraph (d)(1) to paragraphs (d) and (e) so as to encompass all the signature paragraphs of § 1.4 (paragraphs (d)(1), (d)(2), (d)(3) and (e)).

The amendment of § 10.18 to refer to §§ 1.4(d) and (e) also takes into account the clarifications in § 1.4(d) that the permanent signature is to be in dark ink or its equivalent and the confirmation that §§ 1.4(d)(1) and (e) are the only paragraphs of § 1.4 that permit handwritten signatures.

Section 10.18 has also been amended to add a reference to § 2.193(c)(1), which are the trademark signature requirements.

Section 41.20: Section 41.20 sets forth the fee for petitions in part 41. The petition fee amount set forth in § 41.20 is increased from \$130.00 to \$400.00 for consistency with the change to § 1.17. *See* discussion of § 1.17 for comments related to the increase of the petition fees.

Section 104.3: Section 104.3 is amended to set forth a petition fee of \$130.00, rather than a reference to the petition fee set forth in § 1.17(h).

Rule Making Considerations

Administrative Procedure Act: The notable changes in this final rule are: (1) Providing for an alternative to a handwritten signature on a number of submissions; (2) adjusting the fees for a number of patent-related petitions to reflect the actual cost of processing these petitions; (3) codifying the current incorporation by reference practice and also providing the conditions under which a claim for priority or benefit of a prior-filed application would be considered an incorporation by reference of the prior-filed application; (4) expanding the submissions that can be filed on a compact disc; (5) eliminating the requirement for copies of U.S. patents or U.S. patent application publications cited in an information disclosure statement in certain applications; (6) providing that a request for information may contain interrogatories or requests for stipulations seeking technical factual information actually known by the applicant; (7) providing that supplemental replies will no longer be entered as a matter of right; (8) providing for the treatment of preliminary amendments filed on or before the filing date of an application as part of the original disclosure; and (9) eliminating the requirement in a reissue application for the actual physical surrender by applicant of the original Letters Patent.

The changes in this final rule (except for the adjustment to the fees for a number of patent-related petitions to reflect the actual cost of processing the petitions) relate solely to the procedures to be followed in filing and prosecuting a patent application. Therefore, these

rule changes involve interpretative rules, or rules of agency practice and procedure under 5 U.S.C. 553(b)(A), and prior notice and an opportunity for public comment were not required pursuant to 5 U.S.C. 553(b)(A) (or any other law). *See* *Bachow Communications Inc. v. FCC*, 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are “rules of agency organization, procedure, or practice” and exempt from the Administrative Procedure Act’s notice and comment requirement); *see also Merck & Co., Inc. v. Kessler*, 80 F.3d 1543, 1549–50, 38 USPQ2d 1347, 1351 (Fed. Cir. 1996) (the rules of practice promulgated under the authority of former 35 U.S.C. 6(a) (now in 35 U.S.C. 2(b)(2)) are not substantive rules (to which the notice and comment requirements of the Administrative Procedure Act apply)), and *Fressola v. Manbeck*, 36 USPQ2d 1211, 1215 (D.D.C. 1995) (“it is doubtful whether any of the rules formulated to govern patent and trade-mark practice are other than ‘interpretative rules, general statements of policy, * * * procedure, or practice’” (quoting C.W. Ooms, *The United States Patent Office and the Administrative Procedure Act*, 38 Trademark Rep. 149, 153 (1948))).

Regulatory Flexibility Act: As prior notice and an opportunity for public comment were not required pursuant to 5 U.S.C. 553 (or any other law) for the changes in this final rule (except for the change to § 1.17), a final regulatory flexibility analysis under the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*) is not required for the changes in this final rule (with the sole exception of the fee changes in § 1.17). *See* 5 U.S.C. 603. With respect to the fee changes in § 1.17, the factual basis supporting the certification under the Regulatory Flexibility Act is set forth herein.

Accordingly, 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 in this final rule will not have a significant economic impact on a substantial number of small entities. *See* 5 U.S.C. 605(b).

Factual basis for change to petition fees: With regard to fees, the Office is adjusting certain petition fees that are set under the Office’s authority under 35 U.S.C. 41(d), which allows the Office to adjust petition fees to be in alignment with the actual average costs of deciding such petitions. The petition fee for petitions formerly covered in § 1.17(h) and now covered in §§ 1.17(f), 1.17(g), or 41.20(a) will be either \$200.00 (an

increase of \$70.00 or \$400.00 (an increase of \$270.00).

The Office estimates that there will be fewer than 8,000 petitions filed each year of the type that would be affected by the patent fee changes, with fewer than 5,000 petitions being affected by the fee change from \$130.00 to \$400.00, and fewer than 3,000 petitions being affected by the fee change from \$130.00 to \$200.00. Since the small entity filing rate has not exceeded 31.0% during the last five fiscal years, the Office further estimates that there will be fewer than 2,480 petitions filed by a small entity each year of the type that would be affected by the patent fee changes, with fewer than 1,550 petitions by a small entity being affected by the fee change from \$130.00 to \$400.00, and fewer than 930 petitions by a small entity being affected by the fee change from \$130.00 to \$200.00. The Office received about 448,000 patent applications (over 92,500 provisional applications and about 355,500 nonprovisional applications) in fiscal year 2003, the Office received about 443,000 patent applications (over 89,500 provisional applications and about 353,500 nonprovisional applications) in fiscal year 2002, and the Office received over 430,000 patent applications (over 86,000 provisional applications and over 344,000 nonprovisional applications) in fiscal year 2001. Thus, this proposed change would impact relatively few (less than 2% of) patent applicants.

In addition, the petition fee amounts being adopted by the Office for petitions whose fees are set under the authority in 35 U.S.C. 41(d) (\$400.00, \$200.00, and \$130.00) are comparable to or lower than the petition fee amounts for petitions whose fees are set by statute in 35 U.S.C. 41(a) (\$110.00 to \$1,970.00 for extension of time petitions (35 U.S.C. 41(a)(8)), or \$1,300.00 to revive an unintentionally abandoned application (35 U.S.C. 41(a)(7)).

Therefore, the Office has determined that the change to the petition fees in this final rule will not have a significant economic impact on a substantial number of small entities.

Comments received in response to the notice of proposed rule making: The Office published a notice of proposed rule making and certified that an initial Regulatory Flexibility Act analysis was not required. See *Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan*, 68 FR 53816, 53844 (Sept. 12, 2003), 1275 *Off. Gaz. Pat. Office* 23, 47 (Oct. 7, 2003) (proposed rule). The Office has received a comment and several letters from an intellectual property law organization

generally asserting that the Office did not comply with the requirements of the Regulatory Flexibility Act in certifying that the changes in this (and several other) rule makings will not have a significant economic impact on a substantial number of small entities. The intellectual property law organization that submitted a comment and letters argues that the changes to the following sections will increase the burden and economic costs on small entities: §§ 1.4, 1.17, 1.19, 1.53, 1.57, 1.105, 1.111, 1.213. The intellectual property law organization also argues that the Office cannot just label rules that will have a substantial effect on large and small businesses, and that have been objected to by other intellectual property law organizations, as procedural to escape analysis under the Regulatory Flexibility Act. The intellectual property law organization asserts that: (1) 1,435,712 patents were issued between 1977 and 2001 to applicants from the United States of America; (2) 445,872 of these 1,435,712 patents (thirty-one percent) were issued to persons who did not assign their rights in the patents to others; (3) the number of patents obtained by small businesses is undoubtedly higher; and (4) small business and individuals account for a significant portion of the patent business before the Office. The Office has reconsidered the initial certification in view of the comment and letters.

The comment and letters raised several issues that the Office will address. First, the numbers used by the commenters (and even the numbers quoted in this certification) with respect to "small entities" overstate the number of small entities by as much as forty-five percent. In any event, even using the overstated small entity statistics maintained by the Office, none of these rules will impact a substantial number of small entities. Second, the vast majority of the Office's rules are procedural or interpretative, and are thus exempt from the analytical requirements of the Regulatory Flexibility Act. Third, notwithstanding the procedural or interpretative nature of most of the Office's rules, the Office has set forth the factual basis for those rules which commenters allege will create a significant economic impact on a substantial number of small entities. In sum, because the Office provided a sufficient factual basis for the fee changes contained in this final rule, and because the Office has considered, but rejected, all arguments raised regarding the certification in the notice of proposed rule making, 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 in this final rule will not have a significant economic impact on a substantial number of small entities.

Small entity patent activity (as a percentage): Based upon Office Revenue Accounting and Management (RAM) records, small entity status was claimed in between 27.0 and 36.7 percent of nonprovisional (since 1995) utility patent applications over the last thirteen fiscal years (between fiscal years 1990 and 2003), and small entity status was claimed in between 27.0 and 30.7 percent of nonprovisional utility patent applications over the last five fiscal years (between fiscal years 1999 and 2003).

Small entity status for purposes of paying reduced patent fees may be claimed in a patent application if the applicant is an independent inventor (foreign or domestic), a small business concern (foreign or domestic) meeting the SBA's size standards set forth in 13 CFR 121.801 through 121.805, or a qualifying nonprofit organization (foreign or domestic). See 35 U.S.C. 41(h)(1) and § 1.27(a). Small entities within the meaning of Regulatory Flexibility Act analysis or certification are only a subset of small entities for purposes of paying reduced patent fees. The Small Business Administration requires (13 CFR 121.105) that an entity also have a place of business located in the United States, and operate primarily within the United States or make a significant contribution to the U.S. economy through payment of taxes or use of American products, materials or labor, for that entity to be considered a small entity or small business for purposes of the Regulatory Flexibility Act. See *Northwest Mining Ass'n v. Babbitt*, 5 F.Supp. 2d 9, 16-17 (D.D.C. 1998) (an agency must use the Small Business Administration's definition of small entity or small business, rather than its own definition, for a Regulatory Flexibility Act analysis or certification). Since about forty-five percent of all nonprovisional applications are filed by residents of foreign countries (this has been the trend for the last five fiscal years), the number of small entities (as defined by the Small Business Administration) impacted by this rule change is actually up to forty-five percent lower than is being estimated by the Office.

Procedural or interpretative nature of most of the rules involved in this rule making: As discussed previously, the changes in this final rule (except for the

adjustment to the fees for a number of patent-related petitions to reflect the actual cost of processing the petitions (§ 1.17)) involve interpretative rules, or rules of agency practice and procedure under 5 U.S.C. 553(b)(A), and prior notice and an opportunity for public comment were not required pursuant to 5 U.S.C. 553(b)(A) (or any other law). For example: (1) § 1.4 sets out the requirements for correspondence (including signature requirements) with the Office; (2) § 1.19 sets out the fees for certified and uncertified copies of Office documents (the Office is not changing the fees set forth in § 1.19); (3) § 1.53 sets out the application filing date requirements as provided in 35 U.S.C. 111, and specifies the procedures for completing an application and for contesting the filing date accorded to an application; (4) § 1.57 sets out the procedures for incorporating material by reference in an application; (5) § 1.78 sets out the procedures for claiming the benefit of prior-filed provisional applications, nonprovisional applications, or international applications which designate the U.S.; (6) § 1.98 sets out the procedures for having information considered by the Office; (7) § 1.105 sets out the procedures to be followed by examiners and applicants in issuing and replying to (respectively) requirements for information; (8) § 1.111 sets out the conditions under which a supplemental reply to an Office action may entered; and (9) § 1.115 sets out the conditions under which a preliminary amendment filed on or before the filing date of an application will be treated as part of the original disclosure. As indicated by the U.S. Court of Appeals for the District of Columbia Circuit:

Our oft-cited formulation holds that the "critical feature" of the procedural exception [of the Administrative Procedure Act] "is that it covers agency actions that do not themselves alter the rights or interests of parties, although it may alter the manner in which the parties present themselves or their viewpoints to the agency."

JEM Broad. Co. v. FCC, 22 F.3d 320, 326 (D.C. Cir. 1994) (quoting *Batterton v. Marshall*, 648 F.2d 694, 707 (D.C. Cir. 1980)). That a rule has or may have a substantial impact or burden on parties, or that an agency receives numerous objections to a rule or proposed rule change, does not convert a procedural rule into a substantive rule. See *James V. Hurson Assocs., Inc. v. Glickman*, 229 F.3d 277, 281-82 (D.C. Cir. 2000).

The Office does agree that individuals (independent inventors) and small businesses account for a significant portion of the patent business before the Office, and the Office generally does

consider the impact of rule changes (even for regulations exempt from notice and comment requirements, for which a regulatory flexibility analysis is not required under 5 U.S.C. 603) on small entity applicants. For this reason, the Office has often published a notice of proposed rule making for rule makings that are exempt from public comment because the Office is seeking public comment on (*inter alia*) the impacts that a proposed rule (if adopted) will have on the public, which includes small entities. See, e.g., *Clarification of Power of Attorney Practice, and Revisions to Assignment Rules*, 68 FR 38258, 38262 (June 27, 2003), 1272 *Off. Gaz. Pat. Office* 181, 185 (July 29, 2003) (notice seeking comment on changes to procedural rules). *Changes to Implement the 2002 Inter Partes Reexamination and Other Technical Amendments to the Patent Statute*, 68 FR 22343, 22349 (Apr. 28, 2003), 1270 *Off. Gaz. Pat. Office* 106, 110 (May 20, 2003) (notice seeking comment on changes to interpretative and procedural rules), and *Changes to Implement Electronic Maintenance of Official Patent Application Records*, 68 FR 14365, 14372 (Mar. 25, 2003), 1269 *Off. Gaz. Pat. Office* 166, 172 (Apr. 22, 2003) (notice seeking comment on changes to procedural rules). Nevertheless, since prior notice and an opportunity for public comment were not required pursuant to 5 U.S.C. 553 (or any other law) for the changes to §§ 1.4, 1.19, 1.53, 1.57, 1.105, and 1.111 in this final rule, a final regulatory flexibility analysis under the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*) is not required for the changes to §§ 1.4, 1.19, 1.53, 1.57, 1.105, and 1.111 in this final rule.

Discussion of specific sections alleged to increase the burden and economic costs on small entities: The following is a section-by-section discussion of the changes to §§ 1.4, 1.17, 1.19, 1.53, 1.57, 1.105, and 1.111 (the changes that the Office is adopting in this final rule that the intellectual property law organization alleges will increase the burden and economic costs on small entities).

Section 1.4: The intellectual property law organization provides no specific explanation as to how or why the change to § 1.4 will increase the burden and economic costs on small entities. There is no reasonable basis for contending that the change to § 1.4 in this final rule will have a significant economic impact on any entity. The change to this section simply provides additional means of signing certain documents being submitted to the Office. Any entity may continue to either provide correspondence which

bears an original handwritten signature, or provide a copy of correspondence which bears an original handwritten signature (where permitted), as provided in former § 1.4(d). Because small entities are not required to use the alternatives to a handwritten signature (and the alternative signatures does not require the purchase of any special software), the final rule does not have any economic impact on small entities. The Office anticipates that the alternative to a handwritten signature now provided for in § 1.4 will be used primarily by residents of foreign countries and large business entities, and that the number of small entities (as defined by the SBA) who will use the alternative to a handwritten signature now provided for in § 1.4 will be very low (less than 1.0%). Therefore, the Office has determined that the change to § 1.4 in this final rule will not have a significant economic impact on a substantial number of small entities.

Section 1.17: The change to this section revises the petition fees set under the authority provided in 35 U.S.C. 41(d) to reflect the actual costs of processing these petitions. The intellectual property law organization argues that: (1) Certain petition fees (e.g., the fee for a petition under § 1.53) are more than the small entity fee for filing an application; (2) there is no reduction in these petition fees for small entities; and (3) no petition fee should be required for any small entity. The arguments do not explain how or why the change to § 1.17 in this final rule has a significant economic impact on a substantial number of small entities, or explain how or why the Office's analysis that this change would impact relatively few (less than 2% of) patent applicants is not correct. The arguments simply present the changes that the intellectual property law organization would like to see made with regard to the Office's proposed change to the petition fees set forth in § 1.17. The Office is not adopting these suggestions because (as discussed with respect to the comments on the proposed change to § 1.17): (1) The comparison of a petition fee set on a cost-recovery basis under 35 U.S.C. 41(d) to a small entity basic filing fee set under 35 U.S.C. 41(a) is inapt as the full (non-small entity) basic filing fee does not recover the cost of initial processing and examination of an application; (2) the small entity fee reduction in 35 U.S.C. 41(h) only applies to fees charged under 35 U.S.C. 41(a) or (b), where the petition fee amounts being changed in this final rule are charged under the authority provided in 35 U.S.C. 41(d); and (2)

there is no authority in the patent statute to reduce a fee charged under 35 U.S.C. 41 by one hundred percent for small entities. As discussed above, the petition fee increase would be either \$70.00 or \$270.00 depending upon the type of petition, and this petition fee change would impact relatively few (less than 2% of) patent applicants. Therefore, the Office has determined that the change to § 1.17 in this final rule will not have a significant economic impact on a substantial number of small entities.

Section 1.19: The intellectual property law organization argues that the imposition of additional document supply fees will increase the burden and economic costs on small entity applicants. The Office is not revising the document supply fees set forth in § 1.19. The Office is revising § 1.19 to provide that the Office may supply documents on paper or on an electronic medium (*i.e.*, compact disc or by electronic mail message via the Internet) regardless of the form in which the document was originally submitted to the Office, and to provide that the applicable fee is based upon the medium (paper or electronic) upon which the document is being supplied by the Office rather than the medium upon which the document was originally submitted to the Office. This change to § 1.19 will result in many requesters paying less because the fee for the Office to provide a document in an electronic medium (\$55.00 for the first compact disc) is lower than the fee for the Office to provide the document in paper form (\$200 for the first 400 pages). The Office receives fewer than 10,000 requests for a copy of the file wrapper and contents of a patent or patent application each year. Since the changes in this final rule will reduce or have no effect on the document fees under § 1.19, this change to § 1.19 will not have a significant economic impact on a substantial number of small entities even if all 10,000 requests for a copy of the file wrapper and contents of a patent or patent application received by the Office each year are by a small entity. In any event, the document supply fees set forth in § 1.19 are not fees that an applicant for patent must pay as part of the patent application process; rather, the document supply fees set forth in § 1.19 are fees that the Office charges for persons who wish to purchase patent documents (*i.e.*, Office patent products) from the Office. Therefore, the Office has determined that the change to § 1.19 in this final rule will not have a significant economic impact on a substantial number of small entities.

Section 1.53: The intellectual property law organization argues that,

where an application has been filed with omitted drawings or pages of specification, the Office should permit applicants the option of retaining the original filing date and proceeding with the application as filed. The only change to § 1.53 in this final rule is to provide that a petition under § 1.53 requires the petition fee under § 1.17(f) (\$400.00), rather than the petition fee under § 1.17(h) (\$130.00). The Office estimates that fewer than 2,000 petitions under § 1.53 are filed each year (and since the small entity filing rate has not exceeded 31.0% during the last five fiscal years, the Office further estimates that there will be fewer than 620 petitions under § 1.53 by a small entity), and these petitions are included in the fewer than 5,000 petitions indicated as being affected by the fee change from \$130.00 to \$400.00 (see discussion of the change to § 1.17). The Office is otherwise retaining the practice for treating applications filed with omitted drawings or pages of specification set forth in MPEP 601.01(d) through 601.01(g). Therefore, the Office has determined that the change to § 1.53 in this final rule will not have a significant economic impact on a substantial number of small entities.

Section 1.57: The intellectual property law organization argues that § 1.57 is too rigid and inflexible and that incorporation by reference should be more liberal and open. Section 1.57 is adopted to codify the current incorporation by reference practice set forth in MPEP 608.01(p), and also provide the conditions under which a claim for priority or benefit of a prior-filed application would be considered an incorporation by reference of the prior-filed application. The codification of the current incorporation by reference practice set forth in MPEP 608.01(p) is not a change in practice. While the intellectual property law organization complains that the requirement in § 1.57(b) that an applicant express the incorporation by reference by using the root words "incorporat(e)" and "reference," and identify the referenced patent, application, or publication in the manner set forth in §§ 1.98(b)(1) through (b)(5) are too rigid, the requirement that a patent applicant provide this information when incorporating material by reference into an application (*i.e.*, that an applicant be clear when making an incorporation by reference) has no economic impact, let alone a "significant economic impact" on any entity. Any entity who considers the conditions set forth in § 1.57(a) under which a claim for priority or benefit of a prior-filed application may now be

considered an incorporation by reference of the prior-filed application to be too onerous, rigid, and inflexible may simply decline to take advantage of this provision by not amending the application to include any omitted portion of the specification or drawing(s) that is disclosed in a prior-filed application.

Therefore, the Office has determined that the change to § 1.57 in this final rule will not have a significant economic impact on a substantial number of small entities.

Section 1.105: Section 1.105(a)(1) provides that 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 of such information as may be reasonably necessary to properly examine or treat the matter. Section 1.105(a)(1) then proceeds to set forth examples of information requirements. The change to § 1.105(a)(1) in this final rule is to add the following example: technical information known to applicant concerning the interpretation of the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability, or the accuracy of the examiner's stated interpretation of such items. Section 1.105(a)(3) sets forth examples of formats that requirements for factual information may be presented in any appropriate form, namely: (1) A requirement for information; (2) interrogatories in the form of specific questions seeking applicant's factual knowledge; or (3) stipulations as to facts with which the applicant may agree or disagree. The Office estimates that a requirement for information will be issued in fewer than one hundred (0.03% of) nonprovisional patent applications each fiscal year. Since a requirement for information under § 1.105 is issued only rarely during the course of examining a nonprovisional application (fewer than one hundred each year), the change to § 1.105 in this final rule would not impact a substantial number of small entities no matter what percentage of requirements for information under § 1.105 are issued in small entity nonprovisional applications.

Moreover, § 1.105 does not place any new requirements on applicants, but is simply a codification of the Office's (and the examiner's) inherent authority under 35 U.S.C. 131 and 132 to require information that is reasonably necessary to properly examine or treat a matter in an application. *See Changes to*

Implement the Patent Business Goals, 65 FR at 54633, 1238 *Off. Gaz. Pat. Office* at 103; *see also Jaskiewicz v. Mossinghoff*, 822 F.2d at 1061, 3 USPQ2d at 1301 (practitioners have a duty to honestly and forthrightly answer requirements for information from the Office). The change to § 1.105 in this final rule adds no new requirements. Section 1.105 has been in effect for over three years (since November of 2000). Section 1.105 now merely provides an additional example of information that may be required by the Office, and the format by which the Office may require the information, which is permitted under the Office's (and the examiner's) authority under 35 U.S.C. 131 and 132 and former § 1.105 to require information that is reasonably necessary to properly examine or treat a matter in an application). Finally, the Office does not believe that § 1.105, or the changes to § 1.105 to provide an additional example of information that may be required by the Office and the format by which the Office may require the information, will have a "significant economic impact" on any entity because this provision requires the entity to provide only the factual information that is readily available. *See* § 1.105(a)(4). Therefore, the Office has determined that the change to § 1.105 in this final rule will not have a significant economic impact on a substantial number of small entities.

Section 1.111: The change to § 1.111 in this final rule is to provide that a supplemental reply will not (with certain exceptions) be entered as a matter of right. Based upon Office PALM records, over 235,500 replies to non-final Office actions were filed in fiscal year 2003 in applications that were pending before the Office, and fewer than 8,270 of these replies were followed by a supplemental reply. Since the small entity filing rate has not exceeded 31.0% during the last five fiscal years, the Office further estimates that fewer 2,564 replies in a small entity nonprovisional application were followed by a supplemental reply. In addition, the Office will enter a supplemental reply that is filed within the period during which action is suspended by the Office under § 1.103(a) or (c). Thus, if a patent applicant has good cause to file a supplemental reply, the applicant may file the initial reply with a petition for suspension of action under § 1.103(a). Moreover, even if a patent applicant does not have good cause to file a supplemental reply, the applicant may file the initial reply with an RCE under § 1.114 (assuming that the conditions of

§ 1.114 are otherwise met) with a petition for suspension of action under § 1.103(c). The Office is not adjusting the fees for an RCE or for a petition for suspension of action under § 1.103(c), and the change to the fee for a petition for suspension of action under § 1.103(a) (from \$130.00 to \$200.00) is covered in the discussion of the change to § 1.17. Therefore, the Office has determined that the change to § 1.111 in this final rule will not have a significant economic impact on a substantial number of small entities.

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 rule making 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 final rule have been reviewed and previously approved by OMB under the following control numbers: 0651-0016, 0651-0020, 0651-0031, 0651-0032, 0651-0033, 0651-0034 and 0651-0036.

The title, description and respondent description of each of the information collections is shown below with an estimate of the annual reporting burdens. Included in the estimate is the time for reviewing instructions, gathering and maintaining the data needed, and completing and reviewing the collection of information. The principal impacts of the changes in this final rule are to (1) expressly provide for an alternative signature on a number of submissions; (2) adjust the fees for many of the petitions listed under § 1.17(h) to reflect the Office's actual cost of processing these petitions; and (3) expand the submissions that can be filed on a compact disc.

OMB Number: 0651-0016.

Title: Rules for Patent Maintenance Fees.

Form Numbers: PTO/SB/45/47/65/66.

Type of Review: Approved through May of 2006.

Affected Public: Individuals or Households, Business or Other For-Profit Institutions, Not-For-Profit Institutions and Federal Government.

Estimated Number of Respondents: 348,140.

Estimated Time Per Response: Between 20 seconds and 8 hours.

Estimated Total Annual Burden Hours: 30,735 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 October of 2004.

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: 26,859.

Estimated Time Per Response: Between 1 and 25 hours.

Estimated Total Annual Burden Hours: 30,905 hours.

Needs and Uses: The information supplied to the United States Patent and Trademark Office (USPTO) by an applicant requesting reconsideration of a patent term adjustment determination under 35 U.S.C. 154(b) (§ 1.702 *et seq.*) is used by the United States Patent and Trademark Office to determine whether its determination of patent term adjustment under 35 U.S.C. 154(b) is correct, and whether the applicant is entitled to reinstatement of reduced patent term adjustment. The information supplied to the United States Patent and Trademark Office by an applicant seeking a patent term extension under 35 U.S.C. 156 (§ 1.710 *et seq.*) is used by the United States Patent and Trademark 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 USPTO to review final eligibility decisions, withdraw patent term applications, and declare his or her eligibility to apply for a patent term extension.

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/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: 2,223,639.

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

Estimated Total Annual Burden Hours: 2,724,957 hours.

Needs and Uses: During the processing for 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 Disclosure Statements; 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.

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 USPTO in processing and examination of the application.

OMB Number: 0651-0033.

Title: Post Allowance and Refiling.

Form Numbers: PTO/SB/44, PTO/SB/50-51, PTO/SB/51S, PTO/SB/52-53, PTO/SB/56-58, PTOL-85B.

Type of Review: Approved through April of 2007.

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: 223, 411.

Estimated Time Per Response: 1.8 minutes to 2 hours.

Estimated Total Annual Burden Hours: 67,261 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 and License to Export.

Form Numbers: None.

Type of Review: Approved through May 2007.

Affected Public: Individuals or Households, Business or Other For-Profit Institutions, Not-For-Profit Institutions, Farms, Federal Government, and State, Local, or Tribal Governments.

Number of Respondents: 1,669.

Estimated Time Per Response: Between 30 minutes and 4 hours.

Estimated Total Annual Burden Hours: 1,310 hours.

Needs and Uses: When disclosure of an invention may be detrimental to national security, the Director of the USPTO must issue a secrecy order and withhold the publication of the application or grant of a patent for such period as the national interest requires. The USPTO is also required to grant foreign filing licenses in certain circumstances to applicants filing patent applications in foreign countries. This collection is used by the public to petition the USPTO to allow disclosure, modification, or rescission of a secrecy order, or to obtain a general or group permit. Applicants may also petition the USPTO for a foreign filing license or a retroactive license.

OMB Number: 0651-0036.

Title: Statutory Invention Registration.

Form Number: PTO/SB/94.

Type of Review: Approved through April 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: 73.

Estimated Time Per Response: 24 minutes.

Estimated Total Annual Burden Hours: 29 hours.

Needs and Uses: This collection of information is necessary to ensure that the requirements of 35 U.S.C. 157 and 37 CFR 1.293 through 1.297 are met. The public uses form PTO/SB/94, Request for Statutory Invention Registration, to request and authorize publication of a regularly filed patent application as a statutory invention registration, to waive the right to receive a United States patent on the same invention claimed in the identified patent application, and to agree that the waiver will be effective upon publication of the statutory invention registration. The USPTO uses form PTO/SB/94, Request for a Statutory Invention Registration, to review, grant, or deny a request for a statutory invention registration. No forms are associated with the petition to review final refusal to publish a statutory invention registration or the petition to withdraw a publication request. The petition to review final refusal to publish a statutory invention registration is used by the public to petition the USPTO's rejection of a request for a statutory invention registration. The USPTO uses the petition to withdraw a publication request to review requests to stop publication of a statutory invention registration.

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, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or to the Office of Information and Regulatory Affairs, OMB, 725 17th Street, NW.,

Washington, DC 20503, (Attn: PTO Desk Officer).

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, Inventions and patents, Reporting and recordkeeping requirements, Small Businesses.

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.

37 CFR Part 41

Administrative practice and procedure, Inventions and patents, Lawyers.

37 CFR Part 104

Administrative practice and procedure, Claims, Courts, Freedom of Information, Inventions and patents, Tort Claims, Trademarks.

■ For the reasons set forth in the preamble, 37 CFR Parts 1, 5 and 41 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 (d) and (e), and adding new paragraph (h) immediately before the section authority citation to read as follows:

§ 1.4 Nature of correspondence and signature requirements.

* * * * *

(d)(1) *Handwritten signature.* Each piece of correspondence, except as provided in paragraphs (d)(2), (d)(3), (e) and (f) of this section, filed in an application, patent file, or other proceeding in the Office which requires a person's signature, must:

(i) Be an original, that is, have an original handwritten signature personally signed, in permanent dark ink or its equivalent, by that person; or

(ii) Be a direct or indirect copy, such as a photocopy or facsimile transmission (§ 1.6(d)), of an original. In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original.

(2) *S-signature.* An S-signature is a signature inserted between forward slash marks, but not a handwritten signature as defined by § 1.4(d)(1). An S-signature includes any signature made by electronic or mechanical means, and any other mode of making or applying a signature not covered by either a handwritten signature of § 1.4(d)(1) or an Office Electronic Filing System (EFS) character coded signature of § 1.4(d)(3). Correspondence being filed in the Office in paper, by facsimile transmission as provided in § 1.6(d), with a signature in permanent dark ink or its equivalent, or via the Office Electronic Filing System as an EFS Tag(ged) Image File Format (TIFF) attachment, for a patent application, patent, or a reexamination proceeding may be S-signature signed instead of being personally signed (*i.e.*, with a handwritten signature) as provided for in paragraph (d)(1) of this section. The requirements for an S-signature under this paragraph (d)(2) are as follows:

(i) The S-signature must consist only of letters, or Arabic numerals, or both, with appropriate spaces and commas, periods, apostrophes, or hyphens for punctuation, and the person signing the correspondence must insert his or her own S-signature with a first single forward slash mark before, and a second single forward slash mark after, the S-signature (*e.g.*, /Dr. James T. Jones, Jr./); and

(ii) A registered practitioner, signing pursuant to §§ 1.33(b)(1) or 1.33(b)(2), must supply his/her registration number, either as part of the S-signature, or immediately below or adjacent the S-signature. The number (#) character may only be used as part of the S-signature when appearing before a practitioner's registration number; otherwise the number character may not be used in an S-signature.

(iii) The signer's name must be:

(A) Presented in printed or typed form preferably immediately below or adjacent the S-signature, and

(B) Reasonably specific enough so that the identity of the signer can be readily recognized.

(3) *EFS character coded signature.* Correspondence in character coded form being filed via the Office Electronic Filing System for a patent application or patent may be signed electronically. The electronic signature must consist only of

letters of the English alphabet, or Arabic numerals, or both, with appropriate spaces and commas, periods, apostrophes, or hyphens for punctuation. The person signing the correspondence must personally insert the electronic signature with a first single forward slash mark before, and a second single forward slash mark after, the electronic signature (*e.g.*, /Dr. James T. Jones, Jr./).

(4) *Certifications.* (i) *Section 10.18 certifications:* The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any paper by a party, whether a practitioner or non-practitioner, constitutes a certification under § 10.18(b) of this chapter. Violations of § 10.18(b)(2) of this chapter by a party, whether a practitioner or non-practitioner, may result in the imposition of sanctions under § 10.18(c) of this chapter. Any practitioner violating § 10.18(b) of this chapter may also be subject to disciplinary action. See §§ 10.18(d) and 10.23(c)(15) of this chapter.

(ii) *Certifications as to the signature:* (A) *Of another:* A person submitting a document signed by another under paragraphs (d)(2) or (d)(3) of this section is obligated to have a reasonable basis to believe that the person whose signature is present on the document was actually inserted by that person, and should retain evidence of authenticity of the signature.

(B) *Self certification:* The person inserting a signature under paragraphs (d)(2) or (d)(3) of this section in a document submitted to the Office certifies that the inserted signature appearing in the document is his or her own signature.

(C) *Sanctions:* Violations of the certifications as to the signature of another or a person's own signature, set forth in paragraphs (d)(4)(ii)(A) and (B) of this section, may result in the imposition of sanctions under § 10.18(c) and (d) of this chapter.

(e) Correspondence requiring a person's signature and relating to registration practice before the Patent and Trademark Office in patent cases, enrollment and disciplinary investigations, or disciplinary proceedings must be submitted with an original handwritten signature personally signed in permanent dark ink or its equivalent by that person.

* * * * *

(h) *Ratification/confirmation/evidence of authenticity:* The Office may require ratification, confirmation (which includes submission of a duplicate document but with a proper signature), or evidence of authenticity of a

signature, such as when the Office has reasonable doubt as to the authenticity (veracity) of the signature, e.g., where there are variations of a signature, or where the signature and the typed or printed name, do not clearly identify the person signing.

* * * * *

■ 3. Section 1.6 is amended by revising paragraph (d)(4) and removing and reserving paragraph (e) to read as follows:

§ 1.6 Receipt of correspondence.

* * * * *

(d) * * *

(4) Color drawings submitted under §§ 1.81, 1.83 through 1.85, 1.152, 1.165, 1.173, or 1.437;

* * * * *

■ 4. Section 1.8 is amended by revising the introductory text of paragraph (a) and the introductory text of paragraph (b) to read as follows:

§ 1.8 Certificate of mailing or transmission.

(a) Except in the situations enumerated in paragraph (a)(2) of this section or as otherwise expressly excluded in this chapter, correspondence required to be filed in the U.S. Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

* * * * *

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

* * * * *

■ 5. Section 1.10 is amended by adding new paragraphs (g), (h), and (i) to read as follows:

§ 1.10 Filing of correspondence by "Express Mail."

* * * * *

(g) Any person who mails correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS, but has the correspondence returned by the USPS due to an

interruption or emergency in "Express Mail" service, may petition the Director to consider such correspondence as filed on a particular date in the Office, provided that:

(1) The petition is filed promptly after the person becomes aware of the return of the correspondence;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail";

(3) The petition includes the original correspondence or a copy of the original correspondence showing the number of the "Express Mail" mailing label thereon and a copy of the "Express Mail" mailing label showing the "date-in"; and

(4) The petition includes a statement which establishes, to the satisfaction of the Director, the original deposit of the correspondence and that the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally deposited with the USPS on the requested filing date. The Office may require additional evidence to determine if the correspondence was returned by the USPS due to an interruption or emergency in "Express Mail" service.

(h) Any person who attempts to mail correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS, but has the correspondence refused by an employee of the USPS due to an interruption or emergency in "Express Mail" service, may petition the Director to consider such correspondence as filed on a particular date in the Office, provided that:

(1) The petition is filed promptly after the person becomes aware of the refusal of the correspondence;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the attempted mailing by "Express Mail";

(3) The petition includes the original correspondence or a copy of the original correspondence showing the number of the "Express Mail" mailing label thereon; and

(4) The petition includes a statement by the person who originally attempted to deposit the correspondence with the USPS which establishes, to the satisfaction of the Director, the original attempt to deposit the correspondence and that the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally attempted to

be deposited with the USPS on the requested filing date. The Office may require additional evidence to determine if the correspondence was refused by an employee of the USPS due to an interruption or emergency in "Express Mail" service.

(i) Any person attempting to file correspondence under this section that was unable to be deposited with the USPS due to an interruption or emergency in "Express Mail" service which has been so designated by the Director, may petition the Director to consider such correspondence as filed on a particular date in the Office, provided that:

(1) The petition is filed in a manner designated by the Director promptly after the person becomes aware of the designated interruption or emergency in "Express Mail" service;

(2) The petition includes the original correspondence or a copy of the original correspondence; and

(3) The petition includes a statement which establishes, to the satisfaction of the Director, that the correspondence would have been deposited with the USPS but for the designated interruption or emergency in "Express Mail" service, and that the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally attempted to be deposited with the USPS on the requested filing date.

■ 6. 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(g); or

* * * * *

■ 7. Section 1.14 is amended by revising paragraph (h)(1) to read as follows:

§ 1.14 Patent applications preserved in confidence.

* * * * *

(h) * * *

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

* * * * *

■ 8. Section 1.17 is amended by revising paragraphs (h) and (i), and adding new paragraphs (f) and (g) to read as follows:

§ 1.17 Patent application and reexamination processing fees.

* * * * *

(f) For filing a petition under one of the following sections which refers to this paragraph: \$400.00.

§ 1.53(e)—to accord a filing date.

§ 1.57(a)—to accord a filing date.
 § 1.182—for decision on a question not specifically provided for.
 § 1.183—to suspend the rules.
 § 1.378(e)—for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.
 § 1.741(b)—to accord a filing date to an application under § 1.740 for extension of a patent term.
 (g) For filing a petition under one of the following sections which refers to this paragraph: \$200.00
 § 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.
 § 1.59—for expungement of information.
 § 1.103(a)—to suspend action in an application.
 § 1.136(b)—for review of a request for extension of time when the provisions of § 1.136(a) are not available.
 § 1.295—for review of refusal to publish a statutory invention registration.
 § 1.296—to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.
 § 1.377—for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.
 § 1.550(c)—for patent owner requests for extension of time in *ex parte* reexamination proceedings.
 § 1.956—for patent owner requests for extension of time in *inter partes* reexamination proceedings.
 § 5.12—for expedited handling of a foreign filing license.
 § 5.15—for changing the scope of a license.
 § 5.25—for retroactive license.
 (h) For filing a petition under one of the following sections which refers to this paragraph: \$130.00.
 § 1.19(g)—to request documents in a form other than that provided in this part.
 § 1.84—for accepting color drawings or photographs.
 § 1.91—for entry of a model or exhibit.
 § 1.102(d)—to make an application special.
 § 1.138(c)—to expressly abandon an application to avoid publication.
 § 1.313—to withdraw an application from issue.
 § 1.314—to defer issuance of a patent.
 (i) Processing fee for taking action under one of the following sections which refers to this paragraph: \$130.00.

§ 1.28(c)(3)—for processing a non-itemized fee deficiency based on an error in small entity status.
 § 1.41—for supplying the name or names of the inventor or inventors after the filing date without an oath or declaration as prescribed by § 1.63, except in provisional applications.
 § 1.48—for correcting inventorship, except in provisional applications.
 § 1.52(d)—for processing a nonprovisional application filed with a specification in a language other than English.
 § 1.53(b)(3)—to convert a provisional application filed under § 1.53(c) into a nonprovisional application under § 1.53(b).
 § 1.55—for entry of late priority papers.
 § 1.99(e)—for processing a belated submission under § 1.99.
 § 1.103(b)—for requesting limited suspension of action, continued prosecution application for a design patent (§ 1.53(d)).
 § 1.103(c)—for requesting limited suspension of action, request for continued examination (§ 1.114).
 § 1.103(d)—for requesting deferred examination of an application.
 § 1.217—for processing a redacted copy of a paper submitted in the file of an application in which a redacted copy was submitted for the patent application publication.
 § 1.221—for requesting voluntary publication or republication of an application.
 § 1.291(c)(5)—for processing a second or subsequent protest by the same real party in interest.
 § 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.
 * * * * *
 ■ 9. Section 1.19 is amended by revising its introductory text and paragraph (b), and by adding paragraph (g), to read as follows:
§ 1.19 Document supply fees.
 The United States Patent and Trademark Office will supply copies of the following patent-related documents upon payment of the fees indicated. Paper 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.
 * * * * *
 (b) Copies of Office documents to be provided in paper, or in electronic form,

as determined by the Director (for other patent-related materials see § 1.21(k)):
 (1) Copy of a patent application as filed, or a patent-related file wrapper and contents, stored in paper in a paper file wrapper, in an image format in an image file wrapper, or if color documents, stored in paper in an Artifact Folder:
 (i) If provided on paper:
 (A) Application as filed: \$20.00.
 (B) File wrapper and contents of 400 or fewer pages: \$200.00.
 (C) Additional fee for each additional 100 pages or portion thereof of file wrapper and contents: \$40.00.
 (D) Individual application documents, other than application as filed, per document: \$25.00.
 (ii) If provided on compact disc or other physical electronic medium in a single order:
 (A) Application as filed: \$20.00.
 (B) File wrapper and contents, first physical electronic medium: \$55.00.
 (C) Additional fee for each continuing physical electronic medium in the single order of paragraph (b)(1)(ii)(B) of this section: \$15.00.
 (iii) If provided electronically (*e.g.*, by electronic transmission) other than on a physical electronic medium as specified in paragraph (b)(1)(ii) of this section:
 (A) Application as filed: \$20.00.
 (B) File wrapper and contents: \$55.00.
 (2) Copy of patent-related file wrapper contents that were submitted and are stored on compact disc or other electronic form (*e.g.*, compact discs stored in an Artifact Folder), other than as available in paragraph (b)(1) of this section:
 (i) If provided on compact disc or other physical electronic medium in a single order:
 (A) First physical electronic medium in a single order: \$55.00.
 (B) Additional fee for each continuing physical electronic medium in the single order of paragraph (b)(2)(i) of this section: \$15.00.
 (ii) If provided electronically other than on a physical electronic medium per order: \$55.00.
 (3) Copy of Office records, except copies available under paragraph (b)(1) or (2) of this section: \$25.00.
 (4) For assignment records, abstract of title and certification, per patent: \$25.00.
 * * * * *
 (g) Petitions for documents in a form other than that provided by this part, or in a form other than that generally provided by the Director, will be decided in accordance with the merits of each situation. Any petition seeking a decision under this section must be

accompanied by the petition fee set forth in § 1.17(h) and, if the petition is granted, the documents will be provided at cost.

■ 10. Section 1.27 is amended by revising paragraph (a) 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 in the invention to one or more parties, 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; and

(ii) Meets the size standards set forth in 13 CFR 121.801 through 121.805 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, SW., Washington, DC 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.

(5) *Security Interest.* A security interest does not involve an obligation to transfer rights in the invention for the purposes of paragraphs (a)(1) through (a)(3) of this section unless the security interest is defaulted upon.

* * * * *

■ 11. Section 1.47 is amended by revising paragraphs (a) and (b) 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(g), 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(g), 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.

* * * * *

■ 12. Section 1.52 is amended by revising the section heading and paragraphs (b)(2)(ii), (e)(1), (e)(3)(i) and (e)(3)(ii) to read as follows:

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

* * * * *

(b) * * *

(2) * * *

(ii) Text written in a nonscript type font (e.g., Arial, Times Roman, or Courier, preferably a font size of 12) lettering style having capital letters which should be at least 0.3175 cm. (0.125 inch) high, but may be no smaller than 0.21 cm. (0.08 inch) high (e.g., a font size of 6); and

* * * * *

(e) * * *

(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) Any individual table (see § 1.58) if the table is more than 50 pages in length, or if the total number of pages of all of the tables in an application exceeds 100 pages in length, where a table page is a page printed on paper in conformance with paragraph (b) of this section and § 1.58(c).

* * * * *

(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). CD-R discs must be finalized so that they are closed to further writing to the CD-R.

(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 (e.g., tables in landscape orientation should be identified as landscape orientation or be identified when inquired about) the information on the compact disc. Compact discs submitted to the Office will not be returned to the applicant.

* * * * *

■ 13. Section 1.53 is amended by revising paragraph (e)(2) to read as follows:

§ 1.53 Application number, filing date, and completion of application.

* * * * *

(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(f). 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.

* * * * *

■ 14. Section 1.57 is added to read as follows:

§ 1.57 Incorporation by reference.

(a) Subject to the conditions and requirements of this paragraph, if all or a portion of the specification or drawing(s) is inadvertently omitted from an application, but the application contains a claim under § 1.55 for priority of a prior-filed foreign application, or a claim under § 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application, that was present on the filing date of the application, and the inadvertently omitted portion of the specification or drawing(s) is

completely contained in the prior-filed application, the claim under § 1.55 or § 1.78 shall also be considered an incorporation by reference of the prior-filed application as to the inadvertently omitted portion of the specification or drawing(s).

(1) The application must be amended to include the inadvertently omitted portion of the specification or drawing(s) within any time period set by the Office, but in no case later than the close of prosecution as defined by § 1.114(b), or abandonment of the application, whichever occurs earlier. The applicant is also required to:

(i) Supply a copy of the prior-filed application, except where the prior-filed application is an application filed under 35 U.S.C. 111;

(ii) Supply an English language translation of any prior-filed application that is in a language other than English; and

(iii) Identify where the inadvertently omitted portion of the specification or drawings can be found in the prior-filed application.

(2) Any amendment to an international application pursuant to this paragraph shall be effective only as to the United States, and shall have no effect on the international filing date of the application. In addition, no request to add the inadvertently omitted portion of the specification or drawings in an international application designating the United States will be acted upon by the Office prior to the entry and commencement of the national stage (§ 1.491) or the filing of an application under 35 U.S.C. 111(a) which claims benefit of the international application.

(3) If an application is not otherwise entitled to a filing date under § 1.53(b), the amendment must be by way of a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(f).

(b) Except as provided in paragraph (a) of this section, an incorporation by reference must be set forth in the specification and must:

(1) Express a clear intent to incorporate by reference by using the root words “incorporat(e)” and “reference” (e.g., “incorporate by reference”); and

(2) Clearly identify the referenced patent, application, or publication.

(c) “Essential material” may be incorporated by reference, but only by way of an incorporation by reference to a U.S. patent or U.S. patent application publication, which patent or patent application publication does not itself incorporate such essential material by reference. “Essential material” is material that is necessary to:

(1) Provide a written description of the claimed invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and set forth the best mode contemplated by the inventor of carrying out the invention as required by the first paragraph of 35 U.S.C. 112;

(2) Describe the claimed invention in terms that particularly point out and distinctly claim the invention as required by the second paragraph of 35 U.S.C. 112; or

(3) Describe the structure, material, or acts that correspond to a claimed means or step for performing a specified function as required by the sixth paragraph of 35 U.S.C. 112.

(d) Other material (“Nonessential material”) may be incorporated by reference to U.S. patents, U.S. patent application publications, foreign patents, foreign published applications, prior and concurrently filed commonly owned U.S. applications, or non-patent publications. An incorporation by reference by hyperlink or other form of browser executable code is not permitted.

(e) The examiner may require the applicant to supply a copy of the material incorporated by reference. If the Office requires the applicant to supply a copy of material incorporated by reference, the material must be accompanied by a statement that the copy supplied consists of the same material incorporated by reference in the referencing application.

(f) Any insertion of material incorporated by reference into the specification or drawings of an application must be by way of an amendment to the specification or drawings. Such an amendment must be accompanied by a statement that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter.

(g) An incorporation of material by reference that does not comply with paragraphs (b), (c), or (d) of this section is not effective to incorporate such material unless corrected within any time period set by the Office, but in no case later than the close of prosecution as defined by § 1.114(b), or abandonment of the application, whichever occurs earlier. In addition:

(1) A correction to comply with paragraph (b)(1) of this section is permitted only if the application as filed clearly conveys an intent to incorporate the material by reference. A mere

reference to material does not convey an intent to incorporate the material by reference.

(2) A correction to comply with paragraph (b)(2) of this section is only permitted for material that was sufficiently described to uniquely identify the document.

■ 15. Section 1.58 is revised to read as follows:

§ 1.58 Chemical and mathematical formulae and tables.

(a) The specification, including the claims, may contain chemical and mathematical formulae, but shall not contain drawings or flow diagrams. The description portion of the specification may contain tables, but the same tables may only be included in both the drawings and description portion of the specification if the application was filed under 35 U.S.C. 371. Claims may contain tables either if necessary to conform to 35 U.S.C. 112 or if otherwise found to be desirable.

(b) Tables that are submitted in electronic form (§§ 1.96(c) and 1.821(c)) must maintain the spatial relationships (e.g., alignment of columns and rows) of the table elements when displayed so as to visually preserve the relational 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.

(c) Chemical and mathematical formulae and tables must be presented in compliance with § 1.52(a) and (b), except that chemical and mathematical formulae or tables may be placed in a landscape orientation if they cannot be presented satisfactorily in a portrait orientation. Typewritten characters used in such formulae and tables must be chosen from a block (nonscript) type font or lettering style having capital letters which should be at least 0.422 cm. (0.166 inch) high (e.g., preferably Arial, Times Roman, or Courier with a font size of 12), but may be no smaller than 0.21 cm. (0.08 inch) high (e.g., a font size of 6). A space at least 0.64 cm. (1/4 inch) high should be provided between complex formulae and tables and the text. Tables should have the lines and columns of data closely spaced to conserve space, consistent with a high degree of legibility.

■ 16. 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 information, other than what is excluded by paragraph (a)(2) of

this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

* * * * *

■ 17. Section 1.63 is amended by revising paragraph (d)(4) to read as follows:

§ 1.63 Oath or declaration.

* * * * *

(d) * * *

(4) Where the power of attorney or correspondence address was changed during the prosecution of the prior application, the change in power of attorney or correspondence address must be identified in the continuation or divisional application. Otherwise, the Office may not recognize in the continuation or divisional application the change of power of attorney or correspondence address during the prosecution of the prior application.

* * * * *

■ 18. Section 1.69 is amended by revising paragraph (b) to read as follows:

§ 1.69 Foreign language oaths and declarations.

* * * * *

(b) Unless the text of any oath or declaration is in a language other than English, or in a form provided in accordance with PCT Rule 4.17(iv), it must be accompanied by an English translation together with a statement that the translation is accurate, except that in the case of an oath or declaration filed under § 1.63, the translation may be filed in the Office no later than two months from the date applicant is notified to file the translation.

* * * * *

■ 19. Section 1.76 is amended by revising paragraphs (a), (b)(4), (c)(2) and (d) 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. An application data sheet must be titled "Application Data Sheet" and must contain all of the section headings listed in paragraph (b) of this section, with any appropriate data for each section heading. 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) * * *

(4) *Representative information.* This information includes the registration number of each practitioner having a power of attorney 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 in the application (see § 1.32).

* * * * *

(c) * * *

(2) Must be titled "Supplemental Application Data Sheet," include all of the section headings listed in paragraph (b) of this section, include all appropriate data for each section heading, and must identify the information that is being changed, preferably with underlining for insertions, and strike-through or brackets for text removed.

(d) *Inconsistencies between application data sheet and other documents.* For inconsistencies between information that is supplied by both an application data sheet under this section and other documents.

(1) The latest submitted information will govern notwithstanding whether supplied by an application data sheet, an amendment to the specification, a designation of a correspondence address, 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 an amendment to the specification, a designation of correspondence address, or 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 capture bibliographic information from the application data sheet (notwithstanding whether an oath or declaration governs the information). Thus, the Office shall generally, for example, 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 corrected if applicant submits a request therefor and a supplemental application data sheet.

■ 20. Section 1.78 is amended by revising paragraphs (a)(1), (a)(2)(iii), (a)(5)(iii), and (c) to read as follows:

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

(a)(1) A nonprovisional application or international application designating the United States of America may claim an invention disclosed in one or more prior-filed copending nonprovisional applications or international applications designating the United States of America. In order for an application to claim the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America, each prior-filed application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior-filed application must be:

- (i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America; or
- (ii) Entitled to a filing date as set forth in § 1.53(b) or § 1.53(d) and include the basic filing fee set forth in § 1.16; or
- (iii) Entitled to a filing date as set forth in § 1.53(b) and have paid therein the processing and retention fee set forth in § 1.21(l) within the time period set forth in § 1.53(f).

(2) * * *

(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76), or the specification must contain or be amended to contain such reference in the first sentence(s) following the title.

* * * * *

(5) * * *

(iii) If the later-filed application is a non-provisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76), or the specification must contain or be amended to contain such reference in the first sentence(s) 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 person 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. Even if 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 conflicting claims may be rejected under the doctrine of double patenting in view of such commonly owned or assigned applications or patents under reexamination.

* * * * *

■ 21. Section 1.83 is amended by revising paragraph (a) to read as follows:

§ 1.83 Content of drawing.

(a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box). In addition, tables and sequence listings that are included in the specification are, except for applications filed under 35 U.S.C. 371, not permitted to be included in the drawings.

* * * * *

■ 22. Section 1.84 is amended by revising paragraphs (a)(2) and (c) to read as follows:

§ 1.84 Standards for drawings.

(a) * * *

(2) *Color.* On rare occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility or design patent application or the subject matter of a statutory invention registration. The color drawings must be of sufficient quality such that all details in the drawings are reproducible in black and white in the printed patent. Color drawings are not permitted in international applications (see PCT Rule 11.13), or in an application, or copy thereof, submitted under the Office electronic filing system. The Office will accept color drawings in utility or design patent applications and statutory invention registrations only after granting a petition filed under this paragraph

explaining why the color drawings are necessary. Any such petition must include the following:

- (i) The fee set forth in § 1.17(h);
- (ii) Three (3) sets of color drawings; and
- (iii) An amendment to the specification to insert (unless the specification contains or has been previously amended to contain) the following language as the first paragraph of the brief description of the drawings:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

* * * * *

(c) *Identification of drawings.* Identifying indicia should be provided, and 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 within the top margin. Each drawing sheet submitted after the filing date of an application must be identified as either "Replacement Sheet" or "New Sheet" pursuant to § 1.121(d). If a marked-up copy of any amended drawing figure including annotations indicating the changes made is filed, such marked-up copy must be clearly labeled as "Annotated Sheet" pursuant to § 1.121(d)(1).

* * * * *

■ 23. Section 1.85 is amended by revising paragraph (c) to read as follows:

§ 1.85 Corrections to drawings.

* * * * *

(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 drawing in compliance with § 1.84 to avoid abandonment. This time period is not extendable under § 1.136(a) or § 1.136(b).

■ 24. Section 1.91 is amended by adding paragraph (c) to read as follows:

§ 1.91 Models or exhibits not generally admitted as part of application or patent.

* * * * *

(c) Unless the model or exhibit substantially conforms to the requirements of § 1.52 or § 1.84 under paragraph (a)(1) of this section, it must be accompanied by photographs that show multiple views of the material

features of the model or exhibit and that substantially conform to the requirements of § 1.84.

■ 25. Section 1.94 is revised to read as follows:

§ 1.94 Return of models, exhibits or specimens.

(a) Models, exhibits, or specimens may be returned to the applicant if no longer necessary for the conduct of business before the Office. When applicant is notified that a model, exhibit, or specimen is no longer necessary for the conduct of business before the Office and will be returned, applicant must arrange for the return of the model, exhibit, or specimen at the applicant's expense. The Office will dispose of perishables without notice to applicant unless applicant notifies the Office upon submission of the model, exhibit or specimen that a return is desired and makes arrangements for its return promptly upon notification by the Office that the model, exhibit or specimen is no longer necessary for the conduct of business before the Office.

(b) Applicant is responsible for retaining the actual model, exhibit, or specimen for the enforceable life of any patent resulting from the application. The provisions of this paragraph do not apply to a model or exhibit that substantially conforms to the requirements of § 1.52 or § 1.84, where the model or exhibit has been described by photographs that substantially conform to § 1.84, or where the model, exhibit or specimen is perishable.

(c) Where applicant is notified, pursuant to paragraph (a) of this section, of the need to arrange for return of a model, exhibit or specimen, applicant must arrange for the return within the period set in such notice, to avoid disposal of the model, exhibit or specimen by the Office. Extensions of time are available under § 1.136, except in the case of perishables. Failure to establish that the return of the item has been arranged for within the period set or failure to have the item removed from Office storage within a reasonable amount of time notwithstanding any arrangement for return, will permit the Office to dispose of the model, exhibit or specimen.

■ 26. Section 1.98 is amended by revising paragraphs (a) and (c) and removing paragraph (e) to read as follows:

§ 1.98 Content of information disclosure statement.

(a) Any information disclosure statement filed under § 1.97 shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3) of this section.

(1) A list of all patents, publications, applications, or other information submitted for consideration by the Office. U.S. patents and U.S. patent application publications must be listed in a section separately from citations of other documents. Each page of the list must include:

(i) The application number of the application in which the information disclosure statement is being submitted;

(ii) A column that provides a space, next to each document to be considered, for the examiner's initials; and

(iii) A heading that clearly indicates that the list is an information disclosure statement.

(2) A legible copy of:

(i) Each foreign patent;

(ii) Each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office;

(iii) For each cited pending unpublished 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.

(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).

(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 as specified in paragraph (a) of this section may be submitted without copies of the other patents or publications, provided that it is stated that these other patents or publications are cumulative.

* * * * *

■ 27. Section 1.102 is amended by revising paragraph (c) to read as follows:

§ 1.102 Advancement of examination.

* * * * *

(c) A petition to make an application special may be filed without a fee if the basis for the petition is:

(1) The applicant's age or health; or
 (2) That the invention will materially:

(i) Enhance the quality of the environment;

(ii) Contribute to the development or conservation of energy resources; or

(iii) Contribute to countering terrorism.

* * * * *

■ 28. Section 1.103 is amended by revising paragraph (a)(2) to read as follows:

§ 1.103 Suspension of action by the Office.

(a) * * *

(2) The fee set forth in § 1.17(g), unless such cause is the fault of the Office.

* * * * *

■ 29. Section 1.105 is amended by revising paragraph (a)(3) and by adding new paragraphs (a)(1)(viii) and (a)(4) to read as follows:

§ 1.105 Requirements for information.

(a)(1) * * *

(viii) *Technical information known to applicant.* Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability, or concerning the accuracy of the examiner's stated interpretation of such items.

* * * * *

(3) Requirements for factual information known to applicant may be presented in any appropriate manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.

(4) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.

* * * * *

■ 30. Section 1.111 is amended by revising paragraph (a)(2) to read as follows:

§ 1.111 Reply by applicant or patent owner to a non-final Office action.

(a) * * *

(2) *Supplemental replies.* (i) A reply that is supplemental to a reply that in compliance with § 1.111(b) will not be entered as a matter of right except as

provided in paragraph (a)(2)(ii) of this section. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:

- (A) Cancellation of a claim(s);
 - (B) Adoption of the examiner suggestion(s);
 - (C) Placement of the application in condition for allowance;
 - (D) Reply to an Office requirement made after the first reply was filed;
 - (E) Correction of informalities (e.g., typographical errors); or
 - (F) Simplification of issues for appeal.
- (ii) A supplemental reply will be entered if the supplemental reply is filed within the period during which action by the Office is suspended under § 1.103(a) or (c).

* * * * *

■ 31. Section 1.115 is revised 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. The patent application publication may include preliminary amendments (§ 1.215(a)).

(1) A preliminary amendment that is present on the filing date of an application is part of the original disclosure of the application.

(2) A preliminary amendment filed after the filing date of the application is not part of the original disclosure of the application.

(b) A preliminary amendment in compliance with § 1.121 will be entered unless disapproved by the Director.

(1) A preliminary amendment seeking cancellation of all the claims without presenting any new or substitute claims will be disapproved.

(2) 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.

(3) A preliminary amendment will not be disapproved under (b)(2) of this section 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.

(4) The time periods specified in paragraph (b)(3) of this section are not extendable.

■ 32. Section 1.121 is amended by revising paragraph (d) to read as follows:

§ 1.121 Manner of making amendments in applications.

* * * * *

(d) *Drawings*: One or more application drawings shall be amended in the following manner: Any changes to an application drawing must be in compliance with § 1.84 and must be submitted on a replacement sheet of drawings which shall be an attachment to the amendment document and, in the top margin, labeled "Replacement Sheet." Any replacement sheet of drawings shall include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. Any new sheet of drawings containing an additional figure must be labeled in the top margin as "New Sheet." All changes to the drawings shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper.

(1) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change to the drawings.

(2) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

* * * * *

■ 33. Section 1.131 is amended by revising paragraph (b) to read as follows:

§ 1.131 Affidavit or declaration of prior invention.

* * * * *

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

■ 34. Section 1.136 is amended by revising paragraph (b) to read as follows:

§ 1.136 Extensions of time.

* * * * *

(b) When a reply cannot be filed within the time period set for such reply and the provisions of paragraph (a) of this section are not available, the period for reply will be extended only for sufficient cause and for a reasonable time specified. Any request for an extension of time under this paragraph must be filed on or before the day on which such reply is due, but the mere filing of such a request will not affect any extension under this paragraph. In no situation can any extension carry the date on which reply is due beyond the maximum time period set by statute. See § 1.304 for extensions of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action; § 1.645 for extensions of time in interference proceedings; § 1.550(c) for extensions of time in *ex parte* reexamination proceedings; and § 1.956 for extensions of time in *inter partes* reexamination proceedings. Any request under this section must be accompanied by the petition fee set forth in § 1.17(g).

* * * * *

■ 35. Section 1.137 is amended by revising paragraph (d)(3) to read as follows:

§ 1.137 Revival of abandoned application, terminated reexamination proceedings, or lapsed patent.

* * * * *

(d) * * *

(3) The provisions of paragraph (d)(1) of this section do not apply to applications for which revival is sought solely for purposes of copendency with a utility or plant application filed on or after June 8, 1995, to lapsed patents, to reissue applications, or to reexamination proceedings.

* * * * *

■ 36. Section 1.165 is amended by revising paragraph (b) to read as follows:

§ 1.165 Plant drawings.

* * * * *

(b) The drawings may be in color. The drawing must be in color if color is a distinguishing characteristic of the new variety. Two copies of color drawings or photographs must be submitted.

■ 37. Section 1.173 is amended by revising paragraph (b) introductory text to read as follows:

§ 1.173 Reissue specification, drawings, and amendments.

* * * * *

(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, as follows:

* * * * *

■ 38. Section 1.175 is amended by adding a new paragraph (e) to read as follows:

§ 1.175 Reissue oath or declaration.

* * * * *

(e) The filing of any continuing reissue application which does not replace its parent reissue application must include an oath or declaration which, pursuant to paragraph (a)(1) of this section, identifies at least one error in the original patent which has not been corrected by the parent reissue application or an earlier reissue application. All other requirements relating to oaths or declarations must also be met.

■ 39. Section 1.178 is amended by revising paragraph (a) to read as follows:

§ 1.178 Original patent; continuing duty of applicant.

(a) The application for reissue of a patent shall constitute an offer to surrender that patent, and the surrender shall take effect upon reissue of the patent. Until a reissue application is granted, the original patent shall remain in effect.

* * * * *

§ 1.179 [Removed and Reserved]

■ 40. Section 1.179 is removed and reserved.

■ 41. Section 1.182 is revised to read as follows:

§ 1.182 Questions not specifically provided for.

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

■ 42. Section 1.183 is revised to read as follows:

§ 1.183 Suspension of rules.

In an extraordinary situation, when justice requires, any requirement of the

regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

■ 43. Section 1.215 is amended by revising paragraphs (a) and (c) to read as follows:

§ 1.215 Patent application publication.

(a) The publication of an application under 35 U.S.C. 122(b) shall include a patent application publication. The date of publication shall be indicated on the patent application publication. The patent application publication will be based upon the specification and drawings deposited on the filing date of the application, as well as the executed oath or declaration submitted to complete the application. The patent application publication may also be based upon amendments to the specification (other than the abstract or the claims) that are reflected in a substitute specification under § 1.125(b), amendments to the abstract under § 1.121(b), amendments to the claims that are reflected in a complete claim listing under § 1.121(c), and amendments to the drawings under § 1.121(d), provided that such substitute specification or amendment is submitted in sufficient time to be entered into the Office file wrapper of the application before technical preparations for publication of the application have begun. Technical preparations for publication of an application generally begin four months prior to the projected date of publication. The patent application publication of an application that has entered the national stage under 35 U.S.C. 371 may also include amendments made during the international stage. See paragraph (c) of this section for publication of an application based upon a copy of the application submitted via the Office electronic filing system.

* * * * *

(c) At applicant's option, the patent application publication will be based upon the copy of the application (specification, drawings, and oath or declaration) as amended, provided that applicant supplies such a copy in compliance with the Office electronic filing system requirements within one month of the mailing date of the first Office communication that includes a confirmation number for the application, or fourteen months of the earliest filing date for which a benefit is

sought under title 35, United States Code, whichever is later.

* * * * *

■ 44. Section 1.291 is revised to read as follows:

§ 1.291 Protests by the public against pending applications.

(a) A protest may be filed by a member of the public against a pending application, and it will be matched with the application file if it adequately identifies the patent application. A protest submitted within the time frame of paragraph (b) of this section, which is not matched, or not matched in a timely manner to permit review by the examiner during prosecution, due to inadequate identification, may not be entered and may be returned to the protestor where practical, or, if return is not practical, discarded.

(b) The protest will be entered into the record of the application if, in addition to complying with paragraph (c) of this section, the protest has been served upon the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible; and, except for paragraph (b)(1) of this section, the protest was filed prior to the date the application was published under § 1.211, or a notice of allowance under § 1.311 was mailed, whichever occurs first.

(1) If a protest is accompanied by the written consent of the applicant, the protest will be considered if the protest is matched with the application in time to permit review during prosecution.

(2) A statement must accompany a protest that it is the first protest submitted in the application by the real party in interest who is submitting the protest; or the protest must comply with paragraph (c)(5) of this section. This section does not apply to the first protest filed in an application.

(c) In addition to compliance with paragraphs (a) and (b) of this section, a protest must include:

(1) A listing of the patents, publications, or other information relied upon;

(2) A concise explanation of the relevance of each item listed pursuant to paragraph (c)(1) of this section;

(3) A copy of each listed patent, publication, or other item of information in written form, or at least the pertinent portions thereof;

(4) An English language translation of all the necessary and pertinent parts of any non-English language patent, publication, or other item of information relied upon; and

(5) If it is a second or subsequent protest by the same real party in interest, an explanation as to why the

issue(s) raised in the second or subsequent protest are significantly different than those raised earlier and why the significantly different issue(s) were not presented earlier, and a processing fee under § 1.17(i) must be submitted.

(d) A member of the public filing a protest in an application under this section will not receive any communication from the Office relating to the protest, other than the return of a self-addressed postcard which the member of the public may include with the protest in order to receive an acknowledgment by the Office that the protest has been received. The limited involvement of the member of the public filing a protest pursuant to this section ends with the filing of the protest, and no further submission on behalf of the protestor will be considered, unless the submission is made pursuant to paragraph (c)(5) of this section.

(e) Where a protest raising inequitable conduct issues satisfies the provisions of this section for entry, it will be entered into the application file, generally without comment on the inequitable conduct issues raised in it.

(f) In the absence of a request by the Office, an applicant has no duty to, and need not, reply to a protest.

(g) Protests that fail to comply with paragraphs (b) or (c) of this section may not be entered, and if not entered, will be returned to the protestor, or discarded, at the option of the Office.

■ 45. Section 1.295 is amended by revising paragraph (a) to read as follows:

§ 1.295 Review of decision finally refusing to publish a statutory invention registration.

(a) Any requester who is dissatisfied with the final refusal to publish a statutory invention registration for reasons other than compliance with 35 U.S.C. 112 may obtain review of the refusal to publish the statutory invention registration by filing a petition to the Director accompanied by the fee set forth in § 1.17(g) within one month or such other time as is set in the decision refusing publication. Any such petition should comply with the requirements of § 1.181(b). The petition may include a request that the petition fee be refunded if the final refusal to publish a statutory invention registration for reasons other than compliance with 35 U.S.C. 112 is determined to result from an error by the Patent and Trademark Office.

* * * * *

■ 46. Section 1.296 is revised to read as follows:

§ 1.296 Withdrawal of request for publication of statutory invention registration.

A request for a statutory invention registration, which has been filed, may be withdrawn prior to the date on which the notice of the intent to publish a statutory invention registration issued pursuant to § 1.294(c) by filing a request to withdraw the request for publication of a statutory invention registration. The request to withdraw may also include a request for a refund of any amount paid in excess of the application filing fee and a handling fee of \$130.00 which will be retained. Any request to withdraw the request for publication of a statutory invention registration filed on or after the date on which the notice of intent to publish issued pursuant to § 1.294(c) must be in the form of a petition accompanied by the fee set forth in § 1.17(g).

■ 47. 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 or other post-allowance fees set forth in § 1.18 to a deposit account may be filed in an individual application only after mailing of the notice of allowance. The submission of either of the following after the mailing of a notice of allowance will operate as a request to charge the correct issue fee or any publication fee due to any deposit account identified in a previously filed authorization to charge such fees:

- (1) An incorrect issue fee or publication fee; or
- (2) A fee transmittal form (or letter) for payment of issue fee or publication fee.

■ 48. Section 1.324 is amended by revising paragraph (a) and the introductory text of paragraph (b) to read as follows:

§ 1.324 Correction of inventorship in patent, pursuant to 35 U.S.C. 256.

(a) Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his or her part, the Director, pursuant to 35 U.S.C. 256, may, on application of all the parties and assignees, or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors. A request to correct inventorship of a patent involved in an interference must comply with the requirements of this section and must be accompanied by a motion under § 1.634.

(b) Any request to correct inventorship of a patent pursuant to paragraph (a) of this section must be accompanied by:

* * * * *

■ 49. Section 1.377 is amended by revising paragraph (b) to read as follows:

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

* * * * *

(b) Any petition under this section must be filed within two months of the action complained of, or within such other time as may be set in the action complained of, and must be accompanied by the fee set forth in § 1.17(g). The petition may include a request that the petition fee be refunded if the refusal to accept and record the maintenance fee is determined to result from an error by the Patent and Trademark Office.

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■ 50. Section 1.378 is amended by revising paragraph (e) to read as follows:

§ 1.378 Acceptance of delayed payment of maintenance fee in expired patent to reinstate patent.

* * * * *

(e) Reconsideration of a decision refusing to accept a maintenance fee upon petition filed pursuant to paragraph (a) of this section may be obtained by filing a petition for reconsideration within two months of, or such other time as set in the decision refusing to accept the delayed payment of the maintenance fee. Any such petition for reconsideration must be accompanied by the petition fee set forth in § 1.17(f). After the decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director. If the delayed payment of the maintenance fee is not accepted, the maintenance fee and the surcharge set forth in § 1.20(i) will be refunded following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed. Any petition fee under this section will not be refunded unless the refusal to accept and record the maintenance fee is determined to result from an error by the Patent and Trademark Office.

■ 51. Section 1.550 is amended by revising paragraph (c) to read as follows:

§ 1.550 Conduct of ex parte reexamination proceedings.

* * * * *

(c) The time for taking any action by a patent owner in an *ex parte*

reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

■ 52. Section 1.741 is amended by revising paragraph (b) to read as follows:

§ 1.741 Complete application given a filing date; petition procedure.

(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(f) 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.

■ 53. Section 1.956 is revised to read as follows:

§ 1.956 Patent owner extensions of time in inter partes reexamination.

The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.

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

■ 54. The authority citation for 37 CFR part 5 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2), 41, 181–188, as amended by the Patent Law Foreign Filing Amendments Act of 1988, Pub. L. 100–418, 102 Stat. 1567; the Arms Export Control Act,

as amended, 22 U.S.C. 2751 *et seq.*; the Atomic Energy Act of 1954, as amended, 42 U.S.C. 2011 *et seq.*; the Nuclear Non Proliferation Act of 1978, 22 U.S.C. 3201 *et seq.*; and the delegations in the regulations under these Acts to the Director (15 CFR 370.10(j), 22 CFR 125.04, and 10 CFR 810.7).

■ 55. 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(g) 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.

■ 56. Section 5.15 is amended by revising paragraph (c) to read as follows:

§ 5.15 Scope of license.

(c) A license granted under § 5.12(b) pursuant to § 5.13 or § 5.14 shall have the scope indicated in paragraph (a) of this section, if it is so specified in the license. A petition, accompanied by the required fee (§ 1.17(g) of this chapter), may also be filed to change a license having the scope indicated in paragraph (b) of this section to a license having the scope indicated in paragraph (a) of this section. No such petition will be granted if the copy of the material filed pursuant to § 5.13 or any corresponding United States application was required to be made available for inspection under 35 U.S.C. 181. The change in the scope of a license will be effective as of the date of the grant of the petition.

■ 57. Section 5.25 is amended by revising paragraph (a)(4), redesignating paragraph (b) as paragraph (c), and adding a new paragraph (b) to read as follows:

§ 5.25 Petition for retroactive license.

(a) * * *
 (4) The required fee (§ 1.17(g) of this chapter).
 (b) The explanation in paragraph (a) of this section must include a showing of facts rather than a mere allegation of action through error and without deceptive intent. The showing of facts as to the nature of the error should include statements by those persons having personal knowledge of the acts regarding filing in a foreign country and should be accompanied by copies of any necessary supporting documents such as letters of transmittal or instructions for filing. The acts which are alleged to constitute error without deceptive intent

should cover the period leading up to and including each of the proscribed foreign filings.

PART 10—REPRESENTATION OF OTHERS BEFORE THE PATENT AND TRADEMARK OFFICE

■ 58. The authority citation for 37 CFR part 10 continues to read as follows:

Authority: 5 U.S.C. 500; 15 U.S.C. 1123; 35 U.S.C. 2, 6, 32, 41.

■ 59. Section 10.18 is amended by revising paragraph (a) to read as follows:

§ 10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.

(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the provisions of § 1.4(d), § 1.4(e), or § 2.193(c)(1) of this chapter.

PART 41—PRACTICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

■ 60. The authority citation for 37 CFR Part 41 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2), 3(a)(2)(A), 21, 23, 32, 41, 134, 135.

■ 61. Section 41.20 is amended by revising paragraph (a) to read as follows:

§ 41.20 Fees.

(a) *Petition fee.* The fee for filing a petition under this part is: \$400.00

PART 104—LEGAL PROCESSES

■ 62. The authority citation for 37 CFR part 104 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2), 10, 23, 25; 44 U.S.C. 3101, except as otherwise indicated.

■ 63. Section 104.3 is revised to read as follows:

§ 104.3 Waiver of rules.

In extraordinary situations, when the interest of justice requires, the General Counsel may waive or suspend the rules of this part, *sua sponte* or on petition of an interested party to the Director, subject to such requirements as the General Counsel may impose. Any such petition must be accompanied by a petition fee of \$130.00.

Dated: September 9, 2004.

Jon W. Dudas,

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

[FR Doc. 04-20936 Filed 9-20-04; 8:45 am]

BILLING CODE 3510-16-P