

Rule by Rule Overview of the PBG - Final Rule
Revised (November 15, 2000)

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Part I: Introduction

The focus in Part II is on the changes in practice resulting from the final rule - Changes to Implement the Patent Business Goals. Significant clarifications are also identified. Conforming amendments in the rules are generally not listed. Cross references to related rules have been provided.

The final rule has been published as follows: _____

_____ Federal Register 65 *Fed. Reg.* 54603 (September 8, 2000)
_____ Official Gazette 1238 *Off. Gaz. Pat. Office* 77 (September 19, 2000)

The Office intends to publish a notice of correction to note inadvertent errors in the published rules, update changes in implementation, and address other technical issues

The Office of Patent Legal Administration (OPLA) of the Office of the Deputy Commissioner for Patent Examination Policy has a webpage on the final rule entitled PBG - Final Rule webpage (<http://www.uspto.gov/web/offices/dcom/olia/pbg/index.html>)

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Part II: Brief Summary of Changes by Rule (Section) Order

§ 1.4(b) Nature of correspondence and signature requirements: Provides that the Office may dispose of duplicate copies of correspondence (not required to be filed in duplicate), and that a separate copy must be supplied of each paper for every file it is to be considered in.

§ 1.14 Patent Applications preserved in confidence: Completely re-written so as to define

- status and access, and to make it easier to understand when status information about, and access to, an application are available, and to whom.
- § 1.14(d)(4) Clarifies that a registered attorney or agent named in papers accompanying an application may give a power to inspect the application if an executed oath or declaration under § 1.63 has not been filed.
- § 1.14(e) Access is no longer given to an abandoned application simply because it claims benefit of the filing date of another application that is open to public inspection (former § 1.14(a)(3)(iv)(C) dropped).
- § 1.19(b)(2) Document supply fees: Fee for a copy of a patent-related file wrapper (previously \$150 total) is \$200 for the first 400 or fewer pages, plus \$40 for each additional 100 or fewer pages. An additional fee of \$25 is charged for certification.
- § 1.19(b)(3) New fee of \$55 for the first copy of patent-related file-wrapper contents that were submitted on compact disc, and \$15 for each additional copy. See §§ 1.52(e), 1.96 and 1.821 et seq.
- § 1.19(g) Eliminated the practice of comparing and certifying documents not produced by the Office.
- § 1.19(h) Removed the \$25 fee for obtaining a corrected filing receipt as the Office now performs that service without charge.
- § 1.22 Fee payable in advance: The preamble (of the rulemaking) states that the Office will no longer treat authorizations to charge a deposit account, for purposes of refund payments under §§ 1.26 and 1.28, as a payment as of the date that the deposit account is actually debited. Instead, such payment will be treated the same as a payment by check. Thus, the date the payment is received in the Office is considered to be the date that the payment is made (and not any § 1.8 date, however, if § 1.10 is used, the certificate of express mail date will govern for refund purposes and not the actual date the payment arrives at the Office) .
- § 1.22(b) Where a single payment is made that represents more than one fee, an itemization of fees being paid is now required. Where an itemization is not supplied, the payment may be returned.
- § 1.26(a) Refunds: Refunds by electronic transfer are made easier as the Office may issue a credit to a bank account (from information on a check), a credit card account, or an Office deposit account, without the need to first obtain a specific authorization to do so.
- § 1.26(b) The period for requesting a refund has been changed from within a reasonable time (a subjective standard) to within two years from the date of payment (note the change in practice re § 1.22), or the date of a deposit account statement where the Office charges an amount other than what was indicated in the authorization.
- § 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 simplified procedure for asserting a claim for small entity status will be effective on the date of publication of the amended rule in the Federal Register.

- § 1.27(a) Contains definitions of small entities transferred from former § 1.9(f), which have also been revised.
- § 1.27(a)(4)(i) Removes bar to small entity status for a person granting a license to the U.S. government from a rights determination under Executive Order 10096.
- § 1.27(c)(1) Small entity status can be established by a simple written assertion of entitlement to small entity status without use of a specialized form. The Office will liberally construe any written reference to small entity status to be a request for small entity status.
- § 1.27(c)(2) The parties who can assert small entity status are expanded to include a registered practitioner (who need not actually be of record), one of the inventors (instead of all the inventors), or a partial assignee (instead of all the assignees). Note: An assignee assertion (of small entity status) must be filed by a § 1.33(b) party, § 1.27(c)(2)(iii).
- § 1.27(c)(3) Payment of any exact small entity basic filing (§§ 1.16(a), (f), (g), (h), or (k)) or basic national fee (§§ 1.492(a)(1)-(a)(5)) is sufficient to assert and obtain small entity status (even if incorrectly identified for the type of application being filed), which expands the practice from continuing and reissue applications under former § 1.28(a)(2). Payment of any other small entity fee in its exact amount, e.g., the issue fee, will not result in small entity status absent a specific written assertion of entitlement to small entity status, § 1.27(d).
- § 1.28(a) Refunds when small entity status is later established; how error in small entity status are excused: The period for requesting a refund based on small entity status is increased to 3 months from 2 months (from the date of payment of the large entity fee).
- § 1.28(c)(1) Any paper correcting an error in claiming small entity status where one or more small entity fees were erroneously paid must be limited to the payment error(s) in one application, or in one patent file.
- § 1.28(c)(2)(i) Where the fee paid in error was subject to a fee decrease, the deficiency owed is equal to the amount previously paid (rather than being based on the new lower large entity fee less the small entity amount paid in error).
- § 1.28(c)(2)(ii) Submissions of deficiency payments for errors in claiming small entity status must be itemized.
- § 1.28(c)(3) Failure to comply with the separate submission and itemization requirements of §§ 1.28(c)(1) and (2) can be treated as an authorization for the Office to process the deficiency payment and charge a processing fee. Alternatively, at the option of the Office, a requirement can be mailed by the Office for compliance with the

rule within a one month non-extendable time period to avoid return of the fee deficiency paper.

- § 1.33(a) Correspondence respecting patent applications, reexamination proceedings, and other proceedings: The correspondence address must be specified in a clearly identifiable manner or in a newly proposed Application Data Sheet (§ 1.76), or correspondence will be forwarded to the first named inventor. A request is added for a daytime telephone number.
- § 1.33(a)(1) Prior to filing a § 1.63 oath/declaration, the correspondence address may be changed by the party filing the application, including: (1) those inventors who filed the application (versus all the listed inventors), (2) a party that will be a (full or partial) assignee (as the inventors are only identified and not named until the oath/declaration is filed), (3) the attorney or agent, or (4) any other practitioner who did not file the application but was named in the application transmittal papers as a representative (but not simply identified in the letterhead as a member of the firm).
- § 1.41(a)(4) Applicant for patent: Clarification that § 1.48(f) (§ 1.63 declaration names the inventors) does not apply to applications entering the national stage. To change the inventorship from what is set forth in the international application, a § 1.48(a) petition is required as is set forth in § 1.497(d).
- § 1.44 Reserved. The accompanying proof requirement for the power or authority of the legal representative for a dead inventor (§ 1.42), or an insane or legally incapacitated inventor (§ 1.43), is deleted. Identification of the party as the legal representative in the executed oath/dec is sufficient.
- § 1.47(c) Filing when an inventor refuses to sign or cannot be reached: When processing a continuation or divisional application, the Office will not send another § 1.47 notice to the non-signing inventor as a § 1.47 notice was sent to the non-signing inventor when the prior application was accorded status under 37 CFR 1.47. Similarly, the Office will not publish another notice in the Official Gazette for a continuation or divisional application.
- § 1.48(f)(1) Correction of inventorship in a patent application, other than a reissue application, pursuant to 35 U.S.C. 116: Clarification to indicate that once an executed declaration is submitted by any of the inventors, the inventorship is set and § 1.48(f) no longer applies.
- § 1.52(b)(6) Language, paper, writing, margins, compact disc specification: Provides for the option of numbering paragraphs in the specification, not including the claims, abstract, or non-text elements, to support the change to § 1.121 relating to

- amendment by replacement paragraphs.
- § 1.52(e) Provides for the electronic submission of a computer program listing (§ 1.96), a nucleotide and/or amino acid sequence listing (§ 1.821(c)), or a large table (§ 1.58). A statement under § 1.77(b)(4) is needed to incorporate by reference to parts of the specification submitted on compact disc.
- § 1.53(e)(2) Application number, filing date, and completion of application: The petition fee relating to a notification of failure to meet filing date requirements for a provisional application under § 1.53(c) is raised to the same level as the petition fee relating to applications under §§ 1.53(b) and (d) (\$50 to \$130).
- § 1.53(f)(5) An application retention fee may be submitted in place of the filing fee where an application is not desired to be examined but is to be used for its priority date under 35 U.S.C. 120 for the filing of a continuing application. The one year period for submitting a retention fee to retain the (prior) application is replaced with a requirement that the retention fee be submitted during the pendency of the prior application (in timely response to a Notice to File Missing Parts of Application as may be extended under § 1.136).
- § 1.55(a) Claim for foreign priority: No longer permits a petition for entry of a claim for foreign priority after the issue fee is paid. While a priority claim may still be filed (along with the processing fee), it would not be reviewed for compliance with the conditions of 35 U.S.C. 119(a)-(d) and the patent will not contain a priority claim. The patentee, however, could then file a request for a certificate of correction under § 1.323 to have the priority claim reviewed for compliance with 35 U.S.C. 119 (a)-(d).
- § 1.56(e) Duty to disclose information material to patentability: Adds an explicit duty to disclose all information known to be material to patentability as defined under § 1.56(b) which became available between the filing date of the prior application and the national or PCT international filing date of a continuation-in-part application. This change does away with the need for a separate CIP § 1.63 oath or declaration that contains the provision that now would be explicitly added to § 1.56(b). The § 1.63 oath/dec form will be modified but will continue to recite the material added to § 1.56(e) as comments indicated such citation is helpful.
- § 1.58(b) Chemical and mathematical formula and tables: Requires that tables submitted in electronic form (see § 1.96(c) and § 1.821(c)) must maintain row and column formatting and proper page presentation of formulas.
- § 1.63(a)(1) Oath or declaration: Clarifies that there is no (minimum) age requirement for an inventor to sign the oath or declaration, rather competency to understand what is being signed is needed.

- § 1.63(c) Permits certain information (mailing address and residence, and foreign application information) to be on an Application Data Sheet (new Rule 1.76) rather than in the § 1.63 oath/dec. Missing or incorrect information need not, therefore, be submitted or corrected by way of a supplemental oath/dec.

Note: The term mailing address has been replaced by the term post office address for clarity because many applicants have expressed confusion about the term post office address. The two terms have the same meaning and there is no change in the requirement that an applicant state where mail is normally received. § 1.63(c)(1).

- § 1.64(b) Person making oath or declaration: If the person signing the oath or declaration is the legal representative of a deceased or incapacitated inventor, the legal representative must provide the citizenship, residence and mailing address of the legal representative (in addition to that of the deceased or incapacitated inventor).
- § 1.67(a) Supplemental oath or declaration: Supplemental oaths/declarations may be completed by fewer than all the inventors (or an applicant other than an inventor) to correct deficiencies or inaccuracies that applied to less than all the inventors. Submission (as opposed to execution) of such a completed oath/dec remains, however, controlled by §§ 1.33(a) and (b), e.g., a supplemental declaration completed by one of several inventors must be submitted by a practitioner or with a cover sheet signed by all the inventors if a power of attorney has not been given.
- § 1.72(b) Title and abstract: The word length of the abstract, for consistency with PCT, is required not to exceed 150 words, replacing the MPEP 608.01(b) range of 50-250 words.
- § 1.76 Application data sheet: A new rule that optionally provides for an Application Data Sheet (ADS) containing bibliographic data (§ 1.76(b)) in a specified format in both provisional and nonprovisional applications. An ADS or a supplemental ADS (§ 1.76(c)), can be used by practitioners to supply certain bibliographic information or to correct information that, prior to the rule change, had to be supplied by a § 1.63 oath or declaration, or corrected by a supplemental oath/dec.
- § 1.76(b)(3) The ADS optionally provides for the submission of certain examination related information, e.g., class/subclass for assigning the application to be examined, and the art unit or Technology Center where the application should be examined in, and other information, such as a suggested drawing figure for publication purposes. The Office particularly desires classification information for provisional applications (although not to be examined, they provide a useful indicator for future filings of nonprovisional applications).
- § 1.76(d) Provides how the Office will treat inconsistencies between an ADS and an

oath/dec in terms of which governs, and that the Office will initially capture information from the ADS and not the § 1.63 oath/dec notwithstanding which governs.

§ 1.78(a)(2) Claiming benefit of earlier filing date and cross-reference to other applications: Permits the specific priority reference required by 35 U.S.C. § 120 to be in the Application Data Sheet (ADS) of § 1.76 rather than in the first sentence of the specification following the title. (This will be used in creating the patent front page.)

§ 1.84 Standards for drawings: Drawing standards are mostly retained in the rule to provide guidance as to producing a high quality drawing. The Office, however, will focus on what is needed to scan the drawings for publishing patent applications, and patents, and for communicating the invention to the examiner. As a result less notices of drawing informalities are expected to be issued. (The proposals for printing patents in color and eliminating the petition for color drawings or color photographs were not implemented.)

§ 1.84(b) Eliminates requirement for three copies of a photograph. Replaces petition requirement to accept a photograph with a list of examples when a photograph is acceptable, but examiner may require drawing in place of photograph where a drawing would better illustrate the invention.

§ 1.85(c) Correction to drawings: Extensions of time are no longer permitted to extend the three month period for filing corrected or formal drawings from the Notice of Allowability. See § 1.136(c). The change applies only to a Notice of Allowability mailed on or after sixty days from publication of the rule in the Federal Register.

§ 1.96(c) Submission of computer program listings: Requires computer program listings over 300 lines to be submitted on CD-ROM or CD-R as the official copy and eliminates microfiche submissions. See also §§ 1.52(e), 1.77(b)(4), and 1.821. Listings under 300 lines may be submitted on paper or compact disc. Submissions may be made under the former rule until March 1, 2001.

§ 1.97(b)(1) Filing information disclosure statement: The 3 month window for filing an IDS submission in a CPA (§ 1.53(d)) is eliminated - since CPAs are treated as amended applications by examiners and subject to short turnover times. Note: Section 1.103 has been revised, by the PG Pubs rulemaking, so as to permit applicants to request a three month suspension of action by the Office if such a period is desired, e.g., in order to submit an IDS, a preliminary amendment, or an affidavit under § 1.132.

§ 1.97(c) The limitation or an action that otherwise closes prosecution is added to provide for types of actions other than final actions and notices of allowance that close prosecution, e.g., Ex parte Quayle, 1935 Dec. Comm r Pat. 11 (1935). The fee has been reduced from \$240 to \$180 (§ 1.17(p)), and it is made the same as

- the fee for IDS s submitted after allowance under § 1.97(d).
- § 1.97(d)(2) The fee has been increased from \$130 to \$180 (§ 1.17(p)), and it is made the same as the fee for IDS s submitted after a first Office action but before the close of prosecution under § 1.97(c).
- § 1.97(e)(1) Added requirement that the item of information be cited for the first time in a communication in a counterpart application from a foreign patent office not more than three months prior to its submission in the U.S. application. (This avoids the abuse which occurs when a document was first cited in a search report, then submitted to the Office within three months after it was again cited in an examination report from the same foreign office, or it is submitted within three months after is it cited for a second time from a different foreign patent office - but the second citation (improperly) occurs more than three months prior to submission to the USPTO).
- § 1.98(a)(2) Content of information disclosure statement: Section 1.98(a)(2)(iii) requires submission of copies of U.S. patent applications that are being cited in IDS statements.
- § 1.98(d)(2) If a U.S. application was cited in an IDS prior to the effective date of the change to § 1.98(a)(2) (now requiring a copy of the cited application) but a copy of the cited application was not supplied, as was permissible under the former rule, a copy of the cited application must be supplied if cited in any continuing application where the citation is made after the effective date of the changes to §§ 1.98(a) and (d).
- § 1.105 Requirement for information: A new rule that provides explicit authority for an examiner or other Office employee to require the submission of such information as may be reasonably necessary to properly examine an application or treat a matter therein. The requirement for information may be included in an Office action that includes other matters or sent separately. Any reply that states that the information required to be submitted is unknown and/or is not readily available will be accepted as a complete reply. Specific nonexclusive examples are provided in the rule: existence of a particularly relevant commercial data base, whether a prior art search was made, and if so, what was searched, non-patent literature by any of the inventors that relates to the claimed invention, information used in the inventive process or to draft the application, where the claimed invention is an improvement, identification of what is being improved, and identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.
- § 1.111 Reply by applicant or patent owner to a non-final Office action: The Commissioner has the right to disapprove entry of a second, or subsequent, supplemental reply (a third reply) where the second, or subsequent, supplemental

reply unduly interferes with an Office action being prepared in response to the previous reply or replies. Factors that will be considered for disapproval are: the state of preparation of an Office action responsive to the previous reply or replies as of the date of receipt by the Office of the second, or subsequent, supplemental reply, and the nature of any changes to the specification or claims that would result from entry of the second, or subsequent, supplemental reply. Implementation will apply to second, or subsequent, supplemental replies filed on or after sixty days from the date of publication of the rule in the Federal Register. See also § 1.115.

§ 1.115 Preliminary amendments: A new rule. The Commissioner has the right to disapprove entry for preliminary amendments, not filed within three months of the filing date for non-CPAs, or not filed when the CPA is filed, that unduly interfere with the preparation of an Office action. See the factors set forth in § 1.111 for disapproval related to second, or subsequent, supplemental replies. The three month window for filing the preliminary amendment is not extendable. Implementation will apply to applications filed on or after 60 days from the date of publication of the rule in the Federal Register.

§ 1.121 Manner of making amendments in applications: Amendments must be made by submission of a clean replacement paragraph/section/claim. The paragraph being amended can be identified in any unambiguous manner, such as by using page and line numbering or paragraph numbers. (The Office will not accept a direction to add paragraph numbers to currently pending applications.) An entire paragraph/claim can be deleted by an instruction. Addition/deletion of specific words or sentences would no longer be permitted. A marked up version of the replacement paragraph/section/claim showing all changes made must also be submitted. § 1.121(c)(1)(ii). See also § 1.52(b)(6). A clean set of all pending claims can be submitted. § 1.121(c)(3). The presentation of a clean version of a claim that is not accompanied by a marked up version will constitute an assertion that the clean version of the claim has not been modified relative to the immediate prior version. § 1.121(c)(3). An exception is made for examiner's amendments. Re-writing of a paragraph or claim, and a marked up version are not required, while deletion of specific words or sentences are permitted. Examiner's amendments may rely on material from faxes or e-mails as attachments, § 1.121(g). Amendments may be made under the former rule until March 1, 2001.

§ 1.131(a) Affidavit or declaration of prior invention: Expands use of rule, e.g., to include overcoming a rejection based on a prior knowledge or use under 35 U.S.C. 102(a).

§ 1.132 Affidavits or declarations traversing rejections or objections: Expands use of rule, e.g., to include overcoming a rejection based on a prior knowledge or use under

35 U.S.C. 102(a).

§ 1.137(c) Revival of abandoned application or lapsed patent: For revivals of utility and plant applications filed before June 8, 1995, the period needed to be disclaimed is no longer the entire period of abandonment but only the period extending beyond 20 years from the earliest filing date if it is a lesser period than the period of abandonment.

Additionally, the terminal disclaimer provisions no longer apply in pre June 8, 1995 applications (except designs) where revival is sought solely for purposes of copendency with a utility or plant application filed on or after June 8, 1995, since the 20 year term of the later application begins from the 35 U.S.C. § 120 benefit date of the earlier application.

§ 1.152 Design drawings: Eliminates provisions, formerly found in § 1.152(b), relating to the integral nature of indicia disclosed in drawings or photographs filed with a design application to conform to In re Daniels, 46 USPQ2d 1788 (Fed. Cir. 1998).

§ 1.155 Expedited examination of design applications: The section is redrafted to establish a procedure to create an expedited processing and examination procedure for design applications. A preexamination search, a statement that the search was made with an indication of the field of search, an IDS based on the search, formal drawings in compliance with § 1.84, and a \$900 fee are required.

§ 1.163 Specification and arrangement of application elements in a plant application:
 _____ The Latin name of the genus and species of a plant, and the variety denomination are required to be supplied in a plant application to aid in search and examination. §§ 1.163(c)(4) and (5).

§ 1.163(c)(14) Removes the requirement for a plant color coding sheet.

§ 1.173(a)(1) Reissue specification, drawings, and amendments: Requires a reissue specification and claims to be furnished as a copy of the printed patent in double column format on single sided sheets only (same as § 1.510). Also requires submission of a copy of any disclaimer (§ 1.321), certificate of correction (§§ 1.322-1.324), or any reexamination certificate (§ 1.570).

§ 1.173(a)(2) Transfer of the drawings from the patent file to the reissue application is no longer permitted. New drawings, such as copies from the printed patent, are required.

§ 1.173(c) Status of all patent claims and all added claims is required whenever an amendment is made (either at the time of filing or during prosecution). An explanation of support in the disclosure of the patent must be submitted when changes to the claims are made at filing (in addition to the current requirement of when an amendment is made during prosecution).

- § 1.176(b) Examination of reissue: The prohibition against requiring division in reissues is eliminated, and a restriction will now be permitted between: (a) claims to previously unclaimed subject matter added in a reissue application, and (b) the original patent claims. There shall be a constructive election of the subject matter of the original patent claims unless all the patent claims are disclaimed on filing. The prohibition on the Office issuing an Official action within two months from the announcement date in the Official Gazette was removed.
- § 1.177 Issuance of multiple reissue patents: Eliminates the requirements: a) that divisional reissues be limited to separate and distinct parts of the thing patented, b) that divisional reissues issue simultaneously unless otherwise ordered by the Commissioner, c) for a petition to avoid simultaneous issuance, and d) of referral to the Commissioner upon filing of the divisional reissue.
- The rule is expanded to include continuations of reissues as well as divisionals, and requires that all multiple applications for reissue of a single patent include a cross reference to the other reissue application(s). Where one reissue issues without the appropriate cross reference, the Office will issue a certificate of correction under § 1.322 to provide the cross reference. (These are changes consequential to In re Graff, 42 USPQ2d 1471 (Fed. Cir. 1997) and In re Amos, 953 F.2d 613, 21 USPQ2d 1271 (Fed. Cir. 1991)).
- § 1.178(a) Original patent; continuing duty of applicant: Where the original patent is lost or inaccessible and an offer to surrender it in a reissue application cannot therefore be made, a statement rather than an affidavit or declaration is now required to inform the Office of the loss or lack of access.
- An offer to surrender the original patent (that has not been lost or is not inaccessible) is no longer required to accompany the filing of a reissue application (although the original patent must be surrendered before the reissue can be allowed).
- § 1.178(b) The Office's attention must be called to any prior or concurrent proceedings in which the patent (for which reissue is requested) is or was involved, such as interferences, reissues, reexaminations, or litigation and the results of such proceedings.
- § 1.181(f) Petitions to the Commissioner: Clarifies the rule to apply its two month period from the mailing date of the Office action or notice from which relief is requested to any petition under part 1, such as §§ 1.182 and 1.183, unless otherwise provided. The rule is also clarified that the two month period is not extendable. The clarifications are in response to Helfgott v. Dickinson, 209 F.3d 1328, 1333 n.3, 54 USPQ2d 1425, 1428 n.3 (Fed. Cir. 2000).

- § 1.311(b) Notice of allowance: Authorizations to charge the issue fee may be filed only after the mailing of the notice of allowance. Where an incorrect issue fee, or a completed fee transmittal form (PTOL-85(B)) without payment is submitted (so that it is clear that there is an intent to pay the issue fee), however, either will operate as a valid request to charge the correct issue fee to any deposit account identified in a previously filed authorization to charge fees.
- § 1.322 Certificate of correction of Office mistake: Clarifies certificate of correction (C of C) practice re third parties. While third parties may request that the Office consider issuing a C of C (after notification to the patent owner), they have no standing to require that the Office do so. Papers from third parties requesting C of Cs will be disposed of rather than made of record after the Office reviews these requests.
- § 1.324(b)(1) Correction of inventorship in patent, pursuant to 35 U.S.C. 256: Eliminates the requirement for a statement from the inventor being deleted from a patent that the inventorship error occurred without deceptive intent, to conform to Stark v. Advanced Magnetics, Inc., 119 F.3d 1551, 43 USPQ2d 1321 (Fed. Cir. 1997).
- § 1.366(c) Submission of maintenance fees: Provides that both the patent number and the application number be supplied. Where one is missing, the Office intends to first attempt to telephone the party who submitted the payment. If contact is unsuccessful: (1) Where the maintenance fee payment only identifies the patent number (and not also the application number), the Office may apply the payment to the identified patent or return the payment; and (2) Where only the application number is identified, the payment will be returned.
- § 1.497(d) Oath or declaration under 35 U.S.C. 371(c)(4): Clarifies that § 1.48(f) national practice does not apply to correction of inventorship by submission of a declaration in a national stage application, as correction must be by the way indicated in the rule (which is analogous to § 1.48(a)). See also § 1.41(a).
- § 1.510 Request for reexamination: A copy of a patent for which reexamination is requested must be submitted in double column format on single sided sheets only (see also § 1.173(a)(1)).
- § 1.740(a)(9) Formal requirements for application for extension of patent term; correction of informalities: Replaces requirement for explaining how each applicable claim reads on the categories of approved product, or method of using, or method of manufacturing, with the requirement that the explanation is needed for only one claim in each category.
- § 1.740(b) The requirement for an oath/declaration is deleted, and a total of three copies of the

application is required to reflect that two copies are sent to the FDA.

- § 1.741(b) Review of a notice that an application for extension of patent term is incomplete, or review of the filing date accorded an application therefor, now requires a petition and petition fee, and the period for filing the petition is extendable under § 1.136 unless the notice indicates otherwise.
- § 1.821+ Nucleotide and/or amino acid sequence disclosures in patent applications: For nucleotide and/or amino acid sequences, no change is made to computer readable form (CRF) practice under § 1.821(e), but the paper version under § 1.821(c) can continue to be on paper or may now be on a compact disc, CD-ROM, or CD-R. Tables (§ 1.58) over 50 pages (§ 1.52(e)(1)(iii)) may also be submitted on a compact disk, § 1.823(a)(2). See also §§ 1.52(e), and 1.96.
- § 3.71 Prosecution by assignee: Revises definitions of a single assignee and partial assignees to be linked to being of record in the patent application/proceeding and to set forth how each may become of record and thereby intervene to control prosecution in a patent application/proceeding.
- § 3.73 Establishing right of assignee to take action: Clarifies that the documentary evidence required must include proof of who is the assignee. Clarifies that the § 3.73(b) submission is required in addition to (although it may be combined with) the specific action taken (e.g., appointing an attorney) by the assignee. Requires that a partial assignee in a patent application/proceeding indicate in the submission the extent of its ownership interest, to help account for the entire ownership interest.
- § 3.81(b) Issue of patent to assignee: Eliminates the need for a petition in order to submit assignments after payment of the issue fee. Processing by the Office to have the assignee reflected in the published patent, however, is subject to time restraints inherent in the issue process.
- The assignment need no longer be recorded among the Office's assignment records before the Office will issue a patent to the assignee as the Office will now accept a § 3.73(b) statement (submitted with the assignment information or one already present in the file if it is still valid).
- § 5.12 Petition for license: Requires a petition fee (§ 1.17(h)) for all petitions for a foreign filing license (rather than just expedited petitions) since all such petitions are treated on an expedited basis.

Part III: List of All Rules Changed

The final rulemaking includes changes to the following sections of 37 CFR:

1.4, 1.6, 1.9, 1.12, 1.14, 1.17, 1.19, 1.22, 1.25, 1.26, 1.27, 1.28, 1.33, 1.34, 1.36, 1.41, 1.47, 1.48, 1.51, 1.52, 1.53, 1.55, 1.56, 1.58, 1.59, 1.63, 1.64, 1.67, 1.72, 1.77, 1.78, 1.84, 1.85, 1.91, 1.96, 1.97, 1.98, 1.102, 1.104, 1.111, 1.112, 1.115, 1.121, 1.125, 1.131, 1.132, 1.133, 1.136, 1.137, 1.138, 1.152, 1.154, 1.155, 1.163, 1.173, 1.176, 1.177, 1.178, 1.181, 1.193, 1.303, 1.311, 1.314, 1.322, 1.323, 1.324, 1.366, 1.446, 1.497, 1.510, 1.530, 1.550, 1.565, 1.666, 1.720, 1.730, 1.740, 1.741, 1.780, 1.821, 1.823, 1.824, 1.825, 3.27, 3.71, 3.73, 3.81, 5.1, 5.2, 5.12, and 10.23.

Part IV: Rules Deleted and Added

Sections of 37 CFR that are deleted: §§ 1.44 and 1.174,

Sections of 37 CFR that are added: §§ 1.76, 1.105, and 1.115.

Part V: Coordination with AIPA rulemaking packages

The USPTO is currently in the process of implementing the American Inventors Protection Act (AIPA) of 1999, which includes the following four patents rulemakings:

- 1) **Request for Continued Examination (RCE)**, "Changes to Application Examination and Provisional Application Practice," 65 Fed. Reg. 14865 (March 20, 2000), 1233 Off. Gaz.. Pat. Office 47 (April 11, 2000) (**Interim Rule**); and 65 Fed. Reg. 50091 (August 16, 2000) (**Final Rule**), which sets forth changes from the Interim Rule. **Thus, both the Interim Rule, as modified by the Final Rule, must be considered.**
- 2) **Patent Term Adjustment (PTA)**, "Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term," 65 Fed. Reg. 17215 (March 31, 2000), 1233 Off. Gaz.. Pat. Office 109 (April 25, 2000) (**Proposed Rule**), and 65 Fed. Reg. 56365 (Sept. 18, 2000) (**Final Rule**).
- 3) **Eighteen-Month or Pre-Grant Publication (PG Pub)**, "Changes to Implement Eighteen-Month Publication of Patent Applications," 65 Fed. Reg. 17945 (April 5, 2000), 1233 Off. Gaz.. Pat. Office 121 (April 25, 2000) (**Proposed Rule**), and 65 Fed. Reg. 56365 (Sept. 18, 2000) (**Final Rule**).
- 4) **Inter Partes Reexamination**, "Rules to Implement Optional *Inter Partes* Reexamination Proceedings," 65 Fed. Reg. 18153 (April 6, 2000), 1234 Off. Gaz.. Pat. Office 93 (May 23, 2000) (**Proposed Rule**).

To coordinate this final PBG rule and the four rulemakings to implement the AIPA, it was necessary to shift some of the proposed changes in the PBG proposed rulemaking to two of the AIPA rulemaking packages.

First: The following three changes are set forth in the **RCE** rulemaking:

- (1) The change to 37 CFR 1.103 that provides for a request for up to a three month suspension of a first Office action in a CPA application under § 1.53(d) (§ 1.103(b)) and in an RCE under (new) § 1.114 (§ 1.103(c));
- (2) The change to 37 CFR 1.312 that prohibits the filing of amendments after payment of the issue fee (except as permitted in 37 CFR 1.313); and
- (3) The change to 37 CFR 1.313 that limits the reasons an applicant can request withdrawal of an application from issue to: 1) unpatentability (in which case the petition must include a statement that the claim(s) is unpatentable; 2) to file an RCE; and 3) for express abandonment (which may be in favor of a continuing application). The reasons the USPTO can withdraw an application from issue on its own initiative, as set forth in 37 CFR 1.313, are not changed.

Second: The change to § 1.52(d), that modifies the requirement for supplying a translation of a non-English language provisional application, is included in the **PG Pub** final rulemaking. If a provisional application is filed in a foreign language, an English language translation will no longer have to be filed in the provisional application. Instead, the translation of the non-English language provisional application can be filed in the nonprovisional application at the time the claim for priority to the provisional application is made in the nonprovisional application.

Part VI: Proposed Changes to Rules Which Were Not Implemented

The PBG final rule did **not** go forward with proposals related to: § 1.14 (eliminating the availability of some types of status information), § 1.22 (defining date of payment of fees), and § 1.809 (eliminating the extensions of time for making deposits after an indication that the application is otherwise in condition for allowance). Modifications were made in many other proposals, e.g., § 1.84 only some of the drawing requirements which were proposed to be eliminated were eliminated, and § 1.121 eliminating requirement for specification amendment by replacement specification if paragraph numbering were not used.