

DEPARTMENT OF COMMERCE**Patent and Trademark Office****37 CFR Parts 1 and 5**

[Docket No.: 000308065-0065-01]

RIN 0651-AB05

Changes To Implement Eighteen-Month Publication of Patent Applications**AGENCY:** United States Patent and Trademark Office, Commerce.**ACTION:** Notice of proposed rulemaking.

SUMMARY: The United States Patent and Trademark Office (Office) is proposing changes to the rules of practice in patent cases to implement certain provisions of the "American Inventors Protection Act of 1999." These provisions of the "American Inventors Protection Act of 1999" provide, with certain exceptions, for the publication of pending patent applications (other than for a design patent) at eighteen months from the earliest claimed priority date.

DATES: *Comment Deadline Date:* To be ensured of consideration, written comments must be received on or before May 22, 2000. No public hearing will be held.

ADDRESSES: Comments should be sent by electronic mail message via the Internet addressed to pregrantpub.comments@uspto.gov. Comments may also be submitted by mail addressed to: Box Comments—Patents, Assistant Commissioner for Patents, Washington, D.C. 20231, or by facsimile to (703) 872-9411, marked to the attention of Robert W. Bahr. Although comments may be submitted by mail or facsimile, the Office prefers to receive comments via the Internet. If comments are submitted by mail, the Office would prefer that the comments be submitted on a DOS formatted 3½ inch disk accompanied by a paper copy.

The comments will be available for public inspection at the Special Program Law Office, Office of the Deputy Assistant Commissioner for Patent Policy and Projects, located at Room 3-C23 of Crystal Plaza 4, 2201 South Clark Place, Arlington, Virginia, and will be available through anonymous file transfer protocol (ftp) via the Internet (address: <http://www.uspto.gov>). Since comments will be made available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included in the comments.

FOR FURTHER INFORMATION CONTACT:

Concerning this notice of proposed rulemaking: Robert W. Bahr, Karin L.

Tyson, or Robert A. Clarke by telephone at (703) 308-6906, or by mail addressed to: Box Comments—Patents, Assistant Commissioner for Patents, Washington, D.C. 20231, or by facsimile to (703) 872-9411, marked to the attention of Robert W. Bahr.

Concerning the electronic filing system (EFS): Jay Lucas or Michael Lewis by electronic mail message via the Internet addressed to jay.lucas@uspto.gov.

SUPPLEMENTARY INFORMATION: The "American Inventors Protection Act of 1999" (Title IV of the "Intellectual Property and Communications Omnibus Reform Act of 1999" (S. 1948) as introduced in the 106th Congress on November 17, 1999) was incorporated and enacted into law on November 29, 1999, by § 1000(a)(9), Division B, of Public Law 106-113, 113 Stat. 1501 (1999). The "American Inventors Protection Act of 1999" contains a number of changes to title 35, United States Code. This notice proposes changes to the rules of practice to implement the provisions of §§ 4501 through 4508 (Subtitle E, Domestic Publication of Patent Applications Published Abroad) of the "American Inventors Protection Act of 1999." These provisions of the "American Inventors Protection Act of 1999" provide that, with certain exceptions, applications for patent shall be published promptly after the expiration of a period of eighteen months from the earliest filing date for which a benefit is sought under title 35, United States Code ("eighteen-month publication").

Section 4502 of the "American Inventors Protection Act of 1999" amends 35 U.S.C. 122 (35 U.S.C. 122(b)) to provide that applications for patent shall be published promptly after the expiration of a period of eighteen months from the earliest filing date for which a benefit is sought under title 35, United States Code, and that an application may be published earlier than the end of such eighteen-month period at the request of the applicant. Section 4502 of the "American Inventors Protection Act of 1999" (35 U.S.C. 122(b)) also contains a number of exceptions to eighteen-month publication of patent applications.

First: An application shall not be published if it is: (1) no longer pending; (2) subject to a secrecy order under 35 U.S.C. 181 or an application for which publication or disclosure would be detrimental to national security; (3) a provisional application under 35 U.S.C. 111(b); or (4) an application for a design patent under 35 U.S.C. chapter 16. See 35 U.S.C. 122(b)(2)(A) and (d).

Second: An application shall not be published if an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires eighteen-month publication. An applicant may rescind such a request at any time. In addition, an applicant who has made such a request but who subsequently files an application directed to the invention disclosed in the application filed in the Office in a foreign country, or under a multilateral international agreement, that requires eighteen-month publication, must notify the Office of such filing within forty-five days after the date of the filing of such foreign or international application. An applicant's failure to timely provide such a notice to the Office will result in abandonment of the application (subject to revival if it is shown that the delay in submitting the notice was unintentional). If an applicant rescinds such a request or notifies the Office that an application was filed in a foreign country or under a multilateral international agreement that requires eighteen-month publication, the application is subject to eighteen-month publication. See 35 U.S.C. 122(b)(2)(B)(i)-(iv).

Third: If an applicant has filed applications in one or more foreign countries, directly or through a multilateral international agreement, and such foreign-filed applications or the description of the invention in such foreign-filed applications is less extensive than the application or description of the invention in the application filed in the Office, the applicant may submit a redacted copy of the application filed in the Office eliminating any part or description of the invention in such application that is not also contained in any of the corresponding applications filed in a foreign country. The Office may only publish the redacted copy of the application unless the redacted copy of the application is not received within sixteen months after the earliest filing date for which a benefit is sought under title 35, United States Code. See 35 U.S.C. 122(b)(2)(B)(v).

Section 4503(a) of the "American Inventors Protection Act of 1999" amends 35 U.S.C. 119(b) to provide that no application for patent shall be entitled to a right of priority under 35 U.S.C. 119(a)-(d) unless a claim is filed in the Office, identifying the foreign application by specifying the application number of that foreign application, the intellectual property

authority or country in or for which the application was filed, and the date of filing the application, at such time during the pendency of the application as required by the Director. Section 4503(a) of the "American Inventors Protection Act of 1999" also amends 35 U.S.C. 119(b) to provide that the Director may consider the failure of the applicant to file a timely claim for priority as a waiver of any such claim, and may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed claim under 35 U.S.C. 119(b)-(d). Section 4503(a) of the "American Inventors Protection Act of 1999" also amends 35 U.S.C. 119(b) to authorize the Director to determine whether to require a certified copy of the original foreign application.

Section 4503(b)(1) of the "American Inventors Protection Act of 1999" amends 35 U.S.C. 120 to provide that no application shall be entitled to the benefit of an earlier filed application under 35 U.S.C. 120 unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. Section 4503(b)(1) of the "American Inventors Protection Act of 1999" also amends 35 U.S.C. 120 to provide that the Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under 35 U.S.C. 120, and may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under 35 U.S.C. 120.

Section 4503(b)(2) of the "American Inventors Protection Act of 1999" amends 35 U.S.C. 119(e) to provide that no application shall be entitled to the benefit of an earlier filed provisional application under 35 U.S.C. 119(e) unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. Section 4503(b)(2) of the "American Inventors Protection Act of 1999" also amends 35 U.S.C. 119(e) to provide that the Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under 35 U.S.C. 119(e), and the Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under 35 U.S.C. 119(e) during the pendency of the application.

Case law has indicated that, in certain instances, priority claims may be perfected after issuance. The U.S. Court of Appeals for the District of Columbia

has held that the equitable or remedial provisions of 35 U.S.C. 251 authorize patentees to correct or perfect a claim for priority under 35 U.S.C. 119 in an issued patent by reissue. *See Brenner v. State of Israel*, 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968). The U.S. District Court for the District of Columbia applied this rationale to permit a patentee to amend an intermediate abandoned application in a chain of applications for which a benefit was claimed under 35 U.S.C. 120 to include the specific reference required by 35 U.S.C. 120. *See Sampson v. Commissioner*, 195 USPQ 136 (D.D.C. 1976). In appropriate circumstances, the Office has permitted patentees to state claims under 35 U.S.C. 119, 120 or 121 in an issued patent by certificate of correction under 35 U.S.C. 255 and § 1.323. *See In re Schuurs*, 218 USPQ 443 (Comm'r Pat. 1983); *In re Lambrecht*, 202 USPQ 620 (Comm'r Pat. 1976); *In re Van Esdonk*, 187 USPQ 671 (Comm'r Pat. 1975).

The amendments to 35 U.S.C. 119 and 120 provide that the Director may consider the failure of the applicant to file a timely claim under 35 U.S.C. 119 or 120 as a waiver of any such claim. Sections 1.55 and 1.78 as proposed implement these amendments to 35 U.S.C. 119 and 120 by specifying time periods during the pendency of the application within which claims under 35 U.S.C. 119(a)-(d), 119(e), and 120 must be stated (or are considered waived). 35 U.S.C. 119(b), 119(e), and 120 each provide that the Director may establish procedures to accept an unintentionally delayed submission of a claim under 35 U.S.C. 119(b), 119(e), or 120 (respectively); however, 35 U.S.C. 119(e) requires that such unintentionally delayed claim (amendment) be submitted during the pendency of the application. Thus, a claim under 35 U.S.C. 119(a)-(d) or 120 for the benefit of a prior application may be added (or corrected) in an issued patent by reissue or certificate of correction (assuming the conditions for reissue or certificate of correction are otherwise met) by submitting such untimely claim under the procedures established in § 1.55 or § 1.78 (including payment of any applicable surcharge). A claim under 35 U.S.C. 119(e) for the benefit of a prior provisional application, however, must be added or corrected during the pendency of the application.

Section 4504 of the "American Inventors Protection Act of 1999" amends 35 U.S.C. 154 to provide that, subject to a number of conditions, a patent includes the right to obtain a reasonable royalty during the period

beginning on the date of publication of the application for such patent under 35 U.S.C. 122(b) (or the date of publication under Patent Cooperation Treaty (PCT) Article 21(2) of an international application designating the United States) and ending on the date the patent is issued ("provisional rights").

Section 4505 of the "American Inventors Protection Act of 1999" amends 35 U.S.C. 102(e) to, *inter alia*, set forth the conditions under which an application published under 35 U.S.C. 122(b) or under PCT Article 21(2) is prior art as of its filing date.

Section 4506 of the "American Inventors Protection Act of 1999" provides that the Office shall recover the cost of early publication required by 35 U.S.C. 122(b) by charging a separate publication fee after a notice of allowance is given under 35 U.S.C. 151.

Section 4508 of the "American Inventors Protection Act of 1999" provides that its eighteen-month publication provisions take effect on November 29, 2000, and apply to applications (other than for a design patent) filed under 35 U.S.C. 111(a) on or after November 29, 2000, and to applications in compliance with 35 U.S.C. 371 that resulted from international applications filed under 35 U.S.C. 363 on or after November 29, 2000.

In August of 1995, the Office published a notice of proposed rulemaking to implement legislation pending before the 104th Congress that (if enacted) would have provided for the eighteen-month publication of pending patent applications. *See Changes to Implement 18-Month Publication of Patent Applications*, Notice of Proposed Rulemaking, 60 FR 42352 (August 15, 1995), 1177 *Off. Gaz. Pat. Office* 61 (August 15, 1995). The Office is now publishing a notice of proposed rulemaking, rather than simply adopting changes based upon the notice of proposed rulemaking published in 1995, because: (1) The eighteen-month publication provisions of the "American Inventors Protection Act of 1999" are different from those pending before the 104th Congress; and (2) the Office's planning approach to implementing eighteen-month publication is different from its 1995 planning approach. The Office's current planning approach to eighteen-month publication includes: (1) Disseminating a publication document (patent application publication) for each published application; and (2) providing (under conditions set forth below) any member of the public with access to the file wrapper and contents of each published application (which may be limited to a

copy of the file wrapper and contents of the application).

Patent application publication: The patent application publication will include a front page containing information similar to that contained on the front page of a patent, and the drawings (if any) and specification (including claims) of the published application. To create the patent application publication, the Office plans to use its Patent Application Capture and Review (PACR) system to create an electronic database (PACR database) containing: (1) The application papers and drawings deposited on the filing date of the application; and (2) any subsequently filed application papers and drawings needed to create the patent application publication. The application information contained in the Office's PACR database will be used to create the patent application publication, unless the applicant provides a copy of the application via the Office's electronic filing system (EFS) to be used to create the patent application publication (discussed below).

The Office currently uses the PACR database as the Office's record of the application papers submitted on the filing date of the application (*i.e.*, the original disclosure of the invention). The application papers submitted on the filing date of the application, however, may not include the content needed (*e.g.*, an abstract), and the application papers or drawings may not be of sufficient quality (*e.g.*, papers not having sufficient contrast to permit electronic capture by digital imaging and conversion to text by optical character recognition or drawings not having sufficient quality) to be used, to create a patent application publication. Since the patent application publication will be a prior art document (and, in most cases, the prior art document having the earliest effective date under 35 U.S.C. 102(a), (b), and (e)), the Office must consider the usability of the patent application publication as a prior art document when determining what drawing quality is needed to create the patent application publication.

If the application papers submitted on the filing date of the application do not include the content needed, or the application papers or drawings are not of sufficient quality to be used, to create a patent application publication, the Office of Initial Patent Examination (OIPE) will issue a notice requiring that the applicant submit the needed application content, or application papers or drawings of sufficient quality, for use in creating a patent application publication. The applicant's reply to

that notice (application papers and drawings needed to create the patent application publication) will then be added to the PACR database. The Office must separate the application papers and drawings deposited on the filing date of the application and the subsequently filed application papers and drawings in its PACR database because the PACR database is also used to create any requested certified copy of the application (which may only include the application papers and drawings deposited on the filing date of the application).

Initially, an application filed under 35 U.S.C. 111(a) (nonprovisional) must be entitled to a filing date (*i.e.*, contains a written description of the invention, a drawing (if necessary for an understanding of the invention), and at least one claim) for the application to be in condition for publication. In addition, if an application filed under 35 U.S.C. 111(a) otherwise entitled to a filing date appears to omit a portion of the description or a drawing figure, the omitted portion of the description or drawing figure(s) must be supplied, or the period for supplying such portion of the description or drawing figure(s) must have expired, for the application to be in condition for publication. The requirements for an application filed under 35 U.S.C. 111(a) to be entitled to a filing date and the treatment of an application filed under 35 U.S.C. 111(a) that appears to omit a portion of the description or a drawing figure is set forth in sections 601.01(d) through 601.01(g) of the *Manual of Patent Examining Procedure* (7th ed. 1998) (MPEP).

In addition, an application filed under 35 U.S.C. 111(a) must include an executed oath or declaration (§ 1.63), an abstract (§ 1.72(b)), and an English translation (if filed in a language other than English), for the application to have the content necessary to create the patent application publication. For eighteen-month publication purposes, the oath or declaration must at a minimum: (1) Name each inventor at least by a family and given name; and (2) be signed by each inventor or a party qualified to sign under §§ 1.42, 1.43, or 1.47 in compliance with § 1.64. Finally, an application filed under 35 U.S.C. 111(a) will not be published until the basic filing fee (§ 1.16(a) or (g)) is paid.

A PCT international application must satisfy the requirements of 35 U.S.C. 371 to be subject to eighteen-month publication under 35 U.S.C. 122(b) (and to have the content necessary to create the patent application publication).

Even if an application has the content necessary to create the patent

application publication, the application papers and drawings must also be reviewed to determine whether they are of sufficient quality to be used in creating the patent application publication. To be of sufficient quality to create the patent application publication, the specification must be on sheets of paper that: (1) Are flexible, strong, smooth, non-shiny, durable, and white; (2) are either A4 (21 cm x 29.7 cm) or 8½" x 11" with each sheet having a left margin of at least 2.5 cm (1") and top, bottom and right margins of at least 2.0 cm (¾"); (3) are written on one side only in portrait orientation; (4) are plainly and legibly written either by a typewriter or machine printer in permanent dark ink or its equivalent; (5) have lines that are either 1½ or double-spaced; and (6) have sufficient clarity and contrast between the paper and the writing on the paper to permit direct reproduction and electronic capture by digital imaging and optical character recognition. These quality standards and requirements are currently set forth in § 1.52(a) and (b). In addition, the title must meet the character type and length requirements of § 1.72(a); the abstract must commence on a separate sheet and meet the word-length requirement of § 1.72(b); the claims must commence on a separate sheet; and the sequence listing (if applicable) must comply with §§ 1.821 through 1.825.

As discussed above, the Office must consider not only whether drawings are of sufficient quality to create a publication (the patent application publication), but whether they are sufficient for the publication to be routinely used as a prior art document. Thus, the drawing sheets (if drawings are included) must comply with the following requirements of § 1.84. Drawings must be done in dark ink (not pencil), except where color drawings or photographs are permitted. Photographs (or photomicrographs) are not permitted unless they are reproducible and the invention cannot be clearly illustrated in an ink drawing. See *Interim Waiver of 37 C.F.R. § 1.84(b)(1) for Petitions to Accept Black and White Photographs and Advance Notice of Change to M.P.E.P. § 608.02*, Notice, 1213 Off. Gaz. Pat. Office 108 (August 4, 1998). Drawing sheets must be reasonably free from erasures and must be free from alterations, overwritings, interlineations, folds, and copy marks. Drawing sheets must be either 21.0 cm by 29.7 cm (DIN size A4) or 21.6 cm by 27.9 cm (8½ by 11 inches). Each drawing sheet must include a top margin of at least 2.5 cm (1 inch), a left side margin of at least 2.5 cm (1 inch),

a right side margin of at least 1.5 cm ($\frac{5}{8}$ inch), and a bottom margin of at least 1.0 cm ($\frac{3}{8}$ inch). Lines, numbers, and letters must be clean, dark (not of poor line quality), uniformly thick, and well defined. The English alphabet must be used for letters, except where another alphabet is customarily used (such as the Greek alphabet to indicate angles, wavelengths, and mathematical formulas). Numbers, letters, and reference characters must measure at least 0.32 cm ($\frac{1}{8}$ inch) in height. Lead lines are required for each reference character (except for those which indicate the surface or cross section on which they are placed, in which case the reference character must be underlined to make it clear that a lead line has not been left out by mistake). Finally, drawing views must be numbered in consecutive Arabic numerals, starting with 1.

In September of 1996, the Office revised the standard and format requirements for the specification (including the abstract and claims), drawings, and other application papers set forth in § 1.52 and § 1.84 for the purpose of obtaining initial application papers in condition for eighteen-month publication. See *Miscellaneous Changes in Patent Practice*, Final Rule Notice, 61 FR 42790 (August 19, 1996), 1190 *Off. Gaz. Pat. Office* 67 (September 17, 1996). Applicants are advised that the Office will: (1) Begin more rigorous enforcement of the provisions of § 1.52(a) and (b) and § 1.84; and (2) no longer permit applicants to request that objections under § 1.84 be held in abeyance pending allowance of the application.

As discussed below, if applicant timely provides the Office with a copy of the application via the Patent and Trademark Office electronic filing system, the Office will use the electronic copy provided by the applicant (rather than the PACR database records) to create the patent application publication. Applicants may use this procedure to obtain inclusion of amendments submitted during prosecution in the patent application publication. Applicants must use this procedure when requesting: (1) Voluntary publication of an application; (2) republication of a previously published application; or (3) publication of only a redacted copy of an application.

The electronic filing system (EFS) is an electronic system for the submission of patent applications to the Office. The EFS encompasses the preparation of the application parts in a special manner on the applicant's computer (authoring), the assembling of the pieces of the

application so authored, and the secure communication of that application to the Office.

The EFS is currently in place as a pilot program for use by a limited number of applicants, who on a voluntary basis, file applications under the EFS program. The same EFS software must be used by applicants who wish to submit a copy of the application for the patent application publication.

The steps for submission of an electronic version of a patent application are as follows: (1) Obtaining a digital certificate; (2) obtaining the authoring and the submission software packages from the Office; (3) authoring the patent application; and (4) assembling the parts of the application, and validating, digitally signing, and submitting the application.

To file a copy of an application using the EFS, an applicant (or representative) must submit a request and receive an Office digital certificate to enable secure communication between the applicant and the Office. A digital certificate will allow the authorized person to conduct electronic filing, as well as have access to the Office's Patent Application Information Retrieval (PAIR) software to display patent application status information.

The digital certificate is given to individuals and firms that obtain a customer number, and also request the digital certificate. Instructions on how to obtain the necessary digital certificate are located at the Office's Electronic Business Center on the Office's Internet Web site (<http://www.uspto.gov>) (under the section Electronic Business Center, select New User for the PAIR system).

The Office makes its branded version of the security software product called Entrust Direct software available to authorized persons. The software operates in conjunction with an Office Public Key Infrastructure (PKI) that is secure and enables communication only between authorized persons who are registered with the Office and the Office.

A person signing up for EFS application filing receives a package with his or her digital certificate including: (1) The software that will attach a digital signature to a document or set of documents; (2) an authoring tool that will allow the applicant to convert a standard patent application into a specialized format; and (3) the electronic Packaging and Validation Engine (ePave) program that will assemble the parts of the application, validate that the parts are complete, encrypt and digitally sign them, and then send them to the Office.

The applicant is responsible for correctly authoring the electronic application, which is defined as reformatting the application into a form that complies with the requirements of XML (the standard eXtensible Markup Language of Internet authoring). The XML requires that all the pieces of information in the application (e.g., the inventor's name, title of the invention, the claims) are tagged with standard XML named tags before and after each piece of information. For example, XML could require that the title be tagged:

MAKING A WIDGET

The tagged information, in turn, is ordered and positioned on the submitted document according to the formula for that document in the document type definition (DTD). The DTD contains a list of all the tagged data elements (pieces of information) that should be on that document, and the relative positioning of the elements. When combined with the document's style sheet (which contains formatting information), the DTD will completely define what the document should contain and, when printed or viewed, what it will look like.

The applicant does the authoring using the software authoring tool given to him or her by the Office and operating on the applicant's computer. The authoring tool displays on the left of the applicant's computer screen a list of all of the data elements that should be in a patent application (according to the Office's DTD). The applicant clicks each element in the list, and when a window opens, types the information requested into the window. For example, the applicant clicks the data element "TITLE" and types "MAKING A WIDGET" when the window opens. The authoring tool will add the tags, paragraph numbers, and other elements that are required by XML. The applicant can continue through this whole process adding the required information to each of the data elements until the application is fully authored.

The applicant can also use the authoring tool to "cut and paste" a fully written application into the proper format. In this mode, the applicant will open up that written application, and also open up the authoring tool to reveal all of the data elements. When the applicant clicks the data element to reveal the data entry window, the applicant will copy the relevant section from the previously written application and paste that section into the window (for tagging by the authoring tool).

Paper copies of the oath or declaration (§ 1.63), drawings, and certain other documents are scanned on the applicant's digital scanner and stored in tagged image file format (TIFF). The TIFF is not tagged by the authoring tool, but is similar to an electronic photograph.

Using either mode, the applicant will produce a copy of the application in compliance with the Office EFS, including a specification and claims (in XML), an oath or declaration (in TIFF), and drawings (also in TIFF).

Once the various parts of the application are prepared, the applicant will use the software tool ePave to assemble those parts and submit the application to the Office. The ePave software interacts with the applicant to fill out an electronic transmittal and fee information letter. This document is developed in the tagged XML format. The applicant then uses the ePave software to associate these documents with the previously produced application.

This association of the related files to be submitted is called bundling. The bundle of files that will be sent to the Office will be compressed using Zip technology to reduce their size. Then ePave will apply the digital signature to the compressed bundle, to both indicate who is sending the package to the Office and to check the file's integrity. The digital signature process also encrypts the bundle, for safety during transmission.

Obviously, fees submitted via EFS must be by an authorization to charge the fee to a credit card or Office deposit account. Therefore, any publication fee or processing fee required for a copy of an application submitted via EFS for use in the patent application publication must be by an authorization to charge the fee to a credit card or Office deposit account.

The authoring tool and ePave software on the applicant's computer perform all of this activity almost invisibly. The applicant must enter a password to apply the digital signature, and the software will finish processing the application for submission to the Office. During the processing of a copy of an application for submission to the Office for use in a patent application publication, the applicant will be advised that the application of a digital signature constitutes a statement that the EFS copy of the application contains no new matter, and, except for a redacted copy of an application (which requires the concurrent submission of other certifications on paper), that the EFS copy of the application corresponds to the application as amended by any

amendment filed in the application. When processing is finished, the software will ask the applicant if the list of displayed files should be sent to the Office. The applicant will click or otherwise express his or her concurrence, and the EFS application files are electronically transmitted to the Office.

On receipt of the bundle of files comprising the application, the Office stores the bundle and takes it apart. The bundle is decrypted, the digital signature is checked, and the integrity of the package is confirmed. In the course of events, the Office sends an acknowledgment back to the applicant's computer listing the date and time of submission, the names and sizes of the files received, and other information to confirm the submission.

If a copy of an application being submitted to the Office for eighteen-month publication purposes contains a sequence listing, and the sequence listing is identical to a sequence listing previously submitted to the Office (*e.g.*, the sequence listing is not amended or redacted) in compliance with §§ 1.821 through 1.825, the EFS copy of the application may contain a reference to the previously filed sequence listing in lieu of a copy of the previously filed sequence listing.

Finally, EFS is currently a pilot program. The Office anticipates that EFS will be capable of receiving copies of applications for eighteen-month publication purposes on a routine basis by November 29, 2000. In the event that EFS is not capable of receiving copies of applications for eighteen-month publication purposes on a routine basis by November 29, 2000, the Office will provide for submission by paper of copies of applications for applicants requesting: (1) A patent application publication reflecting amendments to the application; (2) voluntary publication of an application; (3) republication of a previously published application; or (4) publication of only a redacted copy of an application.

Publication process: The current planning approach involves a fourteen-week publication cycle that results in the publication of patent application publications on Thursday of each week. Ideally, the publication date of an application will be the first Thursday after the date that is eighteen months after the filing date of the application, or if the application claims the benefit of an earlier filing date, the first Thursday after the date that is eighteen months after the earliest filing date for which a benefit is sought. An application, however, may not be published the first Thursday after the

date that is eighteen months after the earliest filing date for which a benefit is sought if the application is not in condition for publication approximately fourteen months after the earliest filing date for which a benefit is sought (eighteen months less the fourteen-week publication cycle).

Obviously, there are events that will delay publication of some applications until a later date: *e.g.*, (1) the application claims the benefit under 35 U.S.C. 120 of an application filed more than eighteen months before the actual filing date of the application; (2) the basic filing fee or oath (or declaration) is not provided within eighteen months after the earliest filing date for which a benefit is sought; or (3) the application does not contain papers or drawings of publication quality within eighteen months after the earliest filing date for which a benefit is sought. In such situations, the publication date of an application will be the first Thursday after the date that is fourteen weeks after the application is in condition for publication. Applicants who attempt to delay publication by intentionally delaying the submission of the application content necessary for publication, however, will encounter a reduction (under regulations established pursuant to 35 U.S.C. 154(b)(2)(C)(iii)) in any patent term adjustment under 35 U.S.C. 154(b).

The Office plans to indicate a projected publication date on the filing receipt or indicate "to be determined" if the application is not in condition for publication. If events change the projected publication date by more than two weeks (*e.g.*, claim for priority under 35 U.S.C. 119(e) presented after mailing of the filing receipt) or the application content necessary for publication is provided, the Office will issue a change notification indicating the revised projected publication date.

The publication process involves producing weekly volumes of patent application publications on a variety of media: *e.g.*, the Office's Examiner Automated Search Tool (EAST) and Web-based Examiner Search Tool (WEST) search systems, optical disk products for sale to the public, and exchange with the Office's Intellectual Property exchange partners. Patent application publications will be available for viewing by the public in the Public Search Room via an on-line search system. The Office does not plan to provide paper copies of the patent application publications for placement in either the Public Search Room or the examiners' search rooms. The Office, however, will provide paper copies of the patent application publications to

any member of the public on request (for a fee) in the manner that paper copies of patents are currently provided.

The publication process provides for: (1) Assembly of application bibliographic information for the patent application publication at fourteen weeks prior to the projected publication date; (2) assembly of the technical content (specification, including claims and abstract, and drawings) of the application for the patent application publication at nine weeks prior to the projected publication date; and (3) placing the application information as assembled into the patent application publication on publication media (e.g., optical disks, magnetic tape) at four weeks prior to the projected publication date.

Any applicant seeking to abandon the application for the purpose of avoiding publication must take appropriate action (see § 1.138 discussed below) well prior to the projected publication date. If the application is not expressly abandoned at least four weeks prior to the projected publication date, the Office will probably not be able to avoid publication of the application or at least some application information because the Office will place the application (along with the thousands of other applications being published each week) on publication media (e.g., optical disks, magnetic tape) four weeks prior to the projected date. This does not imply that a request to expressly abandon an application to avoid publication (§ 1.138) filed prior to this "four-week" time frame will ensure that the Office will be able to remove an application from publication. The Office simply cannot ensure that it can remove an application from publication or avoid publication of application information any time after the publication process for the application is initiated.

Access to the file wrapper and contents of a published application: The Office plans to permit: (1) Any member of the public to obtain (for a fee) a copy of the complete file wrapper and contents of, or a copy of a specific paper in, any published application, provided that no redacted copy was timely submitted for publication; (2) any member of the public to obtain (for a fee) an appropriately redacted copy of the file wrapper and contents of, or a copy of a specific paper in, any published application for which a redacted copy was timely submitted for publication; and (3) any member of the public to physically inspect (under the conditions that inspection of patented files is permitted) the file of any abandoned published application,

provided that no redacted copy was timely submitted for publication.

Any member of the public may obtain status information concerning any published application via the Office's PAIR system. Permitting physical inspection of pending published applications, however, would interfere with the Office's ability to act on the applications within the time frames set forth in 35 U.S.C. 154(b)(1)(A) and (B). Thus, the Office must limit public access to the file wrapper of pending published applications to obtaining a copy produced by the Office (for a fee) to avoid conferring patent term adjustment on the applicant due to actions by members of the public.

Section 4805 of the "American Inventors Protection Act of 1999" provides that the Comptroller General (in consultation with the Office) shall conduct a study and submit a report to Congress on the potential risks to the United States biotechnology industry relating to biological deposits in support of biotechnology patents, and that the Office shall consider the recommendations of such study in drafting regulations affecting biological deposits (including any modification of § 1.801 *et seq.*). Therefore, this notice does not contain any proposed amendment to § 1.801 *et seq.* concerning the treatment of biological deposits in applications subject to eighteen-month publication.

The term "Commissioner" wherever it is present in the rules of practice affected by this notice is proposed to be changed to "Director" for consistency with § 4732 of the "American Inventors Protection Act of 1999." The provisions of the rules of practice not involved in this notice will be revised for consistency with § 4732 of the "American Inventors Protection Act of 1999" in due course.

Finally, the Office proposed a number of changes to the rules of practice in a rulemaking to support the Patent Business Goals. See *Changes to Implement the Patent Business Goals*, Notice of Proposed Rulemaking, 64 FR 53772 (October 4, 1999), 1228 *Off. Gaz. Pat. Office* 15 (November 2, 1999). The Office indicated in the Patent Business Goals Notice of Proposed Rulemaking that it would have to reconsider its business processes and make such further changes to the rules of practice as are necessary in the event of enactment of patent legislation. See *Id.* Sections 1.9, 1.14, 1.17, 1.55, 1.72, 1.78, 1.89, 1.131, 1.132, 1.137, 1.138, 1.311, and 5.1 as proposed to be amended in this notice also reflect changes proposed in the Patent Business Goals Notice of Proposed Rulemaking.

Discussion of Specific Rules

Title 37 of the Code of Federal Regulations, Parts 1 and 5, are proposed to be amended as follows:

Section 1.9: Section 1.9(c) is proposed to be amended to define a published application as used in 37 CFR chapter I to mean an application for patent which has been published under 35 U.S.C. 122(b).

Section 1.9 as proposed also reflects changes proposed in the Patent Business Goals Notice of Proposed Rulemaking.

Section 1.11: Section 1.11(a) is proposed to be amended to include the file of an abandoned published application (except if a redacted copy of the application was used for the patent application publication) among the files that are open to inspection by the public.

Section 1.12: Section 1.12(a)(1) is proposed to be amended to include the assignment records of a published patent application among the patent assignment records that are available to the public. Section 1.12(b) is proposed to be amended to provide the patent assignment records, digests, and indexes that are available to the public unless they relate to pending or abandoned patent applications that have not been published under 35 U.S.C. 122(b).

Section 1.13: Section 1.13 is proposed to be amended to include patent application publications among the records of the United States Patent and Trademark Office that are open to the public, and of which a copy (certified or uncertified) will be furnished (upon payment of the fee therefor).

Section 1.14: Section 1.14(a) is proposed to be amended to generally maintain the confidentiality of applications that have not been published as a U.S. patent application publication (see 35 U.S.C. 122(b)) pursuant to 35 U.S.C. 122(a). Status information is defined to include identification of whether the application has been published under 35 U.S.C. 122(b), as well as whether the application is pending, abandoned, or patented, and the application numerical identifier.

Section 1.14(b) is proposed to be amended to provide that status information may also be supplied when the application is referred to by its numerical identifier in a U.S. patent application publication as well as a U.S. patent or a published international application. Section 1.14(b) is also proposed to be amended to provide that status information may be supplied for an application which claims the benefit of the filing date of an application for which status information may be

supplied. As a result, the public will be able to obtain continuity data for applications that have been published as a U.S. patent application publication or as a U.S. patent.

Section 1.14(c)(1) as proposed provides that a copy of an application-as-filed or a file wrapper and contents may be supplied where the appropriate fee is paid, and: (1) the application is incorporated by reference in a U.S. patent application publication or U.S. patent; or (2) the application is relied upon for priority under 35 U.S.C. 119(e) or 120 in a U.S. patent application publication or U.S. patent.

Section 1.14(c)(2) as proposed provides that copies of the file wrapper and contents of an application are available to the public when the application has been published as a U.S. patent application publication.

Section 1.14(e) is proposed to be amended to provide public access to an abandoned application that is referenced in a U.S. patent application publication as well as a U.S. patent, or another application that is open to public inspection.

Section 1.14(i) is proposed to provide for greater access to international application files kept by the Office. Specifically, 35 U.S.C. 374 equates the publication under the PCT of an international application designating the U.S. to the publication of a U.S. application under 35 U.S.C. 122(b). As a result of the publication under 35 U.S.C. 122(b) of applications having an international filing date on or after November 29, 2000, the Office will make available copies of the application files and also allow for access to those files in accordance with § 1.14(c) and (e), respectively. Therefore, after publication of an international application having an international filing date on or after November 29, 2000, and designating the U.S. under PCT Article 21, the Office will make available copies of, and allow access to, those international application files which are kept in the Office (the Home, Search, and Examination Copies) to the extent permitted under the PCT. Additionally, § 1.14(i)(2) provides that copies of English language translations of international applications, which were published in a non-English language and which designated the U.S., and which have been submitted to the Office pursuant to 35 U.S.C. 154(d)(4), will also be available to the public. Requests for copies of, or access to, an application file under § 1.14(i) must be in the form of a written request and must include a showing that the international application has been published and that the U.S. was

designated. Such a showing should preferably be in the form of the submission of a copy of the front page of the published international application. Additionally, requests for copies of international application files must also be accompanied by the appropriate fee.

Section 1.14(j) is proposed to be amended to provide that this section not only applies when the Office provides access to or copies of the application, but also when the Office provides access to or copies of part of an application.

Section 1.14 as proposed also reflects changes proposed in the Patent Business Goals Notice of Proposed Rulemaking.

Section 1.17: Section 1.17(h) is proposed to be amended to include a petition under § 1.138 to expressly abandon an application to avoid publication among the petitions requiring the fee (\$130) set forth in § 1.17(h).

Section 1.17(i) is proposed to be amended to include processing a redacted copy of a paper submitted in the file of an application in which a redacted copy was submitted for the patent application publication (§ 1.217), a request for voluntary publication or republication of an application (§ 1.221), and for processing a belated submission under § 1.99 (§ 1.99(e)) to the processing services requiring the processing fee (\$130) set forth in § 1.17(i).

Sections 1.17(l) and 1.17(m) (and the heading of § 1.17) are proposed to be amended to set forth the fees for filing a petition under § 1.137 for revival of a terminated reexamination proceeding (on the basis of unavoidable and unintentional delay), and are discussed in a separate rulemaking (to implement the optional *inter partes* reexamination provisions of the "American Inventors Protection Act of 1999").

Section 1.17(p) is proposed to be amended to make its fee (\$240) applicable to a third party submission under § 1.99, as well as an information disclosure statement under § 1.97(c) or (d).

Section 1.17(u) is proposed to be added to set forth the surcharge (\$1,210) for accepting an unintentionally delayed claim for priority under 35 U.S.C. 119, 120, 121, or 365 (§§ 1.55 and 1.78).

Section 1.17 as proposed also reflects changes proposed in the Patent Business Goals Notice of Proposed Rulemaking.

Section 1.18: Section 1.18(d) is proposed to be added to specify the publication fee (\$300). In view of this proposed addition to § 1.18, the heading of § 1.18 is also proposed to be amended to refer to "post-allowance (including issue) fees" (instead of only "issue fees").

Section 1.24: Section 1.24 is proposed to be removed and reserved. The practice of using coupons to purchase patents, statutory invention registrations, trademark registrations, *etc.*, is inefficient as compared to alternatives such as payment by credit card (especially for orders placed via the Internet). Coupons sold by the Office (before coupon practice is abolished) may still be used but cannot be redeemed.

Section 1.52: Section 1.52(d) is proposed to be amended to provide for nonprovisional applications and provisional applications filed in a language other than English. The treatment of nonprovisional applications filed in a language other than English are revised for clarity, but otherwise remain unchanged (§ 1.52(d)(1)).

Section 1.52(d)(2) as proposed provides that if a provisional application is filed in a language other than English, an English translation will not be required in the provisional application. Section 1.52(d)(2) as proposed also contains a reference to § 1.78(a) concerning the requirements for claiming the benefit of the filing date of such a provisional application in a later filed nonprovisional application.

Section 1.55: Section 1.55 is proposed to be amended to implement the provisions of 35 U.S.C. 119(b) as amended by § 4503(a) of the "American Inventors Protection Act of 1999," by providing: (1) a time period within which a claim for the benefit of a prior foreign application must be stated or waived; and (2) provisions for the acceptance of an unintentionally delayed submission of a claim to the benefit of a prior foreign application.

Section 1.55(a) is proposed to be amended to provide that: (1) in an original application filed under 35 U.S.C. 111(a) (other than a design application), the claim for priority must be presented during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application; (2) in an application that entered the national stage from an international application after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT; and (3) the claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed before the patent is granted.

Section 1.55(c) is proposed to provide that any claim for priority under 35 U.S.C. 119(a)–(d), or 365(a) or (b) not presented within the time period provided by § 1.55(a) is considered to have been waived. Section 1.55(c) as proposed also provides that if a claim to priority under 35 U.S.C. 119(a)–(d) or 365(a) or (b) is presented after the time period provided by § 1.55(a), the claim may be accepted if the claim identifying the prior foreign application by specifying its application number, country, and the day, month and year of its filing was unintentionally delayed. Section 1.55(c) as proposed also provides that a petition to accept a delayed claim for priority under 35 U.S.C. 119(a)–(d) or 365(a) or (b) must be accompanied by: (1) The surcharge set forth in § 1.17(u); and (2) a statement that the entire delay between the date the claim was due under § 1.55(a)(1) and the date the claim was filed was unintentional, and that the Director may require additional information where there is a question whether the delay was unintentional.

Section 1.55 as proposed also reflects changes proposed in the Patent Business Goals Notice of Proposed Rulemaking.

Section 1.72: Section 1.72(a) is proposed to be amended to provide that the title of the invention may include only characters capable of being created by a keyboard and may not exceed 500 characters in length. The title character type and number limitations are necessary to ensure that the title can be completely and accurately captured in the Office's Patent Application Locating and Monitoring (PALM) system. Section 1.72 as proposed also reflects changes proposed in the Patent Business Goals Notice of Proposed Rulemaking.

Section 1.78: Section 1.78(a) is proposed to be amended to implement the provisions of 35 U.S.C. 119(e) and 120 as amended by § 4503(b) of the "American Inventors Protection Act of 1999," by providing: (1) A time period within which a claim to the benefit of a prior nonprovisional or provisional application must be stated or waived; and (2) provisions for the acceptance of the unintentionally delayed submission of a claim to the benefit of a prior nonprovisional or provisional application.

Section 1.78(a)(2) is proposed to be amended to provide that (except for a continued prosecution application filed under § 1.53(d)) any claim to the benefit of a nonprovisional application or international application must be made during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of

the prior application. Section 1.78(a)(2) as proposed also provides that the failure to timely submit the reference required by 35 U.S.C. 120 and § 1.78(a)(2) is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to such prior application, but that the time period set forth in § 1.78(a)(2) does not apply to an application for a design patent.

Section 1.78(a)(2) also provides that if the application claims the benefit of an international application, the first sentence of the specification must include an indication of whether the international application was published under PCT Article 21(2) in English (regardless of whether benefit to such application is claimed in the application data sheet).

Sections 1.78(a)(3) and 1.78(a)(4) are proposed to be redesignated as §§ 1.78(a)(4) and 1.78(a)(5), respectively.

Section 1.78(a)(3) as proposed provides that if the reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section is presented in a nonprovisional application after the time period provided by § 1.78(a)(2), the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior filed copending nonprovisional application or international application designating the United States may be accepted if the claim identifying the prior application by application number or international application number and international filing date was unintentionally delayed. Section 1.78(a)(3) as proposed also provides that a petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior filed copending application must be accompanied by: (1) The surcharge set forth in § 1.17(u); and (2) a statement that the entire delay between the date the claim was due under § 1.78(a)(2) and the date the claim was filed was unintentional, but the Director may require additional information where there is a question whether the delay was unintentional.

Section 1.78(a)(4) is proposed to be amended to provide that, for a nonprovisional application to claim the benefit of a provisional application, the provisional application must be entitled to a filing date as set forth in § 1.53(c), and the basic filing fee set forth in § 1.16(k) must be paid within the time period set forth in § 1.53(g).

Section 1.78(a)(5) as proposed provides that any nonprovisional application claiming the benefit of a provisional application filed in a language other than English must (in addition to the reference required by 35 U.S.C. 119(e) and proposed § 1.78(a)(5)) contain an English language translation

of the non-English language provisional application and a statement that the translation is accurate. Section 1.78(a)(5) as proposed also provides any claim for the benefit of a provisional application and English language translation of a non-English language provisional application must be submitted during the pendency of the nonprovisional application, and within the later of four months from the actual filing date of the nonprovisional application or sixteen months from the filing date of the prior provisional application. Section 1.78(a)(5) as proposed also provides that the failure to timely submit the reference and English language translation of a non-English language provisional application required by 35 U.S.C. 119(e) and § 1.78(a)(5) is considered a waiver of any benefit under 35 U.S.C. 119(e) to such prior provisional application.

Section 1.78(a)(6) as proposed provides that if the reference or English language translation of a non-English language provisional application required by 35 U.S.C. 119(e) and § 1.78(a)(5) is presented in a nonprovisional application after the time period provided by § 1.78(a)(5), the claim under 35 U.S.C. 119(e) for the benefit of a prior filed provisional application may be accepted during the pendency of the nonprovisional application if the claim identifying the prior application by provisional application number and any English language translation of a non-English language provisional application were unintentionally delayed. Section 1.78(a)(6) as proposed also provides that a petition to accept an unintentionally delayed claim under 35 U.S.C. 119(e) for the benefit of a prior filed provisional application must be accompanied by: (1) The surcharge set forth in § 1.17(u); and (2) a statement that the entire delay between the date the claim was due under § 1.78(a)(5) and the date the claim was filed was unintentional, but that the Director may require additional information where there is a question whether the delay was unintentional.

Section 1.78 as proposed also reflects changes proposed in the Patent Business Goals Notice of Proposed Rulemaking.

Section 1.84: Section 1.84(a)(2) as proposed is amended to provide that color drawings are not permitted in an application, or copy thereof, submitted under the Office electronic filing system. Section 1.84(a)(2) as proposed is also amended to provide that any petition to accept color drawings must include a black and white photocopy that accurately depicts, to the extent possible, the subject matter shown in the color drawing. Since § 1.84(b)

provides that color photographs will be accepted in utility patent applications if the conditions for accepting color drawings have been satisfied, the provisions and restrictions in amended § 1.84(a)(2) would also apply to color photographs.

Section 1.84(e) is proposed to be amended to provide that photographs must be developed on paper meeting the sheet-size requirements of § 1.84(f) and the margin requirements of § 1.84(g).

Section 1.84(j) is proposed to be amended to refer to the view suitable for the front page, rather than the view suitable for the *Official Gazette*, since the front page of the patent (and patent application publication) includes the information that is (or would be) included in the *Official Gazette*, and the Office does not plan on creating an *Official Gazette* for patent application publications. Section 1.84(j) is also proposed to be amended to provide that: (1) One of the views should be suitable for inclusion on the front page of the patent application publication and patent as the illustration of the invention; and (2) applicant may suggest a single view (by figure number) for inclusion on the front page of the patent application publication and patent. Applicants should indicate in the application transmittal letter the figure number of the view suggested for inclusion on the front page of the patent application publication and patent. The Office, however, is not bound by applicant's suggestion.

Section 1.85: Section 1.85(a) is proposed to be amended to provide that a utility or plant application will not be placed on the files for examination until objections to the drawings have been corrected. As discussed above, these objections will concern deficiencies that must be corrected for the drawings to be of sufficient quality for use in creating a patent application publication. Since the Office plans to use the copy of the application (including the drawings) from its PACR database to create the patent application publication, the Office must require that new or corrected drawings correcting the objections to the drawings be filed before the application is released from OIPE and placed on the files for examination.

Even if an applicant files the application with a request that the application not be published pursuant to 35 U.S.C. 122(b), the applicant may rescind that request at any time. See 35 U.S.C. 122(b)(2)(B)(ii). In addition, at the time the Office is recording a copy of the application in its PACR database, the Office is not in a position to know whether the applicant will file an

electronic filing system copy of the application for use creating the patent application publication. Therefore, the Office must be prepared to create a patent application publication from its PACR database for each application and insist that objections to the drawings be corrected in all utility and plant applications before the application can be released from OIPE.

Section 1.85(a) is also proposed to be amended to provide that (except as provided in § 1.215(c)), any patent application publication will not include drawings filed after the application has been placed on the files for examination. Thus, corrected drawings submitted after the application has been released from OIPE will not be added to the PACR database or used to create the patent application publication.

Section 1.85(a) is also proposed to be amended to provide that, unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a *bona fide* attempt to advance the application to final action (§ 1.135(c)). That is, if an Office action or notice contains an objection to the drawings (and does not expressly permit such objection to be held in abeyance) and the applicant's reply does not correct the objection, the applicant will be advised that the reply is non-responsive and given the remainder of the period set in the original Office action or notice (and not a new period under § 1.135(c)) within which to correct the objection.

Since design applications are not subject to the eighteen-month publication provisions of 35 U.S.C. 122(b), drawings in a design application will continue to be admitted for examination if the drawings meet the requirements of § 1.84(e), (f), and (g) and are suitable for reproduction.

Section 1.98: Section 1.98(a)(2)(i) is proposed to be amended to also refer to U.S. patent application publications. Section 1.98(b) is proposed to be amended to provide that each U.S. patent application publication listed in an information disclosure statement shall be identified by applicant, patent application publication number, and publication date. The proposed changes to § 1.98 also reflect changes proposed in the Patent Business Goals Notice of Proposed Rulemaking.

Section 1.99: Section 1.99(a) as proposed provides that a submission by a member of the public of patents or publications relevant to a pending published application will be entered in the application file if the submission

complies with the requirements of § 1.99 and the application is still pending when the submission and application file are brought before the examiner. The entry of such a submission does not mean that the patents or printed publications contained in the submission will be necessarily considered and cited by the examiner. If the examiner considers a patent or printed publication contained in the submission to be pertinent in determining patentability, the examiner will initial that patent or printed publication on the listing of the patents or publications submitted for consideration by the Office.

Section 1.99(b) as proposed provides that a submission under § 1.99 must identify the application to which it is directed by application number and include: (1) The fee set forth in § 1.17(p); (2) a listing of the patents or publications submitted for consideration by the Office; (3) a copy of each listed patent or publication in written form or at least the pertinent portions thereof; and (4) an English language translation of all the necessary and pertinent parts of any non-English language patent or publication in written form relied upon.

Section 1.99(c) as proposed provides that a submission under § 1.99 must be served upon the applicant in accordance with § 1.248.

Section 1.99(d) as proposed provides that a submission under § 1.99 may not include any explanation of the patents, publications, or any other information, and is limited to twenty total patents or publications.

Section 1.99(e) as proposed also provides that a submission under § 1.99 must be filed within two months of the date of publication of the application (§ 1.215(a)), or prior to the mailing of a notice of allowance (§ 1.311), whichever is earlier, and that any submission under § 1.99 not filed within this period is permitted only when the patents or publications could not have been submitted to the Office earlier, and must also be accompanied by the processing fee set forth in § 1.17(i). Section 1.99(e) as proposed also provides that a submission by a member of the public to a pending published application that does not comply with the requirements of § 1.99 will be returned or disregarded.

Section 1.99(f) as proposed provides that the involvement of a member of the public in filing a submission under § 1.99 ends with the filing of the submission.

Section 1.104: Section 1.104(d) is proposed to be amended to provide that if domestic (U.S.) patent application publications are cited by the examiner,

their publication number, publication date, and the names of the applicants will be stated.

Section 1.130: Section 1.130(a) is proposed to be amended to refer to published applications (as well as patents). Specifically, § 1.130 is proposed to also be applicable to a rejection of a claim in an application or patent under reexamination based upon a patent application publication in the situation in which the application or patent under reexamination and the published application are currently owned by the same party.

Section 1.131: Section 1.131(a) is proposed to be amended to provide that: (1) The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the date that it is effective as a reference under 35 U.S.C. 102(e); and (2) prior invention may not be established under § 1.131 if the rejection is based upon either a U.S. patent or a U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as defined in § 1.601(n).

Section 1.131 as proposed also reflects changes proposed in the Patent Business Goals Notice of Proposed Rulemaking.

Section 1.132: Section 1.132 is proposed to be amended to provide that an oath or declaration may not be submitted under § 1.132 to traverse a rejection if the rejection is based upon a U.S. patent or a U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as defined in § 1.601(n).

Section 1.132 as proposed also reflects changes proposed in the Patent Business Goals Notice of Proposed Rulemaking.

Section 1.137: Section 1.137 is proposed to be amended to: (1) Make its provisions applicable to the revival of a terminated reexamination proceeding; (2) provide for the revival of an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to timely notify the Office of the filing of an application in a foreign country or under a multinational treaty; and (3) reorganize certain provisions for clarity.

The provisions for revival of a terminated reexamination proceeding (on the basis of unavoidable and unintentional delay) are discussed in a separate rulemaking (to implement the optional *inter partes* reexamination provisions of the "American Inventors Protection Act of 1999").

As discussed above, if an applicant makes a request (nonpublication

request) upon filing with the appropriate certifications, the application will not be published under 35 U.S.C. 122(b)(1). See 35 U.S.C. 122(b)(2)(B)(i). An applicant who has made a nonpublication request but who subsequently files an application directed to the invention disclosed in the application filed in the Office in a foreign country, or under a multilateral international agreement, that requires eighteen-month publication, must notify the Office of such filing within forty-five days after the date of such filing, with the failure to timely provide such a notice to the Office resulting in abandonment of the application. See 35 U.S.C. 122(b)(2)(B)(iii). 35 U.S.C. 122(b)(2)(B)(iii), however, also provides that an application abandoned as a result of the failure to timely provide such a notice to the Office is subject to revival if the "delay in submitting the notice was unintentional." See *id.*

Section 1.137(f) as proposed provides for the revival of an application abandoned for failure to timely notify the Office of a foreign filing. 35 U.S.C. 122(b)(2)(B)(iii) provides for revival only on the basis of unintentional delay, and not on the basis of unavoidable delay. Compare 35 U.S.C. 122(b)(2)(B)(iii) ("delay * * * was unintentional") with 35 U.S.C. 111(a)(4) ("delay * * * was unavoidable or unintentional"). Therefore, § 1.137(f) as proposed provides that a nonprovisional application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to timely notify the Office of the filing of an application in a foreign country or under a multinational treaty that requires eighteen-month publication may be revived only pursuant to § 1.137(b). Section 1.137(f) as proposed also provides that the reply requirement of § 1.137(c) is met by the notification of such filing in a foreign country or under a multinational treaty, but the filing of a petition under § 1.137 will not operate to stay any period for reply that may be running against the application. Since the Office cannot ascertain whether an application is abandoned under 35 U.S.C. 122(b)(2)(B)(iii), the Office may continue to process and examine the application until the applicant notifies the Office that the application is abandoned. Therefore, § 1.137(f) provides that the filing of a petition under § 1.137 to revive such an application will not operate to stay any period for reply that may be running against the application.

Section 1.137 is also proposed to be amended to locate the "reply requirement" provisions in § 1.137(c), rather than include duplicative provisions concerning the reply

requirement in each of § 1.137(a) and (b). Thus, the terminal disclaimer provisions of § 1.137(c), reconsideration provisions of § 1.137(d), and provisional application provisions of § 1.137(e) are proposed to be moved to § 1.137(d), § 1.137(e), and § 1.137(g), respectively. In addition, § 1.137(c) also provides that in an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee. Thus, even if an application abandoned for failure to pay the publication fee is being revived solely for purposes of continuity with a continuing application, the petition to revive under § 1.137 must include payment of the publication fee (unless previously submitted).

Section 1.137 is also proposed to be amended to take into account the provisions of 35 U.S.C. 119(e)(3), which extend the pendency of a provisional application to the next succeeding secular or business day if the day that is twelve months after the filing date of the provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia.

Section 1.137 as proposed also reflects changes proposed in the Patent Business Goals Notice of Proposed Rulemaking.

Section 1.138: Section 1.138(a) is proposed to be amended to add "or publication" to clarify that a letter of express abandonment may not be recognized by the Office unless it is actually received by appropriate officials in time to act thereon before the date of publication.

Section 1.138(c) is proposed to be added to provide for a petition for express abandonment to avoid publication. Section 1.138(c) as proposed provides that an applicant seeking to abandon an application to avoid publication of the application (see § 1.211(a)(1)) must submit a declaration of express abandonment by way of a petition including the fee set forth in § 1.17(h) in sufficient time to permit the appropriate officials to recognize the abandonment and remove the application from the publication process. The petition will be granted when it is recognized in sufficient time to avoid publication of application information and will be denied when it is not recognized in sufficient time to avoid publication of application information. This will avert the situation in which an applicant files a letter of express abandonment to avoid publication, the letter of express abandonment is not recognized in sufficient time to avoid publication, upon publication the applicant wishes to rescind the letter of express

abandonment, and the Office cannot revive the application (once the letter of express abandonment is recognized) because the application was expressly and intentionally abandoned by the applicant.

As discussed above, the publication process is a fourteen-week process, and applicant should expect that the petition will not be granted and application will be published in regular course unless such declaration of express abandonment and petition are received by the appropriate officials more than four weeks prior to the projected date of publication.

Section 1.138 as proposed (§ 1.138(b)) also reflects changes proposed in the Patent Business Goals Notice of Proposed Rulemaking.

Section 1.165: Section 1.165 is proposed to be amended to provide that if plant application drawings include a color drawing or photograph, a black and white photocopy that accurately depicts, to the extent possible, the subject matter shown in the color drawing or photograph must be submitted.

Section 1.211: Sections 1.211, 1.213, 1.215, 1.217, 1.219, and 1.221 are proposed to be added to provide for the pre-grant publication of applications under 35 U.S.C. 122(b).

Section 1.211(a) as proposed provides that (with certain exceptions) each U.S. national application for patent filed in the Office under 35 U.S.C. 111(a) and each international application in compliance with 35 U.S.C. 371 will be published promptly after the expiration of a period of eighteen months from the earliest filing date for which a benefit is sought under title 35, United States Code.

Section 1.211(a)(1) as proposed provides that the Office will not publish applications that are recognized as no longer pending. The phrase "that are recognized by the Office as no longer pending" is meant to cover the situation in which the period for reply (either the shortened statutory period or the maximum extendable period for reply) to an Office action has expired, but the Office has not yet entered the change of status (to abandoned) of the application in the PALM system and mailed a notice of abandonment. An application will remain in the publication process until the PALM system indicates that the application is abandoned. Obviously, once the PALM system indicates that an application is abandoned, the Office will attempt to remove the application from the publication process and avoid dissemination of application information. How much dissemination of application information can be

avoided depends upon how close it is to the publication date when the Office recognizes the application as abandoned. Unless an applicant has received a notice of abandonment, an applicant who wants to abandon the application to avoid publication must file a petition under § 1.138(c) to expressly abandon the application and avoid publication. An applicant permitting an application to become abandoned (for failure to reply to an Office action) to avoid publication by passively waiting for the Office to recognize that the application has become abandoned must bear the risk that the Office will not recognize that the application has become abandoned and change the status of the application in the PALM system in sufficient time to avoid publication.

Section 1.211(a)(2) as proposed provides that the Office will not publish applications that are national security classified (see § 5.2(c)), subject to a secrecy order under 35 U.S.C. 181, or under national security review.

Section 1.211(a)(3) as proposed provides that the Office will not publish applications that have issued as a patent in sufficient time to be removed from the publication process. If the pre-grant publication process coincides with the patent issue process, the Office will continue with the pre-grant publication process until a patent actually issues. This is because there are many instances in which the Office mails a notice of allowance (§ 1.311) in an application but the application does not issue as a patent in regular course (abandonment due to failure to pay the issue fee, or withdrawal from issue either *sua sponte* by the Office or on petition of the applicant). Therefore, the Office will not discontinue the pre-grant publication process until a patent has actually issued. Since the Office cannot discontinue the pre-grant publication process during the last two weeks of the publication process, this will result in a few applications being issued as a patent and subsequently being published as a patent application publication. The Office will refund the publication fee (if paid) if the application is not published as a patent application publication, but will not refund the publication fee if the application is published as a patent application publication, even if published after the patent issues.

Section 1.211(a)(4) as proposed also provides that the Office will not publish applications that were filed with a nonpublication request in compliance with § 1.213(a).

Section 1.211(b) as proposed provides that provisional applications under 35

U.S.C. 111(b) shall not be published. Section 1.211(b) as proposed also provides that design applications under 35 U.S.C. chapter 16 and reissue applications under 35 U.S.C. chapter 25 shall not be published under § 1.211. Provisional applications under 35 U.S.C. 111(b) and design applications under 35 U.S.C. chapter 16 are excluded from the pre-grant publication provisions of 35 U.S.C. 122(b). *See* 35 U.S.C. 122(b)(2)(A)(iii) and (iv). Reissue applications under 35 U.S.C. chapter 25 are not maintained in confidence under 35 U.S.C. 122(a). *See* § 1.11(b).

Section 1.211(c) as proposed provides that the Office will not publish an application filed under 35 U.S.C. 111(a) until it includes the basic filing fee, an English translation if in a language other than English, and an executed oath or declaration. Section 1.211(c) as proposed also provides that publishing may be delayed until the application includes a specification on papers in compliance with § 1.52 and having an abstract (§ 1.72(b)), drawings in compliance with § 1.84, and a sequence listing in compliance with §§ 1.821 through 1.825 (if applicable), and until any petition under § 1.47 is granted. That is, if an application does not contain the application content on papers or drawings of sufficient quality to create a patent application publication by eighteen months from its earliest claimed filing date, the Office will publish the application as soon as practical after these deficiencies are corrected.

Section 1.211(d) as proposed provides that the Office may refuse to publish an application, or to include a portion of an application in the patent application publication (§ 1.215), if publication of the application or portion thereof would violate Federal or state law, or if the application or portion thereof contains offensive or disparaging material. A similar provision exists in PCT practice, in that the International Bureau may omit expressions or drawings in an international application from its publications if the expressions or drawings are contrary to morality or public order, or contain disparaging statements. *See* PCT Article 21(6) and Rule 9.

Section 1.211(e) as proposed provides that the publication fee set forth in § 1.18(d) must be paid in each application published under this section before the patent will be granted, but does not require that the publication fee be paid prior to publication. If an application is subject to publication under this section, the sum specified in the notice of allowance under § 1.311 will also include the publication fee

which must be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable. If the application is not published under this section, the publication fee (if paid) will be refunded.

Section 1.213: Section 1.213 implements the provisions of 35 U.S.C. 122(b)(2)(B)(i)–(iii). An applicant may request that the application not be published under 35 U.S.C. 122(b) and § 1.211 if the invention disclosed in an application has not been and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing. Section 1.213(a) requires that a request that an application not be published under 35 U.S.C. 122(b) (nonpublication request) must: (1) Be submitted with the application upon filing; (2) state in a conspicuous manner that the application is not to be published under 35 U.S.C. 122(b); (3) contain a certification that the invention disclosed in the application has not been and will not be the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing; and (4) be signed in compliance with § 1.33(b). The requirement that a nonpublication request be submitted “upon filing” is a requirement of statute (35 U.S.C. 122(b)(2)(B)(i)), and, as such, the Office must deny any petition requesting a waiver of this provision of § 1.213(a).

Section 1.213(b) as proposed provides that the applicant may rescind a nonpublication request at any time. *See* 35 U.S.C. 122(b)(2)(B)(ii). Section 1.213(b) as proposed also provides that a request to rescind a nonpublication request under § 1.213(a) must: (1) Identify the application to which it is directed (§ 1.5); (2) state in a conspicuous manner that the request that the application is not to be published under 35 U.S.C. 122(b) is rescinded; and (3) be signed in compliance with § 1.33(b). Once a request under § 1.213(b) to rescind a nonpublication request is filed and processed by the Office, the application will be scheduled for publication in accordance with § 1.211(a).

Section 1.213(c) reiterates the provisions of 35 U.S.C. 122(b)(2)(B)(iii). Section 1.213(c) specifically states that if an applicant who has submitted a nonpublication request under § 1.213(a) subsequently files an application directed to the invention disclosed in the application in which the

nonpublication request was submitted in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing, the applicant must notify the Office of such filing within forty-five days after the date of the filing of such foreign or international application. The failure to timely notify the Office of the filing of such foreign or international application shall result in abandonment of the application in which the nonpublication request was submitted. *See* 35 U.S.C. 122(b)(2)(B)(iii).

Section 1.215: Section 1.215(a) as proposed indicates that the publication of an application under 35 U.S.C. 122(b) shall include a patent application publication. The Office will not mail a paper copy of the patent application publication to the applicant, but will mail a notice to the applicant indicating that the application has been published.

Section 1.215(a) as proposed also provides that the date of publication shall be indicated on the patent application publication.

Section 1.215(a) as proposed also provides that (except as discussed below in § 1.215(c)) the patent application publication will be based upon the application papers deposited on the filing date of the application, except for preliminary amendments, as well as the executed oath or declaration submitted to complete the application, and any application papers or drawings submitted in reply to a preexamination notice requiring a title and abstract in compliance with § 1.72, application papers in compliance with § 1.52, drawings in compliance with § 1.84, or a sequence listing in compliance with §§ 1.821 through 1.825. That is, the patent application publication will not reflect the application as it was amended during the examination process, but will only reflect the application as recorded in the Office’s PACR database.

Section 1.215(b) as proposed provides a mechanism by which applicants may have assignee information (the name and address of the assignee of the entire right, title, and interest in an application) included on the patent application publication. To have assignee information included on the patent application publication, the applicant must include a separate paper indicating that such information is being provided for inclusion on the patent application publication. The assignee information might not be included on the patent application publication if such paper is not included with the application on filing. Finally, § 1.215(b) clarifies that

providing assignee information for inclusion on the patent application publication does not substitute for an assignment submitted to the Office for recording under 37 CFR part 3.

Section 1.215(c) as proposed provides a mechanism by which applicants may have the patent application publication reflect the application as amended during the examination process (rather than the application as recorded in the Office’s PACR database). Section 1.215(c) as proposed provides that the Office will use an applicant-supplied copy of the application (specification, drawings, and oath or declaration), provided that: (1) The copy is in compliance with the Office electronic filing system (EFS) requirements; and (2) the EFS copy is filed within one month of the actual filing date of the application or fourteen months of the earliest filing date for which a benefit is sought, whichever is later.

The fourteen-month period differs from the sixteen-month period provided in § 1.217 for submitting a redacted copy of an application because the sixteen-month period provided in § 1.217 is not based upon the fourteen-week publication cycle but is provided for by statute (35 U.S.C. 122(b)(2)(B)(v)).

Section 1.215(d) as proposed provides that if the copy of the application does not comply with the Office EFS requirements, the Office will publish the application based upon the application records in the Office’s PACR database (as provided in § 1.215(a)). If, however, the Office has not started the publication process, the Office may use an untimely filed copy of the application supplied by the applicant under § 1.215(c) in creating the patent application publication.

Section 1.217: Section 1.217(a) as proposed implements the provisions of 35 U.S.C. 122(b)(2)(B)(v), and provides that if an applicant has filed applications in one or more foreign countries, directly or through a multilateral international agreement, and such foreign-filed applications or the description of the invention in such foreign-filed applications is less extensive than the application or description of the invention in the application filed in the Office, the applicant may submit a redacted copy of the application filed in the Office for publication, eliminating any part or description of the invention that is not also contained in any of the corresponding applications filed in a foreign country. Section 1.217(a) as proposed also provides that the Office will publish the application as provided in § 1.215(a) unless the applicant files a redacted copy of the application in

compliance with § 1.217 within sixteen months after the earliest filing date for which a benefit is sought under title 35, United States Code. This sixteen-month period is provided by statute (35 U.S.C. 122(b)(2)(B)(v)), and as such, requests for waiver of this sixteen-month period will be denied.

As discussed above, this sixteen-month period provided in § 1.217 differs from the fourteen-month period provided in § 1.215(c) because the sixteen-month period provided in § 1.217 is not based upon the fourteen-week publication cycle but is provided for by statute (35 U.S.C. 122(b)(2)(B)(v)). If a redacted copy of an application is submitted in compliance with § 1.217 but later than four months prior to the projected publication date, the Office will be required to reprocess the patent application publication (for which assembly will have already started) using the redacted copy of the application provided by applicant.

Section 1.217(b) as proposed provides that the redacted copy of the application must be submitted in compliance with the Office EFS requirements. Section 1.217(b) as proposed also provides that the title of the invention in the redacted copy of the application must correspond to the title of the application at the time the redacted copy of the application is submitted to the Office. The Office uses the title of the invention (among other information) as provided in an EFS copy of an application to confirm the identity of the application for which the EFS copy is submitted. Thus, if a portion of the title has been redacted such that the title (as redacted) in the EFS copy of the application is different from the title of the invention for the application as shown in PALM, it will appear that the redacted EFS copy of the application incorrectly identifies the application for which the redacted EFS copy is submitted. If an applicant wants to redact a portion of the title, the applicant must first submit an amendment to the title of the invention such that it will correspond to the title as redacted. Section 1.217(b) as proposed also provides that if the redacted copy of the application does not comply with the Office EFS requirements, the Office will publish the application based upon the unredacted records in the Office's PACR database.

Section 1.217(c) as proposed provides that the applicant must also concurrently submit in paper (§ 1.52(a)) to be filed in the application: (1) A certified copy of each foreign-filed application that corresponds to the application for which a redacted copy is submitted; (2) a translation of each such

foreign-filed application that is in a language other than English, and a statement that the translation is accurate; (3) a marked-up copy of the application showing the redactions in brackets; and (4) a certification that the redacted copy of the application eliminates only a part or description of the invention that is not contained in any application filed in a foreign country, directly or through a multilateral international agreement, that corresponds to the application filed in the Office. The provisions of § 1.217(c) are designed to ensure that any patent application publication based upon a redacted copy of an application contains the parts and description of the invention contained in any of the corresponding applications filed in a foreign country.

Section 1.217(d) as proposed provides a mechanism for obtaining an appropriately redacted copy of the application contents to provide to members of the public requesting a copy of the file wrapper and contents of the application. Section 1.217(d) as proposed provides that the Office will provide a complete unredacted copy of the file wrapper and contents of an application for which a redacted copy was submitted under § 1.217 (upon payment of a fee) unless the applicant complies with the requirements of § 1.217(d). Since the processing required to provide redacted copies of the application content is the result of an applicant choosing to submit a redacted copy under § 1.217, it is appropriate to require the applicant to timely provide appropriate redacted copies of Office correspondence and applicant submissions, and to pay a processing fee for the special handling required for these papers, should the applicant wish to maintain the redacted portions of the application in confidence prior to the grant of a patent.

Section 1.217(d)(1) as proposed provides that the applicant must accompany the submission required by § 1.217(c) with: (1) a copy of any Office correspondence previously received by applicant including any desired redactions, and a second copy of all Office correspondence previously received by applicant showing the redacted material in brackets; and (2) a copy of each submission previously filed by the applicant including any desired redactions, and a second copy of each submission previously filed by the applicant showing the redacted material in brackets. Section 1.217(d)(2) as proposed provides that the applicant must also: (1) Within one month of the date of mailing of any correspondence from the Office, file a copy of such

Office correspondence including any desired redactions, and a second copy of such Office correspondence showing the redacted material in brackets; and (2) with each submission by the applicant, include a copy of such submission including any desired redactions, and a second copy of such submission showing the redacted material in brackets. Section 1.217(d)(3) as proposed provides that each submission under § 1.217(d)(1) or § 1.217(d)(2) must also be accompanied by the processing fee set forth in § 1.17(i) and a certification that the redactions included therein are limited to the elimination of material that is relevant only to the part or description of the invention that is not contained in the redacted copy of the application submitted for publication. If the applicant fails to comply with these requirements, the Office will provide a complete unredacted copy of the file wrapper and contents of the application to any member of the public (upon payment of a fee).

Section 1.217(e) provides that the certificate of mailing or transmission procedure set forth in provisions of § 1.8 do not apply to the time periods set forth in § 1.217.

Section 1.219: Section 1.219 implements the provisions of 35 U.S.C. 122(b)(1) that authorize (but do not require) the Office to publish earlier than at the eighteen-month period set forth in 35 U.S.C. 122(b)(1) at the request of the applicant. Section 1.219 as proposed provides that any request for early publication must be accompanied by the publication fee set forth in § 1.18(d). Section 1.219 as proposed provides that if the applicant does not submit a copy of the application in compliance with the Office EFS requirements, the Office will publish the application based upon the application records in the Office's PACR database (as provided in § 1.215(a)). Section 1.219 as proposed also provides that no consideration will be given to requests for publication on a certain date (which includes a request that certain applications be published on the same date), and such requests will be treated as a request for publication as soon as possible.

Section 1.221: Section 1.221 provides for voluntary publication of applications filed before, but pending on, November 29, 2000, and for requests for republication of applications previously published under § 1.211. Applicants may request republication of an application under § 1.221 to obtain a patent application publication that: (1) corrects immaterial errors or errors not the result of Office mistake; or (2)

reflects the application as amended during prosecution of the application.

Section 1.221(a) as proposed provides that a request for voluntary publication or republication must include a copy of the application in compliance with the Office EFS requirements and be accompanied by the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i). Since voluntary publication or republication of applications is not mandated by 35 U.S.C. 122(b)(1), if a request for voluntary publication or republication does not comply with the requirements of § 1.221, or the copy of the application does not comply with the Office EFS requirements, the Office will not publish the application based upon the application records in the Office's PACR database (as provided in § 1.215(a)) but will simply not publish the application and will refund the publication fee (but not the processing fee).

Section 1.221(b) as proposed provides that the Office will grant a request for a corrected or revised patent application publication other than as provided in § 1.221(a) only when the Office makes a material mistake which is apparent from Office records. The phrase "material mistake" means a mistake that affects the public's ability to appreciate the technical disclosure of the patent application publication or determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent (*e.g.*, error in the claims, serious error in a portion of the written description or drawings that is necessary to support the claims). The Office will permit applicants to review the bibliographic information contained in the Office's PALM database via its PAIR system. Therefore, applicants are expected to review that information and bring errors to the Office's attention at least fourteen weeks before the projected date of publication. Section 1.221(b) as proposed also provides that any request for a corrected or revised patent application publication other than as provided in § 1.221(a) must be filed within two months from the date of the patent application publication, and that this period is not extendable.

Section 1.291: Section 1.291(a)(1) implements the provisions of 35 U.S.C. 122(c), which specify that the Office shall establish appropriate procedures to ensure that no protest or other form of pre-issuance opposition to the grant of a patent may be initiated after publication of the application without the applicant's express written consent. Section 1.291 is proposed to be amended to provide that a protest must be submitted prior to the date the application was published or the

mailing of a notice of allowance under § 1.311, whichever occurs first.

Section 1.292: Section 1.292(b)(3) is proposed to be amended to require that any petition to institute a public use proceeding be submitted prior to the date the application was published or mailing of a notice of allowance under § 1.311, whichever occurs first.

Section 1.311: Section 1.311(a) is proposed to be amended to provide that the sum specified in the notice of allowance may (in addition to the issue fee) also include the publication fee, in which case the issue fee and publication fee (§ 1.211(f)) must both be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. Section 1.311(a) is also amended to provide that this three-month period is not extendable. Section 1.311(b) is proposed to be amended to provide that an authorization to charge any of the post-allowance fees set forth in § 1.18 to a deposit account may be filed in an individual application only after mailing of the notice of allowance.

Section 1.311(b) as proposed also reflects changes proposed in the Patent Business Goals Notice of Proposed Rulemaking.

Section 1.417: Section 1.417 is proposed to be added to provide for the submission of international publications or English language translations of international applications pursuant to 35 U.S.C. 154(d)(4). This section as proposed sets forth the requirements for the filing of an English language international publication or translation of an international application in order to ensure proper handling by the Office. Section 1.417 as proposed provides that such a submission must clearly identify the international application to which it pertains under § 1.5(a), and unless it is being submitted pursuant to § 1.494 or § 1.495, must be clearly identified as a submission pursuant to 35 U.S.C. 154(d)(4). Failure to properly identify such submissions will result in the English language international publication or translation of the description and claims of the international application being processed as the filing of a national application under 35 U.S.C. 111(a). Additionally, failure to properly identify the international publication or translation as a submission under 35 U.S.C. 154(d)(4) may cause the Office to be unable to properly track or retrieve the international publication or translation in relation to its international application number. Section 1.417 as proposed also provides that such submissions should be marked "Box PCT."

The submission of an international publication or translation of an international application for the purposes of national stage entry in accordance with § 1.494 or § 1.495 may also be relied upon as the submission for the purposes of 35 U.S.C. 154(d)(4). Likewise, an earlier filed international publication or translation (submitted for the purposes of 35 U.S.C. 154(d)(4) and properly identified as such) may also be relied upon for the purpose of satisfying the requirement of 35 U.S.C. 371(c)(2). If applicant intends to rely on such an earlier filed international publication or translation, the submission of documents under § 1.494(f) and § 1.495(g) should include an indication that the international publication or translation has been previously submitted for the purposes of 35 U.S.C. 154(d)(4) to avoid the mailing of either a Notice of Abandonment (PCT/DO/EO/909) indicating that a copy of the international application was not timely filed, or a Notice of Missing Requirements (PCT/DO/EO/905) indicating that a translation of the international application is required. While (as discussed above) applicants may rely on an earlier filed international publication or translation for the purposes of national stage entry and processing, the Office strongly recommends that a second copy of the international publication or translation be included with the initial national stage papers in order to ensure the integrity of the first submitted international publication or translation. Otherwise, processing of the national stage application may result in the alteration of the originally filed international publication or translation through, *e.g.*, the entry of amendments.

Section 1.494: Section 1.494(f) is amended to exempt a copy of the international publication or translation of the international application identified as provided in § 1.417 from the documents that must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371 to avoid being considered a submission under 35 U.S.C. 111(a).

Section 1.495: Section 1.495(g) is amended to exempt a copy of the international publication or translation of the international application identified as provided in § 1.417 from the documents that must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371 to avoid being considered a submission under 35 U.S.C. 111(a).

Part 5

Section 5.1: Section 5.1 is proposed to be amended to implement the provisions of 35 U.S.C. 122(d), which

specify that the application will not be published under 35 U.S.C. 122(b)(1) if publication or disclosure of the application would be detrimental to national security. Section 5.1 as proposed provides that an application under national security review will not be published at least until six months from its filing date or three months from the date the application was referred to a defense agency, whichever is later. These are the current national security review screening time frames for foreign filing license purposes. Section 5.1 as proposed also provides that a national security classified patent application will not be published under § 1.211 of this chapter or allowed under § 1.311 of this chapter until the application is declassified and any secrecy order under § 5.2(a) has been rescinded.

Section 5.1 as proposed also reflects changes proposed in the Patent Business Goals Notice of Proposed Rulemaking.

Classification

Regulatory Flexibility Act

The Chief Counsel for Regulation of the Department of Commerce certified to the Chief Counsel for Advocacy, Small Business Administration, that the changes proposed in this notice, if adopted, would not have a significant impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)). This rulemaking implements the eighteen-month publication provisions of §§ 4501 through 4508 of the "American Inventors Protection Act of 1999." The changes proposed in this notice (if adopted) would provide procedures for the eighteen-month publication of patent applications.

An applicant may file a nonpublication request (opt-out of eighteen-month publication) if the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires eighteen-month publication. Since almost all small entities file patent applications only in the United States, almost all small entities can choose whether they want their applications to be subject to eighteen-month publication. The Office receives roughly 60,000 applications each year from small entities. Based upon input from small entity groups during the legislative process, the Office expects that small entities will file a nonpublication request for roughly 30,000 applications (fifty percent) with the remaining 30,000 applications being subject to eighteen-month publication. Since the current application allowance

rate is roughly sixty-seven percent, roughly 20,000 applications subject to eighteen-month publication will be allowed, at which time a publication fee (\$300.00) will be due. Since the publication fee is less than one-third of the combined cost of the application filing fee (\$345.00) and patent issue fee (\$605.00), there will not be a significant economic impact on a substantial number of small entities due to eighteen-month publication.

Executive Order 13132

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

Executive Order 12866

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

Paperwork Reduction Act

This notice of proposed rulemaking 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.*). The collections of information involved in this notice of proposed rulemaking have been reviewed and previously approved by OMB under OMB control numbers: 0651-0021, 0651-0027, 0651-0031, 0651-0032, 0651-0033, and 0651-0034.

As required by the Paperwork Reduction Act of 1995 (44 U.S.C. 3507(d)), the Patent and Trademark Office has submitted an information collection package to OMB for its review and approval of the proposed information collections under OMB control number 0651-0031 and 0651-0032. The Patent and Trademark Office is submitting these information collections to OMB for its review and approval because this notice of proposed rulemaking will add the nonpublication request, rescission of the nonpublication request, electronic filing system copy of the application (for publication purposes), copy of the application file content showing redactions, and petition to accept a delayed priority claim to these collections.

As discussed above, this notice of proposed rulemaking also involves currently approved information collections under OMB control numbers: 0651-0021, 0651-0027, 0651-0033, and 0651-0034. The Patent and Trademark Office is not resubmitting those information collection packages to

OMB for its review and approval because the changes in this notice of proposed rulemaking do not affect the information collection requirements associated with the information collections under those OMB control numbers.

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: 0651-0021.

Title: Patent Cooperation Treaty.

Form Numbers: PCT/RO/101, ANNEX/134/144, PTO-1382, PCT/IPEA/401, PCT/IB/328.

Type of Review: Approved through May of 2000.

Affected Public: Individuals or Households, Business or Other For-Profit Institutions, Federal Agencies or Employees, Not-for-Profit Institutions, Small Businesses or Organizations.

Estimated Number of Respondents: 102,950.

Estimated Time Per Response: 0.9538 hour.

Estimated Total Annual Burden Hours: 98,195 hours.

Needs and Uses: The information collected is required by the Patent Cooperation Treaty (PCT). The general purpose of the PCT is to simplify the filing of patent applications on the same invention in different countries. It provides for a centralized filing procedure and a standardized application format.

OMB Number: 0651-0027.

Title: Changes in Patent and Trademark Assignment Practices.

Form Numbers: PTO-1618 and PTO-1619, PTO/SB/15/41.

Type of Review: Approved through May of 2002.

Affected Public: Individuals or Households and Businesses or Other For-Profit Institutions.

Estimated Number of Respondents: 209,040.

Estimated Time Per Response: 0.5 hour.

Estimated Total Annual Burden Hours: 104,520 hours.

Needs and Uses: The Office records about 209,040 assignments or documents related to ownership of patent and trademark cases each year. The Office requires a cover sheet to expedite the processing of these documents and to ensure that they are properly recorded.

OMB Number: 0651-0031.

Title: Patent Processing (Updating).
Form Numbers: PTO/SB/08/21–27/
 31/42/43/61/62/63/64/67/68/91/92/96/
 97.

Type of Review: Approved through
 October of 2002.

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

Estimated Number of Respondents:
 2,040,630.

Estimated Time Per Response: 0.39
 hours.

Estimated Total Annual Burden
Hours: 788,421 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 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
 Revoke; Express Abandonments; Appeal
 Notices; Petitions for Access; Powers to
 Inspect; Certificates of Mailing or
 Transmission; Statements under
 § 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: Approved through
 October of 2002.

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

Estimated Number of Respondents:
 344,100.

Estimated Time Per Response: 8.7
 hours.

Estimated Total Annual Burden
Hours: 2,994,160 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 processing and examination of
 the application.

OMB Number: 0651–0033.

Title: Post Allowance and Refiling.

Form Numbers: PTO/SB/13/14/44/
 50–57; PTOL–85b.

Type of Review: Approved through
 September of 2000.

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

Estimated Number of Respondents:
 135,250.

Estimated Time Per Response: 0.325
 hour.

Estimated Total Annual Burden
Hours: 43,893 hours.

Needs and Uses: This collection of
 information is required to administer
 the patent laws pursuant to title 35,
 U.S.C., concerning the issuance of
 patents and related actions including
 correcting errors in printed patents,
 refiling of patent applications,
 requesting reexamination of a patent,
 and requesting a reissue patent to
 correct an error in a patent. The affected
 public includes any individual or
 institution whose application for a
 patent has been allowed or who takes
 action as covered by the applicable
 rules.

OMB Number: 0651–0034.

Title: Secrecy/License to Export.

Form Numbers: None.

Type of Review: Approved through
 January of 2001.

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

Estimated Number of Respondents:
 2,187.

Estimated Time Per Response: 0.67
 hour.

Estimated Total Annual Burden
Hours: 1,476 hours.

Needs and Uses: In the interest of
 national security, patent laws and
 regulations place certain limitations on
 the disclosure of information contained
 in patents and patent applications and
 on the filing of applications for patent
 in foreign countries.

The principal impact of the changes
 in this notice of proposed rulemaking is
 to implement the changes to Office
 practice necessitated by §§ 4501 through
 4508 of the “American Inventors
 Protection Act of 1999” (enacted into
 law by § 1000(a)(9), Division B, of
 Public Law 106–113).

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, Special Program
 Law Office, Patent and Trademark
 Office, Washington, D.C. 20231, or to
 the Office of Information and Regulatory
 Affairs of OMB, New Executive Office
 Building, 725 17th Street, N.W., Room
 10235, Washington, D.C. 20503,
 Attention: Desk Officer for the 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

37 CFR Part 1

Administrative practice and
 procedure, Courts, Freedom of
 Information, Inventions and patents,
 Reporting and recordkeeping
 requirements, Small businesses.

37 CFR Part 5

Classified information, foreign
 relations, inventions and patents.

For the reasons set forth in the
 preamble, 37 CFR Parts 1 and 5 are
 proposed to be amended as follows:

PART 1—RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR
 Part 1 is revised to read as follows:

Authority: 35 U.S.C. 2(b)(2), unless
 otherwise noted.

2. Section 1.9 is amended by revising
 paragraph (c) to read as follows:

§ 1.9 Definitions.

* * * * *

(c) A published application as used in
 this chapter means an application for
 patent which has been published under
 35 U.S.C. 122(b).

* * * * *

3. Section 1.11 is amended by revising
 paragraph (a) to read as follows:

§ 1.11 Files open to the public.

(a) The specification, drawings, and
 all papers relating to the file of an
 abandoned published application,
 except if a redacted copy of the
 application was used for the patent
 application publication, a patent, or a
 statutory invention registration are open
 to inspection by the public, and copies
 may be obtained upon the payment of

the fee set forth in § 1.19(b)(2). See § 2.27 for trademark files.

* * * * *

4. Section 1.12 is amended by revising paragraphs (a)(1) and (b) to read as follows:

§ 1.12 Assignment records open to public inspection.

(a)(1) Separate assignment records are maintained in the Patent and Trademark Office for patents and trademarks. The assignment records, relating to original or reissue patents, including digests and indexes, for assignments recorded on or after May 1, 1957, published patent applications, and assignment records relating to pending or abandoned trademark applications and to trademark registrations, for assignments recorded on or after January 1, 1955, are open to public inspection at the Patent and Trademark Office, and copies of those assignment records may be obtained upon request and payment of the fee set forth in § 1.19 and § 2.6 of this chapter.

* * * * *

(b) Assignment records, digests, and indexes relating to any pending or abandoned patent application which has not been published under 35 U.S.C. 122(b) are not available to the public. Copies of any such assignment records and information with respect thereto shall be obtainable only upon written authority of the applicant or applicant's assignee or attorney or agent or upon a showing that the person seeking such information is a bona fide prospective or actual purchaser, mortgagee, or licensee of such application, unless it shall be necessary to the proper conduct of business before the Office or as provided by these rules.

* * * * *

5. Section 1.13 is revised to read as follows:

§ 1.13 Copies and certified copies.

(a) Non-certified copies of patents, patent application publications, and trademark registrations and of any records, books, papers, or drawings within the jurisdiction of the United States Patent and Trademark Office and open to the public, will be furnished by the United States Patent and Trademark Office to any person, and copies of other records or papers will be furnished to persons entitled thereto, upon payment of the fee therefor.

(b) Certified copies of patents, patent application publications, and trademark registrations and of any records, books, papers, or drawings within the jurisdiction of the United States Patent and Trademark Office and open to the public or persons entitled thereto will

be authenticated by the seal of the United States Patent and Trademark Office and certified by the Director, or in his or her name attested by an officer of the United States Patent and Trademark Office authorized by the Director, upon payment of the fee for the certified copy.

6. Section 1.14 is amended by revising paragraphs (a), (b), (c) and (e), and adding paragraphs (h), (i) and (j) to read as follows:

§ 1.14 Patent applications preserved in confidence.

(a) *Confidentiality of patent application information.* Patent applications that have not been published under 35 U.S.C. 122(b) are generally preserved in confidence pursuant to 35 U.S.C. 122(a). Information concerning the filing, pendency, or subject matter of an application for patent, including status information, and access to the application, will only be given to the public as set forth in § 1.11 or in this section.

(1) *Status information is:*

- (i) Whether the application is pending, abandoned, or patented;
- (ii) Whether the application has been published under 35 U.S.C. 122(b); and
- (iii) The application "numerical identifier" which may be:

(A) The eight digit application number (the two digit series code plus the six digit serial number); or

(B) The six digit serial number plus any one of the filing date of the national application, the international filing date, or date of entry into the national stage.

(2) *Access* is defined as providing the application file for review and copying of any material.

(b) *When status information may be supplied.* Status information of an application may be supplied by the Office to the public if any of the following apply:

(1) Access to the application is available pursuant to paragraph (e) of this section;

(2) The application is referred to by its numerical identifier in a published patent document (*e.g.*, a U.S. patent, a U.S. patent application publication, or an international application publication), or in a U.S. application open to public inspection (§ 1.11(b), or paragraph (e)(2)(i) or (e)(2)(ii) of this section); or

(3) The application is a published international application in which the United States of America has been indicated as a designated state.

(4) The application claims the benefit of the filing date of an application for which status information may be

provided pursuant to paragraphs (b)(1) through (b)(3) of this section.

(c) *When copies may be supplied.* A copy of an application-as-filed or a file wrapper and contents may, subject to paragraph (j) of this section (addresses international applications), be supplied by the Office to the public if any of the following apply:

(1) *Application-as-filed.* If a U.S. patent application publication or patent incorporates by reference, or includes a specific reference under 35 U.S.C. 119(e) or 120 to, a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request, including the fee set forth in § 1.19(b)(1).

(2) *File wrapper and contents.* A copy of the specification, drawings, and all papers relating to the file of an abandoned or pending published application may be provided to any person upon written request, including the fee set forth in § 1.19(b)(2). If a redacted copy of the application was used for the patent application publication, the copy of the specification, drawings, and papers may be limited to a redacted copy.

* * * * *

(e) *Public access to a pending or abandoned application may be provided.* Access to an application may, subject to paragraph (j) of this section, be provided to any person if a written request for access is submitted, the application file is available, and any of the following apply:

(1) The application is open to public inspection pursuant to § 1.11(b); or

(2) The application is abandoned, it is not within the file jacket of a pending application under § 1.53(d), and it is referred to:

(i) In a U.S. patent application publication or patent; or

(ii) In another U.S. application which is open to public inspection either pursuant to § 1.11(b) or paragraph (e)(2)(i) of this section.

* * * * *

(h) [Reserved]

(i) *International applications.* (1) Copies of international application files for international applications filed on or after November 29, 2000, and which designate the U.S. and which have been published in accordance with PCT Article 21(2), or copies of a document in such application files, will be furnished in accordance with Patent Cooperation Treaty (PCT) Articles 30 and 38 and PCT Rules 94.2 and 94.3, upon written request including a showing that the publication of the application has occurred and that the U.S. was

designated, and upon payment of the appropriate fee (§ 1.19(b)(2) or § 1.19(b)(3)), if:

(i) With respect to the Home Copy, the international application was filed with the U.S. Receiving Office;

(ii) With respect to the Search Copy, the U.S. acted as the International Searching Authority; or

(iii) With respect to the Examination Copy, the United States acted as the International Preliminary Examining Authority, an International Preliminary Examination Report has issued, and the United States was elected.

(2) A copy of an English language translation of an international application, which has been filed in the Patent and Trademark Office pursuant to 35 U.S.C. 154(2)(d)(4) will be furnished upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate fee (§ 1.19(b)(2) or § 1.19(b)(3)).

(3) Access to international application files for international applications filed on or after November 29, 2000, and which designate the U.S. and which have been published in accordance with PCT Article 21(2), or copies of a document in such application files, will be furnished in accordance with Patent Cooperation Treaty (PCT) Articles 30 and 38 and PCT Rules 94.2 and 94.3, upon written request including a showing that the publication of the application has occurred and that the U.S. was designated.

(4) In accordance with PCT Article 30, copies of an international application-as-filed under paragraph (c)(1) of this section will not be provided prior to the international publication of the application pursuant to PCT Article 21(2).

(5) Access to international application files under paragraphs (e) and (i)(3) of this section will not be permitted with respect to the Examination Copy in accordance with PCT Article 38.

(j) *Access or copies in other circumstances.* The Office, either *sua sponte* or on petition, may also provide access or copies of all or part of an application if necessary to carry out an Act of Congress or if warranted by other special circumstances. Any petition by a member of the public seeking access to, or copies of, all or part of any pending or abandoned application preserved in confidence pursuant to paragraph (a) of this section, or any related papers, must include:

(1) The fee set forth in § 1.17(h); and

(2) A showing that access to the application is necessary to carry out an Act of Congress or that special circumstances exist which warrant petitioner being granted access to all or part of the application.

7. Section 1.17 is amended by revising its heading and paragraphs (h), (i), (l), (m) and (p) and adding paragraph (u) to read as follows:

§ 1.17 Patent application and reexamination processing fees.

* * * * *

(h) For filing a petition under one of the following sections which refers to this paragraph: 130.00

§ 1.12—for access to an assignment record.

§ 1.14—for access to an application.

§ 1.47—for filing by other than all the inventors or a person not the inventor.

§ 1.53(e)—to accord a filing date.

§ 1.59—for expungement and return of information.

§ 1.84—for accepting color drawings or photographs.

§ 1.91—for entry of a model or exhibit.

§ 1.102—to make an application special.

§ 1.103(a)—to suspend action in application.

§ 1.138(c)—to expressly abandon an application to avoid publication.

§ 1.182—for decision on a question not specifically provided for.

§ 1.183—to suspend the rules.

§ 1.295—for review of refusal to publish a statutory invention registration.

§ 1.313—to withdraw an application from issue.

§ 1.314—to defer issuance of a patent.

§ 1.377—for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.

§ 1.378(e)—for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.

§ 1.644(e)—for petition in an interference.

§ 1.644(f)—for request for reconsideration of a decision on petition in an interference.

§ 1.666(b)—for access to an interference settlement agreement.

§ 1.666(c)—for late filing of interference settlement agreement.

§ 1.741(b)—to accord a filing date to an application for extension of a patent term.

§ 5.12—for expedited handling of a foreign filing license.

§ 5.15—for changing the scope of a license.

§ 5.25—for retroactive license.

(i) Processing fee for taking action under one of the following sections which refers to this paragraph: 130.00

§ 1.28(c)(3)—for processing a non-itemized fee deficiency based on an error in small entity status.

§ 1.41—for supplying the name or names of the inventor or inventors after the filing date without an oath or declaration as prescribed by § 1.63, except in provisional applications.

§ 1.48—for correcting inventorship, except in provisional applications.

§ 1.52(d)—for processing a nonprovisional application filed with a specification in a language other than English.

§ 1.55—for entry of late priority papers.

§ 1.99(e)—for processing a belated submission under § 1.99.

§ 1.103(b)—for requesting limited suspension of action in continued prosecution application.

§ 1.217—for processing a redacted copy of a paper submitted in the file of an application in which a redacted copy was submitted for the patent application publication.

§ 1.221—for requesting voluntary publication or republication of an application.

§ 1.497(d)—for filing an oath or declaration pursuant to 35 U.S.C. 371(c)(4) naming an inventive entity different from the inventive entity set forth in the international stage.

* * * * *

(l) For filing a petition for the revival of an unavoidably abandoned application under 35 U.S.C. 111, 133, 364, or 371, for delayed payment of the issue fee under 35 U.S.C. 151, or for the revival of an unavoidably terminated reexamination proceeding under 35 U.S.C. 133 (§ 1.137(a)):

By a small entity (§ 1.9(f)): 55.00

By other than a small entity: 110.00

(m) For filing a petition for revival of an unintentionally abandoned application, for the unintentionally delayed payment of the fee for issuing a patent, or for the revival of an unintentionally terminated reexamination proceeding under 35 U.S.C. 41(a)(7) (§ 1.137(b)):

By a small entity (§ 1.9(f)): 605.00

By other than a small entity: 1,210.00

* * * * *

(p) For an information disclosure statement under § 1.97(c) or (d) or a submission under § 1.99: 240.00

* * * * *

(u) For the acceptance of an unintentionally delayed claim for priority under 35 U.S.C. 119, 120, 121, or 365 (§§ 1.55 and 1.78): 1,210.00

8. Section 1.18 is amended by revising its heading and adding paragraph (d) to read as follows:

§ 1.18 Patent post-allowance (including issue) fees.

* * * * *

(d) Publication fee: 300.00

§ 1.24 [Removed and Reserved]

9. Section 1.24 is removed and reserved.

10. Section 1.52 is amended by revising paragraph (d) to read as follows:

§ 1.52 Language, paper, writing, margins.

* * * * *

(d) A nonprovisional or provisional application may be filed in a language other than English.

(1) *Nonprovisional application.* If a nonprovisional application is filed in a language other than English, an English language translation of the non-English language application, a statement that the translation is accurate, and the processing fee set forth in § 1.17(i) are required. If these items are not filed with the application, applicant will be notified and given a period of time within which they must be filed in order to avoid abandonment.

(2) *Provisional application.* If a provisional application is filed in a language other than English, an English language translation of the non-English language provisional application will not be required in the provisional application. See § 1.78(a) for the requirements for claiming the benefit of such provisional application in a nonprovisional application.

11. Section 1.55 is amended by revising paragraph (a) and adding paragraph (c) to read as follows:

§ 1.55 Claim for foreign priority.

(a) An applicant in a nonprovisional application may claim the benefit of the filing date of one or more prior foreign applications under the conditions specified in 35 U.S.C. 119(a) through (d), 172, and 365(a) and (b).

(1)(i) In an original application filed under 35 U.S.C. 111(a), the claim for priority must be presented during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. This time period is not extendable. The claim must identify the foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. The time period in this paragraph does not apply to an application for a design patent.

(ii) In an application that entered the national stage from an international application after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT.

(2) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed before the patent is granted. If the claim

for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by the processing fee set forth in § 1.17(i), but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323 of this part.

(3) When the application becomes involved in an interference (§ 1.630), when necessary to overcome the date of a reference relied upon by the examiner, or when deemed necessary by the examiner, the Office may require that the claim for priority and the certified copy of the foreign application be filed earlier than provided in paragraphs (a)(1) or (a)(2) of this section.

(4) An English-language translation of a non-English-language foreign application is not required except when the application is involved in an interference (§ 1.630), when necessary to overcome the date of a reference relied upon by the examiner, or when specifically required by the examiner. If an English-language translation is required, it must be filed together with a statement that the translation of the certified copy is accurate.

(c) Unless such claim is accepted in accordance with the provisions of this paragraph, any claim for priority under 35 U.S.C. 119(a)–(d), or 365(a) or (b) not presented within the time period provided by paragraph (a) of this section is considered to have been waived. If a claim for priority under 35 U.S.C. 119(a)–(d) or 365(a) or (b) is presented after the time period provided by paragraph (a) of this section, the claim may be accepted if the claim identifying the prior foreign application by specifying its application number, country, and the day, month and year of its filing was unintentionally delayed. A petition to accept a delayed claim for priority under 35 U.S.C. 119(a)–(d) or 365(a) or (b) must be accompanied by:

(1) The surcharge set forth in § 1.17(u); and

(2) A statement that the entire delay between the date the claim was due under paragraph (a)(1) of this section and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

12. Section 1.72 is amended by revising paragraph (a) to read as follows:

§ 1.72 Title and abstract.

(a) The title of the invention may include only characters capable of being created by a keyboard and may not exceed 500 characters in length. The

title should be as short and specific as possible. Unless the title is supplied in an application data sheet (§ 1.76), the title of the invention should appear as a heading on the first page of the specification.

* * * * *

13. Section 1.78 is amended by revising paragraphs (a)(2), (a)(3), and (a)(4), and adding new paragraphs (a)(5) and (a)(6) to read as follows:

§ 1.78 Claiming benefit of earlier filing date and cross references to other applications.

(a)(1) * * *

(2) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application claiming the benefit of one or more prior filed copending nonprovisional applications or international applications designating the United States of America must contain a reference to each such prior application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. This reference must be submitted during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. This time period is not extendable. Unless the reference required by this paragraph is included in an application data sheet (§ 1.76), the specification must contain or be amended to contain such reference in the first sentence following the title. If the application claims the benefit of an international application, the first sentence of the specification must include an indication of whether the international application was published under PCT Article 21(2) in English (regardless of whether benefit for such application is claimed in the application data sheet). The request for a continued prosecution application under § 1.53(d) is the specific reference required by 35 U.S.C. 120 to the prior application. The identification of an application by application number under this section is the specific reference required by 35 U.S.C. 120 to every application assigned that application number. Cross references to other related applications may be made when appropriate (see § 1.14). Except as provided in paragraph (a)(3) of this section, the failure to timely submit the reference required by 35 U.S.C. 120 and this paragraph is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to such prior application. The time period set forth in this paragraph does not

apply to an application for a design patent.

(3) If the reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section is presented in a nonprovisional application after the time period provided by paragraph (a)(2) of this section, the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior filed copending nonprovisional application or international application designating the United States of America may be accepted if the reference identifying the prior application by application number or international application number and international filing date was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior filed application must be accompanied by:

(i) The surcharge set forth in § 1.17(u); and

(ii) A statement that the entire delay between the date the claim was due under paragraph (a)(2) of this section and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(4) A nonprovisional application other than for a design patent may claim an invention disclosed in one or more prior filed provisional applications. In order for a nonprovisional application to claim the benefit of one or more prior filed provisional applications, each prior provisional application must name as an inventor at least one inventor named in the later filed nonprovisional application and disclose the named inventor's invention claimed in at least one claim of the later filed nonprovisional application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior provisional application must be entitled to a filing date as set forth in § 1.53(c), and the basic filing fee set forth in § 1.16(k) must be paid within the time period set forth in § 1.53(g).

(5) Any nonprovisional application claiming the benefit of one or more prior filed copending provisional applications must contain a reference to each such prior provisional application, identifying it as a provisional application, and including the provisional application number (consisting of series code and serial number), and, if the provisional application is filed in a language other than English, an English language translation of the non-English language provisional application and a statement that the translation is accurate. This reference and English language

translation of a non-English language provisional application must be submitted during the pendency of the nonprovisional application, and within the later of four months from the actual filing date of the nonprovisional application or sixteen months from the filing date of the prior provisional application. This time period is not extendable. Unless the reference required by this paragraph is included in an application data sheet (§ 1.76), the specification must contain or be amended to contain such reference in the first sentence following the title. Except as provided in paragraph (a)(6) of this section, the failure to timely submit the reference and English language translation of a non-English language provisional application required by 35 U.S.C. 119(e) and this paragraph is considered a waiver of any benefit under 35 U.S.C. 119(e) to such prior provisional application.

(6) If the reference or English language translation of a non-English language provisional application required by 35 U.S.C. 119(e) and paragraph (a)(5) of this section is presented in a nonprovisional application after the time period provided by paragraph (a)(5) of this section, the claim under 35 U.S.C. 119(e) for the benefit of a prior filed provisional application may be accepted during the pendency of the nonprovisional application if the claim identifying the prior application by provisional application number and any English language translation of a non-English language provisional application were unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 119(e) for the benefit of a prior filed provisional application must be accompanied by:

(i) The surcharge set forth in § 1.17(u); and

(ii) A statement that the entire delay between the date the claim was due under paragraph (a)(5) of this section and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

* * * * *

14. Section 1.84 is amended by revising paragraphs (a)(2), (e), and (j) to read as follows:

§ 1.84 Standards for drawings.

(a) * * *

(2) *Color.* On rare occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility or design patent application or the subject matter of a statutory

invention registration. The color drawings must be of sufficient quality such that all details in the drawings are reproducible in black and white in the printed patent. Color drawings are not permitted in international applications (see PCT Rule 11.13), or in an application, or copy thereof, submitted under the Office electronic filing system. The Office will accept color drawings in utility or design patent applications and statutory invention registrations only after granting a petition filed under this paragraph explaining why the color drawings are necessary. Any such petition must include the following:

(i) The fee set forth in § 1.17(h);

(ii) Three (3) sets of color drawings;

(iii) A black and white photocopy that accurately depicts, to the extent possible, the subject matter shown in the color drawing; and

(iv) An amendment to the specification to insert (unless the specification contains or has been previously amended to contain) the following language as the first paragraph of the brief description of the drawings:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Patent and Trademark Office upon request and payment of the necessary fee.

* * * * *

(e) *Type of paper.* Drawings submitted to the Office must be made on paper which is flexible, strong, white, smooth, non-shiny, and durable. All sheets must be reasonably free from cracks, creases, and folds. Only one side of the sheet may be used for the drawing. Each sheet must be reasonably free from erasures and must be free from alterations, overwritings, and interlineations. Photographs must be developed on paper meeting the sheet-size requirements of paragraph (f) of this section and the margin requirements of paragraph (g) of this section. See paragraph (b) of this section for other requirements for photographs.

* * * * *

(j) *Front page view.* One of the views should be suitable for inclusion on the front page of the patent application publication and patent as the illustration of the invention. Applicant may suggest a single view (by figure number) for inclusion on the front page of the patent application publication and patent.

* * * * *

15. Section 1.85 is amended by revising paragraph (a) to read as follows:

§ 1.85 Corrections to drawings.

(a) A utility or plant application will not be placed on the files for examination until objections to the drawings have been corrected. Except as provided in § 1.215(c), any patent application publication will not include drawings filed after the application has been placed on the files for examination. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a *bona fide* attempt to advance the application to final action (§ 1.135(c)). If a drawing in a design application meets the requirements of § 1.84(e), (f), and (g) and is suitable for reproduction, but is not otherwise in compliance with § 1.84, the drawing may be admitted for examination.

* * * * *

16. Section 1.98 is amended by revising paragraphs (a)(2) and (b) to read as follows:

§ 1.98 Content of information disclosure statement.

(a) * * *

(2) A legible copy of:

(i) Each U.S. patent application publication and U.S. and foreign patent;

(ii) Each publication or that portion which caused it to be listed;

(iii) For each cited pending U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and (iv) All other information or that portion which caused it to be listed; and

* * * * *

(b) Each U.S. patent listed in an information disclosure statement shall be identified by patentee, patent number, and issue date. Each U.S. patent application publication listed in an information disclosure statement shall be identified by applicant, patent application publication number, and publication date. Each listed U.S. application shall be identified by the inventor, application number, and filing date. Each listed foreign patent or published foreign patent application shall be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application. Each listed publication shall be identified by author (if any), title, relevant pages of the

publication, date, and place of publication.

* * * * *

17. A new § 1.99 is added to read as follows:

§ 1.99 Third party submission in published application.

(a) A submission by a member of the public of patents or publications relevant to a pending published application will be entered in the application file if the submission complies with the requirements of this section and the application is still pending when the submission and application file are brought before the examiner.

(b) A submission under this section must identify the application to which it is directed by application number and include:

(1) The fee set forth in § 1.17(p);

(2) A listing of the patents or publications submitted for consideration by the Office;

(3) A copy of each listed patent or publication in written form or at least the pertinent portions thereof; and

(4) An English language translation of all the necessary and pertinent parts of any non-English language patent or publication in written form relied upon.

(c) The submission under this section must be served upon the applicant in accordance with § 1.248.

(d) A submission under this section may not include any explanation of the patents, publications, or any other information, and is limited to twenty total patents or publications.

(e) A submission under this section must be filed within two months of the date of publication of the application (§ 1.215(a)) or prior to the mailing of a notice of allowance (§ 1.311), whichever is earlier. Any submission under this section not filed within this period is permitted only when the patents or publications could not have been submitted to the Office earlier, and must also be accompanied by the processing fee set forth in § 1.17(i). A submission by a member of the public to a pending published application that does not comply with the requirements of this section will be returned or discarded.

(f) A member of the public may include a self-addressed postcard with a submission to receive an acknowledgment by the Office that the submission has been received. A member of the public filing a submission under this section will not receive any communications from the Office relating to the submission other than the return of a self-addressed postcard. In the absence of a request by the Office, an applicant has no duty to,

and need not, reply to a submission under this section. The limited involvement of the member of the public filing a submission pursuant to this section ends with the filing of the submission, and no further submission on behalf of the member of the public will be considered, except for additional prior art, or unless such submission raises new issues which could not have been earlier presented.

18. Section 1.104 is amended by revising paragraph (d)(1) to read as follows:

§ 1.104 Nature of examination.

* * * * *

(d) *Citation of references.* (1) If domestic patents are cited by the examiner, their numbers and dates, and the names of the patentees will be stated. If domestic patent application publications are cited by the examiner, their publication number, publication date, and the names of the applicants will be stated. If foreign published applications or patents are cited, their nationality or country, numbers and dates, and the names of the patentees will be stated, and such other data will be furnished as may be necessary to enable the applicant, or in the case of a reexamination proceeding, the patent owner, to identify the published applications or patents cited. In citing foreign published applications or patents, in case only a part of the document is involved, the particular pages and sheets containing the parts relied upon will be identified. If printed publications are cited, the author (if any), title, date, pages or plates, and place of publication, or place where a copy can be found, will be given.

* * * * *

19. Section 1.130 is amended by revising its heading and paragraph (a) to read as follows:

§ 1.130 Affidavit or declaration to disqualify commonly owned patent or published application as prior art.

(a) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 103 on a U.S. patent or U.S. patent application publication which is not prior art under 35 U.S.C. 102(b), and the inventions defined by the claims in the application or patent under reexamination and by the claims in the patent or published application are not identical but are not patentably distinct, and the inventions are owned by the same party, the applicant or owner of the patent under reexamination may disqualify the patent or patent application publication as prior art. The patent or patent application publication can be

disqualified as prior art by submission of:

(1) A terminal disclaimer in accordance with § 1.321(c); and

(2) An oath or declaration stating that the application or patent under reexamination and patent or published application are currently owned by the same party, and that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104.

* * * * *

20. Section 1.131 is amended by revising its heading and paragraph (a) to read as follows:

§ 1.131 Affidavit or declaration of prior invention.

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the date that it is effective as a reference under 35 U.S.C. 102(e). Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. Prior invention may not be established under this section before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a WTO member country other than a NAFTA country. Prior invention may not be established under this section if either:

(1) The rejection is based upon a U.S. patent or U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as defined in § 1.601(n); or

(2) The rejection is based upon a statutory bar.

* * * * *

21. Section 1.132 is revised to read as follows:

§ 1.132 Affidavits or declarations traversing rejections or objections.

When any claim of an application or a patent under reexamination is rejected or objected to, an oath or declaration may be submitted to traverse the rejection or objection. An oath or declaration may not be submitted under this section to traverse a rejection if the

rejection is based upon a U.S. patent or a U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as defined in § 1.601(n).

22. Section 1.137 is revised to read as follows:

§ 1.137 Revival of abandoned application, terminated reexamination proceeding, or lapsed patent.

(a) *Unavoidable.* Where the delay in reply by applicant or patent owner was unavoidable, a petition may be filed to revive an abandoned application, a terminated reexamination proceeding, or a lapsed patent pursuant to this paragraph. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § 1.17(l);

(3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

(b) *Unintentional.* Where the delay in reply by applicant or patent owner was unintentional, a petition may be filed to revive an abandoned application, a terminated reexamination proceeding, or a lapsed patent pursuant to this paragraph. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

(c) *Reply.* In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed after June 8,

1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance thereof. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(d) *Terminal disclaimer.* (1) Any petition to revive pursuant to this section in a design application must be accompanied by a terminal disclaimer and fee as set forth in § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application. Any petition to revive pursuant to this section in either a utility or plant application filed before June 8, 1995, must be accompanied by a terminal disclaimer and fee as set forth in § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the lesser of:

(i) The period of abandonment of the application; or

(ii) The period extending beyond twenty years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application(s) under 35 U.S.C. 120, 121, or 365(c), from the date on which the earliest such application was filed.

(2) Any terminal disclaimer pursuant to paragraph (d)(1) of this section must also apply to any patent granted on a continuing utility or plant application filed after June 8, 1995, or a continuing design application, that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to the application for which revival is sought.

(3) The provisions of paragraph (d)(1) of this section do not apply to applications for which revival is sought solely for purposes of copendency with a utility or plant application filed on or after June 8, 1995, to lapsed patents, or to reexamination proceedings.

(e) *Request for reconsideration.* Any request for reconsideration or review of a decision refusing to revive an abandoned application or lapsed patent upon petition filed pursuant to this section, to be considered timely, must be filed within two months of the decision refusing to revive or within such time as set in the decision. Unless a decision indicates otherwise, this time period may be extended under the provisions of § 1.136 for an abandoned

application or lapsed patent; under the provisions of § 1.550(c) for a terminated *ex parte* reexamination proceeding filed under § 1.510; and under the provisions of § 1.956 for a terminated *inter partes* reexamination proceeding filed under § 1.913.

(f) *Abandonment for failure to notify the Office of a foreign filing.* A nonprovisional application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to timely notify the Office of the filing of an application in a foreign country or under a multinational treaty that requires publication of applications eighteen months after filing, may be revived only pursuant to paragraph (b) of this section. The reply requirement of paragraph (c) of this section is met by the notification of such filing in a foreign country or under a multinational treaty, but the filing of a petition under this section will not operate to stay any period for reply that may be running against the application.

(g) *Provisional applications.* A provisional application, abandoned for failure to timely respond to an Office requirement, may be revived pursuant to this section. Subject to the provisions of 35 U.S.C. 119(e)(3) and § 1.7(b), a provisional application will not be regarded as pending after twelve months from its filing date under any circumstances.

23. Section 1.138 is revised to read as follows:

§ 1.138 Express abandonment.

(a) An application may be expressly abandoned by filing in the Patent and Trademark Office a written declaration of abandonment identifying the application. Express abandonment of the application may not be recognized by the Office unless it is actually received by appropriate officials in time to act thereon before the date of issue or publication.

(b) A written declaration of abandonment must be signed by a party authorized under § 1.33(b)(1), (b)(3) or (b)(4) to sign a paper in the application, except as otherwise provided in this paragraph. A registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a) when filing a continuing application may expressly abandon the prior application as of the filing date granted to the continuing application.

(c) An applicant seeking to abandon an application to avoid publication of the application (see § 1.211(a)(1)) must submit a declaration of express abandonment by way of a petition under this section including the fee set forth in § 1.17(h) in sufficient time to permit

the appropriate officials to recognize the abandonment and remove the application from the publication process. Applicant should expect that the petition will not be granted and the application will be published in regular course unless such declaration of express abandonment and petition are received by the appropriate officials more than four weeks prior to the projected date of publication.

24. Section 1.165 is amended by revising paragraph (b) to read as follows:

§ 1.165 Plant drawings.

* * * * *

(b) The drawings may be in color. The drawing must be in color if color is a distinguishing characteristic of the new variety. Two copies of color drawings or photographs and a black and white photocopy that accurately depicts, to the extent possible, the subject matter shown in the color drawing or photograph must be submitted.

25. A new, undesignated center heading and new sections 1.211, 1.213, 1.215, 1.217, 1.219, and 1.221 are added to Subpart B to read as follows:

Publication of Applications

§ 1.211 Publication of applications.

(a) Each U.S. national application for patent filed in the Office under 35 U.S.C. 111(a) and each international application in compliance with 35 U.S.C. 371 will be published promptly after the expiration of a period of eighteen months from the earliest filing date for which a benefit is sought under title 35, United States Code, unless:

(1) The application is recognized by the Office as no longer pending;

(2) The application is national security classified (see § 5.2(c)), subject to a secrecy order under 35 U.S.C. 181, or under national security review;

(3) The application has issued as a patent in sufficient time to be removed from the publication process; or

(4) The application was filed with a nonpublication request in compliance with § 1.213(a).

(b) Provisional applications under 35 U.S.C. 111(b) shall not be published, and design applications under 35 U.S.C. chapter 16 and reissue applications under 35 U.S.C. chapter 25 shall not be published under this section.

(c) An application filed under 35 U.S.C. 111(a) will not be published until it includes the basic filing fee (§ 1.16(a) or 1.16(g)), any English translation required by § 1.52(d), and an executed oath or declaration under § 1.63. The Office may delay publishing any application until it includes a specification on papers in compliance with § 1.52 and having an abstract

(§ 1.72(b)), drawings in compliance with § 1.84, and a sequence listing in compliance with §§ 1.821 through 1.825 (if applicable), and until any petition under § 1.47 is granted.

(d) The Office may refuse to publish an application, or to include a portion of an application in the patent application publication (§ 1.215), if publication of the application or portion thereof would violate Federal or state law, or if the application or portion thereof contains offensive or disparaging material.

(e) The publication fee set forth in § 1.18(d) must be paid in each application published under this section before the patent will be granted. If an application is subject to publication under this section, the sum specified in the notice of allowance under § 1.311 will also include the publication fee which must be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable. If the application is not published under this section, the publication fee (if paid) will be refunded.

§ 1.213 Nonpublication request.

(a) If the invention disclosed in an application has not been and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing, the application will not be published under 35 U.S.C. 122(b) and § 1.211 provided:

(1) A request (nonpublication request) is submitted with the application upon filing;

(2) The request states in a conspicuous manner that the application is not to be published under 35 U.S.C. 122(b);

(3) The request contains a certification that the invention disclosed in the application has not been and will not be the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing; and

(4) The request is signed in compliance with § 1.33(b).

(b) The applicant may rescind a nonpublication request at any time. A request to rescind a nonpublication request under paragraph (a) of this section must:

(1) Identify the application to which it is directed;

(2) State in a conspicuous manner that the request that the application is not to be published under 35 U.S.C. 122(b) is rescinded; and

(3) Be signed in compliance with § 1.33(b).

(c) If an applicant who has submitted a nonpublication request under paragraph (a) of this section subsequently files an application directed to the invention disclosed in the application in which the nonpublication request was submitted in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing, the applicant must notify the Office of such filing within forty-five days after the date of the filing of such foreign or international application. The failure to timely notify the Office of the filing of such foreign or international application shall result in abandonment of the application in which the nonpublication request was submitted (35 U.S.C. 122(b)(2)(B)(iii)).

§ 1.215 Patent application publication.

(a) The publication of an application under 35 U.S.C. 122(b) shall include a patent application publication. The date of publication shall be indicated on the patent application publication. The patent application publication will be based upon the application papers deposited on the filing date of the application, except for preliminary amendments, as well as the executed oath or declaration submitted to complete the application, and any application papers or drawings submitted in reply to a preexamination notice requiring a title and abstract in compliance with § 1.72, application papers in compliance with § 1.52, drawings in compliance with § 1.84, or a sequence listing in compliance with §§ 1.821 through 1.825, except as otherwise provided in this section.

(b) If applicant wants the patent application publication to include assignee information, the applicant must include a separate paper indicating that such information is being provided for inclusion on the patent application publication. Assignee information might not be included on the patent application publication if such paper is not included with the application on filing. Assignee information as used in this paragraph means the name and address of the assignee of the entire right, title, and interest in an application. Providing this information does not substitute for compliance with any requirement of part 3 of this chapter to have an assignment recorded by the Office.

(c) At applicant's option, the patent application publication will be based upon the copy of the application (specification, drawings, and oath or

declaration) as amended during examination, provided that applicant supplies such a copy in compliance with the Office electronic filing system requirements within one month of the actual filing date of the application or fourteen months of the earliest filing date for which a benefit is sought under title 35, United States Code, whichever is later.

(d) If the copy of the application submitted pursuant to paragraph (c) of this section does not comply with the Office electronic filing system requirements, the Office will publish the application as provided in paragraph (a) of this section. If, however, the Office has not started the publication process, the Office may use an untimely filed copy of the application supplied by the applicant under paragraph (c) of this section in creating the patent application publication.

§ 1.217 Publication of a redacted copy of an application.

(a) If an applicant has filed applications in one or more foreign countries, directly or through a multilateral international agreement, and such foreign-filed applications or the description of the invention in such foreign-filed applications is less extensive than the application or description of the invention in the application filed in the Office, the applicant may submit a redacted copy of the application filed in the Office for publication, eliminating any part or description of the invention that is not also contained in any of the corresponding applications filed in a foreign country. The Office will publish the application as provided in § 1.215(a) unless the applicant files a redacted copy of the application in compliance with this section within sixteen months after the earliest filing date for which a benefit is sought under title 35, United States Code.

(b) The redacted copy of the application must be submitted in compliance with the Office electronic filing system requirements. The title of the invention in the redacted copy of the application must correspond to the title of the application at the time the redacted copy of the application is submitted to the Office. If the redacted copy of the application does not comply with the Office electronic filing system requirements, the Office will publish the application as provided in § 1.215(a).

(c) The applicant must also concurrently submit in paper (§ 1.52(a)) to be filed in the application:

(1) A certified copy of each foreign-filed application that corresponds to the application for which a redacted copy is submitted;

(2) A translation of each such foreign-filed application that is in a language other than English, and a statement that the translation is accurate;

(3) A marked-up copy of the application showing the redactions in brackets; and

(4) A certification that the redacted copy of the application eliminates only the part or description of the invention that is not contained in any application filed in a foreign country, directly or through a multilateral international agreement, that corresponds to the application filed in the Office.

(d) The Office will provide a copy of the complete file wrapper and contents of an application for which a redacted copy was submitted under this section to any person upon written request pursuant to § 1.14(c)(2), unless applicant complies with the requirements of paragraphs (d)(1), (d)(2), and (d)(3) of this section.

(1) Applicant must accompany the submission required by paragraph (c) of this section with the following:

(i) A copy of any Office correspondence previously received by applicant including any desired redactions, and a second copy of all Office correspondence previously received by applicant showing the redacted material in brackets; and

(ii) A copy of each submission previously filed by the applicant including any desired redactions, and a second copy of each submission previously filed by the applicant showing the redacted material in brackets.

(2) In addition to providing the submission required by paragraphs (c) and (d)(1) of this section, applicant must:

(i) Within one month of the date of mailing of any correspondence from the Office, file a copy of such Office correspondence including any desired redactions, and a second copy of such Office correspondence showing the redacted material in brackets; and

(ii) With each submission by the applicant, include a copy of such submission including any desired redactions, and a second copy of such submission showing the redacted material in brackets.

(3) Each submission under paragraph (d)(1) or (d)(2) of this paragraph must also be accompanied by the processing fee set forth in § 1.17(i) and a certification that the redactions included therein are limited to the elimination of material that is relevant

only to the part or description of the invention that were not contained in the redacted copy of the application submitted for publication.

(e) The provisions of § 1.8 do not apply to the time periods set forth in this section.

§ 1.219 Early publication.

(a) Applications that will be published under § 1.211 may be published earlier than as set forth in § 1.211(a) at the request of the applicant. Any request for early publication must be accompanied by the publication fee set forth in § 1.18(d). If the applicant does not submit a copy of the application in compliance with the Office electronic filing system requirements, the Office will publish the application as provided in § 1.215(a). No consideration will be given to requests for publication on a certain date, and such requests will be treated as a request for publication as soon as possible.

§ 1.221 Voluntary publication or republication of patent application publication.

(a) Any request for publication of an application filed before, but pending on, November 29, 2000, and any request for republication of an application previously published under § 1.211, must include a copy of the application in compliance with the Office electronic filing system requirements and be accompanied by the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i). If the request does not comply with the requirements of this paragraph or the copy of the application does not comply with the Office electronic filing system requirements, the Office will not publish the application and will refund the publication fee.

(b) The Office will grant a request for a corrected or revised patent application publication other than as provided in paragraph (a) of this section only when the Office makes a material mistake which is apparent from Office records. Any request for a corrected or revised patent application publication other than as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable.

26. Section 1.291 is amended by revising paragraph (a)(1) to read as follows:

§ 1.291 Protests by the public against pending applications.

(a) * * *

(1) The protest is submitted prior to the date the application was published

or the mailing of a notice of allowance under § 1.311, whichever occurs first; and

* * * * *

27. Section 1.292 is amended by revising paragraph (b)(3) to read as follows:

§ 1.292 Public use proceedings.

* * * * *

(b) * * *

(3) The petition is submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, whichever occurs first.

* * * * *

28. Section 1.311 is revised to read as follows:

§ 1.311 Notice of allowance.

(a) If, on examination, it shall appear that the applicant is entitled to a patent under the law, a notice of allowance will be sent to the applicant at the correspondence address indicated in § 1.33. The notice of allowance shall specify a sum constituting the issue fee which must be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. The sum specified in the notice of allowance may also include the publication fee, in which case the issue fee and publication fee (§ 1.211(f)) must both be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable.

(b) An authorization to charge the issue or other post-allowance fees set forth in § 1.18 to a deposit account may be filed in an individual application only after mailing of the notice of allowance.

29. A new § 1.417 is added to read as follows:

§ 1.417 Submission of translation of international application.

The submission of the international publication or an English language translation of an international application pursuant to 35 U.S.C. 154(d)(4) must clearly identify the international application to which it pertains (§ 1.5(a)) and, unless it is being submitted pursuant to § 1.494 or § 1.495, be clearly identified as a submission pursuant to 35 U.S.C. 154(d)(4). Otherwise, the submission will be treated as a filing under 35 U.S.C. 111(a). Such submissions should be marked "Box PCT."

30. Section 1.494 is amended by revising paragraph (f) to read as follows:

§ 1.494 Entering the national stage in the United States of America as a Designated Office.

* * * * *

(f) The documents and fees submitted under paragraphs (b) and (c) of this section must, except for a copy of the international publication or translation of the international application that is identified as provided in § 1.417, be clearly identified as a submission to enter the national stage under 35 U.S.C. 371. Otherwise, the submission will be considered as being made under 35 U.S.C. 111(a).

* * * * *

31. Section 1.495 is amended by revising paragraph (g) to read as follows:

§ 1.495 Entering the national stage in the United States of America as an Elected Office.

* * * * *

(g) The documents and fees submitted under paragraphs (b) and (c) of this section must, except for a copy of the international publication or translation of the international application that is identified as provided in § 1.417, be clearly identified as a submission to enter the national stage under 35 U.S.C. 371. Otherwise, the submission will be considered as being made under 35 U.S.C. 111(a).

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

32. The authority citation for 37 CFR Part 5 is revised to read as follows:

Authority: 35 U.S.C. 2(b)(2), 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 Director (15 CFR 370.10(j), 22 CFR 125.04, and 10 CFR 810.7).

33. Section 5.1 as proposed to be revised at 64 FR 53844 is amended by revising paragraph (e) to read as follows:

§ 5.1 Applications and correspondence involving national security.

* * * * *

(e) An application will not be published under § 1.211 of this chapter or allowed under § 1.311 of this chapter if publication or disclosure of the application would be detrimental to national security. An application under national security review will not be published at least until six months from its filing date or three months from the

date the application was referred to a defense agency, whichever is later. A national security classified patent application will not be published under § 1.211 of this chapter or allowed under

§ 1.311 of this chapter until the application is declassified and any secrecy order under § 5.2(a) has been rescinded.

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Dated: March 24, 2000.

Q. Todd Dickinson,

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

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