

Summary<sup>1</sup> of Notice of Proposed Rule Making for  
"Changes to Support Implementation of the United States Patent and Trademark Office 21<sup>st</sup>  
Century Strategic Plan," 68 FR 53815 (September 12, 2003); 1275 Off. Gaz. Pat. Office 23  
October 7, 2003)<sup>2</sup>

§ 1.4 Electronic signature<sup>3</sup>: Section 1.4 signature requirements would be amended to permit papers submitted to the Office for a patent application, patent or reexamination proceeding by approved means (mail, fax, hand-carry, EFS, but not e-mail) to have an electronic signature (e-signature) without the need for a wet ink signature. The e-signature must be composed only of numbers and/or letters between two forward slashes (/.../), including punctuation, spaces and titles. The number (#) character may be used in the e-signature only if it precedes a practitioner's registration number. Where the actual name (including given name, middle name or initial and family name) of a nonpractitioner signer is not used as part of the signature, the actual name must be supplied in printed or typed form immediately below the e-signature along with a clear indication that it is the signer's actual name. Only the family name when presented as part of the e-signature or in printed or typed form, can and must be entirely in capital letters. Examples:

- a. After practitioner creates a document and e-signs it on her PC, it is faxed directly from the PC; or it is printed, and then faxed, mailed, or hand-carried to the Office,
- b. After an affidavit under § 1.132 is electronically signed using /signature/ by the party making the affidavit, the e-signed affidavit is then electronically sent to practitioner, e.g., via the Internet. The practitioner can then proceed as set forth in example a. above in submitting the e-signed document to the Office.

The person signing must personally insert the electronic signature between the forward slash marks.

Special Requirement for Practitioners:

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<sup>1</sup>The following items may hold particular interest for practitioners: § 1.4, § 1.17, § 1.27 (security interests, SBA requirements), § 1.55 (foreign priority claims), § 1.57, § 1.78 (multiple sentences), § 1.91, § 1.105, § 1.111; § 1.115, § 1.178, § 1.213, § 1.705.

<sup>2</sup>For a list of contacts, see the attached Appendix A. For an identification of rules changes which support each of the key drivers of the USPTO 21<sup>st</sup> Century Strategic Plan initiatives, see Appendix B.

<sup>3</sup>For a series of examples, see the corresponding set of presentation slides.

Practitioners signing pursuant to §§ 1.33(b)(1) (of record) or 1.33(b)(2) (not of record but acting in a representative capacity) must use their complete name, as registered, as the e-signature and place their registration number, as part of, or adjacent electronic signature.

Ratification of an e-signature may be required where the Office has reasonable doubt as to the authenticity of the signature, such as where there are variations in the signature or where a document contains the name of the signer in its text without some indication of the family name, such as by all capitals..

§ 1.6 Drawings: Section 1.6(d) would be amended to provide that black and white drawings in patent applications may be transmitted by facsimile at all times and not just at the time of payment of the issue fee, which is permitted under current practice.

Note: - color drawings are not permitted to be sent by fax,  
- photographs or drawings with fine detail should not be sent by fax as faxing may degrade the quality, but the Office would generally print what is received.

Interruptions in postal service: Section 1.6(e) material would be transferred to § 1.10 as a more appropriate place.

§ 1.8 Certificate of mailing: Section 1.8(a) would be clarified to indicate that the list of exclusions in § 1.8(a)(2) is not exhaustive and that other prohibitions to the utilization of certificates of mailing are provided in rules other than § 1.8. For example, the provisions of § 1.8 do not apply to time periods or situations set forth in §§ 1.217(e) and 1.703(f) (which is not reflected in the § 1.8(a)(2) list of exclusions).

Correspondence not received by Office: Section 1.8(b) would be amended to conform the rule to current practice. Where applicant has determined that the Office has not received correspondence sent from applicant, applicant would not be required to wait until the end of the maximum extendable period for reply in an Office action to which the correspondence was in reply to (and receive a notice of abandonment) before informing the Office of nonreceipt and supplying a duplicate copy of the correspondence to the Office.

§ 1.10 Express mail interruption of service: Interruption of postal service would be transferred from § 1.6(e) to new paragraph § 1.10(i) with an explicit provision for a petition.

Express mail returned by USPS: New sections 1.10(g) and (h) would be created to provide for a petition to treat Express Mail that was refused or returned by USPS. The refused or returned item would be considered as having been filed on the

Express Mail date of deposit notwithstanding its return.

§ 1.14 Access: Would provide the appropriate petition fee reference in current § 1.14(h) to the fee amount in § 1.17(g). [Note § 1.14 is currently proposed to be amended whereby the pertinent section would be § 1.14(j)].

§ 1.17 Petition fees: The current flat-rate general \$130 petition fee would be adjusted to more accurately reflect the Office's current cost of treating petitions and would become a three-level structure:

1. \$130 current fee retained for processing fees (e.g., § 1.102 to make an application special), § 1.17(h),
2. \$200 (e.g., § 1.47 noncooperating inventor, § 1.59 expungement), § 1.17 (g) and
3. \$400 (e.g., § 1.53(e) to accord a filing date, § 1.182 questions not specifically provided for, and § 1.183 waiver), § 1.17(f).

Processing fee: For section 1.17(i), a processing fee would replace a petition fee for replacement drawings submitted within the § 1.215(a) publication time period.

§ 1.19 Copies: Section 1.19(b) would be amended to set a fee for supplying copies of documents from an IFW. Where Office records are stored in an IFW instead of in their original paper or compact disc form(s), the Office could, at its option, for an appropriate fee, produce a paper or compact disc copy from the IFW rather than create the copy from the original source document.

Sections 1.19(b)(1) and (2) would provide a fee for a copy made from the electronic image (of a patent application as filed, or a patent related file wrapper) and that the fee would be the same as the fee for a copy made from an equivalent paper file.

§ 1.19(g) would be added to provide for supplying copies at cost of unscanned documents (e.g., large blueprints, microfiche and video cassette) and to provide for a petition to obtain copies of documents at cost in a form other than provided for by the rules of practice (§ 1.19(h)).

Seven day requirement: It is proposed to eliminate the seven day requirement on the Office for processing copy requests, § 1.19(b)(1).

§ 1.27 Security interests: The term "obligation" would be changed to "currently enforceable obligation" to clarify that a security interest in an application or patent held by a large entity (e.g., a large entity bank supplying financing) would not be a sufficient interest to bar entitlement to small entity status so long as the security

interest is not triggered. §§ 1.27(a)(1), (a)(2)(i), and (a)(3)(i).

SBA requirements: It would be clarified that certain Small Business Administration requirements relating to location in the U.S., or making a significant contribution to the U.S. economy, would not apply to patent applicants as those particular requirements would violate the Paris Convention for the Protection of Industrial Property. § 1.27(a)(2)(ii).

Requirements for small business concerns: Would clarify that the requirements for small business concerns regarding assignment of rights only to a small entity and the meeting of SBA requirements, such as the number of employees, are additive. § 1.27(a)(2)(i).

- § 1.47 Noncooperating inventor: New petition fee amount would be set, raised from \$130 to \$200 re the § 1.17 change. Sections 1.47(a) and (b).
- § 1.52 Translations: The statement that a translation is accurate would now be required to be signed by the individual who made the translation. Sections 1.52(b)(1)(ii), and (d)(1). See also §§ 1.55(a)(4), § 1.69(b) and § 1.78(a)(5)(iv).  
Font size: Would recommend that the font size be at least 12, which is approximately 0.166 inches or 0.422 cm high. Section 1.52(b)(2)(ii) See also § 1.58(c).  
Tables: If the total number of pages of all the tables in an application exceeds 100 pages in length (or a table is more than 50 pages in length, which is current practice), they would be able to be submitted on compact disc (CD-R or CD-ROM). Section 1.52(e)(1)(iii).  
Page : What constitutes a page would be clarified. Section 1.52(e)(1)(iii).  
Finalize CD: To assure archival nature of discs, requirement would be added that discs be finalized so that they are closed. Section 1.52(e)(3)(i).
- § 1.53 Petition fee raised: Petition fee amount would be raised from \$130 to \$400 for petitions relating to according a filing date per § 1.17(f). The Office will continue existing practice that filing date petitions which result solely from the fault of the PTO (e.g., a lost application) will have the entire petition fee returned. Section 1.53(e)(2).
- § 1.55 Foreign priority claims where reliance is made on intermediate applications: A U.S. application filed more than twelve months from a prior foreign application can claim priority to the prior-filed foreign application by relying upon an intermediate U.S. nonprovisional, or international application(s) which stretches back to within twelve months of the prior-filed foreign application. It would now be required that each such intermediate application contain a compliant claim for priority to the prior-filed foreign application. Failure to make foreign priority claims in intermediate applications would result in waiver of such claims for

which the Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed foreign priority claim. This would parallel current requirements for benefit claims under § 1.78.  
Section 1.55(a)(1)(ii)

Translations, § 1.55(a)(4): See § 1.52

§ 1.57 Incorporation by reference of a prior application (Section 1.57(a)): A claim for priority under § 1.55 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 date of receipt of a U.S. application would also be considered an incorporation by reference of the prior-filed application for material inadvertently omitted from the U.S. application that is completely contained in the prior-filed application. For the national stage of international applications designating the U.S., 35 U.S.C. 371, the incorporation would only be effective as to incorporate omitted material from a foreign national application for which priority is claimed in the § 371 national stage application.

Any amendment to include inadvertently omitted material would need to be made no later than the close of prosecution of the application to which it is to be added or within any earlier time frame if one is set by the Office upon discovering an omission. An amendment adding the omitted material would not need to be accompanied by an explicit statement of inadvertent omission or refer to § 1.57. The examiner would be able to require applicant to supply a copy of the prior-filed application and an English language translation if the prior application is in a foreign language (if one is not already of record), and to identify where the omitted portion being added can be found in the prior-filed application. Section 1.57(a)(1).

Any amendment to an international application would be effective only as to the United States.

Incorporation by reference of essential and nonessential material (Sections 1.57(b)-(f)):

Trigger: Specific language would be provided, "incorporated by reference," that must be used to trigger an incorporation by reference, particularly where incorporation is essential to 35 U.S.C. 112, sixth paragraph evaluation of the means or steps to perform a function. Section 1.57(b).

Codification: Codification of MPEP material (608.01(p)) on incorporation by reference of essential material would be made with two changes:

- a. Incorporation of essential material from an allowed application with the issue fee paid, would no longer be permitted. § 1.57(c);
- b. Incorporation of essential material from an application which has been published, which does not itself incorporate such material, would now be permitted. Section 1.57(c).

Definition: A definition of essential material based on 35 U.S.C. 112, first, second paragraphs and sixth paragraphs, as required, would be provided, sections 1.57(c)(1)-(3), as well as a definition for other (nonessential) material, section 1.57(d). A prohibition against hyperlink or other browser incorporation would be set forth. Section 1.57(d).

Requirement for submission: Would clarify that the examiner may require submission of a copy of material incorporated by reference along with a statement that the copy consists of the same material incorporated, even if properly incorporated, e.g., to review background material to better understand the invention. Section 1.57(e).

Improper incorporation: Would clarify that an improper incorporation is not an effective incorporation unless corrected by applicant in a timely manner. Section 1.57(f).

- § 1.58 Formulae and table duplication: Section 1.58(a) would be amended to clarify that a table not be included in both the drawings and in the body of the specification.  
Integrity when rendering: Sections 1.58(b) would be clarified that when tables and chemical and mathematical formulas are rendered (opened and viewed using a text viewer program) by the Office, the integrity of the rows and columns of the tables and the proper positioning of the characters in formulas must be maintained. See also § 1.83.  
Font size: Section 1.58(c). See § 1.52(b)(2)(ii).  
Font type: A reference to elite type (typewriter type) would be deleted as inconsistent with the font size being recommended.

- § 1.59 Expungement: Petition fee amount would be raised from \$130 to \$ 200 re § 1.17(g).

- § 1.69 Translations, § 1.69(b): See § 1.52

- § 1.76 Application data sheet:  
All data resupplied: Would change requirement for supplemental Application Data Sheets to require all appropriate information be supplied with identification of what information is being corrected, added or deleted (as opposed to only submitting the new information). § 1.76(c)(2).  
Titles: Would require for application data sheets and supplemental application

data sheets the use of a title identifying the sheet as an application data sheet or a supplemental application data sheet and that each application or supplemental application data sheet have all seven headings identified in § 1.76(b). §§ 1.76(a) and (c).

- § 1.78      Condition for U.S. benefit: Section 1.78(a)(1)(ii) (prior application must be complete for a benefit claim to it) would be deleted as unnecessary as any application meeting that condition for claiming benefit (prior application is complete) would also automatically meet the less restrictive condition of § 1.78(a)(1)(iii) (prior application entitled to a filing date and include the basic filing fee for a benefit claim to it).  
Translations, § 1.78(a)(5)(iv): See § 1.52  
Double patenting rejections: Section 1.78(c) would be amended to clarify that the prior art exception under 35 U.S.C. 103(c) (common assignee) does not apply to double patenting rejections. This will emphasize need for applicants to provide information about related applications for examiner to determine whether conflict exists and a double patenting rejection should be made.  
Use of single sentence: The current practice of requiring the benefit claims to be in a single sentence, §§ 1.78(a)(2)(iii) and (a)(5)(iii), would be changed to permit multiple sentences for clarity purposes. For example, where there is a provisional application and multiple intermediate nonprovisional applications, identification in the latest nonprovisional application as to which intermediate applications claim benefit to a provisional application, would be easier to set forth in a clear manner.
- § 1.83      Content of drawings: Would be clarified that subject matter illustrated in the specification, such as tables and sequence listings, must not also be illustrated in the drawings. § 1.83(a). See also § 1.58.
- § 1.84      Color drawings and photographs: Requirement for black and white copies of any color drawings or photographs in § 1.84(a)(2)(iii) would be removed in accordance with previous OG waiver. See also § 1.165. Current § 1.84(a)(2)(iv) material would be moved to § 1.84(a)(2)(iii) .  
Drawing identification: Would be clarified that identification (labeling) of the drawing is recommended but not required and the recommended location of any identification would be changed to the left of center within the top margin of the front. Section 1.84(c).
- § 1.91      Models and exhibits, photographs: It would be required that any model or exhibit that cannot be stored in the file, § 1.52, must be accompanied by photographs in conformance with § 1.84 (which are legible after being scanned by Office) to show multiple views. It is explained in the preamble that videos and DVDs should

be accompanied by photos or some description that can be retained in the file (see § 1.94).

- § 1.94 Models, exhibits and specimens, return of: For models, exhibits, or specimens that do not substantially conform to § 1.52 and therefore cannot be stored in the file (see § 1.91 where photographs thereof are submitted), applicant would be notified and be required to arrange for their return (to applicant) at applicant's expense. Applicant would be responsible for retaining the model, exhibit or specimen for the enforceable life of any patent. For perishables, it would be presumed that the Office has permission to dispose of them without notice to applicant unless applicant notifies the Office upon submission of the perishable that a return is desired and arrangements will be promptly made for its return upon notice by the Office.
- § 1.98 IDS format: Each page of an IDS list of citations (where applicant is not using an Office PTO-1449 or PTO/SB/08A or B form) would be required to include: a column providing a space next to each citation for the examiner to initial and a heading clearly identifying the list as an IDS for a particular application number. Section 1.98(a)(1).  
Separately list: Would require applicants to separately list U.S. patents and U.S. patent application publications from other citations. This would aid the Office in OCR scanning the U.S. patent and U.S. application publication list and to electronically provide the numerical list and search capability of the documents directly to examiners for IDSs. Section 1.98(a)(1).  
Conformance with paper and disc requirements: Copies of publications and NPL would be required to conform to § 1.52 paper and compact disc format requirements unless the copies being submitted are the best evidence of the publication (e.g., video tape image). Section 1.98(a)(2).  
Copies of U.S. patents or U.S. patent application publications: Would eliminate requirement to supply copies of U.S. patents or U.S. patent application publications for: 1) any national patent applications filed after June 30, 2003, 2) in any international application that has entered the national stage under 35 U.S.C. 371 after June 30, 2003, and 3) in any information disclosure statement submitted in compliance with the Office's electronic filing system.. Section 1.98(e). 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 (August 5, 2003).
- § 1.102 Advancement of examination: Would permit by rule a petition without cost to make an application special based on an invention's ability to counter terrorism. Section 1.102(c).



- § 1.103      Suspension of actions: The petition fee for suspension of actions for cause, § 1.103(a), would be increased from \$130 to \$200 re § 1.17(g).
- § 1.105      Requirements for Information re an added example for technical information: An additional (nonlimiting) example as to what applicant could be questioned about would be added to § 1.105 relating to technical information known to applicant concerning the interpretation of the related art, the disclosure, the claimed subject matter, other information pertinent to patentability, or the accuracy of the examiner's stated interpretation of such items. Section 1.105(a)(1)(viii).  
The form for presentation of requirements for information: The form for presentation of requirements of requirements for information would be identified as any appropriate form and three examples given: 1) a requirement for documents, 2) interrogatories in the form of specific questions seeking applicant's knowledge, or 3) stipulations in the form of statements with which the applicant may agree or disagree. Section 1.105(a)(3).  
Responses to requirements for information seeking an opinion: It would be recognized that where applicant is asked for an opinion, such as under newly proposed § 1.105(a)(1)(viii), a response that an opinion is not held by the party from which it was requested would be accepted as a complete reply. Section 1.105(a)(4).
- § 1.111      Supplemental replies: The current disapproval procedures for supplemental replies that are dependent upon an undue interference with the preparation of an Office action would be eliminated to avoid continuing abuse situations. Supplemental replies would no longer be entered as a matter of right. The factor of whether they did not unduly interfere with the preparation of an Office action has been eliminated, and is no longer a factor. Where action by the Office is suspended on an application pursuant to §§ 1.103(a)-(c), supplemental replies filed during the suspension period would continue to be entered as a matter of right. Supplemental replies submitted (in an application not under suspensions pursuant to §§ 1.103(a)-(c)) at any time before final rejection or allowance and within expiration of any statutory period could be approved for entry under a standard similar to that used for amendments after final rejection, i.e., claims are canceled, an examiner's suggestion is adopted, or the application is placed in condition for allowance. IDSs are not considered replies except where submitted in response to a § 1.105 requirement for information. Section 1.111(a)(2).
- § 1.115      Preliminary amendments as part of the original disclosure: All preliminary amendments adding subject matter filed on or prior to (in the case of a filing date accorded being later than the original receipt date of the application papers) an application's filing date would be treated as part of the original disclosure. For such a preliminary amendment that adds new matter but is not referred to in an

accompanying oath or declaration (or later submitted one), a new oath or declaration under § 1.63 which refers to such preliminary amendment would be required (the surcharge under § 1.16(e) would not be required). Section 1.115(b). Preliminary amendments canceling all claims: The Office would by rule be permitted to disapprove a preliminary amendment (submitted prior to, on, or after the filing date of an application) canceling all claims without presenting any new claims, except that such amendment would be treated as containing a single claim for filing/fee calculation purposes. Section 1.115(c)(1)(i).

§ 1.116 After final entry: Would clarify that the reexamination proceeding is not terminated under §§ 1.550(d) or 1.957(b), but rather the prosecution of the reexamination is concluded under §§ 1.550(d) or § 1.957. Section 1.116(b). See also § 1.502, (especially) 1.550, 1.570, 1.902, 1.953, subhead proceeding § 1.956, 1.957, 1.958, 1.979, 1.997. Additionally a reference to § 1.957(c) would be added to set forth its consequence of a failure by the patent owner to respond in an *inter partes* reexamination, which consequence is issuance of an Office action to thereby permit the third party requester to challenge any claims found patentable.

§ 1.131 Affidavit of prior invention: Would clarify that the lack of original exhibits, drawings or records in support of the affidavit must be satisfactorily explained. Section 1.131(b).

§ 1.136 Extension of time for sufficient cause: A \$200 fee requirement, § 1.17(g), would be added to defray the cost of evaluating the presence of sufficient cause to support an extension of time request under § 1.136(b).

§ 1.137 Revival of an abandoned application: Would be amended to clarify that the reexamination proceedings under § 1.957(c) referred to in §§ 1.137(a), (b) and (e) are "limited as to further prosecution."

Would clarify that when reviving a reissue application pursuant to § 1.137, a terminal disclaimer is not required. § 1.137(d)(3)

§ 1.165 Color drawings or photographs for plants: Section 1.165(b) would be amended in a manner similar to § 1.84 changes.

§ 1.173 Amendments in reissue applications: Would clarify that paragraphs § 1.173(b)(1)-(3) are to be read with paragraph § 1.173(b) (replace "." with a":").

§ 1.175 Oath or declaration in reissue applications: Where a continuation reissue application is filed, it would be clarified that the oath or declaration in the continuation must identify an error not being corrected in a parent or earlier

reissue application when the parent or earlier application is not being abandoned. Section 1.175(e).

- § 1.178 Original letters patent: The requirement for the actual physical surrender by applicant in a reissue application of the original letters patent (ribboned copy) would be eliminated. Section 1.178(a).
- § 1.179 Notice of reissue application: Section 1.179 would be removed and reserved to eliminate requirements on the Office for placement of a paper notice in the original patent file of: the filing, termination and/or grant of a reissue.
- § 1.182 Petition re matters not provided for: The petition fee would be raised from \$130 to \$400 re § 1.17(f).
- § 1.183 Petition re waiver of rule requirements: The petition fee would be raised from \$130 to \$400 re § 1.17(f).
- § 1.213 Nonpublication certification requests: Prior to providing a certification in support of a nonpublication request, an inquiry consistent with § 10.18(b) would need to be made to determine that the application has not been filed in another country, or under a multilateral international agreement that requires publication of applications at eighteen months after filing and that applicant's intent at the time of the nonpublication request is that the application will not be the subject of such a foreign filing. Section 1.213(a)(4).  
Notification vs rescission: Would clarify that notification of a foreign filing is independent of a request for rescission of a nonpublication request. §§ 1.213(b) and (c). See previous notices: "Reminder of a Nonpublication Request is Not Itself a Notice of Foreign Filing," 1270, *Off. Gaz. Pat Office* 20 (May 6, 2003), and "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).  
Rescissions: Would clarify that a request to rescind a nonpublication request is not appropriate unless the person signing the request has made inquiry consistent with § 10.18(b) to determine that a nonpublication request was in fact previously filed in the application in which the request to rescind is directed. § 1.213(b)(3).  
Sanctions/disciplinary action: Would alert practitioners who file a request to rescind a nonpublication request in application for which a nonpublication request was never filed that they: may be subject to sanctions, disciplinary action or both. See discussion of § 1.213(b) in the preamble (beginning) portion of the rule package at page 53839, middle column of the Federal Register page.  
Notification: Section 1.213(c) would be amended to more accurately track the language of 35 U.S.C. 122(b)(2)(B)(iii) in regard to filing in another country, or

under a multilateral international agreement.

Publication: Would provide that where a rescission is filed in view of a prior submission of a nonpublication request, the application shall be published as soon as practical after the expiration of the eighteen month period from the earliest filing date for which benefit is sought. Section 1.213(d).

- § 1.215 Replacement drawings for publication: The current procedure for petition under § 1.182 would be replaced by a processing fee pursuant to § 1.17(i) for submission (which does not require utilization of EFS) of replacement paper drawings to be used in publication of the application within the period as it is being proposed to be amended for § 1.215(c). Section 1.215(a).  
Amended application for publication: Codification of OG notice providing a new additional time frame of one month from the mail date of a filing receipt (instead of one month from the actual filing date of the application). "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 (December 26, 2000). The OG notice would be expanded to apply the one month mail date to the first Office communication with a confirmation number (and not just the mail date of the filing receipt), for submitting an amended application via EFS for publication. Section 1.215(c).
- § 1.291 Consent to untimely protest: Would create an explicit provision to accept a protest at any time, § 1.291(b)(1) (ii), including after the application publication date § 1.291(g), based on the express written consent of the applicant pursuant to 35 U.S.C. 122(c).  
Protests: The real party in interest would need to be identified when filing a protest, except where a statement and processing fee are submitted that the protest is the first protest by the unnamed real party in interest. Section 1.291(b)(3).  
 [Note: While the NPR change applies to all applications, the Office is considering limiting the change to reissue applications.]  
Second or subsequent protests: For second or subsequent protests by the same party, to ensure consideration, an explanation would be required as to why the additional art issues are significantly different and why the art issues were not earlier presented. § 1.291(c)(5).  
Reformatted: The section would be reformatted for clarity.
- § 1.295 Statutory invention registration, review of refusal to publish: The fee for review of a decision refusing to publish a statutory invention registration would be raised to from \$130 to \$200 re § 1.17(g).
- § 1.296 Statutory invention registration, withdrawal of: The fee for a request to withdraw from publication a statutory invention registration, where the request is filed on or

after the date of a notice of intent to publish, would be converted from a petition under § 1.183 to a § 1.17 fee and raised to \$200 re § 1.17(g).

- § 1.311 Notice of allowance : Added exceptions would be included to permit reliance on a previous authorization to charge allowance and publication fees. The submission of an incorrect publication fee or a completed fee transmittal form (which form applies to both issue and publication fees), for payment of a publication fee, would operate as a valid request to charge the publication fee to any previously identified deposit account (notwithstanding that previously submitted general authorizations to charge a deposit account are generally ineffective to pay issue or publication fees). The prohibition on non-Office issue fee forms would be removed and non-Office publication fee forms would also be permitted. Section 1.311(b).
- Appropriate fee must be identified: It would be clarified that previously filed authorizations would be given effect under the exceptions provided by the rule only where the previous authorizations cover the issue and publication fees to be charged, e.g., previous authorizations only to pay §§ 1.16 and 1.17 fees would not effectuate payment of issue fee or publication fees. Section 1.311(b).
- § 1.324 Inventorship correction in a patent, all parties required: would be clarified by adding a specific reference to 35 U.S.C. 256, which requires that a request to correct the inventorship in a patent must be a request from all the inventors together with all the assignees. The current reference to "petition" would be replaced by a "request" to conform to previous changes made in § 1.17(h) and (I). § 1.324(a).
- § 1.377 Maintenance fee, review: The fee for review of a decision refusing to accept a maintenance fee would be raised to \$200 from \$130 re § 1.17(g).
- § 1.378 Maintenance fee, reconsideration: The fee for reconsideration of a decision refusing to accept a maintenance fee would be raised to \$400 from \$130 re § 1.17(f).
- § 1.502 Processing of prior art during reexamination: Would clarify that it is the publication of an *ex parte* reexamination certificate that terminates the reexamination proceeding (and not the failure to timely respond, or the issuance of a NIRC). See also §§ 1.116, (especially) 1.550, 1.570, 1.902, 1.953, subhead preceding § 1.956, 1.958, 1.979, and 1.997.
- § 1.550 Ex parte reexamination petition fee: Extensions of time for cause, § 1.550(c), would now have a petition fee requirement that would be \$200.
- Conclusion of prosecution: Would clarify that a failure to file a timely response

results in conclusion of the prosecution of the reexamination proceeding but does not terminate the reexamination proceeding. Section 1.550(d). See also §§ 1.116, 1.502, 1.570, 1.902, 1.953, subhead preceding § 1.956, 1.957, 1.958, 1.979, and 1.997.

- § 1.570 Ex parte reexamination certificate: Would clarify that the publication of the *ex parte* reexamination certificate is the act that terminates the reexamination proceeding and not failure to timely respond or issuance of a NIRC. Section 1.570(a). See also §§1.116, 1.502, (especially) 1.550, 1.902, 1.953, subhead preceding § 1.956, 957, 1.958, 1.979, and 1.997.
- § 1.644 Petitions in interferences: The fee for a petition in an interference would be raised to \$400 from \$130 re § 1.17(f).
- § 1.666 Interference settlement agreements: The fees for filing of interference settlement agreements would be raised to \$400 from \$130 re § 1.17(f).
- § 1.704 PTA re IDS after allowance: Would amend § 1.704 to provide that the 30 day safe harbor provision for IDS submissions re PTA reduction exists only where receipt from a foreign Office is the first receipt. This tracks the first receipt requirement in the three month requirement in § 1.97(e). Section 1.704(d).
- § 1.705 Patent term adjustment: Where a patent issues with a patent term revised from what is indicated in an issue notification letter, reconsideration of the patent term would be permitted (based on events occurring after the mailing of a notice of allowance) if filed within 30 days of the issue date. Currently, the patent must issue on a date other than the projected date of issue causing a revised patent term to permit such review. Section 1.705(d). Requests for reconsideration would continue to be dismissed as untimely for issues previously raised or issues that could have been raised in the determination provided with the mailing of the notice of allowance.
- § 1.741 Application for extension of patent term: The fee for a petition for review of a notice of an incomplete application for extension of patent term would be raised to \$400 from \$130 re § 1.17(f). Section 1.741(b).
- § 1.902 Inter partes reexamination: Would clarify that it is the publication of the *inter partes* reexamination certificate that terminates the reexamination proceeding and not a failure to respond or issuance of a NIRC. See also §§ 1.116, 1.502, especially 1.550, 1.570, 1.953, subhead preceding § 1.956, 1.958, 1.979, and 1.997.

- § 1.953 Examiner's right of appeal in *inter partes* reexamination: Would clarify that the patent owner's failure to timely file a response will result in a conclusion of the prosecution of the reexamination proceeding as to all claims not found patentable, but will not terminate the reexamination proceeding itself. Section 1.953(c). See also §§ 1.116, 1.502, (especially) 1.550, 1.570, subhead preceding § 1.956, 1.958, 1.979, and 1.997.
- Subhead The subhead preceding § 1.956 would be amended to refer to concluding of prosecution of a reexamination proceeding, rather than termination of the reexamination proceeding. See also §§ 1.116, 1.502, (especially) 1.550, 1.570, 1.953, 1.958, 1.979, and 1.997.
- § 1.956 *Inter partes* reexamination: Extensions of time for cause, § 1.956, would now have a petition fee requirement that would be \$200 re § 1.17(g).
- § 1.957 Response in *inter partes* reexamination: Would clarify that a patent owner's failure to file a timely response will result in a conclusion of the prosecution of an *inter partes* reexamination proceedings as to all claims not found patentable, rather than terminate the reexamination proceeding itself. Section 1.957(b). See also §§ 1.116, 1.502, (especially) 1.550, 1.570, 1.902, 1.953, subhead preceding § 1.956, 1.958, 1.979, and 1.997.
- § 1.958 Revival *inter partes* reexamination: Title would recite the conclusion of the prosecution of the reexamination rather than termination of the reexamination proceeding. Section 1.958(a). See also §§ 1.116, 1.502, (especially) 1.550, 1.570, 1.902, 1.953, subhead preceding § 1.956, 957, 1.979, and 1.997.
- § 1.979 Action following Board decision in *inter partes* reexamination: Would clarify that the patent owner's failure to file a timely response will conclude prosecution of the reexamination proceeding but will not conclude or terminate the reexamination proceeding itself. Additionally, it would be clarified that the reexamination certificate terminates the reexamination proceeding. Section 1.979(f). See also §§ 1.116, 1.502, (especially) 1.550, 1.570, 1.902, 1.953, subhead preceding § 1.956, 1.957, 1.958, and 1.997.
- § 1.997 Issuance of *inter partes* reexamination certificate: Would clarify that the publication of the *inter partes* certificate terminates the reexamination proceeding. Section 1.997(a). See also §§ 1.116, 1.502, (especially) 1.550, 1.570, 1.902, 1.953, subhead preceding § 1.956, 1.958, and 1.979.
- § 5.12 Petition for foreign filing license: The petition fee for a foreign filing license would be raised to \$200 from \$130 re § 1.17(g). Section 5.12(b).

§ 5.15      Scope of foreign filing license: The petition fee for changing the scope of a foreign filing license would be raised to \$200 from \$130 re § 1.17(g). Section 5.15(c).

§ 5.25      Retroactive foreign filing license: The petition fee for a retroactive foreign filing license would be raised to \$200 from \$130 re § 1.17(g). Section 5.25(a)(4).



Appendix A - Contacts

Generally:

- Hiram H. Bernstein (Senior Legal Advisor) (703) 305-8713
- Robert J. Spar (Director) 308-5107

For the more significant rules<sup>4</sup>:

- § 1.4, Michael Lewis (703) 306-5585
- § 1.6, Karin Ferriter (703) 306-3159
- § 1.17, Anton Fetting (703) 305-8449
- § 1.19, Michael Lewis (703) 306-5585
- § 1.27, Eugenia Jones, (703) 306-5586
- § 1.52 (translations) (font size), Karin Ferriter (703) 306-3159
- § 1.52, (compact discs), Michale Lewis (703) 306-5585
- § 1.55, Eugenia Jones, (703) 306-5586
- § 1.57(a), Eugenia Jones, (703) 306-5586
- § 1.57(b),(c), Michael Lewis (703) 306-5585
- § 1.58, Michael Lewis (703) 306-5585
- § 1.76, Kery Fries (703) 308-0687
- § 1.78, Eugenia Jones (703) 308-0687
- §§ 1.83, 1.84, 1.165, Karin Ferriter (703) 306-3159
- §§ 1.91, 1.94, Hiram Bernstein (703) 305-8713
- §1. 98, Joni Chang (703) 308-3858
- § 1.102, James Engel (703) 306-3159
- § 1.105, Anton Fetting (703) 305-8449
- § 1.111, Joni Chang (703) 308-3858
- § 1.115, Fred Silverberg (703) 305-8986
- §§ 1.136, 1.550, 1.956, Kenneth Schor (703) 308-6710
- §§ 1.137, 1.175, 1.178, 1.179, Joe Narcavage (703) 305-1795
- §§ 1.213, 1.215, Mark Polutta (703) 305-1795
- § 1.311, Cynthia Nessler (703) 305-0271
- § 1.705, Kery Fries (703) 308-0687

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<sup>4</sup>For a complete list of contacts for all the rules see the Fed Reg at page 53816

Appendix B - Changes in Support of the 21<sup>st</sup> century Strategic Plan Initiatives

The following concepts are the drivers behind the USPTO 21<sup>st</sup> Century Strategic Plan. Identified with each driver are examples of the rules changes that best embody these concepts:

*Quality:* §§ 1.52/1.55/1.78, 1.105, 1.291, 1.705

*E-government:* §§ 1.4, 1.19 1.52, 1.58, 1.84(c), 1.91(c), 1.94, 1.98

*Pendency/Timeliness:* §§ 1.6, 1.111, 1.115, 1.213

*Resource alignment:* §§ 1.17, 1.94, 1.136/1.550/1.956

*Unnecessary formalities removal:* §§ 1.6, 1.27, 1.57(a), 1.137, 1.178, 1.179, 1.215, 1.311