

pursuant to the authority granted the Secretary under section 514 of the Foreign Service Act of 1946. As the management of available resources requires flexibility, this rule grants the Deputy Assistant Secretary the ability to best manage such resources by designating the geographical area for which each consular office possesses jurisdiction to process nonimmigrant visa applications. The list of services for each consular office, including the providing of nonimmigrant visa processing services, continues to be published in Appendix C of Part IV of Volume 9 of the Foreign Affairs Manual.

It should be noted that pursuant to the authority granted the Deputy Assistant Secretary, the Deputy Assistant Secretary may determine that aliens resident in a country in which there is more than one consular office processing nonimmigrant visas may apply for nonimmigrant visa issuance at a designated post or at any of those NIV processing consular offices in that country.

#### Final Rule

As the amendments to the regulation provide a benefit to aliens by facilitating the visa application process, the Department has determined that it is unnecessary to publish a proposed rule or to solicit comments from the public.

This final rule is not expected to have a "significant economic impact" on a substantial number of small entities, because it is inapplicable. This rule imposes no reporting or recordkeeping action from the public requiring the approval of the Office of Management and Budget under the Paperwork Reduction Act requirements. This rule has been reviewed as required by E.O. 12988 and certified to be in compliance therewith. This rule is exempted from E.O. 12866 but has been reviewed to ensure consistency therewith.

#### List of Subjects in 22 CFR Part 41

Aliens, Applications, Nonimmigrants, Passports and visas.

In view of the foregoing, title 22 of the Code of Federal Regulations part 41 is amended to read as follows:

#### PART 41—[AMENDED]

1. The authority citation for Part 40 continues to read as follows:

Authority: 8 U.S.C. 1104.

2. Sec. 41.101 is amended by revising paragraph (a) to read as follows:

#### § 41.101 Place of application.

(a) *Application for regular visa made at jurisdictional consular office of alien's residence or physical presence.*

(1) An alien applying for a nonimmigrant visa shall make application at a consular office having jurisdiction over the alien's place of residence, or if the alien is a resident of Taiwan, at the American Institute in Taiwan, unless—

(i) the alien is physically present in the United States and is entitled to apply for issuance or reissuance of a visa under the provisions of § 41.111(b); or

(ii) a consular office having jurisdiction over the area in which the alien is physically present but not resident has agreed, as a matter of discretion or at the direction of the Department, to accept the alien's application.

(2) The Deputy Assistant Secretary of State to the Visa Office is authorized to designate the geographical area for which each consular office possesses jurisdiction to process nonimmigrant visa applications.

Dated: October 11, 1996.

Ruth A. Davis,

*Acting Assistant Secretary for Consular Affairs.*

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## DEPARTMENT OF COMMERCE

### Patent and Trademark Office

#### 37 CFR Parts 1, 5 and 10

[Docket No. 951006247-6255-02]

RIN 0651-AA70

### Communications With the Patent and Trademark Office

**AGENCY:** Patent and Trademark Office, Commerce.

**ACTION:** Final rule.

**SUMMARY:** The Patent and Trademark Office (Office) is amending its rules of practice to specify addresses for agency mail to expedite mail delivery, define "Federal holiday within the District of Columbia," clarify and simplify procedures for filing papers and fees by "Express Mail," and remove certain exclusions from § 1.8(a)(2)(ii) to permit additional trademark documents to be considered timely filed if they are mailed or transmitted by the due date and in compliance with § 1.8(a)(1).

**EFFECTIVE DATE:** December 2, 1996.

#### FOR FURTHER INFORMATION CONTACT:

Lawrence E. Anderson (for patent-related matters) by telephone at (703) 305-9285, by electronic mail at landerso@uspto.gov, or by mail to his

attention addressed to the Assistant Commissioner for Patents, Box DAC, Washington, DC 20231; or Nancy L. Omelko (for trademark-related matters) by telephone at (703) 308-8910, extension 39, or by mail marked to her attention and addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

**SUPPLEMENTARY INFORMATION:** In a Notice of Proposed Rulemaking published in the Federal Register at 57 FR 55691 (November 2, 1995) and in the Patent and Trademark Office *Official Gazette* at 1180 *Off. Gaz. Pat. Office* 122 (November 28, 1995), the Office proposed to change addresses for correspondence with the Office to reflect the creation of a mailroom site at the South Tower Building for processing most trademark-related mail; to distinguish correspondence intended for organizations reporting to the Assistant Commissioner for Patents from other correspondence; to add a separate mailing address in the Office of the Solicitor for disciplinary matters; and to delete the requirement for a certificate of mailing by Express Mail from § 1.10(b).

The following includes a discussion of the rules being changed, the reasons for those changes, and an analysis of the comments received in response to the Notice of Proposed Rulemaking.

#### General Mailing Addresses

The Office will now have three separate general mailing addresses: (1) Assistant Commissioner for Patents for correspondence processed by organizations reporting to the Assistant Commissioner for Patents, except for patent documents sent to the Assignment Division for recordation and requests for certified and uncertified copies of patent documents, which should be addressed to the Commissioner of Patents and Trademarks; (2) Assistant Commissioner for Trademarks for all trademark-related mail, except for trademark documents sent to the Assignment Division for recordation and requests for certified and uncertified copies of trademark documents, which should be addressed to the Commissioner of Patents and Trademarks; and (3) Commissioner of Patents and Trademarks for all other correspondence. In addition, there will be separate mailing addresses in the Office of the Solicitor for certain disciplinary matters and cases involving pending litigation. These addresses are set forth and discussed below.

Those who correspond with the Office are requested to use separate envelopes directed to the different areas.

*Patent-Related Mail*

Section 1.1 is amended to provide for correspondence which is processed by organizations reporting to the Assistant Commissioner for Patents to be addressed to the "Assistant Commissioner for Patents, Washington, DC 20231." The Office first announced the new address for patent-related mail in a notice entitled "Change of Address for Patent Applications and Patent Related Papers," published in the Patents *Official Gazette* at 1173 *Off. Gaz. Pat. Office* 13 (April 4, 1995).

This change will affect correspondence such as: patent applications, responses to notices of informality, requests for extension of time, notices of appeal to the Board of Patent Appeals and Interferences (the Board), briefs in support of an appeal to the Board, requests for oral hearing before the Board, extensions of term of patent, requests for reexamination, statutory disclaimers, certificates of correction, petitions to the Commissioner, submission of information disclosure statements, petitions to institute a public use proceeding, petitions to revive abandoned patent applications, and other correspondence related to patent applications and patents which is processed by organizations reporting to the Assistant Commissioner for Patents. When patent-related documents are filed with a certificate of mailing, pursuant to § 1.8, the certificate of mailing should be completed with the new address: Assistant Commissioner for Patents, Washington, DC 20231.

Unless otherwise specified, correspondence not processed by organizations reporting to the Assistant Commissioner for Patents, such as communications with the Board (excluding Notices of Appeal and appeal briefs), patent services including patent copy sales, assignments, requests for lists of patents and SIRs in a subclass, requests for the status of maintenance fee payments, as well as patent practitioner enrollment matters including admission to examination, registration to practice, certificates of good standing, and financial service matters including establishing a deposit account should continue to be addressed to the Commissioner of Patents and Trademarks, Washington, DC 20231. Documents to be recorded with the Assignment Division, except those filed with new applications, should be addressed to: Box Assignment, Commissioner of Patents and Trademarks, Washington, DC 20231. Orders for certified and uncertified copies of Office documents

should be addressed to: Box 10, Commissioner of Patents and Trademarks, Washington, DC 20231.

Special Office mail boxes as currently listed in each issue of the Patents *Official Gazette* should continue to be used to allow forwarding of particular types of mail to the appropriate areas as quickly as possible. Use of special box designations will facilitate the Office's timely and accurate identification and processing of the designated correspondence.

Checks should continue to be made payable to the Commissioner of Patents and Trademarks.

*Trademark-Related Mail*

Most trademark-related mail should be sent directly to the Trademark Operation at: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513. When trademark-related documents are filed with a certificate of mailing, pursuant to § 1.8, the certificate of mailing should be completed with the new address: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513. Use of the correct address will avoid processing delays. Trademark documents to be recorded with the Assignment Division, except those filed with new applications, should be addressed to: Box Assignment, Commissioner of Patents and Trademarks, Washington, D.C. 20231. Orders for certified and uncertified copies of trademark documents should be addressed to: Box 10, Commissioner of Patents and Trademarks, Washington, D.C. 20231.

The Office announced the new address for trademark-related mail in a notice entitled "Change of Address for Trademark Applications and Trademark Related Papers," published in the Federal Register at 59 FR 29275 (June 6, 1994) and in the Trademarks *Official Gazette* at 1163 *Off. Gaz. Trademark Office* 80 (June 28, 1994) (republished at 1170 *Off. Gaz. Pat. Office* 303 (January 3, 1995)).

The Office will continue to maintain the special box designations and FEE/NO FEE indicators for trademark mail as currently listed in each issue of the Trademarks *Official Gazette*. Use of the boxes is encouraged, to expedite processing of incoming mail.

Checks should continue to be made payable to the Commissioner of Patents and Trademarks.

Mail intended for the Trademark Trial and Appeal Board should be addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513,

including BOX TTAB/FEE or BOX TTAB/NO FEE, whichever is applicable.

*Hand-Carried Correspondence*

All correspondence with the Office, except for communications relating to pending litigation as specified in amended § 1.1(a)(3)(i), may continue to be filed directly at the Attorney's Window located in Room 1B03 of Crystal Plaza Building 2, 2011 South Clark Place, Arlington, Virginia. Trademark-related papers may also be filed at the "walk-up" window located on the third floor of the South Tower Building, 2900 Crystal Drive, Arlington, Virginia. Hand delivery of trademark papers and fees directly to the South Tower Building is recommended, to expedite processing.

*Trademark Documents Filed with Certificates of Mailing or Transmission Under § 1.8*

The Office is amending § 1.8(a)(2) to remove the exclusions listed in § 1.8(a)(2)(ii)(B) through (F). This will permit the following trademark documents to be considered timely filed if they are mailed or transmitted by the due date and in compliance with § 1.8(a)(1): (1) affidavits of continued use or excusable nonuse, under 15 U.S.C. 1058; (2) renewal applications, under 15 U.S.C. 1059; (3) amendments to allege use, under 15 U.S.C. 1051(c); (4) statements of use, under 15 U.S.C. 1051(d)(1); (5) requests for extensions of time to file a statement of use, under 15 U.S.C. 1051(d)(2); and (6) petitions to cancel registered marks, under 15 U.S.C. 1064. This change is intended to make filing easier and less expensive because a significantly larger number of documents will be considered timely filed using the simpler, less expensive first class mailing provisions of § 1.8.

Section 2.165(a)(1), dealing with affidavits of use or excusable non-use filed under Section 8 of the Trademark Act, is amended by deleting the last sentence referencing the inapplicability of certificates of mailing provided by § 1.8.

It should be noted that § 1.6(d)(8), which provides that correspondence other than notices of ex parte appeal may not be transmitted by facsimile to the Trademark Trial and Appeal Board, will not change. Thus, while a cancellation petitioner may now ensure timely filing with the certificate of mailing procedure set forth in § 1.8(a)(1), the petitioner may not transmit the above-mentioned documents directed to the Trademark Trial and Appeal Board by fax or ensure timely filing with the certificate of facsimile transmission.

Section 1.8(a)(2)(ii)(A), which states that the Certificate of Mailing or Transmission Procedure does not apply to the filing of applications for registration of marks, will not change. The filing date of an application is considered to be much more critical than the filing dates of the papers accepted under § 1.8. For example, in Trademark applications, the granting of a filing date to an application potentially establishes a date of constructive use of the mark, and is also critical for determining whether foreign priority can be claimed under 15 U.S.C. 1126(d); therefore, entry of the date of deposit by a disinterested USPS employee is required.

#### *Express Mail*

Section 1.10 is being amended to simplify and clarify the procedures for filing correspondence by the "Express Mail Post Office to Addressee" (Express Mail) service of the United States Postal Service (USPS), by deleting the requirement for a Certificate of Mailing by Express Mail.

Section 1.10 was promulgated to implement 35 U.S.C. 21, under which the Commissioner may "by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service."

Under the prior rule, the filer was required to include a Certificate of Mailing by Express Mail, certifying the date of deposit as Express Mail. Papers which did not include this certificate, or which included a certificate that did not meet the requirements of the rule, were given a filing date as of the date received in the Office rather than the date of deposit as Express Mail. The lost filing date for a significant number of these papers resulted in the loss of substantive rights. In light of the problematic nature of the requirement for a Certificate of Mailing by Express Mail and its apparent redundancy in purpose, inasmuch as the date of deposit has already been entered by a disinterested third party, the Office has deleted this requirement from § 1.10(b).

Under the new rule, Office personnel will routinely look to the Express Mail mailing label, and stamp the "date-in" or other official USPS notation as the filing date of the correspondence. If the USPS deposit date cannot be determined, the correspondence will be accorded the date of receipt in the Office as the filing date.

Section 1.10(b), as amended, provides that the Express Mail mailing label number should be placed on

correspondence filed by Express Mail under § 1.10 prior to the original mailing. Correspondence *actually received* by the Office will not be denied a filing date as of the date of deposit with the USPS because the Express Mail mailing label number was not placed thereon prior to its original mailing. However, the absence of the number of the Express Mail mailing label will preclude a party from obtaining relief on petition, under § 1.10 (c) through (e).

Section 1.10(b) also provides that correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the Express Mail mailing label with the "date-in" clearly marked, and that persons dealing indirectly with the employees of the USPS (such as by deposit in an Express Mail drop box) do so at the risk of not receiving a copy of the Express Mail mailing label with the desired "date-in" clearly marked.

Sections 1.10(c) through 1.10(e) set forth procedures for petitioning the Commissioner to accord a filing date as of the date of deposit as Express Mail. Section 1.10(c) applies where there is a discrepancy between the filing date accorded by the Office and the "date-in" or other official notation entered by the USPS on the Express Mail mailing label; § 1.10(d) applies where the "date-in" is incorrectly entered by the USPS; and § 1.10(e) applies where correspondence deposited with the USPS as Express Mail is not received by the Office.

#### *Miscellaneous Changes*

Sections 1.3 and 5.33 are also being amended to change "communications" to "correspondence," and for consistency with §§ 1.1, 1.6, and 1.8.

Section 1.6(a)(2) is amended to provide that correspondence deposited as Express Mail in accordance with § 1.10 will be considered filed on the date of its deposit, regardless of whether that date is a Saturday, Sunday or Federal holiday within the District of Columbia.

Section 1.9 is amended to add a definition of a "Federal holiday within the District of Columbia" to include an official closing of the Office.

Since the certificate of mailing by Express Mail is no longer a requirement of § 1.10, the provisions of Part 10 relating to misconduct have been amended to delete reference to this requirement.

#### *Discussion of Specific Rules*

The heading of § 1.1 is amended to state that the section contains the addresses for correspondence to the Patent and Trademark Office.

Section 1.1 is amended to set out all pertinent Office mailing addresses in paragraph (a) and in added paragraphs (a)(1), (a)(2), and (a)(3). The remaining paragraphs of § 1.1 contain directions for using box designations rather than addresses. Paragraph (a)(1) sets forth the new mailing address to which most patent-related documents should be sent. Paragraph (a)(2) sets forth the new mailing address to which most trademark-related documents should be sent. It is noted that correspondence not addressed according to (a)(1) and (a)(2), but sent instead to the Commissioner of Patents and Trademarks, will not be refused consideration but may be delayed in processing. The Solicitor's mailing address, formerly set out in paragraph (g) of the section, is moved to a new paragraph (a)(3). Paragraph 1.1(g) is removed and reserved.

Sections 1.1 and 1.3 are amended so that the word "communications" is changed to "correspondence."

Section 1.5(a) is amended by removing the requirement that the words "PATENT APPLICATION" appear on letters concerning patent applications. The remainder of the section remains unchanged.

Section 1.6(a)(1) is amended to add the sentence "[t]he Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday or Federal holiday within the District of Columbia." In addition, § 1.6(a)(1) is further amended to add the phrase "[e]xcept for correspondence transmitted by facsimile as provided for in paragraph (a)(3) of this section" to the beginning of the sentence "[n]o correspondence is received in the Patent and Trademark Office on Saturdays, Sundays or Federal holidays within the District of Columbia." Since the Office may "receive" a facsimile transmission under § 1.6(a)(3) on a Saturday, Sunday or Federal holiday within the District of Columbia, § 1.6(a)(1) is amended to add the phrase "[e]xcept for correspondence transmitted by facsimile as provided for in paragraph (a)(3) of this section" for clarity and consistency with § 1.6(a)(3). In addition, § 1.6(a)(1) is amended to begin with the sentence "[t]he Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday or Federal holiday within the District of Columbia" to clarify that any day that is a Saturday, Sunday or Federal holiday within the District of Columbia is a day that the Patent and Trademark Office is not open for the filing of applications within the meaning of Article 4(C)(3) of the Paris Convention.

Section 1.6(a)(2) is amended to delete the phrase "unless the date of deposit is a Saturday, Sunday or Federal holiday within the District of Columbia in which case the date stamped will be the succeeding day which is not a Saturday, Sunday or Federal holiday within the District of Columbia." Thus, § 1.6(a)(1) will provide that the Office is not open for the filing of correspondence on any day that is a Saturday, Sunday or Federal holiday within the District of Columbia, but that correspondence deposited as Express Mail with the USPS in accordance with § 1.10 will be considered filed on the date of its deposit, regardless of whether that date is a Saturday, Sunday or Federal holiday within the District of Columbia (under 35 U.S.C. 21(b) or § 1.7).

Section 1.8(a)(1)(i)(A) is revised to state that papers and fees must be addressed as set out in § 1.1(a). For the purposes of 1.8(a)(1)(i)(A), first class mail is interpreted as including "Express Mail" and "Priority Mail" deposited with the USPS.

Section 1.8(a)(2)(ii) is revised to remove and reserve paragraphs (a)(2)(ii)(B) through (a)(2)(ii)(F). This will permit the following items to be filed in accordance with the procedures set forth in § 1.8(a): (1) an affidavit of continued use or excusable nonuse under section 8 (a) or (b) or section 12(c) of the Trademark Act, 15 U.S.C. 1058(a), 1058(b), 1062(c); (2) an application for renewal of a registration under section 9 of the Trademark Act, 15 U.S.C. 1059; (3) a petition to cancel a registration of a mark under section 14, subsection (1) or (2) of the Trademark Act, 15 U.S.C. 1064; (4) in an application under section 1(b) of the Trademark Act, 15 U.S.C. 1051(b), an amendment to allege use in commerce under section 1(c) of the Trademark Act, 15 U.S.C. 1051(c), or a statement of use under section 1(d)(1) of the Trademark Act, 15 U.S.C. 1051(d)(1); and (5) in an application under section 1(b) of the Trademark Act, 15 U.S.C. 1051(b), a request under section 1(d)(2) of the Trademark Act, 15 U.S.C. 1051(d)(2), for an extension of time to file a statement of use under section 1(d)(1) of the Trademark Act, 15 U.S.C. 1051(d)(1).

Section 1.9 is amended to add a definition of "Federal holiday within the District of Columbia" to include an official closing of the Office. When the entire Patent and Trademark Office is officially closed for business for an entire day, for reasons due to adverse weather or other causes, the Office will consider each such day a "Federal holiday within the District of Columbia" under 35 U.S.C. 21. Any action or fee due on such a day may be taken, or fee

paid, on the next succeeding business day the Office is open.

This provision implements existing policy. In the past, the Office has published notices concerning unscheduled closings, stating that correspondence due on the date of the unscheduled closing would be deemed timely if filed on the next succeeding business day that the Office is open. See, e.g., "Closing of Patent and Trademark Office on Thursday, January 20, 1994 and Friday, February 11, 1994" published in the Patent *Official Gazette* at 1161 *Off. Gaz. Pat. Office* 12 (April 5, 1994) (republished at 1170 *Off. Gaz. Pat. Office* 8 (January 3, 1995)) and "Filing of Papers During Unscheduled Closings of the Patent and Trademark Office" published in the Patent *Official Gazette* at 1097 *Off. Gaz. Pat. Office* 53 (December 20, 1988) (republished at 1170 *Off. Gaz. Pat. Office* 8 (January 3, 1995)).

Other legal holidays within the District of Columbia are New Year's Day (January 1), Martin Luther King, Jr.'s Birthday (third Monday in January), Presidential Inauguration Day, Washington's Birthday (third Monday in February), Memorial Day (last Monday in May), Independence Day (July 4), Labor Day (first Monday in September), Columbus Day (second Monday in October), Veterans Day (November 11), Thanksgiving Day (fourth Thursday in November) and Christmas Day (December 25).

The title of § 1.10 is revised to: (1) change "papers and fees" to "correspondence" and (2) remove the reference to a "certificate." These changes are for consistency with the amendment to § 1.10 in this final rulemaking.

Section 1.10(a) is amended to provide that: (1) any correspondence received by the Office that was delivered by the "Express Mail Post Office to Addressee" (Express Mail) service of the USPS will be considered filed in the Office on the date of deposit with the USPS, (2) the date of deposit with the USPS is the "date-in" or other official USPS notation on the Express Mail mailing label, and (3) if the USPS deposit date cannot be determined, the correspondence will be accorded a filing date as of the date of receipt in the Office.

The date of deposit or mailing with the USPS is defined by the USPS as: (1) For correspondence that is paid for at the time of deposit—the date the correspondence is presented and accepted for Express Mail delivery at designated post offices, branches, or stations, and (2) For correspondence that is prepaid (i.e., with a completed

mailing label and postage affixed)—the date the prepaid correspondence is accepted by the USPS collection employees or the USPS pickup service. USPS Domestic Mail Manual (DMM) 49, at D-38 (Sept. 1, 1995).

Section 1.10(b) is amended by deleting the requirement for a certificate of mailing by Express Mail. As amended, § 1.10(b) provides that the number of the Express Mail mailing label should be placed on each piece of correspondence prior to the original mailing. Correspondence that is *actually received* by the Office will not be denied a filing date as of the date of deposit because the number of the Express Mail mailing label was not placed thereon prior to the original mailing. However, if the number of the mailing label did not appear on the correspondence as originally filed, relief will not be granted on petition under §§ 1.10(c) through (e), even if the party who filed the correspondence satisfies the other requirements of § 1.10(c), § 1.10(d) or § 1.10(e).

Since the filing of correspondence under § 1.10 without the number of the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition. A party's inadvertent failure to comply with the requirements of a rule is not deemed to be an extraordinary situation that would warrant waiver of a rule under §§ 1.183, 2.146(a)(5) or 2.148, nor is such an inadvertent omission considered to be an "unavoidable delay," within the meaning of 15 U.S.C. 1062(b), 35 U.S.C. 133, § 1.137(a) or § 2.66(a). See *Honigsbaum v. Lehman*, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995) (Commissioner did not abuse his discretion in refusing to waive requirements of § 1.10(c) in order to grant filing date to patent application, where applicant failed to produce Express Mail customer receipt or any other evidence that application was actually deposited with USPS as Express Mail); *Nitto Chemical Industry Co., Ltd. v. Comer*, No. 93-1378, 1994 U.S. Dist. LEXIS 19211, at \*13-14 (D.D.C. Mar. 7, 1994) (Commissioner's refusal to waive requirements of § 1.10 in order to grant priority filing date to patent application not arbitrary and capricious, because failure to comply with the requirements of § 1.10 is an "avoidable" oversight that could have been prevented by the exercise of ordinary care or diligence, and thus not an extraordinary situation under § 1.183); *Vincent v. Mossinghoff*, 230 USPQ 621 (D.D.C. 1985) (Misunderstanding of § 1.8 not

unavoidable delay in responding to Office Action); *Gustafson v. Strange*, 227 USPQ 174 (Comm'r Pats. 1985) (Counsel's unawareness of § 1.8 not extraordinary situation warranting waiver of a rule); *In re Chicago Historical Antique Automobile Museum, Inc.*, 197 USPQ 289 (Comm'r Pats. 1978) (Since certificate of mailing procedure under § 1.8 was available to petitioner, lateness due to mail delay not deemed to be extraordinary situation).

Section 1.10(b) further provides that correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the Express Mail mailing label with the "date-in" clearly marked, and that persons dealing indirectly with the employees of the USPS (such as by depositing correspondence in an Express Mail drop box) do so at the risk of not receiving a copy of the Express Mail mailing label with the desired "date-in" clearly marked. On petition, the failure to obtain an Express Mail mailing label with the "date-in" clearly marked will be considered an omission that could have been avoided by the exercise of due care, as discussed above.

Sections 1.10(c) through 1.10(e) set forth procedures for petitioning the Commissioner to accord a filing date as of the date of deposit as Express Mail. Such petitions are filed under § 1.181 for patent correspondence and § 2.146 for trademark correspondence. Section 1.10(c) sets forth procedures for filing a petition to the Commissioner for a filing date as of the date of deposit with the USPS, where there is a discrepancy between the filing date initially accorded by the Office and the "date-in" entered by the USPS. Such a petition should: (1) be filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date, (2) include a showing that the number of the Express Mail mailing label was placed on each piece of correspondence prior to the original mailing, and (3) include a true copy of the Express Mail mailing label showing the "date-in" or other official notation by the USPS.

Section 1.10(d) sets forth procedures for filing a petition to the Commissioner to accord a filing date as of the actual date of deposit with the USPS, where the "date-in" or other official notation is incorrectly entered by the USPS. Such a petition should: (1) be filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS, (2) include a showing that the number of the Express Mail mailing label was placed on each piece of

correspondence prior to the original mailing, and (3) include a showing that the correspondence was deposited as Express Mail prior to the last scheduled pickup on the requested filing date. The showing under Section 1.10(d) must be corroborated by (1) evidence from the USPS, or (2) evidence that came into being *after* deposit and within one business day of the deposit of the correspondence as Express Mail. Evidence that came into being within one day after the deposit of the correspondence as Express Mail may be in the form of a log book which contains information such as the Express Mail number; the application number, attorney docket number or other such file identification number; the place, date and time of deposit; the time of the last scheduled pick-up for that date and place of deposit; the depositor's initials or signature; and the date and time of entry in the log. Any statement submitted in support of such a showing must be verified if made by a person other than an employee of the USPS or a practitioner as defined in § 10.1(r) of this chapter.

The reason the Office considers correspondence to have been filed as of the date of deposit as Express Mail is that this date has been verified by a disinterested USPS employee, through the insertion of a "date-in," or other official USPS notation, on the Express Mail mailing label. Due to the questionable reliability of evidence from a party other than the USPS that did not come into being contemporaneously with the deposit of the correspondence with the USPS, § 1.10(d) specifically requires that any petition under § 1.10(d) be corroborated either by evidence from the USPS, or by evidence that came into being after deposit and within one business day *after* the deposit of the correspondence as Express Mail. A petition alleging that the USPS erred in entering the "date-in" will be denied if it is supported only by evidence (other than from the USPS) which was: (1) created prior to the deposit of the correspondence as Express Mail with the USPS (e.g., an application transmittal cover letter, or a client letter prepared prior to the deposit of the correspondence), or (2) created more than one business day after the deposit of the correspondence as Express Mail (e.g., an affidavit or declaration prepared more than one business day after the correspondence was deposited with the USPS as Express Mail). On the other hand, a notation in a log book, entered by the person who deposited the correspondence as Express Mail within one business day

after such deposit, setting forth the items indicated above would be deemed on petition to be an adequate showing of the date of deposit under § 1.10(d)(3).

Section 1.10(d)(3) further provides that a party must show that correspondence was deposited as Express Mail before the last scheduled pickup on the requested filing date in order to obtain a filing date as of that date. This incorporates existing practice, as set forth in the *Manual of Patent Examining Procedure* (6th ed., January, 1995) § 513, and *Trademark Manual of Examining Procedure* (2nd ed., May, 1993) § 702.02(e) into the rule.

Section 1.10(e) sets forth procedures for filing a petition to the Commissioner to accord a filing date as of the date of deposit with the USPS, where correspondence deposited as Express Mail is never received by the Office. Such a petition should: (1) be filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence, (2) include a showing that the number of the Express Mail mailing label was placed on each piece of correspondence prior to the original mailing, (3) include a true copy of the originally deposited correspondence showing the number of the Express Mail mailing label thereon, a copy of any returned postcard receipt, a copy of the Express Mail mailing label showing the "date-in" or other official notation entered by the USPS, and (4) include a statement, signed by the person who deposited the documents as Express Mail with the USPS, setting forth the date and time of deposit, and declaring that the copies of the correspondence, Express Mail mailing label, and returned postcard receipt accompanying the petition are true copies of the correspondence, mailing label and returned postcard receipt originally mailed or received. Any statement in support of a petition under § 1.10(e) must be verified if made by a person other than a practitioner as defined in § 10.1(r) of this chapter.

Section 1.10(e) provides for the filing of a petition to accord correspondence a filing date as of the date of deposit with the USPS as Express Mail only where the correspondence was mailed with sufficient postage and addressed as set out in § 1.1(a). There is no corresponding provision that correspondence be properly addressed and mailed with sufficient postage in §§ 1.10(a), (c) and (d), because these sections apply only to correspondence that is actually received by the Office. Correspondence mailed by Express Mail that is *actually received* by the Office will not be denied a filing date as of the date of deposit as Express Mail simply

because the correspondence was not mailed with sufficient postage or not addressed as set out in § 1.1(a).

Section 1.10(e)(3) provides that if the requested filing date is a date other than the "date-in" on the Express Mail mailing label, the petition should include a showing under § 1.10(d)(3), as discussed above, that the correspondence was deposited as Express Mail before the last scheduled pickup on the requested filing date in order to obtain a filing date as of that date.

Section 1.10(f) provides that the Office may require additional evidence to determine whether the correspondence was deposited as Express Mail with the USPS on the date in question.

Section 2.165(a)(1), dealing with affidavits of use or excusable non-use filed under Section 8 of the Trademark Act, is amended by deleting the last sentence referencing the inapplicability of certificates of mailing provided by § 1.8.

Section 5.33 (entitled "Correspondence") is amended to change the correspondence address to "Assistant Commissioner for Patents (Attention: Licensing and Review), Washington, D.C. 20231."

Section 10.23(c)(9) is revised to reflect the fact that the certificate of mailing by Express Mail is no longer a requirement of § 1.10.

#### Response to Comments on the Rules

The comments received in response to the notice of proposed rulemaking have been given careful consideration and a number of the suggested modifications have been adopted. The comments and responses are discussed below.

*Comment 1:* One comment suggested that the Office return to a single mailing address.

*Response:* Addressing correspondence to specific areas within the agency, in accordance with § 1.1, reduces the amount of sorting required. Except as set out in § 1.1(a)(3)(iv), mail will be delivered within the Office regardless of how it is addressed. Nevertheless, use of a specific address should produce faster results for correspondents and savings to the Office in terms of reduced time and cost. The suggestion to address mail to a single mailing address will not be adopted.

*Comment 2:* Three comments requested a clarification of the reference to "organizations reporting to the Assistant Commissioner for Patents" in § 1.1(a)(1), suggested that each organization be identified, and noted that the change of address from "Commissioner of Patents and

Trademarks" to "Assistant Commissioner for Patents" is confusing.

*Response:* Section 1.1(a)(1) has not been amended to list "organizations reporting to the Assistant Commissioner for Patents." The vast majority of mail to be addressed to the Assistant Commissioner is intended for the Examining Groups. Furthermore, once a list of organizations is established in the rule, amendment to such a list would require implementation of a rule change. However, a list of papers that should be addressed to the Assistant Commissioner for Patents appears under the heading "Patent-Related Mail" in the Supplementary Information section.

*Comment 3:* Two comments requested clarification concerning how a new application incorrectly addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231, will be treated. Two comments opposed the address change in § 1.1, if the benefit of obtaining a filing date is conditioned upon the correspondence address being addressed correctly.

*Response:* Except for certain mail addressed incorrectly to the Office of the Solicitor, there will be no penalty for addressing a document to the wrong area within the Office, as long as one of the approved addresses is used. Use of the specific addresses listed within § 1.1 is strongly encouraged because it will facilitate the process both for the Office and the filer. Accordingly, a new application incorrectly addressed to the Commissioner will be treated the same as if the application was addressed to the specific Assistant Commissioner.

*Comment 4:* One comment supported the separate mailing addresses for mail directed to the Assistant Commissioner for Patents, Assistant Commissioner for Trademarks, Solicitor and the Commissioner, but viewed the practice under § 1.1(a)(3) with respect to correspondence to the Office of the Solicitor as a penalty for correspondents who misaddress mail.

*Response:* While the language in the proposed rule was based on the existing rule, 37 CFR 1.1(g) (1996), which has been in effect since 1988, § 1(a)(3)(iv) has been reworded in the final rule to state that improperly addressed correspondence "may be returned." This language better represents the intent of the rule. The Post Office boxes are located off-site and mail to these boxes is handled directly by the Office of the Solicitor. The Office of the Solicitor cannot handle large volumes of mail from users who choose not to follow Office mailing rules.

*Comment 5:* One comment requested clarification on the distinction between § 1.1(a) which states that mail "must" be

addressed to the Assistant Commissioner for Patents and § 1.1(a)(1) which states that mail "should" be addressed to the Assistant Commissioner for Patents, if any.

*Response:* The language of 1.1(a) has been amended to indicate that all correspondence must be addressed either to the "Commissioner of Patents and Trademarks, Washington, D.C. 20231" or to specific areas within the Office as set out in paragraphs (a)(1), (2) and (3) of § 1.1.

*Comment 6:* One comment questioned why it is now merely permissible to identify a patent application by its serial number and filing date whereas such information was previously mandatory.

*Response:* The only change to § 1.5 is the elimination of the requirement to include the words "PATENT APPLICATION" on letters concerning patent applications. Section 1.5 both before and after the proposed amendment provides that "[w]hen a letter . . . concerns a previously filed application for a patent, it must identify on the top page in a conspicuous location, the application number (consisting of the series code and the serial number; e.g., 07/123,456) or the serial number and filing date assigned to that application. . . ." Accordingly, correspondence must continue to identify a previously filed patent application by either (1) the application number, or (2) the serial number and filing date. The combination of the serial number and filing date is unique by itself.

*Comment 7:* One comment objected to the return of correspondence pertaining to an application that had not yet been accorded an application number because some correspondence may require immediate action. This person suggested that the Office search the computerized records given sufficient other identifying information, instead of returning the correspondence.

*Response:* If the correspondence is returned for failure to identify the correspondence with the appropriate information, the applicant has the option to return the correspondence with the appropriate information within two weeks of the date of the cover letter from the Office by utilizing the Certificate of Mailing or Transmission procedure under § 1.8 or the Express Mail procedure under § 1.10 to obtain the benefit of the date of deposit with the USPS. There does not appear to be any situation where a file would require immediate action in applications where the application number had not been assigned. If an application number has already been assigned, it is within the

filer's control to supply that information and avoid delays.

*Comment 8:* Seven comments opposed the addition of unscheduled closings of the Office to the definition of "Federal holidays within the District of Columbia." The comments noted that substantive rights would be at risk for persons filing provisional patent applications and applications asserting priority claims based on foreign applications should the date on which an application must be filed fall on a day that the Office is closed for unforeseen reasons. One comment noted that the substantive rights of applicants seeking to secure a filing date prior to divulging an invention may lose rights if a later filing date, resulting from an unscheduled closing of the Office, is subsequent to the date of divulgence. Some of the comments suggested amending § 1.9 to make an exception for provisional patent applications and applications asserting a claim of priority based on a foreign application so that the filing date would not be affected by an unscheduled closing of the Office. One comment also suggested that § 1.9 be amended to distinguish between the filing of applications and the filing of responses. One comment suggested that the Commissioner allow for filing of a non-provisional patent application on Federal holidays where the one year anniversary of the provisional application falls on a Federal holiday.

*Response:* Section 1.6(a)(2) is being amended to delete the phrase "unless the date of deposit is a Saturday, Sunday or Federal holiday within the District of Columbia in which case the date stamped will be the succeeding day which is not a Saturday, Sunday or Federal holiday in the District of Columbia." Section 1.6(a)(2) now provides that even if the Office is closed because it is a Saturday, Sunday or Federal holiday in the District of Columbia, correspondence deposited in the "Express Mail Post Office to Addressee" service of the USPS in accordance with § 1.10 will be considered filed on the date of deposit regardless of whether that date is Saturday, Sunday or a Federal holiday within the District of Columbia. Therefore, in light of the option to file an application under § 1.10 on any day and the amendment to § 1.6(a)(2), no substantive rights would be at risk, and the suggestions, set forth in the comments and noted above, have not been adopted.

*Comment 9:* Several comments objected to the requirement set forth in proposed § 1.10(b) which required deposit of Express Mail correspondence directly with the United States Postal

Service (USPS) to ensure that a copy of the Express Mail label marked with the "date in" is received at the time of deposit. The reasons generally expressed by commenters were: (1) Practitioners and applicants feel compelled to oversee the work of the USPS employee to make certain that the "date in" is marked accurately, legibly and in a timely fashion and perceive a loss of control over the filing of the document under § 1.10 as a result; (2) inefficiency and burden are imposed upon persons filing who must actually go to the post office, stand in line and generally be confined to fewer hours during the day to deposit the Express Mail correspondence directly with the USPS than the hours available for deposit in the Express Mail drop box; and (3) inequality of opportunity to deposit directly with the USPS for individual practitioners and small firms which employ fewer people than larger firms to handle. Two comments questioned the Office's use of the term "deposit" and whether the Office exceeded any authority in the perceived understanding that the proposed rule was requiring the applicants or practitioners to do something beyond "depositing" the correspondence with the USPS, namely, overseeing the act of acceptance of the Express Mail correspondence by the USPS.

*Response:* Section 1.10(b) has been amended so that direct deposit of correspondence with the USPS is a recommendation, rather than a requirement. While the Office strongly urges direct deposit of Express Mail correspondence in order to obtain a legible copy of the Express Mail mailing label, parties are not precluded from using Express Mail drop boxes. Parties who do use drop boxes can protect themselves from uncertainty due to illegible mailing labels by routinely maintaining a log of Express Mail deposits in which notations are entered by the person who deposited the correspondence as Express Mail within one business day after deposit with the USPS in a petition filed under § 1.10 (c), (d) or (e). Evidence that came into being within one day after the deposit of the correspondence as Express Mail may be in the form of a log book which contains information such as the Express Mail number; the application number, attorney docket number or other such file identification number; the place, date and time of deposit; the time of the last scheduled pick-up for that date and place of deposit; the depositor's initials or signature; and the date and time of entry in the log. Any statement submitted in support of such a showing

must be verified if made by a person other than an employee of the USPS or a practitioner as defined in § 10.1(r) of this chapter.

*Comment 10:* Several comments opposed the elimination of the certificate of mailing by "Express Mail" because it would eliminate a reliable mode of proving the date of deposit with the USPS.

*Response:* The elimination of the requirement for the certificate of mailing is adopted primarily to streamline the Office's processing of Express Mail correspondence. Under the old rule, the Office was required to scrutinize the certificate as well as the Express Mail label. Under the new rule, the "date in" on the Express Mail label would be the only date that the Office would look for to determine the filing date. Under the prior rule, the certificate of mailing by Express Mail only served as proof of a date of deposit when the certificate date was the same as the "date in" on the Express Mail label. The certificate did not afford protection to an applicant in the event that the certificate date differed from the Express Mail label date. Therefore, the elimination of the certificate of mailing requirement would not eliminate a reliable mode of proving the date of deposit.

*Comment 11:* Four comments suggested allowing Express Mail Corporate Account Mailing Statement of the USPS to serve as additional proof of the date of deposit.

*Response:* This suggestion has been adopted. Such records would be acceptable as additional proof of the date of deposit.

*Comment 12:* One comment requested clarification concerning whether deposit of correspondence as Express Mail in the Express Mail drop box must be done prior to the last scheduled pickup of the day in order to be entitled to the deposit date as the filing date of the correspondence.

*Response:* Correspondence sent by the "Express Mail Post Office to Addressee" service is considered filed in the Office on the "date-in" entered by the USPS. Accordingly, if the USPS enters the deposit date as its "date-in," the correspondence will receive the deposit date as its filing date. However, if the USPS enters a date later than the deposit date as its "date-in," the correspondence will receive the later date as its filing date. Section 1.10(d) permits the Office to correct a USPS "date-in" error when the correspondence is deposited in an Express Mail drop box prior to last scheduled pick up of the day, that is, the time clearly marked on the Express Mail drop box indicating when the box



will be cleared for the last time on the date of deposit. Section 1.10(d) sets forth the procedures to be followed to be entitled to such a correction.

#### Other Considerations

The rule changes are in conformity with the requirements of the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*), Executive Order 12612, and the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*). This rule has been determined to not be significant for the purposes of Executive Order 12866.

The Office has determined that this rule change has no Federalism implications affecting the relationship between the National Government and the States as outlined in Executive Order 12612.

The Assistant General Counsel for Legislation and Regulation of the Department of Commerce has certified to the Chief Counsel for Advocacy, Small Business Administration, that the rule changes would not have a significant impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)). The rule change has no effect on patent fees.

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.

This rule change contains a collection of information subject to the requirements of the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*), which is currently approved by the Office of Management and Budget under Control No. 0651-0031. The public reporting burden for the certificate of mailing is estimated to average six minutes per response, including the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed, and completing and reviewing the collection of information. Send comments regarding this burden estimate or any other aspect of this collection of information, including suggestions for reducing this burden to the Office of System Quality and Enhancement Division, Patent and Trademark Office, Washington, D.C. 20231, and to the Office of Information and Regulatory Affairs, Office of Management and Budget, Washington, DC 20503. (ATTN: Paperwork Reduction Act Project 0651-0031).

#### List of Subjects

##### 37 CFR Part 1

Administrative practice and procedure, Freedom of information, Inventions and patents, Reporting and record keeping requirements.

##### 37 CFR Part 2

Administrative practice and procedure, Courts, Lawyers, Trademarks.

##### 37 CFR Part 5

Classified information, Foreign relations, Inventions and patents.

##### 37 CFR Part 10

Administrative practice and procedure, Conflicts of interest, Courts, Inventions and patents, Lawyers.

For the reasons set forth in the preamble and under the authority granted to the Commissioner of Patents and Trademarks by 35 U.S.C. 6 and 15 U.S.C. 1123, 37 CFR Parts 1, 2, 5 and 10 are 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. 6, unless otherwise noted.

2. Section 1.1 is amended by removing and reserving paragraph (g) and by revising the heading and paragraph (a) to read as follows:

##### § 1.1 Addresses for correspondence with the Patent and Trademark Office.

(a) Except for § 1.1(a)(3) (i) and (ii), all correspondence intended for the Patent and Trademark Office must be addressed to either "Commissioner of Patents and Trademarks, Washington, D.C. 20231" or to specific areas within the Office as set out in paragraphs (a) (1), (2) and (3)(iii) of this section. When appropriate, correspondence should also be marked for the attention of a particular office or individual.

(1) *Patent correspondence.* All correspondence concerning patent matters processed by organizations reporting to the Assistant Commissioner for Patents should be addressed to "Assistant Commissioner for Patents, Washington, D.C. 20231."

(2) *Trademark correspondence.* All correspondence concerning trademark matters, except for trademark-related documents sent to the Assignment Division for recordation and requests for certified and uncertified copies of trademark application and registration documents, should be addressed to "Assistant Commissioner for

Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513." This includes correspondence intended for the Trademark Trial and Appeal Board.

##### (3) Office of Solicitor correspondence.

(i) Correspondence relating to pending litigation required by court rule or order to be served on the Solicitor shall be hand-delivered to the Office of the Solicitor or shall be mailed to: Office of the Solicitor, P.O. Box 15667, Arlington, Virginia 22215; or such other address as may be designated in writing in the litigation. See §§ 1.302(c) and 2.145(b)(3) for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.

(ii) Correspondence relating to disciplinary proceedings pending before an Administrative Law Judge or the Commissioner shall be mailed to: Office of the Solicitor, P.O. Box 16116, Arlington, Virginia 22215.

(iii) All other correspondence to the Office of the Solicitor shall be addressed to: Box 8, Commissioner of Patents and Trademarks, Washington, D.C. 20231.

(iv) Correspondence improperly addressed to a Post Office Box specified in paragraphs (a)(3) (i) and (ii) of this section will not be filed elsewhere in the Patent and Trademark Office, and may be returned.

\* \* \* \* \*

(g) [Reserved]

\* \* \* \* \*

3. Section 1.3 is revised to read as follows:

##### § 1.3 Business to be conducted with decorum and courtesy.

Applicants and their attorneys or agents are required to conduct their business with the Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Commissioner and will be returned by the Commissioner's direct order. Complaints against examiners and other employees must be made in correspondence separate from other papers.

4. Section 1.5 is amended by revising paragraph (a) to read as follows:

##### § 1.5 Identification of application, patent, or registration.

(a) No correspondence relating to an application should be filed prior to receipt of the application number from the Patent and Trademark Office. When a letter directed to the Patent and Trademark Office concerns a previously filed application for a patent, it must identify on the top page in a conspicuous location, the application number (consisting of the series code and the serial number; e.g., 07/123,456),



or the serial number and filing date assigned to that application by the Patent and Trademark Office, or the international application number of the international application. Any correspondence not containing such identification will be returned to the sender where a return address is available. The returned correspondence will be accompanied by a cover letter which will indicate to the sender that if the returned correspondence is resubmitted to the Patent and Trademark Office within two weeks of the mailing date on the cover letter, the original date of receipt of the correspondence will be considered by the Patent and Trademark Office as the date of receipt of the correspondence. Applicants may use either the Certificate of Mailing or Transmission procedure under § 1.8 or the Express Mail procedure under § 1.10 for resubmissions of returned correspondence if they desire to have the benefit of the date of deposit with the United States Postal Service. If the returned correspondence is not resubmitted within the two-week period, the date of receipt of the resubmission will be considered to be the date of receipt of the correspondence. The two-week period to resubmit the returned correspondence will not be extended. In addition to the application number, all letters directed to the Patent and Trademark Office concerning applications for patents should also state the name of the applicant, the title of the invention, the date of filing the same, and, if known, the group art unit or other unit within the Patent and Trademark Office responsible for considering the letter and the name of the examiner or other person to which it has been assigned.

\* \* \* \* \*

5. Section 1.6 is amended by revising paragraph (a) to read as follows:

**§ 1.6 Receipt of correspondence.**

(a) *Date of receipt and Express Mail date of deposit.* Correspondence received in the Patent and Trademark Office is stamped with the date of receipt except as follows:

(1) The Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday or Federal holiday within the District of Columbia. Except for correspondence transmitted by facsimile as provided for in paragraph (a)(3) of this section, no correspondence is received in the Patent and Trademark Office on Saturdays, Sundays or Federal holidays within the District of Columbia.

(2) Correspondence filed in accordance with § 1.10 will be stamped with the date of deposit as "Express Mail" with the United States Postal Service.

(3) Correspondence transmitted by facsimile to the Patent and Trademark Office will be stamped with the date on which the complete transmission is received in the Patent and Trademark Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

\* \* \* \* \*

6. Section 1.8 is amended by revising paragraphs (a)(1)(i)(A) and (a)(2)(ii) to read as follows:

**§ 1.8 Certificate of mailing or transmission.**

(a) \* \* \*

(1) \* \* \*

(i) \* \* \*

(A) Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail; or

\* \* \* \* \*

(2) \* \* \*

(i) \* \* \*

(ii) Relative to Trademark Registrations and Trademark Applications:

(A) The filing of a trademark application.

(B) [Reserved]

(C) [Reserved]

(D) [Reserved]

(E) [Reserved]

(F) [Reserved]

\* \* \* \* \*

7. Section 1.9 is amended by adding a new paragraph (h) to read as follows:

**§ 1.9 Definitions.**

\* \* \* \* \*

(h) A *Federal holiday within the District of Columbia* as used in this chapter means any day, except Saturdays and Sundays, when the Patent and Trademark Office is officially closed for business for the entire day.

8. Section 1.10 is revised to read as follows:

**§ 1.10 Filing of correspondence by "Express Mail."**

(a) Any correspondence received by the Patent and Trademark Office (Office) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed in the Office on the date of deposit with the USPS. The date of deposit with the USPS is shown by

the "date-in" on the "Express Mail" mailing label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the Office receipt date as the filing date. See § 1.6(a).

(b) Correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the "Express Mail" mailing label with the "date-in" clearly marked. Persons dealing indirectly with the employees of the USPS (such as by deposit in an "Express Mail" drop box) do so at the risk of not receiving a copy of the "Express Mail" mailing label with the desired "date-in" clearly marked. The paper(s) or fee(s) that constitute the correspondence should also include the "Express Mail" mailing label number thereon. See paragraphs (c), (d) and (e) of this section.

(c) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Commissioner to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;" and

(3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of deposit.

(d) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Commissioner to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and

(3) The petition includes a showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS. Any statement submitted in support of such a showing pursuant to this paragraph must be a verified statement if made by a person other than an employee of the USPS or a practitioner as defined in § 10.1(r) of this chapter.

(e) Any person mailing correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS but not received by the Office, may petition the Commissioner to consider such correspondence filed in the Office on the USPS deposit date, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail";

(3) The petition includes a copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section that the requested filing date was the date the correspondence was deposited in "Express Mail Post

Office to Addressee" service prior to the last scheduled pickup for that day; and

(4) The petition includes a statement which establishes, to the satisfaction of the Commissioner, the original deposit of the correspondence, and that the copies of the correspondence, the copy of the "Express Mail" mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence and original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS. Such statement must be a verified statement if made by a person other than a practitioner as defined in § 10.1(r) of this chapter.

(f) The Office may require additional evidence to determine if the correspondence was deposited as "Express Mail" with the USPS on the date in question.

## PART 2—RULES OF PRACTICE IN TRADEMARK CASES

9. The authority citation for 37 CFR Part 2 continues to read as follows:

Authority: 15 U.S.C. 1123; 35 U.S.C. 6, unless otherwise noted.

10. Section 2.165(a)(1) is revised to read as follows:

### § 2.165 Reconsideration of affidavit or declaration.

(a)(1) If the affidavit or declaration filed pursuant to § 2.162 is insufficient or defective, the affidavit or declaration will be refused and the registrant will be notified of the reason. Reconsideration of the refusal may be requested within six months from the date of the mailing of the action. The request for reconsideration must state the grounds for the request. A supplemental or substitute affidavit or declaration required by section 8 of the Act of 1946 cannot be considered unless it is filed before the expiration of six years from the date of the registration or from the date of publication under section 12(c) of the Act.

\* \* \* \* \*

## PART 5—SECRECY OF CERTAIN INVENTIONS AND LICENSES TO EXPORT AND FILE APPLICATIONS IN FOREIGN COUNTRIES

11. The authority citation for 37 CFR Part 5 continues to read as follows:

Authority: 35 U.S.C. 6, 41, 181–188, as amended by the Patent Law Foreign Filing Amendments Act of 1988, Pub. L. 100–418, 102 Stat. 1567; the Arms Export Control Act, as amended, 22 U.S.C. 2751 et seq., the Atomic Energy Act of 1954, as amended, 42 U.S.C. 2011 et seq., and the Nuclear Non-Proliferation Act of 1978, 22 U.S.C. 3201 et

seq., and the delegations in the regulations under these acts to the Commissioner (15 CFR 370.10(j), 22 CFR 125.04, and 10 CFR 810.7).

12. Section 5.33 is revised to read as follows:

### § 5.33 Correspondence.

All correspondence in connection with this part, including petitions, should be addressed to "Assistant Commissioner for Patents (Attention: Licensing and Review), Washington, D.C. 20231."

## PART 10—REPRESENTATION OF OTHERS BEFORE THE PATENT AND TRADEMARK OFFICE

13. The authority citation for 37 CFR Part 10 continues to read as follows:

Authority: 5 U.S.C. 500; 15 U.S.C. 1123; 35 U.S.C. 6, 31, 32, 41.

14. Section 10.23 is amended by revising paragraph (c)(9) to read as follows:

### § 10.23 Misconduct.

\* \* \* \* \*

(c) \* \* \*  
(9) Knowingly misusing a "Certificate of Mailing or Transmission" under § 1.8 of this chapter.

\* \* \* \* \*

Dated: October 24, 1996.

Bruce A. Lehman,

*Assistant Secretary of Commerce and  
Commissioner of Patents and Trademarks.*

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## DEPARTMENT OF VETERANS AFFAIRS

### 38 CFR Part 2

RIN 2900–AI17

### Delegations of Authority; Nonsubstantive Miscellaneous Changes

AGENCY: Department of Veterans Affairs.  
ACTION: Final rule.

**SUMMARY:** This document amends the Department of Veterans Affairs (VA) regulations on delegation of authority to authorize Directors of Department of Veterans Affairs property and facilities under the charge and control of the Department of Veterans Affairs to appoint police officers with power to enforce Federal laws and Department of Veterans Affairs regulations, to investigate violations of those laws and to arrest for crimes committed on Department of Veterans Affairs property