

# Changes to Implement the Patent Business Goals



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# Publication and Effective Dates

- **Patent Business Goals** - Proposed Rule: 64  
*Fed. Reg.* 53772 (Oct. 4, 1999), 1228 *Off. Gaz.*  
*Pat. Office* 15 (November 2, 1999); Final Rule 65  
*Fed. Reg.* 54603 (September 8, 2000).
  - Effective date: 2 months from publication,  
(November 7, 2000) for most changes (see 65  
*Fed. Reg.* 54604)

# Information Contacts:

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- Robert Bahr ((703) 308-6906): §§ 1.22, 1.25, 1.26, 1.53, 1.55, 1.72, 1.76, 1.78, 1.112, 1.131, 1.132, 1.137, 1.138, 1.193, 1.311 through 1.313, 1.366, Part 5, and Part 10.
- Hiram Bernstein ((703) 305-8713): §§ 1.9, 1.22, 1.26 through 1.28, 1.41, 1.48, 1.56, 1.85(c), 1.97, 1.98, 1.105, 1.111, 1.115, 1.133, 1.136, 1.322 through 1.324, and Part 3.
- Robert Clarke ((703) 305-9177): Processing and petition fees, and § 1.52(b)(2).
- James Engel ((703) 308-5106) or Fred Silverberg ((703) 557-8986): §§ 1.152 et seq.
- Eugenia Jones ((703) 306-5586): §§ 1.9, 1.27, and 1.28.

# Information Contacts cont'd:

- Jay Lucas ((703) 308-6868), Anton Fetting ((703) 305-8449) or Michael Lewis ((703) 306-5585): §§ 1.96, and 1.821 et seq. Joe Narcavage ((703) 305-1795): §§ 1.52(b)(6), 1.121, 1.125, and 1.173 et seq.
- Kenneth Schor ((703) 308-6710): §§ 1.97, 1.98, 1.173 et seq., 1.510 et seq., and Part 3.
- Fred Silverberg ((703) 305-8986): § 1.63 (oath or declaration) form.
- Karin Tyson ((703) 306-3159): §§ 1.14, 1.33, 1.44, 1.47, 1.51, 1.52 (except (b)(2) and (b)(6)), 1.59, 1.63, 1.64, 1.67, 1.77, 1.84, 1.85 (except (c)), 1.163, and 1.720 et seq.

## **§ 1.4(b) - Correspondence**

- Clarified that duplicate copies of correspondence should be avoided
- Office may dispose of duplicate papers
- If a paper is directed to multiple files, a separate copy of the paper must be furnished in each file

## **§ 1.14 - Patent Applications Preserved In Confidence**

- Rewritten to define “status” and “access”
- “Status” is defined as:
  - whether the application is pending, abandoned, or patented; and
  - the application numeric identifier
- “Access” is defined as providing the application file for review and copying of material

## **§ 1.14(d)(4) - Power to Inspect**

- § 1.14(d)(4) now allows registered attorney or agent named in application transmittal papers to give a power to inspect until an executed § 1.63 oath or declaration is filed.

## **§ 1.14(e) - Access To Applications**

- Modified to remove former provision § 1.14(a)(3)(iv)(C) so that access is no longer given to an abandoned application simply because it claims benefit of another application open to public inspection



# **§ 1.17 - Application Processing Fees (1.17(h) and (i))**

- § 1.17 (h) and (i) are reformulated to:
  - provide for petition fees in paragraph (h)
    - matters typically requiring the exercise of judgment or discretion are now located in this paragraph
  - provide for processing fees in paragraph (i)
    - matters typically not requiring the exercise of judgment or discretion are now located in this paragraph

# **§ 1.17 - Application Processing Fees - IDS (1.17(p))**

- § 1.17(p) has been amended to provide for a single fee for the submission of information disclosure statements under either § 1.97(c) or § 1.97(d).
  - The fee for either type of submission has been amended to be \$180.00, the actual cost to the Office associated with the submission
    - Results in a fee reduction for IDS's submitted before a final Office action and a fee increase for IDS's submitted after a final Office action

## § 1.19 - Fees

- § 1.19(a)(3) clarifies that the fee for a copy of a patent including a color drawing is \$25 and not \$3.
- § 1.19(b)(2) now sets forth a fee of \$200 for the first 400 or fewer pages of a copy of a patent-related file wrapper, a fee of \$40 for each additional 100 pages and a \$25 fee for certification.
- § 1.19(b)(3) sets forth a new fee of \$55 for the first copy of a compact disc in a file wrapper, with \$15 fee for each additional copy.
- §§ 1.19 (g) and (h) are eliminated. Certification of a third party copy of a filewrapper is no longer permitted, thus the fee is eliminated (1.19(g)). Further, there is no longer a \$25 fee for obtaining a corrected filing receipt (1.19(h)).

## **§ 1.22(b) - Fee Itemization**

- Itemization is required when multiple fees made by a single payment
- Office may return fees that are not itemized

## **§ 1.26(a) - Refunds**

- Absent any instructions to credit a deposit account, Office may designate “electronic funds transfer” as the refund method, unless the relevant fee was paid by credit card
- Refund of fees paid by credit card will be by a credit to the credit card account to which the fee was charged

## § 1.26(b) - Refunds

- Sets a 2-year time period within which a request for a refund must be filed
- Payments made by check and by authorization to charge a deposit account are treated the same way
  - Date of payment for authorizations to charge a deposit account is the date of filing of the fee paper, no longer the date the deposit account is debited

## **§ 1.27 - Establishing Small Entity Status**

- Simplified the procedure for asserting a claim for small entity status
- Applicants still need to make a thorough investigation before making an assertion of entitlement to small entity status
- New standard is effective on the date of publication in the Federal Register

## **§ 1.27(c)(1) - Assertion by Writing**

- Small entity status can be established by a simple written assertion of entitlement to small entity status
- The Office will liberally construe any written reference to small entity status to be a request for small entity status



## **§ 1.27(c)(2) - Parties Who Can Sign and File Assertion**

- The parties who can assert small entity status are expanded to include:
  - a registered practitioner (need not be of record)
  - one of the inventors (instead of all inventors)
  - a partial assignee (instead of all assignees)
    - An assertion of small entity status by an assignee must be filed by a § 1.33(b) party

## § 1.27(c)(3) - Assertion by Fee Payment

- 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 the wrong exact basic filing or national fee is identified)
- Payment of any other small entity fee in its exact amount will **not** result in small entity status absent a specific written assertion

## **§ 1.33(a) - Correspondence Address**

- § 1.33(a)(1) now permits the party who filed the application to change the correspondence address until a § 1.63 oath or declaration is filed:
  - includes those inventors who filed the application
  - a prospective or partial assignee
  - the attorney or agent
  - any other practitioner named as an additional representative
- Please provide a daytime telephone number

## **§ 1.44 - Proof of Authority of Legal Representative**

- Proof of authority of the legal representative of deceased (§ 1.42) or incapacitated (§ 1.43) inventor
  - no longer required in any application, regardless of the filing date of the application
  - just indicate title as legal representative in the oath or declaration when executing the oath or declaration so that the relationship of the legal rep to the deceased/incapacitated inventor is clear

# **§ 1.47 - Notice to Non-signing Inventor**

- Notice to the inventor of the filing of an application by other than the inventor
  - such notice will not be provided a second or subsequent time for the filing of continuing applications either
    - by mail directly to the non-participating inventor, or
    - by publication in the Official Gazette

# § 1.52(b)(6) - Optional Paragraph Numbering

- Optional numbering of paragraphs in specification at filing will facilitate amendment practice by paragraph replacement (§ 1.121)
- Will provide a uniform method for identifying paragraphs in the specification, and overcome word processing pagination and formatting differences
- Suggested format: **[0001]** Bold font, four digit leading zeroes, enclosed by brackets, positioned to the right of the left margin as the first part of the paragraph
- Will ease transition into total electronic filing

# **Compact Disc Specifications**

## **Added to § 1.52**

- Submission on Compact Disc of certain specification parts in lieu of paper or microfiche
- Limited to CD-ROM (Compact Disc-Read Only Memory) and CD-R (Compact Disc-Recordable) media
  - No CD-RW media allowed
  - No DVD

## **§ 1.52(e) - Disc Requirements**

- Must conform to (International Standards Organization) ISO 9660 standard
- A duplicate copy of each disc is required except for conventional CRF
  - Transmittal letter must state duplicate discs are identical
- Specification must contain an incorporation-by-reference of the material on compact disc § 1.77(b)(4)



## **§ 1.52(e) - Disc Requirements (cont.)**

- All files must be ASCII, no proprietary file formats permitted
- Data may span multiple discs if required
- Discs must be transmitted in protective packaging and labeled as provided in the rule
- Files on CD must be identified in specification as provided in the rule (by name,size,date)

## **§ 1.52(e) - Application Parts**

- Submissions on Compact Disc limited to:
  - Nucleotide and/or amino acid sequence listing (§ 1.821(c))
  - Tables over 50 pages (§ 1.58)
  - Computer program listings over 300 lines (§ 1.96)

# **Example of Optional Paragraph Numbering**

## **ORIGINAL SPECIFICATION:**

**[0045]** A regenerative adaptive fluid motor system integrating a load adaptive fluid motor control system is being developed to improve upon existing systems. No additional feedback systems need be included in the improved .....

**[0046]** Additionally, several old mechanisms could be employed without creating more functionality or requiring more manufactured components.

## **§ 1.53(c) - Application Filing Requirements - Provisional Application**

- In a provisional application, an application data sheet (§ 1.76) may be used as the required cover sheet.

## **§ 1.53(e) - Failure to Meet Filing Date Requirements**

- Regardless of whether the application is filed under §§ 1.53(b), 1.53(c), or § 1.53(d), all petitions to accord a filing date must be accompanied by a fee of \$130.00 set forth in § 1.17(h).

## **§ 1.53(f) - Completion of Application Subsequent to Filing Nonprovisional**

- Provisions of § 1.53(f) apply to *all* nonprovisional applications including *reissues*.
- If applicant does not pay one of the basic filing, or processing and retention fees during the *pendency*\* of the application, the Office may dispose of the application. § 1.53(f)(5)
  - Applicant no longer has one year from the date of the mailing of a Notice to File Missing Parts.

## **§ 1.53(g) - Completion of Application Subsequent to Filing Provisional**

- If applicant does not pay the basic filing fee during the *pendency* of the provisional application, the Office may dispose of the application. § 1.53(g)(3)

## § 1.55(a) - Foreign Priority Data

- § 1.55(a) no longer permits a petition for entry of a foreign priority claim *after the issue fee has been paid*.
  - After payment of the issue fee, a priority claim filed with the required processing fee of \$130 will not be reviewed for compliance with 35 USC 119(a)-(d) and the patent will not publish with a priority claim.
    - Patentee can then request a certificate of correction to place the foreign priority on the patent for an additional \$130.00 fee under 37 CFR 1.323. § 1.55(a)(2)(iv)



## **§ 1.58 - Tables on Compact Disc**

- Must be ASCII file no proprietary file or non-ASCII row/column format delimiters allowed (e.g. no MS-Word “Tables” or spreadsheets)
- Data must be arranged to preserve row and columns in tables and formulas when viewed with a text viewer

## **§ 1.63 - Oath or Declaration**

- Clarified that there is no minimum age requirement for signature on an oath or declaration (§ 1.63(a)(1)), rather
  - competency to understand what is being signed is required

## **§ 1.63(c) - Oath or Declaration**

- The term “post office address” has been replaced by “mailing address”
  - no change in requirement
  - intended to eliminate confusion by applicants
- oath or declaration does not need the following if provided in an application data sheet (§ 1.76)
  - mailing address
  - residence
  - foreign priority information

## **§ 1.64(b) - Legal Representative**

- A legal representative must state, in the oath or declaration, his or her:
  - citizenship,
  - residence and
  - mailing address

## **§ 1.67(a) - Supplemental Oath or Declaration**

- A deficiency or inaccuracy that relates to fewer than all of the inventors may be corrected by:
  - a declaration signed by the inventor(s) pertaining to the deficiency or inaccuracy, or
  - if the deficiency or inaccuracy is in the failure to meet the requirements of § 1.63(c), by an application data sheet (§ 1.76)

## § 1.72 - Title and Abstract

- Title should be as short and specific as possible and located on the first page of the specification, *unless supplied in an application data sheet (§ 1.76)*
- Abstract should be brief, *no longer than 150 words*, and on a separate piece of paper.
  - An application filed with an abstract having more than 150 words cannot be published and will be held in OIPE until corrected.

# **§1.76 - Application Data Sheet**

- Provides for a sheet(s) containing bibliographic and other application information in a specified format
- This information includes applicant, correspondence address, representative, domestic priority claim, and foreign priority claim information
- Guide to the Application Data Sheet can be found on the USPTO's Web site at <http://www.uspto.gov/web/offices/pac/dapp/sir/doc/patappde.html>

## **§ 1.78(a)(2) - Priority Reference Under 35 U.S.C. 119(e) & 120**

- § 1.78(a)(2) is amended to permit applicants to state the specific priority reference required by 35 U.S.C. 120 in the Application Data Sheet (ADS) (37 CFR 1.76) instead of in the first sentence of the application's specification.
- § 1.78(a)(4) is amended to permit applicants to state domestic priority reference as required by 35 U.S.C. 119(e) in the Application Data Sheet.
- This provision is effective on the date of publication in the Federal Register.



## § 1.84 - Standards for Drawings

- Drawing standards mostly retained and will focus on:
  - scan-ability of drawings for publishing applications and patents
  - communication of the invention to the examiner
- Eliminated three sets of black and white photographs
- Replaced petition to accept photographs with
  - list of examples where a photograph is acceptable, but
    - examiner may require a drawing
      - where a drawing would better illustrate the invention

## **§ 1.85(c) - Corrections to Drawings**

- period of time to file corrected or formal drawings after allowance is not extendable under § 1.136(a) or (b)
  - fewer corrected or formal drawings will be filed after allowance in view of up front PG Pub review and correction cycle
  - applies to applications with a Notice of Allowability mailed on or after [60 days after publication in Fed. Reg.]

## **§ 1.96(c) - Computer Listings on Compact Disc**

- Replaces microfiche submissions (less expensive, more available)
- Mandatory for computer program listings over 300 lines, optional for smaller listings
- Listing must be an ASCII file (e.g. no proprietary file formats allowed)
- Microfiche submissions under former rule may be made until March 1, 2001

## **§ 1.97(b) - Filing Information Disclosure Statement (IDS)**

- Eliminated the 3-month window for filing an IDS in a CPA filed under § 1.53(d)
- If a 3-month window is desired, applicant may:
  - Request a 3-month suspension of action by the Office under §1.103
  - Pay filing fee later with a surcharge in response to missing parts notice

## § 1.97(c) - Filing IDS Before Close of Prosecution

- Added “or an action that otherwise closes prosecution”
  - To provide for types of actions that close prosecution other than final Office action and notice of allowance, e.g., an *Ex parte Quayle* action
- Fee for an IDS submission under § 1.97(c)
  - Reduced from \$240 to \$180 (§ 1.17(p)) to reflect the average cost of processing an IDS submission filed under § 1.97(c)

## **§ 1.97(d) - Filing an IDS After Close of Prosecution & Before Payment of Issue Fee**

- Eliminated the requirement for a petition
- Replaced the requirement for a petition fee of \$130 with an IDS processing fee of \$180 (§ 1.17(p))
  - The IDS processing fee reflects the average cost of processing an IDS submission filed under § 1.97(d)
  - The fee for § 1.97(c) and (d) are now the same

## § 1.97(e)(1) - Statement for Filing IDS under §§ 1.97(c) and (d)

- Amended to require statement that the **first** citation of the item by a foreign patent office in a counterpart foreign application was not made, in **any** communication from the foreign office, more than three months prior to the IDS filing

## § 1.98 - Content of IDS

- Copies of any cited U.S. patent applications are required under § 1.98(a)(2)(iii)
  - Specification (including the claims), and the drawings, of the cited application,
  - or
  - The portion of the application which caused it to be cited, including any claims directed to that portion



## § 1.105 - Requirement for Information

- Examiner or other Office employee **may require** the submission,
- from individuals identified under 37 CFR 1.56(c), or any assignee,
- **information reasonably necessary to properly examine or treat a matter**
- Where an assignee has asserted its right to prosecute, may also be applied to such assignee.
- Any reply that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply.
- The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.
- A reply, or a failure to reply, to a requirement for information will be governed by §§ 1.135 and 1.136.

# § 1.105 - Requirement for Information

## Example Requirements

- Commercial Databases: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.
- Search: Whether a search of the prior art was made, and if so, what was searched.
- Related Information: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.
- Information Used to Draft Application: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.
- Information Used in Invention Process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.
- Improvements: Where the claimed invention is an improvement, identification of what is being improved.
- In Use: 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.

# **§ 1.105 - Requirement for Information**

## **Reasonable Necessity**

- Necessity
  - arises from a lack of accessible pertinent art or a suggestion of a specific need from the record or examiner's search and analysis
  - examiner will consider the response and apply to the examination as appropriate
- Reasonableness implies
  - Examiner performs the search ordinarily performed for such subject matter and finds the the need for specific information
  - Office does not have access to necessary information
  - Applicant or assignee likely has access to necessary information

## **§ 1.105 - Requirement for Information Requirement Criteria**

- Need for search areas used and references found by applicants
- Need for base technology teachings as from inventors' publications and references used to draft application
- Need for references implied in disclosure or response
- Need for information of inventors' or competitors' product or service
- Need for industry technical or legal standards used in the invention design

## **§ 1.105 - Requirement for Information Relation to § 1.56**

- § 1.105 requirement is separate from § 1.56 and any art material to patentability must still be submitted in an IDS indicating that such art is submitted under the requirement of § 1.56 .
- § 1.105 requirement for information is not necessarily material to patentability but is necessary for a complete examination on the merits

## **§ 1.111 - Reply to Non-Final Office Action**

- Second or subsequent supplemental reply (a third reply) may be disapproved under § 1.111(a)(2)
  - If it unduly interferes with the preparation of an Office action
- The authority of disapproval under § 1.111(a)(2) will be delegated to the appropriate Group Directors

## Factors to be Considered under § 1.111(a)(2)

State of preparation of an Office action as of the date of receipt of the reply (§ 1.6)

**AND**

Nature of the changes to the specification or claims

For example, if an examiner has devoted a significant amount of time to preparing an Office action before receiving the second (or subsequent) supplemental reply and, because of claims added in such supplemental reply the examiner would have to spend significant additional time to revise the Office action, then denial of entry would be appropriate.

## **When Denial of Entry under § 1.111(a)(2) is not OK**

If a second (or subsequent) supplemental reply merely cancels claims, eliminates rejections under 35 U.S.C. § 112 ¶2nd, or includes changes that were previously suggested by the examiner, then denial of entry would not be appropriate



## **When Denial of Entry under § 1.111(a)(2) is OK**

If a second (or subsequent) supplemental reply would place a significant burden by:

- adding new claims, or
- amending the specification that changes the scope of the claims or raises a new matter issue,

**AND**

The examiner has devoted a significant amount of time to preparing an Office action before receiving such reply,

Then denial of entry would be appropriate

# § 1.115 - Preliminary Amendments

- May be disapproved
  - If it unduly interferes with the preparation of a first Office action (same factors used in § 1.111)
- To avoid § 1.115 issues, preliminary amendments should be filed:
  - Within 3 months from the filing date of an application filed under § 1.53(b) or from the entry date of the national stage under § 1.491 in an international application,
  - On filing date of a CPA filed under § 1.53(d), or
  - Within the period of suspension requested by applicant under § 1.103(b) in a CPA or RCE

# **§ 1.121 - Amendment by Replacement Paragraph/Section/Claim**

## **ADVANTAGES OF CHANGES TO RULE 1.121:**

- Provides for amendment of the specification/claims by replacement paragraphs/sections/claims
- Eliminates handwritten red-ink amendment entries and claims with underlining and bracketing
- Clean text in specs and claims facilitates OCR scanning in patent publication process

## **§ 1.121 - Amendment by Replacement Paragraph/Section/Claim (cont.)**

- Rule language is clearer and easier to understand
- Printed patents should have fewer errors
- Improves efficiency of technical support when used with optional paragraph numbering

## **§ 1.121(b) - Amendment by Replacement Paragraph/Section/Claim**

### **How to make amendments to the specification:**

- Submit a clean (with no underlining or bracketing) amended paragraph/section with an instruction to substitute it for the pending paragraph/claim
- Identify the pending paragraph/section to be replaced by any clear instruction (e.g., paragraph [0045], the paragraph beginning on page x, line y; the 3rd full paragraph on p.3, etc.)
- Also submit a marked-up version of the prior pending paragraph/section with all changes (relative to the prior paragraph) shown by any conventional comparison system

## **§ 1.121(b) - Amendment by Replacement Paragraph/Section/Claim**

### **How to make amendments to the specification (cont.):**

- The text of any added (new) or deleted paragraph does not have to be presented in any marked-up version (with underlining and bracketing); an indication that the paragraph has been added or deleted is sufficient, e.g., “The paragraph beginning at p. 2, line 6, has been deleted.”
- A substitute specification may be submitted for extensive amendments (must comply with § 1.125)

## **§ 1.121(c) - Amendment by Replacement Paragraph/Section/Claim**

### **How to make amendments to the claims:**

- Submit a clean (with no underlining and bracketing) amended claim with an instruction to substitute it for the pending claim with the same number; also submit a marked-up version of the prior pending claim with all changes shown by any conventional comparison system
- Any new or canceled claim does not have to be in marked-up version; an indication that claim X is new or claim Y was canceled is sufficient
- Both the clean amended claim and the marked-up version should have the same expression: “amended,” “twice amended,” etc. in parentheses after claim number

## **§ 1.121(c) - Amendment by Replacement Paragraph/Section/Claim**

### **How to make amendments to the claims (cont.):**

- A claim may be canceled by an instruction (e.g., “cancel claim 3”)
- A canceled claim can be reinstated only by re-presentation of the complete text of the claim with a new claim number



## **§ 1.121(c)(3) - Amendment by Replacement Paragraph/Section/Claim**

### **How to make amendments to the claims (cont.):**

- A clean set of all pending claims with the same numbers as the pending claims being re-presented can be submitted at any time (provided the requirements of §§ 1.116 and 1.312 are met)
- This submission will be construed as directing the cancellation of all previous versions of the re-presented claims
- The absence of an accompanying marked up version constitutes an assertion that the claim has not been changed relative to the immediate prior version

# **§ 1.121(g) - Amendment by Replacement Paragraph/Section/Claim**

## **Exception for Examiner's Amendments:**

- Examiner's amendments are exempt from this rule
- Amendment(s) to paragraph(s)/claim(s) in an examiner's amendment can be made by instruction to insert/delete specific word(s)
- Examiners will not be required to provide either a clean version or a separate marked up version of paragraph(s) or claim(s) amended by an examiner's amendment
- A clean version of a paragraph/claim, or a portion of a paragraph/claim submitted by applicant in a fax or e-mail may be relied upon as an attachment to an examiner's amendment

# **§ 1.125 Substitute Specification**

- Substitute specification must be submitted in clean form and must be accompanied by marked up version showing changes
- Paragraphs should be numbered as per § 1.52(b)(6) to facilitate amendment practice (§ 1.121); not necessary to show numbers as changes in marked up version

# **§§ 1.131 & 1.132 - Affidavits or Declarations**

- §§ 1.131(a) and 1.132 are amended to now be applicable to rejections based on non-publication prior art available under 35 U.S.C. 102(a), e.g., public use by others.
  - This change is effective for any reply filed on or after the date of publication of the final rule in the Federal Register.

# **§ 1.155 - Design Rocket Docket**

Expedited examination of design patents if:

- submission of request with \$900 fee
- drawings in compliance with § 1.84
- statement that a preexamination search was conducted indicating the field of search
- IDS submitted
- application in condition for examination

## **§ 1.173 - Reissue Specification, Drawings & Amendments**

- Consolidated all procedural requirements for preparing reissue specification, drawings and amendments into single rule
- Specification (including claims) is required to be a copy of the pages of the original patent in double column format
  - Amendments via replacement paragraphs can be entered in double column format
- Cutting and pasting to produce a specification in a single column format is no longer needed or desired

## **§ 1.173 - Reissue Specification, Drawings & Amendments (cont.)**

- Clean copies of patent drawing sheets will be accepted in lieu of formal drawings if they meet § 1.84 criteria
- Transfer of drawings from patent is no longer permitted
- New drawings are required for new or amended figures after approval of proposed drawing (in red) by examiner

## **§ 1.176 - Examination of Reissue**

- Restriction now permitted between original patent claims and added claims directed to a different invention; no restriction among patented claims can be made by examiner
- Restriction would be based on same separate and distinct standard as in an original application (MPEP 806)
- Original patent claims must be constructively elected unless original claims are disclaimed in reissue; withdrawal of disclaimer not permitted
- Constructively elected claims examined in first reissue application; nonelected claims examined in divisional application(s)



## **§ 1.176 - Examination of Reissue (cont.)**

- Continuation/Divisional reissues will continue to be announced in Official Gazette
- Continuation/divisional reissue applications may be acted on sooner than two months after announcement in Official Gazette

# § 1.177 - Issuance of Multiple Reissue Patents

- Eliminates former requirements: (1) that multiple reissue applications be drawn to separate and distinct parts of the thing patented, (2) for simultaneous issuance, (3) for a petition for non-simultaneous issuance
- Each sibling reissue application must cross reference each other sibling reissue application in specification, providing notice to public that more than one reissue patent may replace original patent
- Original patent claims must be presented in each divisional or continuation reissue as either unamended (in only one reissue), amended, or deleted (bracketed)
- Added claims to be numbered following highest numbered original claim
- A divisional reissue drawn to only unamended original claims (which do not correct any error in original patent) cannot be issued, but will be recombined with sibling divisional reissue when latter is allowed

## **§ 1.178 - Original Patent; Continuing Duty of Applicant**

- Offer to surrender original patent grant no longer required at filing, but actual surrender of original still required before allowance
- Requires only a “statement” (and not an affidavit or declaration) of loss, if original patent cannot be located
- Establishes ongoing duty of applicants to call attention of Office to prior or concurrent proceedings (e.g., litigation) directed to original patent

## § 1.311(b) - Authorization to Charge Issue Fee

- § 1.311(b) has been amended to *only* allow authorizations to charge issue fee to be filed *after* the mailing of the Notice of Allowance and Issue Fee Due (PTOL-85).
  - Payment of an incorrect issue fee or submission of a completed fee transmittal form (PTOL-85B) without payment will operate as a valid request to charge the correct issue fee to a previously authorized deposit account.

## § 1.322 - Certificate of Correction Office Mistake

- Incorporate provisions of 35 U.S.C. 254
  - The Director may issue a certificate of correction to correct a mistake which is clearly disclosed in the records of the Office:
    - At the request of the patentee or the assignee
    - Acting *sua sponte*
    - \*Acting on information supplied by a third party
- \*The Office is not obligated to act on or respond to a submission by a third party. Papers submitted by a third party will not be made record of nor retained by the Office.

## **§ 1.323 - Certificate of Correction Applicant's Mistake**

- The Office may issue a certificate of correction under the conditions specified in 35 U.S.C. 255 *at the request of the patentee or the patentee's assignee* upon payment of fee set forth in § 1.20(a)

## **§ 1.366(c) - Maintenance Fees**

### **Patent and Application Nos. Required**

- § 1.366(c) has been amended to require that both the patent number and the application number be provided with any maintenance fee payment
  - Failure to provide both will result in:
    - if only the patent number is listed, the Office may attempt to verify the information, but may also simply apply the maintenance fee to the patent listed
    - if only the application number is listed, the Office will return of the fee (and the period for payment is not tolled)

## **§ 1.510 - Request for Reexamination Format**

- Specification (including claims) required to be copy of sheets of original patent in double column format.
- Previously required in single column format.
- Single column format no longer needed for entry of multiple amendments, since replacement paragraphs/claims now required.
- This change corresponds with the § 1.173 reissue change. Reexamination and reissue provision correspondence is considered advantageous, in order to eliminate confusion.



## § 1.530 (l) - Change of Inventorship

- § 1.530 (l) added; to correct inventorship of a patent being reexamined, must submit petition for correction of inventorship which complies with § 1.324.
- If petition under § 1.324 granted, certificate of correction to change inventorship is **not** issued; reexamination certificate to issue will contain the change-of-inventorship information (certificate of correction is merged with reexamination certificate).
- In an instance where no reexamination certificate is issued (reexamination vacated or reexamination is denied), patentee may then request the inventorship correction by certificate of correction.

# **§§ 1.730 & 1.740 - Patent Term Extension**

- clarifies who may sign an application for patent term extension (§ 1.730)
- reduces required explanation as to how the patent reads on the approved product (§ 1.740(a)(9))
- eliminates requirement for oath or declaration in application for patent term extension (§ 1.740(b))

## **§ 1.821(c) - Nucleotide and/or Amino Acid Sequences**

- In lieu of paper copy, this is in addition to the CRF submission under § 1.821(e)
  - Must submit duplicate discs and the CRF even if the CRF submission under § 1.821(e) is the same as the Compact Disc under § 1.821(c)
- Only ASCII files, no proprietary file formats
- 72 characters per line
- All § 1.52(e) requirements apply

# § 3.71 - Prosecution by Assignee

- Who can prosecute:
  - An individual assignee of the entire right, title and interest of the patent or trademark property
  - Multiple parties who together own the entire right, title and interest
    - All partial assignees,
    - All inventors who have not assigned their right, title and interest (§ 3.71 does not apply here since there is no assignee)
    - All partial assignees and inventors who have not assigned their right, title and interest
- Assignee becomes of record in the application by filing a § 3.73(b) statement signed by a party who is authorized to act on behalf of the assignee

## **§ 3.73 - Establishing Right of Assignee to Take Action**

- The assignee must be explicitly identified by name in a statement establishing ownership
- Submission of § 3.73(b) statement is required in addition to, and as prerequisite for, the specific action taken by the assignee
- Partial assignee must indicate in the § 3.73(b) statement the extent of its ownership interest

## **§ 3.81 - Issue of Patent to Assignee**

- § 3.81(b) request for issuance to assignee after payment of the issue fee
  - requirement for a petition has been eliminated
- Recordation of the assignment in Office assignment records is not required
  - The request under § 3.81(a) or (b) must be submitted with a § 3.73(b) statement (or rely on previously filed statement), and the § 3.73(b) statement should have a copy of the assignment attached, if it was not previously recorded

# **§ 10.23(c)(11) - Permitted Alterations are not Misconduct**

- § 10.23(c)(11) has been amended to explicitly allow for the alterations permitted under § 1.52(c)
  - § 1.52(c) provides:
    - alterations to application papers must (rather than should) be made before the oath or declaration is signed
    - alterations, that do not include new matter, may be made in applications which include a copy of an oath or declaration from a prior application

# Compact Disc Submission Filing New Application

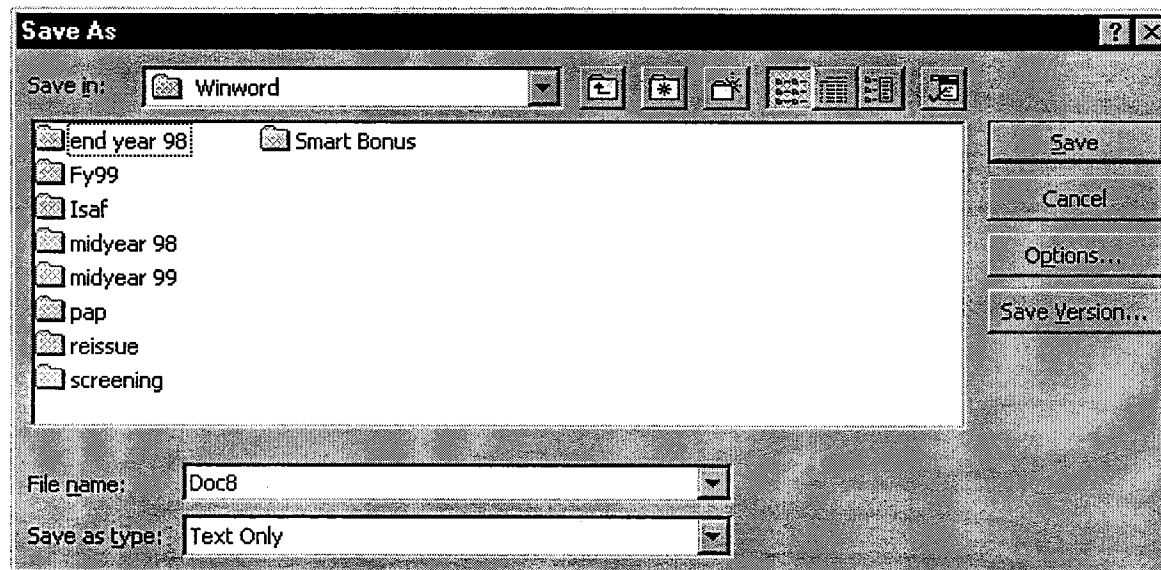


# Compact Disc (CD) Submissions

- § 1.52 Generally defines requirements for submissions on compact disc
- § 1.58 Requirements for tables submitted on compact disc
- § 1.96 Computer listings on compact disc
- § 1.821+ Nucleotide and/or Amino Acid Sequences on compact disc

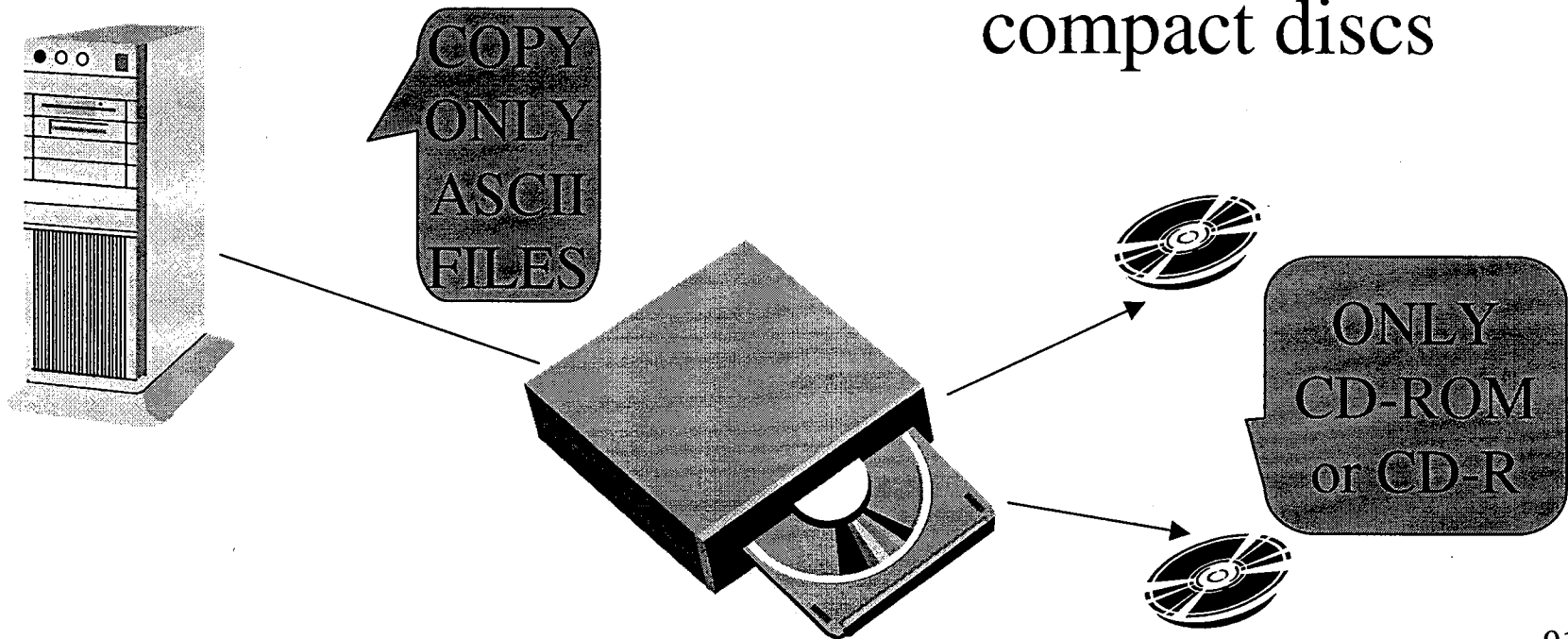
# Create ASCII Files

- Step 1: Create ASCII text files
- Select “text” as save “type” on file save menu



# Create CD Submission

Step 2: Copy files to create duplicate compact discs



# Create CD Submission (cont'd)

Step 3: Read each file on each disc with an ASCII (text) viewer to verify:

- all data is present
- tables are accurately rendered to maintain rows and columns
- chemical and mathematical formulas are accurately rendered

# Create CD Submission (cont'd)

Step 4: Verify file directory information:  
name, size, and creation date on each disc  
matches the information on:

- list of discs and files on each disc in the transmittal letter
- list of discs and files on each disc in the specification
- verify duplicate discs are identical

# Create CD Submission (cont'd)

Step 5: Label each compact disc as required by 37 CFR 1.52(e) (4) and (6) including “Copy 1” and “Copy 2” nomenclature

Step 6: Place each compact disc in a unsealed padded and protective mailing envelope

# Create CD Submission (cont'd)

Step 7: Verify there is an incorporation-by-reference statement to material on compact discs in body of application

Step 8: Verify there is a statement in the transmittal letter indicating that duplicate discs are identical

# Create CD Submission (cont'd)

Step 7: Verify there is an incorporation-by-reference statement to material on compact discs in body of application

Step 8: Verify there is a statement in the transmittal letter indicating that duplicate discs are identical