



February 11, 1998

Changes to Patent Practice and Procedure - Final Rule  
62 Fed. Reg. 53131 (October 10, 1997); 1203 Off. Gaz. Pat. Office 63 (October 21, 1997)

Highlights - Summary I

Filing of Applications

- ! Rule 1.53 - All applications under 35 U.S.C. 111 must be filed under this rule.
- ! Rule 60 and 62 have been eliminated in toto.
- ! Continuations & divisional applications, filed with a copy of prior oath/declaration & any specification that does not contain new matter, § 1.53(b):
  - an inventor may be deleted
  - similar to former rule 60 practice.
- ! CPA (Continued Prosecution Application) created under § 1.53(d):
  - can be FAX filed & processed entirely in examining group
  - uses same file jacket, application no., & filing date as prior complete application: no reference to prior application in first paragraph of specification
  - CIP-CPA not permitted
  - \* - immediate prior application can have filing date before, on or after June 8, 1995
- ! Naming of actual inventors no longer required to receive filing date as §§ 1.41 & 1.53 changed.
- ! Inventor(s) name(s), if known, or alphanumeric application identifier to be used for identification purposes only until executed oath/declaration is filed:
  - inventorship is established from executed oath/declaration when it is filed
  - rule 48 petitions not needed for differences between inventorship given on filing without an executed oath/declaration and as later given in an executed oath/ declaration.

Deceptive Intent Issues

- ! The separate verification requirements for submissions from non-practitioners have been eliminated in rules 1.6, 1.8, 1.10, 1.27, 1.28, 1.48, 1.52, 1.55, 1.69, 1.102, 1.125, 1.137, 1.377, 1.378, 1.804, 1.805, 3.26, and 5.4.
- ! Requirements for reissue oaths/decs under § 1.175 have been simplified:
  - only one error being corrected need be identified instead of all errors,
  - only a general statement as to lack of deceptive intent is required instead of a detailed showing of facts and circumstances as to how each error arose or occurred,
  - only one supplemental oath/dec need be supplied prior to allowance stating all errors not covered by the original oath/dec arose without deceptive intent instead of a new oath/dec with each amendment.
- ! Petitions to correct inventorship in pending applications other than reissue applications, § 1.48, and in patents, § 1.324, have been liberalized.
- ! Small entity status can be obtained without a new statement in CPA and reissue applications, and payment of a small entity fee in a continuing or reissue application substitutes for the required reference to the statement in the prior application or patent, § 1.28(a).
- ! For erroneous payments of small entity fees, the submission of the fee deficiency is a representation that status was requested in good faith and a verified statement of facts is no longer required, § 1.28(c).
- ! Actions by assignees under § 3.73(b) no longer require a statement that the evidentiary documents have been reviewed or a certification that title is in the assignee seeking to take action.

### Appeals

- ! New grounds of rejection are prohibited in examiner's answers and reopening of prosecution is required, § 1.193(a)(2), but if a § 1.116 amendment is approved for entry, rejection(s) in the action appealed from may be permitted to be applied to the claims amended under § 1.116.
- ! Reply briefs must be admitted; no longer are they limited to new points of argument raised by the examiner. If an examiner wants to respond to (new issues raised in) a reply brief, prosecution must be reopened. § 1.193(b)(1).
- ! After reopening of prosecution, applicant may reinstate the appeal and file a supplemental brief. § 1.193(b)(1).
- ! The Board of Patent Appeals and Interferences now has authority to enter a rejection of allowed claims, rather than to merely set forth a binding recommendation. § 1.196(b).

### Time Frames

- ! All provisions for revival of abandoned applications and lapsed patents, formerly in §§ 1.139, 1.155, 1.316 and 1.317, are now in § 1.137.
- ! Eliminated the 1 year limit for revivals for unintentional delay under § 1.137(b), and clarified that the entire delay from the due date for reply until the filing date of a grantable petition, must have been unintentional.
- ! Extensions of time of up to 5 months are now permitted, § 1.136(a).
- ! Petitions for extension of time can now be provided for by : 1) a previous general authorization for extensions of time, 2) mere payment of the extension of time fee, or 3) a general authorization to pay an additional fee, § 1.136(a).
- ! Bona fide but incomplete replies to non-final actions may be given an extendable time period for reply. Non-extendable time limit practice has been eliminated.
- ! Multiple protests by a single protestor, based on prior art submissions, now permitted, with timely submission remaining a factor, § 1.291(c).

### Miscellaneous

- ! Amending in reissues, § 1.121(b), has been made the same as amending in reexams, § 1.530(d), and:
  - provides for cancellation in a reissue or reexam of an entire paragraph from the specification (without it being rewritten in brackets),
  - hand entry of five words or less is no longer permitted,
  - status of all patent and all added claims must be supplied with each claim amendment even for added claims subsequently canceled, and
  - support needed for each claim amendment when originally submitted.
- ! Substitute specification permitted by rule if accompanied by statement of no new matter and a marked-up copy, § 1.125(b).
- ! Design drawings:
  - the prohibition against color drawings and photographs is replaced by a petition procedure, § 1.152(a)(2),
  - it is clarified that all matter (e.g., color, indicia) in original informal drawings or photographs not disclaimed on filing is an integral part of the disclosure and claims and cannot be removed on filing of the formal drawings.
- ! Petitions to expunge are now specifically provided for in § 1.59.
- ! Full name of inventor and post office address are now required to be in oath/dec.