

United States Patent and Trademark Office OG Notices: 24 June 2003

DEPARTMENT OF COMMERCE
Patent and Trademark Office
37 CFR Part 1
RIN 0651-AB37

Elimination of Continued Prosecution Application Practice
as to Utility and Plant Patent Applications

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Final rule.

SUMMARY: The American Inventors Protection Act of 1999 (AIPA) enacted provisions for the continued examination of a utility or plant application at the request of the applicant (request for continued examination or RCE practice). Since continued prosecution application (CPA) practice is largely redundant in view of RCE practice, the Office is eliminating CPA practice as to utility and plant applications. An applicant for a utility or plant patent may also continue to effectively obtain further examination of the application by filing a continuing application. Since RCE practice does not apply to design applications, CPA practice will remain in place for design applications.

EFFECTIVE DATE: July 14, 2003.

FOR FURTHER INFORMATION CONTACT: Eugenia A. Jones, by telephone at (703) 306-5586, or by mail addressed to: Box Comments - Patents, Commissioner for Patents, Washington, DC 20231, or by facsimile to (703) 872-9404, marked to the attention of Eugenia A. Jones.

SUPPLEMENTARY INFORMATION: The AIPA was enacted into law on November 29, 1999. See Pub. L. 106-113, 113 Stat. 1501, 1501A-552 through 1501A-591 (1999). Among other things, the AIPA amended title 35 of the United States Code to provide for a request for continued examination (RCE) practice. See 35 U.S.C. 132(b). RCE practice is applicable to any utility or plant application filed on or after June 8, 1995. See 113 Stat. at 1501A-560 through 1501A-561. The Office amended the rules of practice in title 37 of the Code of Federal Regulations to implement the RCE provisions of the AIPA by an interim rule published in March of 2000 and a final rule published in August of 2000. See Changes to Application Examination and Provisional Application Practice, 65 FR 14865 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office 47 (Apr. 11, 2000) (interim rule), and Request for Continued Examination Practice and Changes to Provisional Application Practice, 65 FR 50091 (Aug. 16, 2000), 1238 Off. Gaz. Pat. Office 13 (Sept. 5, 2000) (final rule).

The AIPA also amended title 35 of the United States Code to provide, with certain exceptions, for the publication of pending patent applications (other than design applications) eighteen months after the earliest claimed filing date. See 35 U.S.C. 122(b). The eighteen-month publication provisions of the AIPA apply to utility and plant applications filed on or after November 29, 2000, including any CPA filed on or after November 29, 2000. The Office amended the rules of practice in title 37 of the Code of Federal Regulations to implement the eighteen-month publication provisions of the AIPA by a final rule published in September of 2000. See Changes to Implement Eighteen-Month

Publication of Patent Applications, 65 FR 57023 (Sept. 20, 2000), 1239 Off. Gaz. Pat. Office 63 (Oct. 10, 2000) (final rule). That notice indicated that the Office must create a patent application publication of a CPA using the copy of the prior application that is contained in the Office's Patent Application Capture and Review (PACR) system database or microfilm records. See Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR at 57047, 1239 Off. Gaz. Pat. Office at 84 (comment 58 and response). The PACR system database or microfilm records for applications filed before November 29, 2000, however, are often inadequate for eighteen-month publication purposes. For example, the copy of the specification or drawings contained in the Office's PACR system database or microfilm records for applications filed before November 29, 2000, is often of too poor a quality for use in the eighteen-month publication process. Since the eighteen-month publication of a CPA often requires special handling, the Office has been obliged to create a special eighteen-month publication process for CPAs, which makes the eighteen-month publication of CPAs both costly and inefficient.

The Office revised the rules of practice in December of 1997 to permit applicants to effectively obtain continued examination of an application using a streamlined continuing application practice (i.e., CPA practice). See 37 CFR 1.53(d). CPA practice was a regulatory substitute for statutory authority to provide continued examination of an application for a fee. See Changes to Patent Practice and Procedures, 62 FR 53131, 53142 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 72 (Oct. 21, 1997) (final rule) (comment 17 and response). As a convenience to applicants, the Office did not eliminate CPA practice as to utility and plant applications when RCE practice was implemented. The Office, however, did make CPA practice a transitional practice as to utility and plant applications, by requiring that the prior application have been filed before May 29, 2000. See Request for Continued Examination Practice and Changes to Provisional Application Practice, 65 FR at 50100, 1238 Off. Gaz. Pat. Office at 20. This change to CPA practice was designed to cause CPA filings to phase out over time in utility or plant applications. See Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR at 57047, 1239 Off. Gaz. Pat. Office at 84 (comment 58 and response). Thus, CPA practice was retained only as a temporary transitional practice as to utility and plant applications after RCE practice was implemented.

CPA filings are in the process of being phased out, but the phasing out of CPA filings is resulting in an ever increasing percentage of requests for a CPA being improper because the prior application was not filed before May 29, 2000. Continuing to permit the filing of a CPA in utility or plant applications (filed before May 29, 2000) requires the Office to: (1) check every request for a CPA to determine whether it is a proper CPA; and (2) maintain a special eighteen-month publication process for an ever decreasing number of CPAs. Since CPA practice for utility or plant applications is largely redundant in view of RCE practice and is also costly and inefficient, the Office has determined that it is now appropriate to eliminate CPA practice as to utility and plant applications.

Discussion of Specific Rule

Title 37 of the Code of Federal Regulations, part 1, is amended as follows:

Section 1.53(d)(1) is amended to provide that an application may be filed as a CPA under Sec. 1.53(d) only if the application is for a design patent (either an original or reissue design patent) and the prior nonprovisional application (of which the CPA is a continuation or

divisional) is a design application that is complete as defined by Sec. 1.51(b).

Section 1.53(d)(3) is amended to provide that the filing fee for a CPA filed under Sec. 1.53(d) is the basic filing fee as set forth in Sec. 1.16(f). Since Sec. 1.53(d) no longer applies to utility or plant applications and a design application may contain only a single claim (Sec. 1.154(b)(6)), there is no need for Sec. 1.53(d)(3) to provide for additional claims fees.

Section 1.53(e)(1) is amended to provide that if a request for an application under Sec. 1.53(d) (a CPA) does not meet the requirements of Sec. 1.53(d) because the application in which the request was filed is not a design application, and if the application in which the request was filed was itself filed on or after June 8, 1995, the request for an application under Sec. 1.53(d) will be treated as an RCE under Sec. 1.114. This change to Sec. 1.53(e)(1) incorporates into the rules of practice the Office's current procedures for handling improper CPAs.

Experience has shown that such requests for a CPA may not satisfy the requirements of Sec. 1.114 to be a proper RCE (e.g., the request may lack a submission as defined by Sec. 1.114(c), or may not be accompanied by the fee set forth in Sec. 1.17(e)). In such situations, the Office will treat the improper request for a CPA as an RCE (albeit an improper RCE), and the time period set in the last Office action (or notice of allowance) will continue to run. If the time period (considering any available extension under Sec. 1.136(a)) has expired, the applicant must file a petition under Sec. 1.137 (with a submission as defined by Sec. 1.114(c), unless previously filed, and/or fee set forth in Sec. 1.17(e)) to revive the abandoned application.

During the implementation of RCE practice, the Office indicated that if an applicant files a request for a CPA of an application to which CPA practice no longer applies and the applicant does not want the CPA request to be treated as an RCE (e.g., the CPA is a divisional CPA), the applicant may file a petition under Sec. 1.53(e) requesting that the improper CPA be converted to an application under Sec. 1.53(b). See Request for Continued Examination Practice and Changes to Provisional Application Practice, 65 FR at 50093-94, 1238 Off. Gaz. Pat. Office at 15. Since RCE practice has been in place for over three years and it is burdensome on the Office to treat petitions requesting conversion of a CPA into an application under Sec. 1.53(b), the Office will no longer convert an improper CPA into an application under Sec. 1.53(b) simply because it is requested by the applicant. Therefore, the Office will now convert an improper CPA into an application under Sec. 1.53(b) only if the applicant shows that there are extenuating circumstances that warrant the burdensome process of converting a CPA into an application under Sec. 1.53(b) (e.g., restoring the application to pending status and correcting the improper RCE is not possible because the application has issued as a patent).

In the event that an applicant files a request for a CPA of a utility or plant application that was filed before June 8, 1995, the Office will treat the improper CPA request as an improper application under the provisions set forth in the first sentence of Sec. 1.53(e)(1).

Response to comments: The Office published a notice proposing changes to the rules of practice to eliminate CPA practice as to utility and plant applications. See Elimination of Continued Prosecution Application Practice as to Utility and Plant Patent Applications, 66 FR 35763 (July 9, 2001), 1248 Off. Gaz. Pat. Office 167 (July 31, 2001) (proposed rule). The Office received nineteen written comments (from intellectual property organizations, patent practitioners, and the general public) in response to this notice. The

comments and the Office's responses to the comments follow:

Comment 1: One comment that supported the proposal to eliminate CPA practice (as to utility and plant applications) also suggested that RCE practice be extended to design applications so that the Office could also eliminate CPA practice as to design applications, thus completely eliminating CPA practice.

Response: Section 4404(b)(2) of the AIPA provides that the RCE provisions of 35 U.S.C. 132(b) do not apply to applications for a design patent. See 113 Stat. at 1501A-561. Therefore, the Office is prohibited by statute from making RCE practice applicable to design applications.

Comment 2: Several comments opposing the proposed elimination of CPA practice as to utility and plant applications argued that an RCE is not the equivalent of a CPA, and that the Office has acknowledged as much in its publications. The comments specifically indicate that an RCE is not equivalent to a CPA because: (1) One must file a CPA in an application filed before November 29, 1999, to take advantage of the common prior art exclusion in 35 U.S.C. 103(c) as amended by Sec. 4807 of the AIPA; (2) one must file a CPA in an application filed before May 29, 2000, to take advantage of the patent term adjustment provisions of 35 U.S.C. 154(b) as amended by Sec. 4402 of the AIPA; (3) one must file a CPA in an application filed before November 29, 2000, to take advantage of the eighteen-month publication provisions of the AIPA (without having to file a copy of the application by the Office's electronic filing system (EFS)); (4) one cannot file an RCE in an application filed before June 8, 1995; (5) one cannot file an RCE to obtain examination of a patentably distinct invention (i.e., analogous to a divisional CPA); (6) one cannot file an RCE to change inventorship without a request to correct inventorship under Sec. 1.48; (7) one cannot file an RCE without a submission; and (8) one cannot file an RCE before prosecution in the application is closed.

Response: The Office recognizes that an RCE is not a complete equivalent to a CPA. The Office has addressed the public's concerns regarding the elimination of CPA practice by delaying the elimination of CPA practice (which was initially proposed in July of 2001) until July of 2003, after more than three years have passed since the enactment of the AIPA. Since CPA practice has remained in effect for over three years since the enactment of the AIPA, any applicant wishing to file a CPA to take advantage of the amendment to 35 U.S.C. 103(c) in the AIPA, the patent term adjustment provisions of the AIPA, or the eighteen-month publication provision of the AIPA, has had sufficient time to do so. Any applicant now wishing to file a CPA to take advantage of any provision of the AIPA should file a CPA before July 14, 2003, the effective date of this change to Sec. 1.53(d).

The RCE provisions of 35 U.S.C. 132(b) do not apply to applications filed before June 8, 1995. See 113 Stat. at 1501A-560 through 1501A-561. Based upon the current low usage of Sec. 1.129(a) submission practice, it appears that there are relatively few applications filed before June 8, 1995, that are still pending. In view of the patent term implications of abandoning an application filed before June 8, 1995, in favor of a continuing application, maintaining a streamlined practice (CPA practice) for filing a continuing application may result in applicants inadvertently taking this course of action to their detriment.

An applicant cannot obtain examination of a patentably distinct invention via an RCE (i.e., as with a divisional CPA). The Office's experience with divisional CPA practice, however, has shown that divisional CPA practice is less than desirable. See Request for

Continued Examination Practice and Changes to Provisional Application Practice, 65 FR at 50100, 1238 Off. Gaz. Pat. Office at 20 (response to comment 10). Therefore, the ``benefits'' of divisional CPA practice do not warrant continuing to maintain a burdensome CPA practice.

An applicant cannot file an RCE to change inventorship without a request to correct inventorship under Sec. 1.48 (as can be done in a CPA). The requirements of Sec. 1.48, however, have now been streamlined sufficiently that this benefit of CPA practice does not justify maintaining a burdensome CPA practice.

A continuing application (unlike an RCE) can be filed without a submission and before prosecution in the prior application is closed. These courses of action, however, tend to extend application pendency and thus tend to have an effect that is contrary to the Office's goal of reducing patent application pendency. Therefore, the Office will not maintain CPA practice to allow applicants to easily file a continuing application without a submission to advance prosecution or before prosecution in the prior application is closed.

Comment 3: One comment opposed the proposed change to CPA practice on the basis that it was unnecessary to abruptly end CPA practice as CPA practice is being phased out (as to utility and plant applications). Another comment suggested that the Office wait until all of the applications filed before May 29, 2000, are no longer pending before eliminating CPA practice.

Response: The phasing out of CPA practice has resulted in many requests for a CPA now being improper because they are filed in utility or plant applications that were filed on or after May 29, 2000. The Office considers it appropriate to now eliminate CPA practice outright such that the Office can treat any subsequently filed request for a CPA as an RCE rather than continue the burdensome process of separately tracking proper CPAs and improper CPAs.

Comment 4: One comment that opposed the proposed change to CPA practice suggested that abruptly eliminating CPA practice will likely result in an increase in CPA filings immediately before the effective date of the change.

Response: The Office anticipates that eliminating CPA practice as to utility and plant application effective July 14, 2003, may result in an increase in the number of CPA filings between now and July 14, 2003.

Comment 5: One comment that opposed the proposed change to CPA practice stated that eliminating CPA practice will likely result in an increase in the number of applications that are abandoned when a CPA (now treated as an RCE) is filed without a submission.

Response: As discussed above, the practice of filing continuing applications without any submission to advance prosecution tends to extend application pendency and thus tends to have an effect that is contrary to the Office's goal of reducing patent application pendency. If an improper CPA (the CPA being improper because CPA practice has been eliminated as to utility and plant applications) does not satisfy the requirements of Sec. 1.114 to be treated as a proper RCE, the Office will treat the improper request for a CPA as an RCE (albeit an improper RCE). If the applicant does not supply a submission as defined by Sec. 1.114(c) and/or fee set forth in Sec. 1.17(e) within the time period for reply set in the Office action or notice of allowance (considering any available extension under Sec. 1.136(a)), the applicant will need to file a petition under Sec. 1.137 to revive the abandoned application and supply a submission as defined by Sec. 1.114(c) and/or fee set forth in Sec. 1.17(e), unless previously submitted.

Comment 6: One comment that opposed the proposed change to CPA practice stated that the increased cost of handling CPAs is offset by the publication fee. Another comment that opposed the proposed change to CPA practice stated that if CPAs are more costly to process, the Office should not eliminate CPAs but just charge additional fees for CPAs.

Response: The Office cannot simply offset the additional costs of publishing CPAs under eighteen-month publication with additional fees (the publication fee or a higher publication fee for CPAs). The Office cannot spend the fees it collects absent authority from Congress to do so. Congress generally does not authorize the Office to spend all of the fees it collects; rather, Congress generally authorizes the Office to spend up to only a certain amount of the fees it collects and diverts the remaining fees to other programs. Thus, even if the Office collects additional publication fees (ostensibly to recover the Office's cost of publishing CPAs), such fee revenue would likely be diverted from the Office leaving the Office with no funding to actually cover the increased cost of publishing CPAs.

Comment 7: One comment that opposed the proposed change to CPA practice suggested that the Office provide by rule that a CPA will not be published (under 35 U.S.C. 122(b) and Sec. 1.211). Another comment suggested that the Office require applicant to file a nonpublication request under Sec. 1.213(a) with any CPA, or require that any applicant filing a CPA without a nonpublication request under Sec. 1.213(a) provide a copy of the application by the Office's electronic filing system (Sec. 1.215(c)).

Response: 35 U.S.C. 122(b)(2) does not provide an exception to eighteen-month publication for CPAs. The Office cannot simply require every applicant filing a request for a CPA to also file a nonpublication request under Sec. 1.213(a) because not every applicant can properly make the certification required by 35 U.S.C. 122(b)(2)(B)(i) and Sec. 1.213(a). In addition, the current CPA filing levels do not justify engaging in further refinements of CPA practice (as opposed to simply eliminating CPA practice as to utility and plant applications).

Comment 8: One comment stated that after a notice of appeal has been filed but an agreement with the examiner is reached, the applicant cannot file an RCE and that a CPA is the most efficient mechanism to effect the agreement.

Response: An applicant can file an RCE after a notice of appeal has been filed to effect any agreement with the examiner (or to obtain continued examination of the application before the examiner). See Sec. 1.114(a). There is no reason why a CPA would be a more effective mechanism than an RCE to effect any such agreement.

Comment 9: One comment questioned whether the examination given to an application after the filing of an RCE is the same as for a CPA.

Response: The examination given to an application after the filing of an RCE is the same as for a CPA, except that an applicant cannot file an RCE to obtain examination of a patentably distinct invention as in a divisional CPA. With regard to first action final practice, the action immediately subsequent to the filing of an RCE may be made final only if the conditions set forth in section 706.07(b) of the Manual of Patent Examining Procedure for making a first action final in a continuing application (such as a CPA) are met. See Request for Continued Examination Practice and Changes to Provisional Application Practice, 65 FR at 50096, 1238 Off. Gaz. Pat. Office at 17.

Comment 10: Several comments opposed the proposed change to eliminate CPA practice (as to utility and plant applications) on the basis that a continuing application under Sec. 1.53(b) (non-CPA) requires the applicant to copy and file papers to generate a new file and this is burdensome when compared with the single paper necessary to file a CPA (which the Office recognized when implementing CPA practice). One comment also argued that continuing applications under Sec. 1.53(b) place a greater burden on the Office than do CPAs because CPAs do not require any pre-examination processing and will be picked up by the examiner for action in a more timely fashion than continuing applications under Sec. 1.53(b). One comment noted that applicants with ``deep pockets'' will be able to file a continuing application under Sec. 1.53(b) but that small entities will be more severely impacted.

Response: While a continuing application under Sec. 1.53(b) requires the applicant to copy and file papers to generate a new file, the Office must now publish applications (including CPAs) at eighteen months from its earliest claimed filing date and the application papers (specification, drawings, oath or declaration) are required for the eighteen-month publication process. In most situations in which an applicant would formerly have filed a CPA, the applicant will still be able to avoid filing the application papers necessary for a continuing application under Sec. 1.53(b) by filing an RCE.

Comment 11: One comment opposing the elimination of CPA practice suggested that a substantial number of unnecessary CPAs are filed because the Office has failed to adequately warn the patent bar and its clients that a CPA can be more expensive for the client than an RCE. The comment stated that fewer CPAs would be filed if the Office were to better educate the public on that cost difference.

Response: The Office has a Web page (<http://www.uspto.gov/web/offices/dcom/olia/aipa/index.htm>) devoted to information concerning the AIPA and the Office's implementation of the AIPA. The Web page contains (among other information) a chart explaining the various differences (including fees) between a CPA, an RCE, and a submission under Sec. 1.129(a) (http://www.uspto.gov/web/offices/dcom/olia/aipa/comparison_of_cpa_practice.htm). The Office also provided numerous presentations during fiscal years 2000 and 2001 (including a series of road show presentations) to educate the patent bar and general public about the AIPA and the Office's implementation of the AIPA (including RCE practice). Nevertheless, the elimination of CPA practice (as to utility and plant applications) will moot the issue of unnecessary CPAs being filed.

Comment 12: One comment opposing the elimination of CPA practice suggested that a substantial number of unnecessary CPAs are filed because the Office does not allow an applicant to voluntarily publish an application filed before but pending on November 29, 2000, unless a copy of the application is submitted under the new electronic filing system (EFS), and that EFS is impossible or extremely burdensome for many applicants, or for applications with many formulae or symbols, or for companies with ``firewall'' problems for transmissions of very large documents by electronic mail message. The comment stated that the filing of a CPA is by far the best way to obtain voluntary publications (and fully accurate reproductions) of most applications filed before November 29, 2000.

Response: Any applicant wishing to file a CPA to effectively obtain publication of an application filed before November 29, 2000, would have filed a CPA for this purpose shortly after November 29, 2000.

Nevertheless, the Office has received approximately 470 EFS submissions of a copy of an application for eighteen-month publication purposes (for publication of an application as-amended under Sec. 1.215(c), for publication of an application as-redacted under Sec. 1.217, for voluntary publication under Sec. 1.221(a), and for republication of an application under Sec. 1.221(a)). The Office has also received approximately 7,600 EFS submissions of new application filings. The Office has a Patent Electronic Business Center (EBC) to assist applicants who find EFS burdensome or have other problems using EFS. The Patent EBC Web page is located at (<http://www.uspto.gov/ebc/index.html>), and the EBC Customer Support Center can be reached by telephone at (703) 305-3028.

Comment 13: One comment opposing the elimination of CPA practice suggested that the Office could reduce the number of CPAs by changing the current Office practice of refusing to consider even the most minor of amendments under Sec. 1.116 (not requiring any new art search).

Response: The Office did not propose to change the practice concerning amendments after final action or appeal under Sec. 1.116. Section 1.116(c) permits entry of an amendment after final rejection or appeal upon a showing of good and sufficient reasons why the amendment is necessary and was not presented earlier. An applicant may file an RCE under Sec. 1.114 to obtain entry of an amendment that was refused entry under Sec. 1.116.

Rule Making Considerations

Regulatory Flexibility Act

The Deputy General Counsel for General Law, United States Patent and Trademark Office certified to the Chief Counsel for Advocacy, Small Business Administration, that the changes in this final rule do not have a significant impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)). This final rule eliminates CPA practice as to utility and plant applications. This change does not have a significant economic impact on any business because: (1) Any applicant (including small entities) in a utility or plant application filed before June 8, 1995, can obtain further examination of the application by filing either a continuing application under Sec. 1.53(b) or a submission under Sec. 1.129(a) (if the application is eligible for Sec. 1.129(a) practice); (2) any applicant (including small entities) in a utility or plant application filed on or after June 8, 1995, can obtain further examination of the application by filing either an RCE under 35 U.S.C. 132(b) and Sec. 1.114 or a continuing application under Sec. 1.53(b); and (3) any applicant (including small entities) in a design application can continue to obtain further examination of the application by filing either a CPA under Sec. 1.53(d) or a continuing application under Sec. 1.53(b).

Executive Order 13132

This rule making does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

Executive Order 12866

This rule making has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

Paperwork Reduction Act

This final rule involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 et seq.). As required by the Paperwork Reduction Act of 1995 (44 U.S.C. 3507(d)), the Office submitted an information collection package to OMB for its review and approval of the proposed information collections under OMB control numbers 0651-0031 and 0651-0032. The Office submitted these information collections to OMB for its review and approval because this final rule will increase the number of RCEs. The principal impact of the changes in this final rule is to eliminate CPA practice with respect to utility and plant applications.

The title, description and respondent description of each of the information collections are shown below with an estimate of each of the annual reporting burdens. Included in each estimate is the time for reviewing instructions, gathering and maintaining the data needed, and completing and reviewing the collection of information.

OMB Number: 0651-0031.

Title: Patent Processing (Updating).

Form Numbers: PTO/SB/08/21-27/30-32/35-37/42/43/61/62/63/64/67/68/91/92/96/97/PTO-2053/PTO-2055.

Type of Review: Regular Submission (currently under review).

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

Estimated Number of Respondents: 2,208,339.

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

Estimated Total Annual Burden Hours: 830,629 hours.

Needs and Uses: During the processing of an application for a patent, the applicant/agent may be required or desire to submit additional information to the United States Patent and Trademark Office concerning the examination of a specific application. The specific information required or which may be submitted includes: Information Disclosure Statements; Terminal Disclaimers; Petitions to Revive; Express Abandonments; Appeal Notices; Petitions for Access; Powers to Inspect; Certificates of Mailing or Transmission; Statements under Sec. 3.73(b); Amendments; Petitions and their Transmittal Letters; and Deposit Account Order Forms.

OMB Number: 0651-0032.

Title: Initial Patent Application.

Form Number: PTO/SB/01-07/13PCT/17-19/29/101-110.

Type of Review: Regular Submission (currently under review).

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

Estimated Number of Respondents: 454,287.

Estimated Time Per Response: Between 24 minutes and 10 hours, 45 minutes.

Estimated Total Annual Burden Hours: 4,171,568 hours.

Needs and Uses: The purpose of this information collection is to permit the Office to determine whether an application meets the criteria set forth in the patent statute and regulations. The standard Fee Transmittal form, New Utility Patent Application Transmittal form, New Design Patent Application Transmittal form, New Plant Patent Application Transmittal form, Declaration, and Plant Patent Application Declaration will assist applicants in complying with the requirements of the patent statute and regulations, and will further assist the

Office in the processing and examination of the application.

Comments are invited on: (1) Whether the collection of information is necessary for proper performance of the functions of the agency; (2) the accuracy of the agency's estimate of the burden; (3) ways to enhance the quality, utility, and clarity of the information to be collected; and (4) ways to minimize the burden of the collection of information to respondents.

Interested persons are requested to send comments regarding these information collections, including suggestions for reducing this burden, to Robert J. Spar, Director, Office of Patent Legal Administration, United States Patent and Trademark Office, Washington, DC 20231, or to the Office of Information and Regulatory Affairs of OMB, New Executive Office Building, Room 10235, 725 17th Street NW., Washington, DC 20503, Attention: Desk Officer for the United States Patent and Trademark Office.

Notwithstanding any other provision of law, no person is required to respond to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

List of Subjects in 37 CFR Part 1

Administrative practice and procedure, Courts, Freedom of Information, Inventions and patents, Reporting and record keeping requirements, Small Businesses.

For the reasons set forth in the preamble, 37 CFR part 1 is amended as follows:

PART 1 - RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR part 1 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2).

2. Section 1.53 is amended by revising paragraphs (d)(1), (d)(3), and (e)(1) to read as follows:

Sec. 1.53 Application number, filing date, and completion of application.

* * * * *

(d) * * *

(1) A continuation or divisional application (but not a continuation-in-part) of a prior nonprovisional application may be filed as a continued prosecution application under this paragraph, provided that:

- (i) The application is for a design patent;
- (ii) The prior nonprovisional application is a design application that is complete as defined by Sec. 1.51(b); and
- (iii) The application under this paragraph is filed before the earliest of:

(A) Payment of the issue fee on the prior application, unless a petition under Sec. 1.313(c) is granted in the prior application;

- (B) Abandonment of the prior application; or
- (C) Termination of proceedings on the prior application.

* * * * *

(3) The filing fee for a continued prosecution application filed under this paragraph is the basic filing fee as set forth in Sec. 1.16(f).

* * * * *

(e) * * *

(1) If an application deposited under paragraph (b), (c), or (d) of this section does not meet the requirements of such paragraph to be entitled to a filing date, applicant will be so notified, if a correspondence address has been provided, and given a period of time within which to correct the filing error. If, however, a request for an application under paragraph (d) of this section does not meet the requirements of that paragraph because the application in which the request was filed is not a design application, and if the application in which the request was filed was itself filed on or after June 8, 1995, the request for an application under paragraph (d) of this section will be treated as a request for continued examination under Sec. 1.114.

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May 23, 2003

JAMES E. ROGAN
Under Secretary of Commerce for
Intellectual Property and Director of the
United States Patent and Trademark Office