

**DEPARTMENT OF COMMERCE****United States Patent and Trademark Office****37 CFR Parts 1, 3, 5, 11, and 41****[Docket No.: PTO-P-2013-0025]****RIN 0651-AC87****Changes To Implement the Hague Agreement Concerning International Registration of Industrial Designs****AGENCY:** United States Patent and Trademark Office, Commerce.**ACTION:** Final rule.**SUMMARY:**

Title I of the Patent Law Treaties Implementation Act of 2012 ("PLTIA") amends the United States patent laws to implement the provisions of the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs, July 2, 1999, (hereinafter "Hague Agreement") and is to take effect on the entry into force of the Hague Agreement with respect to the United States. Under the Hague Agreement, qualified applicants may apply for design protection in the Contracting Parties to the Hague Agreement by filing a single, standardized international design application in a single language. The United States Patent and Trademark Office is revising the rules of practice to implement title I of the PLTIA.

**DATES:** *Effective date:* The changes in this final rule take effect on May 13, 2015.

*Applicability date:* The changes to 37 CFR 1.32, 1.46, 1.63, 1.76, and 1.175 in this final rule apply only to patent applications filed under 35 U.S.C. 111, 363, or 385 on or after September 16, 2012. The changes to 37 CFR 1.53(b) and (c) and 1.57(a)(4) in this final rule apply only to patent applications filed under 35 U.S.C. 111 on or after December 18, 2013.

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**SUPPLEMENTARY INFORMATION:**

*Executive Summary: Purpose:* Under the Hague Agreement available at <http://www.wipo.int/treaties/en/registration/hague/>, qualified applicants may apply for design protection in the Contracting Parties to the Hague Agreement by filing a single, standardized international design application in a single language. Title I of the PLTIA amends title 35,

United States Code, to implement the provisions of the Hague Agreement and is to take effect on the entry into force of the Hague Agreement with respect to the United States. This final rule revises the relevant rules of practice in title 37, chapter I, of the Code of Federal Regulations to implement title I of the PLTIA.

*Summary of Major Changes to U.S. Practice:* The major changes to U.S. practice in title I of the PLTIA pertain to: (1) Standardizing formal requirements for international design applications; (2) establishing the United States Patent and Trademark Office ("USPTO" or "Office") as an office through which international design applications may be filed; (3) providing a right of priority with respect to international design applications; (4) treating an international design application that designates the United States as having the same effect from its filing date as that of a national design application; (5) providing provisional rights for published international design applications that designate the United States; (6) setting the patent term for design patents issuing from both national design applications under chapter 16 and international design applications designating the United States to 15 years from the date of patent grant; (7) providing for examination by the Office of international design applications that designate the United States; and (8) permitting an applicant's failure to act within prescribed time limits in an international design application to be excused as to the United States under certain conditions. In addition, as to the applicability dates for certain provisions in existing rules, this final rule makes those applicability dates more accessible by stating them directly in the body of those rules.

The Office is specifically revising the rules of practice (37 CFR parts 1, 3, 5, 11, and 41) to provide for the filing of international design applications by applicants in the USPTO as an office of indirect filing. The Office will transmit the international design application and any collected international fees to the International Bureau of the World Intellectual Property Organization ("WIPO"), subject to national security review and payment of a transmittal fee. The International Bureau will review the application for compliance with the applicable formal requirements under the Hague Agreement.

The Office is also revising the rules of practice to set forth the formal requirements of an international design application, including specific content requirements where the United States is designated. Specifically, an

international design application designating the United States must identify the inventor and include a claim and the inventor's oath or declaration. The final rules also specify that an international design application designating the United States may be refused by the Office as a designated office if the applicant is not a person qualified under 35 U.S.C. chapter 11 to be an applicant.

Additionally, the Office is revising the rules of practice to provide for examination of international design applications that designate the United States. International design applications are reviewed by the International Bureau for compliance with requirements under the Hague Agreement. Where these requirements have been met, the International Bureau will register the industrial design in the International Register and, subsequently, publish the international registration and send a copy of the publication to each designated office. Since international registration will only occur after the International Bureau finds that the application conforms to the applicable formal requirements, examination before the Office will generally be limited to substantive matters. With certain exceptions, the Hague Agreement imposes a time period of up to 12 months from the date of publication of the international registration for an examining office to refuse an international design application. The rules are revised to provide for the applicability of the requirements of 35 U.S.C. chapter 16 to examination of international design applications consistent with the Hague Agreement and to provide for the various notifications to the International Bureau required of an examining office under the Hague Agreement.

The Office is further revising the rules of practice to provide for: (1) Review of a filing date established by the International Bureau; (2) excusing an applicant's failure to act within prescribed time limits in connection with an international design application; (3) priority claims with respect to international design applications; (4) payment of fees; and (5) treatment of international design applications for national security review.

*Costs and Benefits:* This rulemaking is not economically significant under Executive Order 12866 (Sept. 30, 1993).

*Background:* The Hague Agreement, negotiated under the auspices of WIPO, is the latest revision to the 1925 Hague Agreement Concerning the International Deposit of Industrial Designs ("1925

Agreement"). The United States is not a party to the 1925 Agreement and did not join any of the subsequent Acts revising the 1925 Agreement, because those agreements either did not provide, or did not adequately provide, for substantive examination of international design applications by national offices. The Hague Agreement, adopted at a diplomatic conference on July 2, 1999, is the first Act that adequately provides for a system of individual review by the national offices of Contracting Parties.

In accordance with Article 28, the Hague Agreement will enter into force for the United States three months after the date that the United States deposits its instrument of ratification with the Director General of the International Bureau of WIPO or at any later date indicated in the instrument. As stated in the President's November 13, 2006, Letter of Transmittal to the Senate, the United States will not deposit its instrument of ratification until the necessary implementing legal structure has been established domestically. Treaty Doc. 109–21. Title I of the PLTIA, enacted on December 18, 2012, amended title 35, United States Code, in order to implement the Hague Agreement. See Public Law 112–211, sections 101–103, 126 Stat. 1527, 1527–33 (2012). Its provisions are to take effect on the entry into force of the Hague Agreement with respect to the United States. On February 13, 2015, the United States deposited its instrument of ratification with the Director General of the International Bureau of WIPO. These final rules implement title I of the PLTIA.

The main purpose of the Hague Agreement is to facilitate protection for industrial designs by allowing applicants to apply for protection in those countries and intergovernmental organizations that are Contracting Parties to the Hague Agreement by filing a single standardized application in a single language. Currently, a U.S. design applicant seeking global protection generally has to file separate design applications in each country or intergovernmental organization for which protection is sought, complying with the formal requirements imposed by each country or intergovernmental organization. The Hague Agreement simplifies the application process and reduces the costs for applicants seeking to obtain rights globally. The Hague Agreement also provides for centralized international registration of designs and renewal of registrations. The Hague Agreement imposes a time limit on a Contracting Party to refuse the effects of international registration in that Contracting Party if the conditions for

the grant of protection under the law of that Contracting Party are not met.

Major provisions of the Hague Agreement as implemented by title I of the PLTIA include the following:

Article 3 of the Hague Agreement provides that "[a]ny person that is a national of a State that is a Contracting Party or of a State member of an intergovernmental organization that is a Contracting Party, or that has a domicile, a habitual residence or a real and effective industrial or commercial establishment in the territory of a Contracting Party, shall be entitled to file an international application." Article 4(1)(a) provides that "[t]he international application may be filed, at the option of the applicant, either directly with the International Bureau or through the Office of the applicant's Contracting Party." Article 4(2) allows "[t]he Office of any Contracting Party [to] require that the applicant pay a transmittal fee to it, for its own benefit, in respect of any international application filed through it."

Section 101(a) of the PLTIA adds 35 U.S.C. 382 to implement the provisions of Articles 3 and 4. 126 Stat. at 1528. Section 382(a) provides that "[a]ny person who is a national of the United States, or has a domicile, a habitual residence, or a real and effective industrial or commercial establishment in the United States, may file an international design application by submitting to the Patent and Trademark Office an application in such form, together with such fees, as may be prescribed by the Director." *Id.* Section 382(b) requires the Office to "perform all acts connected with the discharge of its duties under the [Hague Agreement], including the collection of international fees and the transmittal thereof to the International Bureau." *Id.* Transmittal of the international design application is subject to 35 U.S.C. chapter 17 and payment of a transmittal fee. *Id.*

Article 5 of the Hague Agreement and Rule 7 of the "Common Regulations under the 1999 Act and the 1960 Act of the Hague Agreement" ("Hague Agreement Regulations" or "Regulations") concern the contents of an international design application. Article 5(1) requires the international design application to be in one of the prescribed languages and specifies the contents required for all international design applications. Specifically, it provides that the application "shall contain or be accompanied by (i) a request for international registration under [the Hague Agreement]; (ii) the prescribed data concerning the applicant; (iii) the prescribed number of copies of a reproduction or, at the

choice of the applicant, of several different reproductions of the industrial design that is the subject of the international application, presented in the prescribed manner; however, where the industrial design is two-dimensional and a request for deferment of publication is made in accordance with [Article 5(5)], the international application may, instead of containing reproductions, be accompanied by the prescribed number of specimens of the industrial design; (iv) an indication of the product or products which constitute the industrial design or in relation to which the industrial design is to be used, as prescribed; (v) an indication of the designated Contracting Parties; (vi) the prescribed fees; [and] (vii) any other prescribed particulars."

Article 5(2) of the Hague Agreement and Rule 11 of the Hague Agreement Regulations set forth additional mandatory contents that may be required by any Contracting Party whose Office is an Examining Office and whose law, at the time it becomes party to the Hague Agreement, so requires. Specifically, Article 5(2) provides that "an application for the grant of protection to an industrial design . . . [may], in order for that application to be accorded a filing date under that law" be required to contain any of the following elements: "(i) Indications concerning the identity of the creator of the industrial design that is the subject of that application; (ii) a brief description of the reproduction or of the characteristic features of the industrial design that is the subject of that application; [and] (iii) a claim."

Section 101(a) of the PLTIA adds 35 U.S.C. 383 to provide that, "[i]n addition to any requirements pursuant to chapter 16, the international design application shall contain—(1) a request for international registration under the treaty; (2) an indication of the designated Contracting Parties; (3) data concerning the applicant as prescribed in the treaty and the Regulations; (4) copies of a reproduction or, at the choice of the applicant, of several different reproductions of the industrial design that is the subject of the international design application, presented in the number and manner prescribed in the treaty and the Regulations; (5) an indication of the product or products that constitute the industrial design or in relation to which the industrial design is to be used, as prescribed in the treaty and the Regulations; (6) the fees prescribed in the treaty and the Regulations; and (7) any other particulars prescribed in the Regulations." 126 Stat. at 1528–29.

Article 6 of the Hague Agreement provides a right of priority with respect to international design applications. Article 6(1) provides that “[t]he international design application may contain a declaration claiming, under Article 4 of the Paris Convention, the priority of one or more earlier applications filed in or for any country party to that Convention or any Member of the World Trade Organization.” Article 6(2) provides that “[t]he international [design] application shall, as from its filing date and whatever may be its subsequent fate, be equivalent to a regular filing within the meaning of Article 4 of the Paris Convention.”

Section 101(a) of the PLTIA adds 35 U.S.C. 386 to provide for a right of priority with respect to international design applications. Section 386(a) provides that “[i]n accordance with the conditions and requirements of subsections (a) through (d) of section 119 and section 172, a national application shall be entitled to the right of priority based on a prior international design application that designated at least 1 country other than the United States.” 126 Stat. at 1529. Section 386(b) provides that “[i]n accordance with the conditions and requirements of subsections (a) through (d) of section 119 and section 172 and the treaty and the Regulations, an international design application designating the United States shall be entitled to the right of priority based on a prior foreign application, a prior international application as defined in section 351(c) designating at least 1 country other than the United States, or a prior international design application designating at least 1 country other than the United States.” *Id.* Section 386(c) provides for domestic benefit claims with respect to international design applications designating the United States in accordance with the conditions and requirements of 35 U.S.C. 120. 126 Stat. at 1529–30.

Article 7 of the Hague Agreement and Rule 12 of the Hague Agreement Regulations provide for designation fees. Under Article 7(2) and Rule 12(3), the designation fee may be an “individual designation fee.” Article 7(2) provides that for any Contracting Party whose Office is an Examining Office, the “amount may be fixed by the said Contracting Party . . . for the maximum period of protection allowed by the Contracting Party concerned.” Rule 12(3) provides that the individual designation fee may “comprise[ ] two parts, the first part to be paid at the time of filing the international design application and the second part to be paid at a later date which is determined

in accordance with the law of the Contracting Party concerned.” Rule 12(1) lists other fees concerning the international design application, including the basic fee and publication fee.

Article 8(1) of the Hague Agreement and Rule 14 of the Hague Agreement Regulations provide that the International Bureau will examine the international design application for compliance with the requirements of the Hague Agreement and Regulations and invite the applicant to make any required correction within a prescribed time limit. Under Article 8(2), the failure to timely comply with the invitation will result in abandonment of the application, except where the irregularity concerns a requirement under Article 5(2) or a special requirement under the Regulations, in which case the failure to timely correct will result in the application being deemed not to contain the designation of the Contracting Party concerned.

Article 9 of the Hague Agreement establishes the filing date of an international design application. Article 9(1) provides that “[w]here the international application is filed directly with the International Bureau, the filing date shall, subject to [Article 9(3)], be the date on which the International Bureau receives the international application.” Article 9(2) provides that “[w]here the international application is filed through the Office of the applicant’s Contracting Party, the filing date shall be determined as prescribed.” The filing date of an international application filed with an office of indirect filing is prescribed in Rule 13(3) of the Regulations.

Article 9(3) provides that “[w]here the international application has, on the date on which it is received by the International Bureau, an irregularity which is prescribed as an irregularity entailing a postponement of the filing date of the international application, the filing date shall be the date on which the correction of such irregularity is received by the International Bureau.” Rule 14(1) sets forth the time limit in which the applicant is required to correct such irregularities, and Rule 14(2) sets forth the irregularities that are prescribed as entailing postponement of the filing date of the international design application.

The PLTIA adds 35 U.S.C. 384, which provides in subsection (a) that the filing date of an international design application in the United States shall be the “effective registration date” subject to review under subsection (b). 126 Stat. at 1529. The term “effective registration date” is defined in section 381(a)(5),

added by the PLTIA, as “the date of international registration determined by the International Bureau under the treaty.” 126 Stat. at 1528. Section 384(b) provides that “[a]n applicant may request review by the Director of the filing date of the international design application in the United States” and that “[t]he Director may determine that the filing date of the international design application in the United States is a date other than the effective registration date.” 126 Stat. at 1529. It also authorizes the Director to “establish procedures, including the payment of a surcharge, to review the filing date under this section.” *Id.* Section 384(a) also provides that “any international design application designating the United States that otherwise meets the requirements of chapter 16 may be treated as a design application under chapter 16.” *Id.*

Article 10(1) of the Hague Agreement provides that “[t]he International Bureau shall register each industrial design that is the subject of an international application immediately upon receipt by it of the international application or, where corrections are invited under Article 8, immediately upon receipt of the required corrections.” Article 10(2) provides that “[s]ubject to subparagraph (b), the date of the international registration shall be the filing date of the international application.” Article 10(2)(b) provides that “[w]here the international application has, on the date on which it is received by the International Bureau, an irregularity that relates to Article 5(2), the date of the international registration shall be the date on which the correction of such irregularity is received by the International Bureau or the filing date of the international application, whichever is the later.” Under Rule 15(2) of the Regulations, “[t]he international registration shall contain (i) all the data contained in the international application . . . ; (ii) any reproduction of the industrial design; (iii) the date of the international registration; (iv) the number of the international registration; [and] (v) the relevant class of the International Classification, as determined by the International Bureau.”

Article 10(3)(a) of the Hague Agreement provides that “[t]he international registration shall be published by the International Bureau.” Under Article 10(3)(b), “[t]he International Bureau shall send a copy of the publication of the international registration to each designated Office.”

Section 101(a) of the PLTIA adds 35 U.S.C. 390 to provide that “[t]he publication under the treaty of an

international design application designating the United States shall be deemed a publication under [35 U.S.C.] 122(b).” 126 Stat. at 1531.

Article 10(4) of the Hague Agreement provides that the International Bureau shall, subject to Articles 10(5) and 11(4)(b), keep each international application and international registration confidential until publication. Under Article 10(5)(a), “[t]he International Bureau shall, immediately after registration has been effected, send a copy of the international registration, along with any relevant statement, document or specimen accompanying the international application, to each Office that has notified the International Bureau that it wishes to receive such a copy and has been designated in the international application.”

Article 11 of the Hague Agreement provides for deferment of publication under certain conditions. Article 11(3) prescribes the procedure where a request for deferment of publication is filed in an international design application designating a Contracting Party that has made a declaration under Article 11(1)(b) stating that deferment of publication is not possible under its law.

Article 12(1) of the Hague Agreement provides that “[t]he Office of any designated Contracting Party may, where the conditions for the grant of protection under the law of that Contracting Party are not met in respect of any or all of the industrial designs that are the subject of an international registration, refuse the effects, in part or in whole, of the international registration. . . .” Article 12(1) further provides that “no Office may refuse the effects, in part or in whole, of any international registration on the ground that requirements relating to the form or contents of the international application that are provided for in [the Hague Agreement] or the Regulations or are additional to, or different from, those requirements have not been satisfied under the law of the Contracting Party concerned.” Article 12(2) provides that the refusal of the effects of an international registration shall be communicated to the International Bureau within the prescribed period and shall state the grounds on which the refusal is based. Under Rule 18(1) of the Hague Agreement Regulations, the prescribed period for sending the notification of refusal is six months from publication, or twelve months from publication where an office makes a declaration under Rule 18(1)(b). The declaration under Rule 18(1)(b) may state that the international registration

shall produce the effects under Article 14(2)(a) at the latest “at a time specified in the declaration which may be later than the date referred to in that Article but which shall not be more than six months after the said date” or “at a time at which protection is granted according to the law of the Contracting Party where a decision regarding the grant of protection was unintentionally not communicated within the period applicable under [Rule 18(1)(a) or (b)].” See Rule 18(1)(c).

Rule 18(2)(b) provides that the notification of refusal “shall contain or indicate (i) the Office making the notification, (ii) the number of the international registration, (iii) all the grounds on which the refusal is based . . . , (iv) where the . . . refusal is based . . . [on] an earlier national, regional or international application or registration, the filing date and number, the priority date (if any), the registration date and number (if available), a copy of a reproduction of the earlier industrial design (if . . . accessible to the public) and the name and address of the owner . . . , (v) where the refusal does not relate to all the industrial designs that are the subject of the international registration, those to which it relates or does not relate, (vi) whether the refusal may be subject to review or appeal . . . , and (vii) the date on which the refusal was pronounced.”

Article 12(3) of the Hague Agreement provides that “[t]he International Bureau shall, without delay, transmit a copy of the notification of refusal to the holder,” and that “[t]he holder shall enjoy the same remedies as if . . . the international registration had been the subject of an application for a grant of protection under the law applicable to the Office that communicated the refusal.” Under Article 12(4), “[a]ny refusal may be withdrawn, in part or in whole, at any time by the Office that communicated it.”

Article 13 of the Hague Agreement permits a Contracting Party to notify the Director General in a declaration, where the Contracting Party’s “law, at the time it becomes party to this Act, requires that designs [in the] application conform to a requirement of unity of design, unity of production or unity of use, . . . or that only one independent and distinct design may be claimed in a single application.”

Under Article 14(1) of the Hague Agreement, “[t]he international registration shall, from the date of the international registration, have at least the same effect in each designated Contracting Party as a regularly-filed application for the grant of protection of

the industrial design under the law of that Contracting Party.”

Section 101(a) of the PLTIA adds 35 U.S.C. 385 to provide that “[a]n international design application designating the United States shall have the effect, for all purposes, from its filing date . . . , of an application for patent filed in the Patent and Trademark Office pursuant to chapter 16 [of title 35, United States Code].” 126 Stat. at 1529. The PLTIA also amends 35 U.S.C. 154 to provide for provisional rights in international design applications that designate the United States. 126 Stat. at 1531–32.

Article 14(2)(a) of the Hague Agreement provides that “[i]n each designated Contracting Party the Office of which has not communicated a refusal in accordance with Article 12, the international registration shall have the same effect as a grant of [design] protection . . . under the law of that Contracting Party at the latest from the date of expiration of the period allowed for it to communicate a refusal or, where a Contracting Party has made a corresponding declaration under the Regulations, at the latest at the time specified in that declaration.” Article 14(2)(b) provides that “[w]here the Office of a designated Contracting Party has communicated a refusal and has subsequently withdrawn, in part or in whole, that refusal, the international registration shall, to the extent that the refusal is withdrawn, have the same effect in that Contracting Party as a grant of [design protection] under the law of the said Contracting Party at the latest from the date on which the refusal was withdrawn.” Rule 18(4) of the Hague Agreement Regulations sets forth the required contents of a notification of withdrawal of refusal. Alternatively, under Rule 18*bis*(2), the office of a Contracting Party may send the International Bureau a statement of grant of protection instead of a notification of withdrawal of refusal.

Article 16 of the Hague Agreement and Rule 21 of the Hague Agreement Regulations provide for the recording of certain changes in the International Register by the International Bureau, such as changes in ownership or the name or address of the holder. Under Article 16(2), any such recording at the International Bureau “shall have the same effect as if it had been made in the Register of the Office of each of the Contracting Parties concerned, except that a Contracting Party may, in a declaration, notify the Director General that a recording [of a change in ownership] shall not have that effect in that Contracting Party until the Office of that Contracting Party has received the

statements or documents specified in that declaration.”

Under Article 17 of the Hague Agreement, an “international design registration shall be effected for an initial term of five years counted from the date of international registration” and “may be renewed for additional terms of five years, in accordance with the prescribed procedure and subject to payment of the prescribed fees.” The initial term of protection and additional terms may be replaced by a maximum period of protection allowed by a Contracting Party. *See* Article 7(2). The PLTIA amends 35 U.S.C. 173 to set the term of a design patent to 15 years from date of grant. 126 Stat. at 1532.

The PLTIA adds 35 U.S.C. 387 to allow the Director to establish procedures, including a requirement for payment of the fee specified in 35 U.S.C. 41(a)(7), to excuse as to the United States “[a]n applicant’s failure to act within prescribed time limits in connection with requirements pertaining to an international design application” upon a showing of unintentional delay. 126 Stat. at 1530.

Hague Agreement Regulations Rule 8 provides for certain requirements concerning the applicant and the creator. Under Rule 8(1)(a)(ii), “[w]here the law of a Contracting Party bound by the 1999 Act requires the furnishing of an oath or declaration of the creator, that Contracting Party may, in a declaration, notify the Director General of that fact.” Rule 8(1)(b) provides that the declarations referred to in Rules 8(1)(a)(i) and (a)(ii) shall specify the form and mandatory contents of any required statement, document, oath, or declaration. Rule 8(3) provides that “[w]here an international application contains the designation of a Contracting Party that has made the declaration referred to in paragraph (1)(a)(ii) it shall also contain indications concerning the identity of the creator of the industrial design.” *See* discussion of § 1.1021(d).

Relevant documents, including the implementing legislation (title I of the PLTIA), Senate Committee Reports, and the Transmittal Letter, are available on the USPTO Web site at [http://www.uspto.gov/patents/int\\_protect/index.jsp](http://www.uspto.gov/patents/int_protect/index.jsp). This Web site also contains a link to WIPO’s Web site, which makes available relevant treaty documents, currently at [http://www.wipo.int/hague/en/legal\\_texts/](http://www.wipo.int/hague/en/legal_texts/).

#### Discussion of Specific Rules

The following is a discussion of the amendments to title 37 of the Code of Federal Regulations, parts 1, 3, 5, 11, and 41.

*Section 1.4:* Section 1.4(a)(2) is amended to include a reference to the final rules relating to international design applications in subpart I.

*Section 1.5:* Section 1.5(a) is amended to provide that the international registration number may be used on correspondence directed to the Office to identify an international design application. The international registration number is the number assigned by the International Bureau upon registration of the international design in the International Register. *See* Rule 15 of the Regulations.

*Section 1.6:* Section 1.6(d)(3) is amended to include the filing of an international design application among the correspondence for which facsimile transmission is not permitted and, if submitted, will not be accorded a receipt date. This is consistent with the treatment of the filing of national patent applications and international applications under the Patent Cooperation Treaty (“PCT”).

Section 1.6(d)(4) is amended to prohibit the filing of color drawings by facsimile in an international design application. This is consistent with the treatment of color drawings in national applications and international applications under the PCT.

Section 1.6(d)(6) is amended to change “a patent application” to “an application” to clearly prohibit the submission of correspondence by facsimile in an international design application that is subject to a secrecy order under §§ 5.1 through 5.5.

*Section 1.8:* Section 1.8(a)(2)(i) is amended to add a new paragraph (K) to include the filing of an international design application among the correspondence that will not receive benefit from a Certificate of Mailing or Transmission. *See* discussion of § 1.6(d)(3), *supra*.

*Section 1.9:* Sections 1.9(a)(1) and (a)(3) are amended to include in the definitions of “national application” and “nonprovisional application,” respectively, an international design application filed under the Hague Agreement for which the Office has received a copy of the international registration pursuant to Hague Agreement Article 10. Pursuant to 35 U.S.C. 385, added by section 101(a) of the PLTIA, an international design application that designates the United States has the effect from its filing date under 35 U.S.C. 384 of an application for patent filed in the United States Patent and Trademark Office pursuant to 35 U.S.C. chapter 16. 126 Stat. at 1529. The filing date of an international design application is, subject to review, the international registration date.

*See* discussion of § 1.1023, *infra*. Under Article 10, the International Bureau will send a copy of the international registration to each designated office after publication (Article 10(3)) or, upon notification by the Contracting Party, immediately after international registration (Article 10(5)). Consequently, the Office will receive a copy of the international registration pursuant to Article 10 only if the United States has been designated. The Office notes that, while the definition of “nonprovisional application” in § 1.9(a)(3) may include international applications under the PCT and international design applications under the Hague Agreement satisfying certain conditions, neither the PCT, the Hague Agreement, nor U.S. law provides for provisional international applications or international design applications.

Sections 1.9(l) and 1.9(m) are added to define “Hague Agreement,” “Hague Agreement Article,” “Hague Agreement Regulations,” and “Hague Agreement Rule” as used in chapter I of title 37 of the Code of Federal Regulations (“CFR”).

Section 1.9(n) is added to define “international design application” as used in chapter I of title 37 of the CFR. Section 1.9(n) further provides that unless otherwise clear from the wording, reference to “design application” or “application for a design patent” in chapter I of the CFR includes an international design application that designates the United States.

*Section 1.14:* Section 1.14(a)(1) introductory text is amended to add a reference to added paragraph (j) concerning international design applications.

Section 1.14(a)(1)(ii) is amended to replace the reference to “abandoned application that has been published as a patent application publication” with a reference to “abandoned published application.” This change is consistent with the language of § 1.11(a) to which § 1.14(a)(1)(ii) refers. In addition, the term “published application” is defined in § 1.9(c) as “an application for patent which has been published under 35 U.S.C. 122(b).” Pursuant to 35 U.S.C. 374 and 35 U.S.C. 390, international applications and international design applications that designate the United States and are published under the respective treaty, “shall be deemed a publication under section 122(b).” Accordingly, a published application for purposes of § 1.14 will include a publication by the International Bureau of either an international application under the PCT or an international design application under the Hague Agreement that designates the United

States. Access to such published applications is permitted under PCT Article 30 and Hague Agreement Article 10. In contrast, the term “patent application publication” refers to a publication by the Office under § 1.215. The Office will not publish international design applications under § 1.215 (see § 1.211), as international design applications are published in English by the International Bureau under the Hague Agreement. See Hague Agreement Article 10(3) and Rule 6(2). See also 35 U.S.C. 390, added by the PLTIA, deeming a publication under the Hague Agreement as a publication under 35 U.S.C. 122(b). 126 Stat. at 1531. In addition, the Office does not publish applications for design patents under 35 U.S.C. chapter 16. See § 1.211(b).

Sections 1.14(a)(1)(iv)–(vi) are amended to include a publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States among the publications for which access to an unpublished application may be obtained. Section 1.14(a)(1)(iv) is amended to permit access to the file contents of an unpublished abandoned application where the application is identified in the publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States, or where benefit of the application is claimed under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) in an application that has issued as a U.S. patent or has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3). Section 1.14(a)(1)(v) is amended to permit access to the file contents of an unpublished pending application where benefit of the application is claimed under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) in an application that has issued as a U.S. patent or has published as a statutory invention registration, a U.S. patent application publication, an international publication under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3). Section 1.14(a)(1)(vi) is amended to permit access to a copy of the application as originally filed of an unpublished pending application if the application is incorporated by reference or otherwise identified in a U.S. patent, a statutory

invention registration, a U.S. patent application publication, an international publication under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States.

Section 1.14(a)(1)(vii) is amended consistent with amendments to §§ 1.14(a)(1)(iv)–(vi).

Section 1.14(a)(2)(iv) is amended to add a reference to benefit claims under 35 U.S.C. 386, as provided by the PLTIA. 126 Stat. 1529–30.

Section 1.14(j) is added to set forth the conditions under which the records of an international design application maintained by the Office will be made available to the public.

Section 1.14(j)(1) provides that, with respect to an international design application maintained by the Office in its capacity as a designated office for national processing, the records associated with the international design application may be made available as provided under §§ 1.14(a)–(i). Under Hague Agreement Article 10(5), the Office is to keep international design registrations confidential until publication of the international registration by the International Bureau. This provision does not alter the Office’s long-standing practice to make application files available to the public to satisfy the constitutionally mandated quid pro quo requiring public disclosure of patented inventions. See *United States ex rel. Pollok v. Hall*, 1889 Dec. Comm’r Pat. 582, 48 O.G. 1263 (D.C. 1888) (recognizing that the rights of exclusivity and confidentiality stem from Article I, Section 8, clause 8, of the Constitution in holding that the Office must make available to the public an abandoned application specifically referenced in a patent); P.J. Federico, *Commentary on the New Patent Act*, reprinted in 75 J. Pat. & Trademark Off. Soc’y 161, 196–97 (1993) (as background discussion to the addition of section 122 to the 1952 Patent Act, noting that for nearly 100 years the Office has had regulations requiring that applications be maintained confidential while recognizing public accessibility when an abandoned application is referenced in a later issued patent); see also *Metropolitan West Side Elevated Railroad Co. et al. v. Siemens*, 1898 Dec. Comm’r Pat. 220, 222, 85 O.G. 290 (Comm’r Pat. 1898); *In re Reed Manufacturing Co.*, 1900 Dec. Comm’r Pat. 140, 92 O.G. 2001 (Comm’r Pat. 1900); *Ex parte Lewis and Unger*, 1903 Dec. Comm’r Pat. 303, 106 O.G. 543 (Comm’r Pat. 1903); *In re Doman*, 1905 Dec. Comm’r Pat. 101, 115 O.G. 804

(Comm’r Pat. 1905). As a designated office, the Office will establish a file for national processing upon receipt of the published international registration from the International Bureau. In such cases, the records of the application file will be available pursuant to §§ 1.14(a)(ii)–(iii). The provisions of § 1.14(j)(1) provide for access to such international design applications maintained by the Office for national processing, thus treating international design applications the same as regular national applications.

Section 1.14(j)(2) provides that, with respect to an international design application maintained by the Office in its capacity as an office of indirect filing (§ 1.1002), the records of the international design application may be available under § 1.14(j)(1) when they are contained in the file of the international design application maintained by the Office for national processing. Also, if benefit of the international design application is claimed under 35 U.S.C. 386(c) in a U.S. patent or published application, the file contents of the application may be made available to the public, or the file contents of the application, a copy of the application-as-filed, or a specific document in the file of the application may be provided to any person upon written request and payment of the appropriate fee (§ 1.19(b)). The Office will place the application filed with the Office as an office of indirect filing in the file used for national processing as a designated office. Consequently, the records maintained by the Office as an office of indirect filing may be available where the records are part of the file maintained by the Office as a designated office and are available pursuant to § 1.14(j)(1). The records maintained by the Office as an office of the indirect filing may also be available where benefit to the international design application is claimed under 35 U.S.C. 386(c) in a U.S. patent or published application. Under the provisions of 35 U.S.C. 386(c) and 35 U.S.C. 388, applicants may claim benefit to an international design application that designates the United States provided the application claiming benefit of the international design application is filed before the date of withdrawal, renunciation, cancellation, or abandonment of the international application, either generally or as to the United States.

**Section 1.16:** Sections 1.16(b), (l), and (p) are amended to clarify that the design application fees specified therein are applicable only to design applications filed under 35 U.S.C. 111 (i.e., an application filed under 35

U.S.C. chapter 16). The other provisions of § 1.16 are not changed.

Section 1.17: Section 1.17(f) is amended to specify the fee for filing a petition under § 1.1023 to review the filing date of an international design application in the United States. Section 101(a) of the PLTIA adds 35 U.S.C. 384, which provides that the filing date of an international application in the United States is the effective registration date (35 U.S.C. 384(a)), and authorizes the Director to establish procedures, including the payment of a surcharge, to review the filing date, which may result in a determination that the application has a filing date in the United States other than the effective registration date (35 U.S.C. 384(b)). 126 Stat. at 1529. The review procedure authorized under 35 U.S.C. 384(b) is set forth in § 1.1023, discussed *infra*, which requires, *inter alia*, the fee set forth in § 1.17(f). Under 35 U.S.C. 389(b), added by the PLTIA, all questions of procedures regarding an international design application designating the United States, unless required by the Hague Agreement and Hague Agreement Regulations, shall be determined as in the case of applications filed under 35 U.S.C. chapter 16. 126 Stat. at 1530.

Accordingly, pursuant to the authority under 35 U.S.C. 389(b), the fee for filing a petition to review the filing date of an international design application under § 1.1023 is the same as the fee for filing a petition to accord a filing date in a national application (*see* § 1.53(e)).

Section 1.17(g) is amended to specify the fee for filing a petition under § 1.55(g) for acceptance of a belated certified copy of a foreign application in a design application. *See* discussion of § 1.55(g).

Section 1.17(i)(1) is amended to remove the processing fee under § 1.55 for entry of a priority claim or certified copy of a foreign application after payment of the issue fee. *See* discussion of § 1.55(g).

Section 1.17(m) is amended to set forth the fee for filing a petition to excuse an applicant's failure to act within prescribed time limits in an international design application. Section 101(a) of the PLTIA adds 35 U.S.C. 387 to provide that an applicant's failure to act within prescribed time limits in connection with requirements pertaining to an international design application may be excused as to the United States upon a showing satisfactory to the Director of unintentional delay and under such conditions, including a requirement for payment of the fee specified in 35 U.S.C. 41(a)(7), as may be prescribed by the Director. 126 Stat. at 1530. The

conditions for excusing an applicant's failure to act within the prescribed time limits in an international design application are set forth in § 1.1051, discussed *infra*. These requirements include, *inter alia*, the requirement to pay the fee set forth in § 1.17(m). The fee set forth in § 1.17(m) does not include a micro entity amount as this fee is set under 35 U.S.C. 41(a)(7) as amended by section 202(b)(1)(A) of the PLTIA, and not section 10(a) of the AIA. Section 10(b) of the AIA provides that the micro entity discount applies to fees set under section 10(a) of the AIA. *See* Public Law 112–29, 125 Stat. 284, 316–17 (2011). The Office will consider including a micro entity amount in § 1.17(m) in the event that patent fees are again set or adjusted under section 10(a) of the AIA.

Section 1.17(t) is amended to specify the fee for filing a petition under § 1.1052 to convert an international design application to a design application under 35 U.S.C. chapter 16. *See* discussion of § 1.1052, *infra*. The petition fee is not being set pursuant to section 10(a) of the AIA. Rather, the Office is setting this fee in this rulemaking pursuant to its authority under 35 U.S.C. 41(d)(2), which provides that fees for all processing, services, or materials relating to patents not specified in 35 U.S.C. 41 are to be set at amounts to recover the estimated average cost to the Office of such processing, services, or materials.

The Office uses an Activity Based Information (“ABI”) methodology to determine the estimated average costs (or expense) on a per process, service, or material basis including the particular processes and services addressed in this rulemaking. The ABI analysis includes compiling the Office costs for a specified activity, including the direct-expense (*e.g.*, direct personnel compensation, contract services, maintenance and repairs, communications, utilities, equipment, supplies, materials, training, rent, and program-related information technology (“IT”) automation), an appropriate allocation of allocated direct expense (*e.g.*, rent, program-related automation, and personnel compensation benefits such as medical insurance and retirement), and an appropriate allocation of allocated indirect expense (*e.g.*, general financial and human resource management, nonprogram specific IT automation, and general Office expenses). The direct expense for an activity plus its allocated direct expense and allocated indirect expense is the “fully burdened” expense for that activity. The “fully burdened” expense for an activity is then divided by

production measures (number of that activity completed) to arrive at the fully burdened per-unit cost for that activity. The cost for a particular process is then determined by ascertaining which activities occur for the process and how often each such activity occurs for the process. If historical activity level information is not available for a particular fee, then ABI uses a cost build-up approach using position, salary, and burdening rate data to determine the full cost of work related to a particular fee. The ABI analysis in this rulemaking is based upon fiscal year 2012 expense. The prospective fees are calculated using the ABI expense and applying adjustment factors to estimate the cost in fiscal year 2015 expense, as fiscal year 2015 may be the next opportunity to consider whether to revisit the fees under section 10(a) of the AIA. This analysis uses 2012 expense as a proxy and adjusts for yearly inflation in the out-years.

The Office is estimating the fiscal year 2015 cost in this rulemaking by using the change in the Consumer Price Index for All Urban Consumers (“CPI-U”) for fiscal years 2013, 2014, and 2015, as the CPI-U is a reasonable basis for determining the change in Office costs between fiscal year 2012 and fiscal year 2015. The individual CPI-U increases for each fiscal year are multiplied together to obtain a cumulative CPI-U from fiscal year 2013 through fiscal year 2015. The actual CPI-U increase for fiscal year 2013 was 1.4 percent. The CPI-U increase for fiscal year 2014 is forecasted to be 1.6 percent. The CPI-U increase for fiscal year 2015 is forecasted to be 2.0 percent. *See Fiscal Year 2015 Analytical Perspectives*, <http://www.whitehouse.gov/sites/default/files/omb/budget/fy2015/assets/spec.pdf>. Thus, the estimated fiscal year 2015 cost amounts are calculated by multiplying the actual expense amount for fiscal year 2012 by 1.051 (1.014 multiplied by 1.016 multiplied by 1.020 equals 1.051). The estimated fiscal year 2015 cost amounts are then rounded to the nearest ten dollars by applying standard arithmetic rules so that the resulting fee amounts will be convenient for international design application users.

The processing of a petition to convert an international design application to a design application under 35 U.S.C. chapter 16 involves review and preparation of a decision for the petition. An estimate of the number of hours required for a GS–12, Step 5, attorney to review the petition and draft a decision is two hours. The ABI analysis indicates that the estimated fully burdened expense during fiscal



year 2012 to review and prepare a decision for the petition is \$172 (\$86 fully burdened labor cost per hour multiplied by 2). Thus, the Office estimates that the fiscal year prospective unit cost to review the petition and draft a decision, using the estimated CPI-U increase for fiscal years 2013, 2014, and 2015, is \$181 (\$172 multiplied by 1.051), which, when rounded to the nearest ten dollars, is a petition fee for conversion of \$180. Additional information concerning the Office's analysis of the estimated fiscal year 2015 costs for converting an international design application to a design application under 35 U.S.C. chapter 16 is available upon request.

**Section 1.18:** Section 1.18(b)(3) is added to provide that an issue fee paid through the International Bureau in an international design application designating the United States shall be in the amount specified on the Web site of WIPO, currently available at <http://www.wipo.int/hague>, at the time the fee is paid. The option for applicants to pay the issue fee through the International Bureau is provided for in Hague Agreement Rule 12(3)(c) and is in lieu of paying the issue fee under § 1.18(b)(1). Article 7(2) permits a Contracting Party to declare that the prescribed designation fee shall be replaced by an individual designation fee, whose amounts can be changed in further declarations. The International Bureau accepts payment only in Swiss currency (see Hague Agreement Rule 28(1)) and all fee amounts specified on the WIPO Web site are in Swiss currency.

**Section 1.25:** Section 1.25(b) is amended to provide that international design application fees may be charged to a deposit account. International design application fees are set forth in § 1.1031. Section 1.25(b) is also amended to provide that a general authorization to charge fees in an international design application set forth in § 1.1031 will only be effective for the transmittal fee (§ 1.1031(a)). The international fees set forth in § 1.1031, other than the transmittal fee set forth in § 1.1031(a), are not required to be paid to the Office as an office of indirect filing. See § 1.1031(d).

**Section 1.27:** The introductory text of § 1.27(c)(3) is amended to provide that the payment, by any party, of the small entity first part of the individual designation fee for the United States to the International Bureau will be treated as a written assertion of entitlement to small entity status. The change to § 1.27(c)(3) will permit international design applicants to establish small entity status for the purpose of the

United States by payment to the International Bureau of the small entity first part of the individual designation fee for the United States.

**Section 1.29:** Section 1.29(e) is amended to provide that a micro entity certification filed in an international design application may be signed by a person authorized to represent the applicant under § 1.1041 before the International Bureau where the micro entity certification is filed with the International Bureau.

**Section 1.32:** The introductory text of § 1.32(d) is amended to add a reference to benefit claims under 35 U.S.C. 386(c), as provided by the PLTIA. 126 Stat. 1529–30. Thus, a power of attorney from a prior national application for which benefit is claimed under 35 U.S.C. 386(c) in a continuing international design application may have effect in the continuing application if a copy of the power of attorney from the prior application is filed in the continuing application, subject to the conditions set forth in § 1.32(d).

**Section 1.41:** Section 1.41(f) is added to set forth the inventorship in an international design application designating the United States. Specifically, the inventorship of an international design application designating the United States is the creator or creators set forth in the publication of the international registration under Hague Agreement Article 10(3). Section 1.41(f) further provides that any correction of inventorship must be pursuant to § 1.48.

**Section 1.46:** The introductory text of § 1.46(b) is amended to provide that if an application entering the national stage under 35 U.S.C. 371 or a nonprovisional international design application is applied for by a person other than the inventor under § 1.46(a) (i.e., the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter, as provided under 35 U.S.C. 118), that person must have been identified as the applicant for the United States in the international stage of the international application or as the applicant in the publication of the international registration under Hague Agreement Article 10(3). The amendment does not change the current practice with respect to national stage applications under 35 U.S.C. 371, where a person seeking to become an applicant under § 1.46 in the national phase was not named as an applicant for the United States in the international phase. In such case, that person must comply with the requirements under § 1.46(c), including the requirements of §§ 3.71

and 3.73, to be an applicant in the national phase. The amendment treats international design applications in the same manner as international applications under the PCT. See discussion of § 1.1011(b), *infra* (regarding who may be an applicant for an international design application designating the United States).

Section 1.46(c) is amended to provide for the correction or update in the name of the applicant in paragraph (c)(1) and a change in the applicant in paragraph (c)(2). Section 1.46(c)(1) corresponds to the first sentence of paragraph (c) of former § 1.46 and further provides that a change in the name of the applicant under § 1.46 recorded pursuant to Hague Agreement Article 16(1)(ii) will be effective to change the name of the applicant in a nonprovisional international design application. Article 16(1)(ii) provides for recording in the International Register by the International Bureau of a change in the name of the holder. Under Article 16(2), such recording has the same effect as if made in the office of each of the designated Contracting Parties. Thus, where the applicant in a nonprovisional international design application under § 1.46 is the holder of the international registration, correction or update of the applicant's name may be made through the mechanism under Article 16(1)(ii). Section 1.46(c)(1) also clarifies that a correction or update of the name of the applicant using an application data sheet must be made in accordance with § 1.76(c)(2), which requires that the information that is changed be indicated by underlining, strike-through, or brackets, as appropriate.

Section 1.46(c)(2) corresponds to the second sentence of paragraph (c) of former § 1.46 and provides that any request to change the applicant under § 1.46 after an original applicant has been specified must include an application data sheet under § 1.76 specifying the applicant in the applicant information section (§ 1.76(b)(7)) in accordance with § 1.76(c)(2) and comply with §§ 3.71 and 3.73. The language of § 1.46(c)(2) is amended to clarify that any change in the applicant under § 1.46 once an applicant has been specified requires identification of the new applicant in an application data sheet in accordance with § 1.76(c)(2) and comply with §§ 3.71 and 3.73. There was some confusion with respect to the proper way to change the applicant where (1) the inventor was the original applicant or (2) the applicant is being changed from a second (or subsequent) applicant to a new applicant. Specifying the applicant in an application filed under 35 U.S.C. 111 may be accomplished



either by the person who has made the application or by the Office where the applicant has not been specified by the time the filing receipt is issued. The Office previously indicated that the inventors may be considered the applicant where an applicant has not otherwise been specified and that compliance with §§ 3.71 and 3.73 is required for any change in the applicant from the inventors. *See Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act*, 77 FR 48775, 48785 (Aug. 14, 2012). In an application entering the national stage under 35 U.S.C. 371, the original applicant specified is the person identified as the applicant for the United States in the international stage of the international application. In a nonprovisional international design application, the original applicant specified is the person identified as the applicant in the publication of the international registration under Hague Agreement Article 10(3). Section 1.46 does not govern changes in inventorship. Rather, any request to add or delete an inventor, or to correct or update the name of an inventor, must be made in accordance with the provisions of § 1.48.

**Section 1.53:** The introductory text of § 1.53(b) is amended to include a reference to 35 U.S.C. 386(c), as added by the PLTIA. Thus, § 1.53(b) provides that a continuing application, which may be a continuation, divisional, or continuation-in-part application, may be filed under the conditions specified in 35 U.S.C. 120, 121, 365(c), or 386(c) and § 1.78.

Section 1.53(c)(4) is amended to include a reference to 35 U.S.C. 386(a) and 386(c), as added by the PLTIA, thus making clear that a provisional application is not entitled to a right of priority or to the benefit of the filing date of an international design application.

Section 1.53(d)(1)(ii) is amended to provide that a continued prosecution application ("CPA") of a prior nonprovisional application may be filed where the prior nonprovisional application is a design application, but not an international design application, that is complete as defined by § 1.51(b), except for the inventor's oath or declaration if the application is filed on or after September 16, 2012, and the prior nonprovisional application contains an application data sheet meeting the conditions specified in § 1.53(f)(3)(i).

**Section 1.55:** Section 1.55 is revised to provide for a right of priority under 35 U.S.C. 386 with respect to

international design applications and for other matters, as discussed below. In addition, as to the applicability dates for certain provisions in existing rules, this final rule makes those applicability dates more accessible by stating them directly in the body of those rules. In particular, the requirements of § 1.55 set forth in the following final rules have been consolidated in this final rule: *Changes To Implement the Patent Law Treaty*, 78 FR 62368, 62399 (Oct. 21, 2013) (changes to § 1.55 made therein applicable to any patent application filed before, on, or after December 18, 2013, except for the changes to § 1.55(f), which is applicable to patent applications filed under 35 U.S.C. 111 on or after December 18, 2013, and international patent applications in which the national stage commenced under 35 U.S.C. 371 on or after December 18, 2013); *Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act*, 78 FR 11024 (Feb. 14, 2013) (applicable to any application filed under 35 U.S.C. 111 or 363 on or after March 16, 2013); *Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act*, 77 FR 48776 (Aug. 14, 2012) (applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012); and *Changes to Implement Eighteen-Month Publication of Patent Applications*, 65 FR 57024 (Sept. 20, 2000) (applicable to patent applications filed on or after November 29, 2000).

Section 1.55(a) is amended to provide that an applicant in a nonprovisional application may claim priority to one or more prior foreign applications under the conditions specified in 35 U.S.C. 386(a) and (b) and this section.

Section 1.55(b) is amended to clarify which application is the "subsequent application" for purposes of § 1.55. Section 1.55(b) provides that the nonprovisional application must be: Filed not later than twelve months (six months in the case of a design application) after the date on which the foreign application was filed, subject to paragraph (c) of the section (a subsequent application); or entitled to claim the benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) of a subsequent application that was filed within the period set forth in paragraph (b)(1) of the section. Thus, the subsequent application in either § 1.55(b)(1) or (b)(2) is the application required to be filed within the period set forth in § 1.55(b)(1). For purposes of § 1.55(b)(2), the subsequent application may be a nonprovisional application, an international application designating

the United States, or international design application designating the United States.

Section 1.55(c) is amended to provide for restoration of priority claims under 35 U.S.C. 386(a) or (b). Restoration of the right of priority is provided for under 35 U.S.C. 119(a), as amended by title II of the PLTIA. 126 Stat. 1534. Section 1.55 was previously amended to implement the provisions of 35 U.S.C. 119, as amended by title II of the PLTIA. *See Changes To Implement the Patent Law Treaty*, 78 FR 62368, 62399 (Oct. 21, 2013). Under 35 U.S.C. 386(a) and (b), entitlement to priority to a prior application shall be "[i]n accordance with the conditions and requirements of subsections (a) through (d) of section 119 and section 172 . . . ." Consequently, § 1.55(c) is amended in this final rule to provide that restoration of the right of priority is available for priority claims under 35 U.S.C. 386(a) and (b).

Section 1.55(c) is also amended to provide that a petition to restore the right of priority filed on or after May 13, 2015 (the effective date of this final rule) must be filed in the subsequent application or in the earliest nonprovisional application claiming benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the subsequent application, if such subsequent application is not a nonprovisional application. The Office has received inquiries from the public asking in which application the petition to restore the right of priority under § 1.55(c) must be filed where there is a chain of applications claiming benefit under 35 U.S.C. 120, 121, or 365(c) to the application for which filing was unintentionally delayed. The amendment to § 1.55(c) is intended to provide clarification by requiring that, on or after May 13, 2015, a petition to restore the right of priority under this paragraph be filed in the subsequent application or in the earliest nonprovisional application claiming benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the subsequent application, if such subsequent application is not a nonprovisional application. If a petition under § 1.55(c) to restore the right of priority is granted, a further petition under § 1.55(c) is not required in an application entitled to claim the benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) of the subsequent application for which the right of priority was restored.

Requiring the filing of the petition under § 1.55(c) in the earliest nonprovisional application claiming benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the subsequent application, when the subsequent application is not a nonprovisional application, is

appropriate because the Office may not have an application file established for the subsequent application. This would occur, for example, where an international application designating the United States was filed in a foreign Receiving office and the applicant files a continuation of the international application under 35 U.S.C. 111(a) rather than entering the national phase under 35 U.S.C. 371. Nevertheless, the statement required under § 1.55(c)(3) must still relate to the unintentional delay in filing the subsequent application, *i.e.*, the international application, in such instance.

Section 1.55(e) is amended to provide that unless such claim is accepted in accordance with the provisions of § 1.55(e), any claim for priority under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 386(a) or 386(b) not presented in the manner required by § 1.55(d) or (m) during pendency and within the time period provided by § 1.55(d) (if applicable) is considered to have been waived. Section 1.55(e) is also amended to provide for the acceptance of a delayed priority claim considered to have been waived under § 1.55 and to provide for acceptance of an unintentionally delayed priority claim under 35 U.S.C. 386(a) or 386(b).

35 U.S.C. 119(b), amended in section 4503 of the American Inventors Protection Act of 1999 (AIPA), provides in paragraph (b)(1) that “[n]o application for patent shall be entitled to this right of priority unless a claim is filed in the Patent and Trademark Office, identifying the foreign application by specifying the application number on 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.” *See* Pub. L. 106–113, 113 Stat. 1501 (1999). 35 U.S.C. 119(b), amended under the AIPA, further provides, in paragraph (b)(2) that “[t]he Director may consider the failure of the applicant to file a timely claim for priority as a waiver of any such claim. The Director may establish procedures, including the requirement for payment of the fee specified in section 41(a)(7), to accept an unintentionally delayed claim under this section.” *Id.* Section 4503 of the AIPA applies “only to applications (including international applications designating the United States) filed on or after [November 29, 2000].” *See Intellectual Property and High Technology Technical Amendments Act of 2002*, Public Law 107–273, 116 Stat. 1757. 35 U.S.C. 119(b)(2) was subsequently amended

under title II of the PLTIA to provide for the payment of the fee specified in 35 U.S.C. 41(a)(7). 126 Stat. 1536. Pursuant to the authority under 35 U.S.C. 119(b)(2), the Office established procedures to accept an unintentionally delayed claim for priority in utility applications. *See Changes to Implement Eighteen-Month Publication of Patent Applications*, 65 FR 57024 (Sept. 20, 2000). However, no procedures were established for accepting an unintentionally delayed priority claim in a design application. The change to § 1.55(e) makes the petition procedure therein applicable to design applications, thus according design applicants the same remedy available to applicants in utility applications.

Section 1.55(f) is amended to provide for an exception under § 1.55(h) to the requirement for a certified copy of the prior foreign application. *See* discussion of § 1.55(h), *infra*.

Section 1.55(g) is amended to provide that 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 within the pendency of the application, unless filed with a petition under § 1.55(e) or (f) or with a petition accompanied by the fee set forth in § 1.17(g), which includes a showing of good and sufficient cause for the delay in filing the certified copy of the foreign application in a design application. MPEP 216.01 provides for the submission of a request for certificate of correction under § 1.323 along with, where applicable, a petition under § 1.55(e), to perfect a claim for priority under 35 U.S.C. 119(a)–(d) and (f) in a patent under certain conditions, including the case where the certified copy was not in the application that issued as a patent but was filed in a parent application. Where the conditions set forth in MPEP 216.01 do not apply, perfection of the claim for foreign priority generally required the filing of a reissue application. *See* MPEP 1417. Section 1.55(g), as amended in this final rule, eliminates the need in many instances to file a reissue application in order to perfect a claim for foreign priority by allowing the certified copy of the foreign application required under § 1.55 to be filed in the application with a petition under § 1.55(f) or as provided in § 1.55(g), together with the fee set forth in § 1.17(g), that includes a showing of good and sufficient cause for the delay in filing the certified copy of the foreign application. In addition, where a priority claim under § 1.55 was not timely made, § 1.55(g) as amended in this final rule allows the priority claim

and certified copy required under § 1.55 to be filed pursuant to a petition under § 1.55(e) even if the application is not pending (*e.g.*, a patented application). Furthermore, where the priority claim required under § 1.55 was timely filed in the application but was not included on the patent because the requirement under § 1.55 for a certified copy was not satisfied, the patent may be corrected to include the priority claim via a certificate of correction under 35 U.S.C. 255 and § 1.323, accompanied by a grantable petition under § 1.55(f) or (g), without the need for a petition under § 1.55(e) to accept an unintentionally delayed priority claim.

Section 1.55(g) is also amended to remove the requirement for the processing fee set forth in § 1.17(i) where the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid. Section 1.55(g), however, retains the provision of former § 1.55(g) that if the claim for priority or the certified copy is filed after the date the issue fee is paid, the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323.

Section 1.55(h) provides that the requirement in § 1.55(f) and (g) for a certified copy of the foreign application will be considered satisfied in a reissue application if the patent for which reissue is sought satisfies the requirement of this section for a certified copy of the foreign application and such patent is identified in the reissue application as containing the certified copy. Section 1.55(h) further provides that the requirement in paragraphs (f) and (g) of this section for a certified copy of the foreign application will also be considered satisfied in an application if a prior-filed nonprovisional application for which a benefit is claimed under 35 U.S.C. 120, 121, 365(c), or 386(c) contains a certified copy of the foreign application and such prior-filed nonprovisional application is identified as containing a certified copy of the foreign application. The exception under § 1.55(h) to the requirement to provide the certified copy of the foreign application is in accord with long-standing Office policy. *See, e.g.*, MPEP 215(III) (9th ed., Mar. 2014).

Sections 1.55(i)–(l) in this final rule correspond to the provisions of paragraphs (h)–(k) of former § 1.55. Section 1.55(i)(4) is also amended, consistent with Office practice, to provide that the request under that paragraph may be filed with a petition under § 1.55(f). *See AIA Frequently Asked Questions*, Question FITF3500,

[http://www.uspto.gov/aia\\_implementation/faqs\\_first\\_inventor.jsp](http://www.uspto.gov/aia_implementation/faqs_first_inventor.jsp). Section 1.55(j)(2) is amended to provide for a time period to submit the copy of the foreign application and separate cover sheet in a national stage application to include the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)) or four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage. Section 1.55(j)(2) is also amended to provide for the submission of the copy of the foreign application and separate cover sheet with a petition under § 1.55(f). *Id.* Nonprovisional international design applications are also excluded from the transition provision of § 1.55(k), as such applications can only be filed on or after the date the treaty takes effect as to the United States.

Section 1.55(m) sets forth the time for filing a priority claim and certified copy of a foreign application in an international design application designating the United States. Section 1.55(m) provides that in an international design application designating the United States, the claim for priority may be made in accordance with the Hague Agreement and the Hague Agreement Regulations. Section 1.55(m) further provides that in a nonprovisional international design application, the priority claim, unless made in accordance with the Hague Agreement and the Hague Agreement Regulations, must be presented in an application data sheet (§ 1.76(b)(6)) identifying the foreign application for which priority is claimed by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. In a nonprovisional international design application, the priority claim and certified copy must be furnished in accordance with the time period and other conditions set forth in § 1.55(g).

Section 1.55(o) provides, in accordance with the effective date provision of title I of the PTLIA, that the right of priority under 35 U.S.C. 386(a) or (b) with respect to an international design application is applicable only to nonprovisional applications, international applications, and international design applications filed on or after May 13, 2015, and patents issuing thereon. 126 Stat. 1532.

Section 1.55(p) provides that the time periods set forth in this section are not extendable, but are subject to 35 U.S.C. 21(b) (and § 1.7(a)), PCT Rule 80.5, and Hague Agreement Rule 4(4). Section 1.55(p) in this final rule corresponds to the provisions contained in paragraphs

(b) and (l) of former § 1.55 and further provide that the time periods are subject to Hague Agreement Rule 4(4). Rule 4(4) provides that if a period expires on a day on which the International Bureau or the office concerned is not open to the public, the period shall expire on the first subsequent day on which the International Bureau or the office concerned is open to the public. Section 101(a) of the PLTIA adds 35 U.S.C. 386(b), which provides: “[i]n accordance with the conditions and requirements of subsections (a) through (d) of section 119 and section 172 and the treaty and the Regulations, an international design application designating the United States shall be entitled to the right of priority based on a prior foreign application . . . .” 126 Stat. at 1529. Thus, pursuant to 35 U.S.C. 386(b), the priority period in an international design application designating the United States is subject to Rule 4(4).

*Section 1.57:* Section 1.57(a)(4) is amended to change the reference from “§ 1.55(h)” to “§ 1.55(i)” in light of the changes to § 1.55 in this final rule. The introductory text of § 1.57(b) is amended to include a reference to priority and benefit claims to international design applications. Section 101(a) of the PLTIA adds 35 U.S.C. 386 to provide for a right of priority or benefit with respect to an international design application. 126 Stat. at 1529–30. Accordingly, the introductory text of § 1.57(b) is amended to provide for incorporation by reference to an inadvertently omitted portion of the specification or drawings based on a claim for priority under § 1.55 or benefit claim under § 1.78 to an international design application present upon filing. Section 1.57(b)(4) is also added to provide that any amendment to an international design application pursuant to § 1.57(b)(1) shall be effective only as to the United States and shall have no effect on the filing date of the application and that no request under § 1.57(b) to add the inadvertently omitted portion of the specification or drawings in an international design application will be acted upon by the Office prior to the international design application becoming a nonprovisional application. Section 1.57(b)(4) is similar to § 1.57(b)(2), which applies to international applications.

*Section 1.63:* Section 1.63(d)(1) is amended to add references to § 1.1021(d) and 35 U.S.C. 386(c) so as to provide that a newly executed oath or declaration under § 1.63, or substitute statement under § 1.64, is not required under §§ 1.51(b)(2) and 1.53(f), or under §§ 1.497 and 1.1021(d), for an inventor in a continuing application that claims

the benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) in compliance with § 1.78 of an earlier-filed application, provided that an oath or declaration in compliance with this section, or substitute statement under § 1.64, was executed by or with respect to such inventor and was filed in the earlier-filed application and a copy of such oath, declaration, or substitute statement showing the signature or an indication thereon that it was executed is submitted in the continuing application. Title I of the PLTIA amends 35 U.S.C. 115(g)(1) (as amended by the Leahy-Smith America Invents Act) by adding a reference to benefit claims under 35 U.S.C. 386(c). *See* 126 Stat. 1531. The amendment to § 1.63(d)(1) is consistent with this statutory change.

*Section 1.76:* Section 1.76(a) is amended to provide for the filing of an application data sheet in a nonprovisional international design application and to include a reference to priority and benefit claims under 35 U.S.C. 386 with respect to international design applications. Section 1.76(b)(5) is amended to provide for domestic benefit information pertaining to benefit claims under 35 U.S.C. 386(c). Section 1.76(b)(6) is amended to provide that the foreign priority information section of the application data sheet may include the intellectual property authority rather than country of filing. This change is for consistency with the requirements of 35 U.S.C. 119(b) and § 1.55.

*Section 1.78:* Section 1.78 is amended, as discussed below, to provide for benefit claims under 35 U.S.C. 386(c) with respect to international design applications designating the United States. In addition, as to the applicability dates for certain provisions in existing rules, this final rule makes those applicability dates more accessible by stating them directly in the body of those rules. In particular, the requirements of § 1.78 set forth in the following final rules have been consolidated in this final rule: *Changes To Implement the Patent Law Treaty*, 78 FR 62368, 62399 (Oct. 21, 2013) (applicable to any patent application filed before, on, or after December 18, 2013); *Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act*, 78 FR 11024 (Feb. 14, 2013) (applicable to any application filed under 35 U.S.C. 111 or 363 on or after March 16, 2013); *Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act*, 77 FR 48776 (Aug. 14, 2012) (applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on

or after September 16, 2012); and *Changes to Implement Eighteen-Month Publication of Patent Applications*, 65 FR 57024 (Sept. 20, 2000) (applicable to patent applications filed on or after November 29, 2000).

Section 1.78(a)(1) is amended to clarify which application is the “subsequent application” for purposes of § 1.78. Section 1.78(a)(1) provides that the nonprovisional application, other than for a design patent, or international application designating the United States must be: Filed not later than twelve months after the date on which the provisional application was filed, subject to paragraph (b) of the section (a subsequent application); or entitled to claim the benefit under 35 U.S.C. 120, 121, or 365(c) of a subsequent application that was filed within the period set forth in paragraph (a)(1)(i) of the section. Thus, the subsequent application in either § 1.78(a)(1)(i) or (a)(1)(ii) is the application required to be filed within the period set forth in § 1.78(a)(1)(i). For purposes of § 1.78(a)(1)(ii), the subsequent application may be a nonprovisional application or an international application designating the United States.

Section 1.78(b) is amended to provide, in paragraph (b)(1), that a petition to restore the benefit of a provisional application under this paragraph filed on or after May 13, 2015, must be filed in the subsequent application. A similar change was made to § 1.55. See discussion of § 1.55(c), *supra*. If a petition under § 1.78(b) to restore benefit of a provisional application is granted, a further petition under § 1.78(b) is not required in an application entitled to claim the benefit under 35 U.S.C. 120, 121, or 365(c) of the subsequent application for which benefit of the provisional application was restored.

The introductory text of § 1.78(d) is amended to provide for benefit claims under 35 U.S.C. 386(c) with respect to international design applications designating the United States. Section 1.78(d)(1)(ii) provides that the prior-filed application to which benefit is claimed may be an international design application entitled to a filing date in accordance with § 1.1023 and designating the United States.

Section 1.78(d)(2) is amended to provide that the reference required under this paragraph to a prior filed international design application designating the United States may identify the international design application by international registration number and filing date under § 1.1023. Where the international design

application becomes a nonprovisional application, which occurs when the Office receives a copy of the international registration from the International Bureau pursuant to Article 10 of the Hague Agreement (*see* § 1.9), the required reference can identify the nonprovisional application number instead of the international registration number and filing date under § 1.1023. Identifying the prior international design application by the nonprovisional application number is preferable to the Office and simpler for applicants.

Section 1.78(d)(3) is amended to provide, in paragraph (d)(3)(i), that the reference required by 35 U.S.C. 120 and § 1.78(d)(2) must be submitted during the pendency of the later-filed application. Section 1.78(d)(3)(ii) sets forth the time period for submitting the reference required under 35 U.S.C. 120 and § 1.78(d)(2) in a later-filed application under 35 U.S.C. 111(a) (excluding design applications) and in a nonprovisional application entering the national stage from an international application under 35 U.S.C. 371 and substantially corresponds to the provisions contained in paragraph (d)(3) of former § 1.78. Section 1.78(d)(3)(iii) provides that, except as provided in § 1.78(e), the failure to timely submit the reference required by 35 U.S.C. 120 and § 1.78(d)(2) is considered a waiver of any benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the prior-filed application. The changes to § 1.78(d)(3) in this final rule would make the procedures under § 1.78(e) to accept an unintentionally delayed benefit claim applicable to design applications and thus accord applicants in design applications the same remedy for accepting an unintentionally delayed benefit claim that is available to applicants in utility applications. The establishment of such procedures is provided for in 35 U.S.C. 120, as amended in section 4503 of the AIPA. See discussion of § 1.55(e), *supra* (regarding acceptance of an unintentionally delayed claim of priority in a design application).

Section 1.78(d)(6) is amended to exclude nonprovisional international design applications, as such applications can only be filed on or after the date the Hague Agreement takes effect as to the United States.

Section 1.78(d)(7) is added to provide that where benefit is claimed under 35 U.S.C. 120, 121, 365(c), or 386(c) to an international application or an international design application, which designates but did not originate in the United States, the Office may require a certified copy of such application

together with an English translation thereof if filed in another language. The authority to require a certified copy of an international design application that designates the United States but did not originate in the United States, and an English translation thereof, is provided in 35 U.S.C. 386(c). Similar authority with respect to international applications that designate the United States but do not originate in the United States is provided in 35 U.S.C. 365(c). Since international applications are published under PCT Article 21(2) and international design applications are published under Hague Agreement Article 10(3), the Office would not ordinarily require a certified copy of the international application or international design application pursuant to § 1.78(d)(7). Rather, the Office foresees use of § 1.78(d)(7) primarily in instances where the international application or international design application did not publish under the respective treaty or where there is a question as to the content of the disclosure of the application as of its filing date and the certified copy and any English translation are needed to determine entitlement to the benefit of the filing date of the international application or international design application in order to, for example, overcome a prior art reference.

Section 1.78(e) is amended to provide for acceptance of a delayed benefit claim under 35 U.S.C. 386(c) to a prior filed international application designating the United States pursuant to the petition procedure set forth therein.

Section 1.78(i) is added to provide that where a petition under paragraphs (b), (c), or (e) of this section is required in an international application that was not filed with the United States Receiving Office and is not a nonprovisional application, then such petition may be filed in the earliest nonprovisional application that claims benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the international application and will be treated as being filed in the international application. This provision is added because, in such instances, the Office does not have an application file established for the international application.

Section 1.78(j) provides, in accordance with the effective date provision of title I of the PTLIA, that benefit under 35 U.S.C. 386(c) with respect to an international design application is applicable only to nonprovisional applications, international applications, and international design applications filed

on or after May 13, 2015, and patents issuing thereon. 126 Stat. 1532.

Section 1.78(k) in this final rule corresponds to the provisions contained in paragraphs (h) and (a)(1) of former § 1.78 and further provides that the time periods are subject to Hague Agreement Rule 4(4).

*Section 1.84:* Section 1.84(a)(2) is amended to eliminate the requirement for a petition and fee set forth in § 1.17(h) to accept color drawings or photographs in design applications. The requirements that the design application include the number of sets of color drawings required by § 1.84(a)(2)(ii) and that the specification contain the reference to the color drawings or photographs set forth in § 1.84(a)(2)(iii) are maintained. The reference set forth in § 1.84(a)(2)(iii) provides notice to the public should the design application issue as a patent that the patented design is in color. In addition, the petition requirement is maintained for utility patent applications. Section 1.84(a)(2) is also amended to reflect current requirements for color drawings submitted through EFS-Web.

*See Legal Framework for Electronic Filing System—Web (EFS-Web)*, 74 FR 55200, 55208 (Oct. 27, 2009) (“The requirement for three (3) sets of color drawings under 37 CFR 1.84(a)(2)(ii) is not applicable to color drawings submitted via EFS-Web. Therefore, only one set of such color drawings is necessary when filing via EFS-Web.”).

Section 1.84(y) is amended to include a cross reference to international design application reproductions in § 1.1026.

*Section 1.85:* Section 1.85(c) is amended to provide that if an amended drawing submitted under § 1.121(d) in a nonprovisional international design application does not comply with § 1.1026 at the time an application is allowed, the Office may notify the applicant in a notice of allowability and set a three-month period of time from the mail date of the notice of allowability within which the applicant must file a corrected drawing to avoid abandonment.

*Section 1.97:* Section 1.97(b) is amended by revising paragraphs (b)(3) and (b)(4), and adding a new paragraph (b)(5) to provide that an information disclosure statement may be filed within three months of the date of publication of the international registration under Hague Agreement Article 10(3) in an international design application. An information disclosure statement may also be submitted with the international design application. *See* Hague Agreement Rule 7(5)(g) (“The international application may be accompanied by a statement that

identifies information known by the applicant to be material to the eligibility for protection of the industrial design concerned.”).

*Section 1.105:* The introductory text of § 1.105(a)(1) is amended to make a requirement for information under § 1.105 applicable to international design applications and to clarify that the requirement under § 1.105 is applicable to a reexamination proceeding ordered as a result of a supplemental examination proceeding.

*Section 1.109:* Section 1.109 is revised such that its definition of “effective filing date” is no longer restricted only to first inventor to file applications, but applies regardless of whether an application is a first to invent or a first inventor to file application. This does not change or affect the meaning of effective U.S. filing date when used in the MPEP to discuss the treatment of first to invent (pre-AIA) applications or the order of examination.

Section 1.109(a)(2) is also amended to include, for purposes of determining the “effective filing date” for a claimed invention in a patent or application for patent (other than a reissue application or reissued patent), a right of priority or benefit of an earlier filing date under 35 U.S.C. 386. Title I of the PLTIA amends 35 U.S.C. 100(i)(1)(B) (as amended by the Leahy-Smith America Invents Act) to include, within the meaning of “effective filing date” for a claimed invention in a patent or application, the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority or the benefit of an earlier filing date under 35 U.S.C. 386. *See* 126 Stat. 1531. The amendment to § 1.109(a)(2) is consistent with the change to 35 U.S.C. 100(i)(1)(B) as amended by title I of the PLTIA.

*Section 1.114:* 35 U.S.C. 132(b), which provides for the request for continued examination practice set forth in § 1.114, was added to title 35, United States Code, in section 4403 of the American Inventors Protection Act of 1999 (AIPA). *See* Public Law 106–113, 113 Stat. 1501, 1501A–561 (1999). With respect to international applications, section 4405(b)(1) of the AIPA provides that 35 U.S.C. 132(b) applies to “applications complying with section 371 of title 35, United States Code, that resulted from international applications filed on or after June 8, 1995.” *See* 113 Stat. at 1501A–561. The Office recently revised its rules to permit applicants, including applicants in national stage applications under 35 U.S.C. 371, to postpone filing the inventor’s oath or declaration until the application is otherwise in condition for allowance

(subject to certain conditions). *See Changes to Implement the Inventor’s Oath or Declaration Provisions of the Leahy-Smith America Invents Act*, 77 FR 48776 (Aug. 14, 2012) (final rule). An international application, however, does not comply with the requirements of 35 U.S.C. 371 until the application includes the inventor’s oath or declaration. *See* 35 U.S.C. 371(c)(4); *see also* 77 FR at 48777, 48780, 48795 (explaining that the inventor’s oath or declaration is still required for a PCT international application to comply with 35 U.S.C. 371, notwithstanding the changes permitting applicants to postpone filing the inventor’s oath or declaration until after a PCT international application enters the national stage). Thus, the Office is revising § 1.114(e)(3) to clarify that the request for continued examination practice set forth in § 1.114 added in section 4403 of the AIPA does not apply to an international application until the international application complies with 35 U.S.C. 371 (which requires the filing of the inventor’s oath or declaration in the international application, as well as, for example, the basic national fee and an English language translation of the international application if filed in another language).

Section 1.114(e) also is amended to provide that a request for continued examination may not be filed in an international design application, as there is no statutory provision to permit the filing of a request for continued examination in an international design application. Section 4405(b)(2) of the AIPA specifically excludes design applications under 35 U.S.C. chapter 16 from the provisions of 35 U.S.C. 132(b), and there is no provision in the AIPA, PLTIA, or other legislative act making 35 U.S.C. 132(b) applicable to international design applications.

*Section 1.121:* Section 1.121(d) is amended to provide for amendments to the drawings in a nonprovisional international design application and requires, *inter alia*, that any changes to the drawings be in compliance with §§ 1.84(c) and 1.1026.

*Section 1.130:* Section 1.130(d) is amended to refer to the definition of “effective filing date” in § 1.109, rather than the definition of “effective filing date” in 35 U.S.C. 100(i). The definition of “effective filing date” in § 1.109 and 35 U.S.C. 100(i) are the same, and other rules of practice refer to definition of “effective filing date” in § 1.109. *See* §§ 1.78, 1.110. Section 1.130(d) is also amended to include a reference to 35 U.S.C. 386(c), added by title I of the PLTIA, concerning domestic benefit claims with respect to international

design applications that designate the United States. Pursuant to 35 U.S.C. 386(c), an application must comply with the conditions and requirements of 35 U.S.C. 120, which include, *inter alia*, a requirement that the application contain a specific reference to the earlier application whose filing date is claimed.

*Section 1.131:* Section 1.131(d) is amended to refer to the definition of “effective filing date” in § 1.109, rather than the definition of “effective filing date” in 35 U.S.C. 100(i). The definition of “effective filing date” in § 1.109 and 35 U.S.C. 100(i) are the same, and other rules of practice refer to definition of “effective filing date” in § 1.109. *See* §§ 1.78, 1.110. Section 1.131(d) is also amended to include a reference to 35 U.S.C. 386(c), added by title I of the PLTIA, concerning domestic benefit claims with respect to international design applications that designate the United States.

*Section 1.137:* Section 1.137(d)(1)(ii) and (d)(2) are amended to include a reference to 35 U.S.C. 386(c) concerning domestic benefit claims with respect to international design applications that designate the United States.

*Section 1.155:* Section 1.155 is amended to provide for expedited examination of an international design application that designates the United States. To qualify for expedited examination, § 1.155(a)(1) provides that the international design application must have been published pursuant to Hague Agreement Article 10(3).

*Section 1.175:* The introductory text of § 1.175(f)(1) is amended to include a reference to 35 U.S.C. 386(c) concerning domestic benefit claims with respect to international design applications that designate the United States.

*Section 1.211:* Section 1.211(b) is amended to provide that an international design application under 35 U.S.C. chapter 38 shall not be published by the Office under § 1.211. International registrations are published by the International Bureau pursuant to Article 10(3) of the Hague Agreement. The international registration includes the data contained in the international design application and any reproduction of the industrial design. *See* Hague Agreement Rule 15(2).

*Section 1.312:* The Office has decided not to amend § 1.312 in this final rule. Pursuant to Rule 29 of the Hague Agreement, where the second part of the individual U.S. designation fee (*i.e.*, the issue fee) is paid to the International Bureau, the International Bureau is to “immediately upon its receipt” credit payment of such fee to the Office. The proposed rule would create an administrative burden in international

design applications where the issue fee was paid to the International Bureau in order to determine the appropriate date to be used for amendment entry purposes. The Office may reconsider the need for such a provision after it gains more experience with the crediting of fees by the International Bureau to the Office.

A new subpart I is added to provide for international and national processing of international design applications.

*Section 1.1001:* Section 1.1001 is added to include definitions of terms used in subpart I.

*Section 1.1002:* Section 1.1002 is added to indicate the major functions of the USPTO as an office of indirect filing. These include: (1) Receiving and according a receipt date to international design applications; (2) collecting and, when required, transmitting fees for processing international design applications; (3) determining compliance with applicable requirements of part 5 of chapter I of title 37 of the CFR; and (4) transmitting an international design application to the International Bureau, unless prescriptions concerning national security prevent the application from being transmitted.

*Section 1.1003:* Section 1.1003 is added to indicate the major functions of the USPTO as a designated office. These include: (1) Accepting for national examination international design applications that satisfy the requirements of the Hague Agreement and Regulations; (2) performing an examination of the international design application in accordance with 35 U.S.C. chapter 16; and (3) communicating the results of examination to the International Bureau.

*Section 1.1004:* Section 1.1004 is added to indicate the major functions of the International Bureau. These include: (1) Receiving international design applications directly from applicants and indirectly from an office of indirect filing; (2) collecting required fees and crediting designation fees to the accounts of the Contracting Parties concerned; (3) reviewing international design applications for compliance with prescribed requirements; (4) translating international design applications into the required languages for recordation and publication; (5) registering the international design in the International Register where the international design application complies with the applicable requirements; (6) publishing international registrations in the International Designs Bulletin; and (7) sending copies of the publication of the

international registration to each designated office.

*Section 1.1005:* Section 1.1005 is added, pursuant to the Paperwork Reduction Act of 1995, to display the currently valid Office of Management and Budget control number for the collection of information in 37 CFR part 1, subpart I. Section 1.1005(a) provides that pursuant to the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*), the collection of information in this subpart has been reviewed and approved by the Office of Management and Budget under control number 0651–0075. Section 1.1005(b) provides that 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 Office of Management and Budget control number. Section 1.1005(b) further provides that § 1.1005 constitutes the display required by 44 U.S.C. 3512(a) and 5 CFR 1320.5(b)(2)(i) for the collection of information under Office of Management and Budget control number 0651–0075.

*Section 1.1011:* Section 1.1011(a) is added to specify who may file an international design application through the USPTO. Under Article 3, any person that is a national of a State that is a Contracting Party or a State member of an intergovernmental organization that is a Contracting Party, or that has a domicile, a habitual residence, or a real and effective industrial or commercial establishment in the territory of a Contracting Party, shall be entitled to file an international application. Under Article 4(1), the international application may be filed, at the option of the applicant, either directly with the International Bureau or through the office of the applicant's Contracting Party (*i.e.*, an office of indirect filing). Title I of the PLTIA adds 35 U.S.C. 382(a), which provides: “[a]ny person who is a national of the United States, or has a domicile, a habitual residence, or a real and effective industrial or commercial establishment in the United States, may file an international design application by submitting to the Patent and Trademark Office an application in such form, together with such fees, as may be prescribed by the Director.” 126 Stat. at 1528. In accordance with 35 U.S.C. 382(a) and Articles 3 and 4(1), § 1.1011(a) specifies that only persons who are nationals of the United States or who have a domicile, a habitual residence, or a real and effective industrial or commercial establishment

in the territory of the United States may file international design applications through the United States Patent and Trademark Office.

Section 1.1011(b) is added to provide that, although the USPTO will accept international design applications filed by any person referred to in § 1.1011(a), an international design application designating the United States may be refused by the Office as a designated office if the applicant is not a person qualified under 35 U.S.C. chapter 11 to be an applicant. The PLTIA does not distinguish a person qualified to be an applicant for an international design application designating the United States from a person qualified to be an applicant in a national design application under 35 U.S.C. 171–173. See section 101(a) of the PLTIA, which adds: 35 U.S.C. 389(b) (“All questions of substance and, unless otherwise required by the treaty and Regulations, procedures regarding an international design application designating the United States shall be determined as in the case of applications filed under chapter 16.”); 35 U.S.C. 382(c) (“Except as otherwise provided in this chapter, the provisions of chapter 16 shall apply.”); and 35 U.S.C. 383 (“In addition to any requirements pursuant to chapter 16, the international design application shall contain. . . .”). 126 Stat. at 1528–30.

*Section 1.1012:* Section 1.1012 is added to provide that, in order to file an international design application through the United States Patent and Trademark Office as an office of indirect filing, the United States must be applicant’s Contracting Party. Pursuant to Article 4, an international design application may be filed through the office of the “applicant’s Contracting Party.” The term “applicant’s Contracting Party” is defined in Article 1(xiv) as “the Contracting Party or one of the Contracting Parties from which the applicant derives its entitlement to file an international application by virtue of satisfying, in relation to that Contracting Party, at least one of the conditions specified in Article 3; where there are two or more Contracting Parties from which the applicant may, under Article 3, derive its entitlement to file an international application, ‘applicant’s Contracting Party’ means the one which, among those Contracting Parties, is indicated as such in the international application.” The indication of applicant’s Contracting Party may be made in Box 4 of the application for international registration form (DM/1 form).

*Section 1.1021:* Section 1.1021 is added to specify the contents of the international design application.

Section 1.1021(a) specifies the mandatory contents of an international design application. The international design application must be in English, French, or Spanish. In addition, the application shall contain or be accompanied by: (1) A request for international registration under the Hague Agreement (Article 5(1)(i)); (2) the prescribed data concerning the applicant (Article 5(1)(ii) and Rule 7(3)(i) and (ii)); (3) the prescribed number of copies of a reproduction or, at the choice of the applicant, of several different reproductions of the industrial design that is the subject of the international design application, presented in the prescribed manner; however, where the industrial design is two-dimensional and a request for deferment of publication is made in accordance with Article 5(5), the international design application may, instead of containing reproductions, be accompanied by the prescribed number of specimens of the industrial design (Article 5(1)(iii)); (4) an indication of the product or products that constitute the industrial design or in relation to which the industrial design is to be used, as prescribed (Article 5(1)(iv) and Rule 7(3)(iv)); (5) an indication of the designated Contracting Parties (Article 5(1)(v)); (6) the prescribed fees (Article 5(1)(vi) and Rule 12(1)); (7) the Contracting Party or Parties in respect of which the applicant fulfills the conditions to be the holder of an international registration (Rule 7(3)(iii)); (8) the number of industrial designs included in the international application, which may not exceed 100, and the number of reproductions or specimens of the industrial designs accompanying the international application (Rule 7(3)(v)); (9) the amount of the fees being paid and the method of payment or instructions to debit the required amount of fees to an account opened with the International Bureau and the identification of the party effecting the payment or giving the instructions (Rule 7(3)(vii)); and (10) an indication of applicant’s Contracting Party as required under Rule 7(4)(a).

Section 1.1021(b) sets forth additional mandatory contents that may be required by certain Contracting Parties. These include: (1) Elements referred to in Article 5(2)(b) required for a filing date in the designated Contracting Party for which a declaration was made by that Contracting Party; and (2) a statement, document, oath, or declaration required pursuant to Rule 8(1) by a designated Contracting Party.

The elements that may be required under Article 5(2)(b) are: (i) Indications concerning the identity of the creator; (ii) a brief description of the reproduction or of the characteristic features of the industrial design; and (iii) a claim.

Section 1.1021(c) identifies optional contents that the international design application may contain. These include: (1) Two or more industrial designs, subject to the prescribed conditions (Article 5(4) and Rule 7(7)); (2) a request for deferment of publication (Article 5(5) and Rule 7(5)(e)) or a request for immediate publication (Rule 17); (3) an element referred to in item (i) or (ii) of Article 5(2)(b) of the Hague Agreement or in Article 8(4)(a) of the 1960 Act even where that element is not required in consequence of a notification in accordance with Article 5(2)(a) of the Hague Agreement or in consequence of a requirement under Article 8(4)(a) of the 1960 Act (Rule 7(5)(a)); (4) the name and address of applicant’s representative, as prescribed (Rule 7(5)(b)); (5) a claim of priority of one or more earlier filed applications in accordance with Article 6 and Rule 7(5)(c); (6) a declaration, for purposes of Article 11 of the Paris Convention, that the product or products that constitute the industrial design, or in which the industrial design is incorporated, have been shown at an official or officially recognized international exhibition, together with the place where the exhibition was held and the date on which the product or products were first exhibited there and, where less than all the industrial designs contained in the international application are concerned, the indication of those industrial designs to which the declaration relates or does not relate (Rule 7(5)(d)); (7) any declaration, statement, or other relevant indication as may be specified in the Administrative Instructions (Rule 7(5)(f)); (8) a statement that identifies information known by the applicant to be material to the eligibility for protection of the industrial design concerned (Rule 7(5)(g)); and (9) a proposed translation of any text matter contained in the international application for purposes of recording and publication (Rule 6(4)).

Section 1.1021(d) sets forth additional required contents for an international design application that designates the United States. Section 1.1021(d) provides that, in addition to the mandatory requirements set forth in § 1.1021(a), an international design application that designates the United States shall contain or be accompanied by: (1) A claim (§§ 1.1021(b)(1)(iii) and 1.1025); (2) indications concerning the



identity of the creator (*i.e.*, the inventor, *see* § 1.9(d)) in accordance with Rule 11(1); and (3) the inventor's oath or declaration (§§ 1.63 and 1.64). Section 1.1021(d)(3) further provides that the requirements in §§ 1.63(b) and 1.64(b)(4) to identify each inventor by his or her legal name, mailing address, and residence, if an inventor lives at a location which is different from the mailing address, and the requirement in § 1.64(b)(2) to identify the residence and mailing address of the person signing the substitute statement, will be considered satisfied by the presentation of such information in the international design application prior to international registration.

Under Article 5(2), a Contracting Party may require an international design application to contain certain additional elements, where the law of that Contracting Party, at the time it becomes a party to the Hague Agreement, requires the application to contain such elements to be accorded a filing date. The elements set forth in Article 5(2) are: (1) Indications concerning the identity of the creator of the industrial design; (2) a brief description of the reproduction or of the characteristic features of the industrial design; and (3) a claim. Article 5(2) permits a Contracting Party to notify the Director General of the elements required in order for the application to be accorded a filing date.

A claim is a filing date requirement for design applications in the United States. While title II of the PLTIA, in implementing the Patent Law Treaty, eliminated the requirement for a claim as a filing date requirement in utility applications, it did not eliminate the requirement for a claim as a filing date requirement for design applications. *See* section 202 of the PLTIA (amending 35 U.S.C. 171 to provide that “[t]he filing date of an application for patent for design shall be the date on which the specification as prescribed by [35 U.S.C.] 112 and any required drawings are filed”). 126 Stat. 1535. The specific wording of the claim shall be as prescribed in § 1.1025. *Id.* Consequently, an international design application that designates the United States but does not contain a claim will not be registered by the International Bureau in the international register and thus will not be entitled to a filing date in the United States. *See* 35 U.S.C. 384; Article 10(2). In such case, the International Bureau will invite the applicant to submit the claim within a prescribed time limit and will accord a date of international registration as of the date of receipt of the claim (assuming there are no other filing date

defects). *See* Article 10(2)(b). Failure to timely submit the claim in response to the invitation by the International Bureau will result in the application being deemed not to contain the designation of the United States. *See* Article 8(2)(b).

Section 1.1021(d) also requires an international design application designating the United States to contain indications concerning the identity of the inventor (*i.e.*, creator) of the industrial design and the inventor's oath or declaration (§§ 1.63 or 1.64). The identity of the inventor and the inventor's oath or declaration are requirements applicable to design applications under 35 U.S.C. chapter 16. *See, e.g.*, 35 U.S.C. 115; 35 U.S.C. 101. The PLTIA provides for parity in the treatment of international design applications designating the United States with design applications under 35 U.S.C. chapter 16, except where otherwise provided by the PLTIA, Hague Agreement, or Regulations. *See, e.g.*, 35 U.S.C. 389(b) (“All questions of substance and, unless otherwise required by the treaty and Regulations, procedures regarding an international design application designating the United States shall be determined as in the case of applications filed under chapter 16.”); 35 U.S.C. 382(c) (“Except as otherwise provided in this chapter, the provisions of chapter 16 shall apply.”); 35 U.S.C. 383 (“In addition to any requirements pursuant to chapter 16, the international design application shall contain. . . .”). 126 Stat. at 1528–30. *See also* discussion of Hague Agreement Rule 8, *supra*.

**Section 1.1022:** Section 1.1022 is added to specify form and signature requirements for international design applications. Section 1.1022(a) provides that the international design application shall be presented on the official form. *See* Hague Agreement Rule 7(1). The term “official form” is defined in Hague Agreement Rule 1(vi) to mean “a form established by the International Bureau or an electronic interface made available by the International Bureau on the Web site of the Organization, or any form or electronic interface having the same contents and format.” Section 1.1022(b) provides that the international design application shall be signed by the applicant. *See* Rule 7(1).

**Section 1.1023:** The filing date of an international design application in the United States is set forth in 35 U.S.C. 384, added by section 101 of the PLTIA, which provides “[s]ubject to subsection (b), the filing date of an international design application in the United States shall be the effective registration date.” 126 Stat. at 1529. The term “effective

registration date” is defined in 35 U.S.C. 381(a)(5) as “the date of international registration determined by the International Bureau under the treaty.” 126 Stat. at 1528. Accordingly, § 1.1023(a) is added to set forth that the filing date of an international design application in the United States is the date of international registration determined by the International Bureau, subject to review under § 1.1023(b).

Section 1.1023(b) is added to set forth a procedure to review the filing date of an international design application. Pursuant to 35 U.S.C. 384(b), “[t]he Director may establish procedures, including the payment of a surcharge, to review the filing date under this section. Such review may result in a determination that the application has a filing date in the United States other than the effective registration date.” 126 Stat. at 1529. Accordingly, § 1.1023(b) provides that, where the applicant believes the international design application is entitled under the Hague Agreement to a filing date in the United States other than the date of international registration, the applicant may petition the Director to accord the international design application a filing date in the United States other than the date of international registration. Section 1.1023(b) requires that the petition be accompanied by the fee set forth in § 1.17(f) and include a showing to the satisfaction of the Director that the international design application is entitled to such filing date.

**Section 1.1024:** Section 1.1024 is added to provide that an international design application designating the United States must include a specification as prescribed by 35 U.S.C. 112 and preferably include a brief description of the reproduction pursuant to Rule 7(5)(a) describing the view or views of the reproductions. Pursuant to Article 5(2), a Contracting Party may require “a brief description of the reproduction or of the characteristic features of the industrial design that is the subject of that application” where such is a filing date requirement under its national law. *See* Article 5(2)(b)(ii). While the “brief description of the reproduction or of the characteristic features of the industrial design” referred to in Article 5(2)(b)(ii) is not a filing date requirement in the United States, applicants should consider whether including additional written description of the invention is needed to comply with the requirements of 35 U.S.C. 112. Rule 7(5)(a) allows the applicant to include in the international design application the description referred to in Article 5(2)(b)(ii) even if

not required by a Contracting Party pursuant to Article 5(2).

In the United States, the requirements for a filing date for an application for design patent are set forth in 35 U.S.C. 171, as amended under section 202 of the PLTIA, which states in subsection (c): “[t]he filing date of an application for patent for design shall be the date on which the specification as prescribed by [35 U.S.C.] 112 and any required drawings are filed.” 126 Stat. 1535. Although a “brief description of the reproduction or of the characteristic features of the industrial design” is not a *per se* filing date requirement, it may be necessary to comply with 35 U.S.C. 112(a), which requires, *inter alia*, that the “specification shall contain a written description of the invention.” This written description requirement may be satisfied by the reproductions. See *In re Daniels*, 144 F.3d 1452, 1456, 46 USPQ2d 1788, 1790 (Fed. Cir. 1998) (“It is the drawings of the design patent that provide the description of the invention.”); *In re Klein*, 987 F.2d 1569, 1571, 26 USPQ2d 1133, 1134 (Fed. Cir. 1993) (“[U]sual[ly] in design applications, there is no description other than the drawings”); *Hupp v. Siroflex of America, Inc.*, 122 F.3d 1456, 1464, 43 USPQ2d 1887, 1893 (Fed. Cir. 1997) (“A design patent contains no written description; the drawings are the claims to the patented subject matter.”); *Ex parte Tayama*, 24 USPQ2d 1614, 1617 (Bd. Pat. App. & Int’l 1992) (“[D]esign applications must meet the requirements of 35 U.S.C. Section 112, first paragraph. While this *ordinarily* requires little if any detailed description, some design applications may require a disclosure as detailed as that in a complex utility application. There is no ‘per se’ rule with respect to the extent of the disclosure necessary in a design application. The adequacy of the disclosure must be determined on a case-by-case basis.”). The Office therefore encourages the inclusion in international design applications of a brief description of the reproduction, pursuant to Rule 7(5)(a), that describes the view or views of the reproductions, as may be required for design applications filed under 35 U.S.C. chapter 16. See, e.g., § 1.153(b) (“No description, other than a reference to the drawing, is ordinarily required. . . .”); § 1.154(b) (“The specification should include . . . 4) Description of the figure or figures of the drawing”); and MPEP 1503.01(II) (“Descriptions of the figures are not required to be written in any particular format, however, if they do not describe the views of the drawing clearly and accurately, the examiner

should object to the unclear and/or inaccurate descriptions and suggest language which is more clearly descriptive of the views.”). Such figure descriptions are helpful for examination and may, in some cases, avoid rejections under 35 U.S.C. 112. Furthermore, a description of the view or views of the reproductions will be required by the Office in a nonprovisional international design application if not furnished under Rule 7(5)(a). See discussion of § 1.1067, *infra*.

Thus, § 1.1024 is added to provide that an international design application designating the United States must include a specification as prescribed by 35 U.S.C. 112, and should preferably include a brief description of the reproduction pursuant to Rule 7(5)(a) describing the view or views of the reproductions.

The Office notes that Article 5(2)(b)(ii) and Rule 11(2) refer to a description of “characteristic features” of the industrial design that may be required by some Contracting Parties. A characteristic features statement is not required under U.S. national law. Applicants are cautioned that a characteristic features statement may serve to later limit the claim in the United States. See *McGrady v. Aspenglas Corp.*, 487 F. Supp. 859 (S.D.N.Y. 1980); MPEP 1503.01.

**Section 1.1025:** Section 1.1025 is added to set forth that the specific wording of the claim in an international design application designating the United States shall be in formal terms to the ornamental design for the article (specifying name of article) as shown, or as shown and described. Section 1.1025 also provides that more than one claim is neither required nor permitted for purposes of the United States. Under Rule 11(3), a declaration requiring a claim pursuant to Article 5(2) “shall specify the exact wording of the required claim.”

**Section 1.1026:** Section 1.1026 is added to provide that reproductions shall comply with the requirements of Rule 9 and Part Four of the Administrative Instructions. Rule 9 sets forth the requirements for reproductions in international design applications, including the form and number of reproductions, and references the requirements of the Administration Instructions. Part Four of the Administrative Instructions sets forth requirements concerning the presentation of the reproductions (Section 401), representation of the industrial design (Section 402), disclaimer (Section 403), requirements for photographs and other graphic representations (Section 404),

numbering of reproductions (Section 405), requirements for specimens (Section 406), and relation with a principal industrial design or a principal application or registration (Section 407).

**Section 1.1027:** Section 1.1027 provides that, where a request for deferment of publication has been filed in respect of a two-dimensional industrial design, the international design application may include specimens of the design in accordance with Rule 10 and Part Four of the Administrative Instructions. Section 1.1027 further provides that specimens are not permitted in an international design application that designates the United States or any other Contracting Party that does not permit deferment of publication. Under the Hague Agreement, specimens are only permitted where a request for deferment of publication has been made. See Article 5(1)(iii); Rule 10(1). However, a request for deferment of publication is not permitted in an international design application that designates a Contracting Party that has made a declaration under Article 11(1)(b) that its applicable law does not provide for deferment of publication. See Article 11(3).

**Section 1.1028:** Section 1.1028 is added to make clear that an international design application may contain a request for deferment of publication, provided the application does not designate the United States or any other Contracting Party that does not permit deferment of publication. Where an international design application contains an improper request for deferment, the International Bureau will require correction pursuant to Article 11(3).

**Section 1.1031:** Section 1.1031 is added to provide for payment of the international design application fees.

Section 1.1031(a) provides that international design applications filed through the Office as an office of indirect filing are subject to payment of a transmittal fee in the amount of \$120. Under the Hague Agreement, an office of indirect filing may require payment of a transmittal fee. See Article 4(2). Section 101(a) of the PLTIA adds 35 U.S.C. 382(b), which provides that the international design application and international fees shall be forwarded by the Office to the International Bureau “upon payment of a transmittal fee.” 126 Stat. at 1528. Accordingly, § 1.1031(a) provides for the payment of a transmittal fee. The transmittal fee is not being set pursuant to section 10(a) of the AIA. Rather, the Office is setting this fee pursuant to its authority under

35 U.S.C. 41(d)(2) in this rulemaking, which provides that fees for all processing, services, or materials relating to patents not specified in 35 U.S.C. 41 are to be set at amounts to recover the estimated average cost to the Office of such processing, services, or materials. *See* 35 U.S.C. 41(d)(2).

The transmittal fee for an international design application filed under the Hague Agreement through the USPTO as an office of indirect filing involves the following activities, which the Office considered in estimating the fiscal year 2012 costs: (1) Processing incoming paper (\$2); (2) processing application fees (\$7); (3) application indexing/scanning (\$65); (4) routing classification/security screening (\$4); (5) second-level security screening and licensing and review processing (\$1); (6) initial bibliographic data entry (\$17); (7) copying and mailing (\$9); (8) performing processing section functions (\$11); and (9) performing Hague file maintenance (\$2).

Applying the ABI methodology discussed above, the Office has thus estimated the fiscal year 2012 unit cost to transmit an international design application and international fees to the International Bureau as the sum total of the aforementioned activities, resulting in a total unit cost of \$118. Using the actual CPI-U increase for fiscal year 2013 and the estimated CPI-U for 2014 and 2015, the Office estimates the fiscal year 2015 unit cost to transmit the international design application and the international fees to the International Bureau is \$124 (\$118 multiplied by 1.051), which, when rounded to the nearest ten dollars, is a fee for transmittal of \$120. Additional information concerning the Office's analysis of the estimated fiscal year 2012 costs for receiving and transmitting international design applications and international fees to the International Bureau is available upon request.

Section 1.1031(b) provides that the Schedule of Fees, a list of individual designation fee amounts, and a fee calculator to assist applicants in calculating the total amount of fees for filing an international design application may be viewed on the Web site of the WIPO, currently available at <http://www.wipo.int/hague>. Under the Hague Agreement, the International Bureau is responsible for collecting the required fees set forth in the Schedule of Fees annexed to the Regulations (Rule 27(1)) and the individual designation fees referred to in Rule 12(1)(a)(iii). Where the required fees have not been paid, the International Bureau will invite the applicant to pay the required

fees to avoid abandonment of the application. *See* Article 8; Rule 14.

Section 1.1031(c) provides that the following fees required by the International Bureau may be paid either directly to the International Bureau or through the Office as an office of indirect filing in the amounts specified on the WIPO Web site described in § 1.1031(b): (1) The international application fees (Rule 12(1)); and (2) the fee for descriptions exceeding 100 words (Rule 11(2)). The fees referred to in Hague Agreement Rule 12(1) include a basic fee, standard designation fees, individual designation fees, and a publication fee. Rule 12(3)(b) states that the Rule 12(1) reference to individual designation fees is construed as a reference to only the first part of the individual designation fee for any Contracting Party with a designation fee comprised of two parts.

Section 1.1031(d) provides that the fees referred to in § 1.1031(c) may be paid directly to the International Bureau in Swiss currency. *See* Rule 27(2)(a). Administrative Instructions to the Hague Agreement set forth the various modes of payment accepted by the International Bureau. *See* Administrative Instruction 801. These include: (1) Payment by debit through an account established with the International Bureau; (2) payment into the Swiss postal check account or any of the specified bank accounts of the International Bureau; or (3) payment by credit card.

Section 1.1031(d) also provides for payment of the fees referred to in § 1.1031(c) through the Office as an office of indirect filing, provided such fees are paid no later than the date of payment of the transmittal fee required under § 1.1031(a). Any payment through the Office must be in U.S. dollars. Section 1.1031(d) also provides that applicants paying fees through the Office may be subject to a requirement by the International Bureau to pay additional amounts where the International Bureau has deemed the amount received as being deficient. This may occur, for example, where the conversion from U.S. dollars to Swiss currency results in the International Bureau receiving less than the prescribed amounts. Under Rule 28(1), “[a]ll payments made under these Regulations to the International Bureau shall be in Swiss currency irrespective of the fact that, where the fees are paid through an Office, such Office may have collected those fees in another currency.” Consequently, the fees collected by the Office for forwarding to the International Bureau must be converted to Swiss currency. If the

converted amount at the time the Office transfers the fees to the International Bureau in Swiss currency is less than the amount required by the International Bureau, the International Bureau may invite the applicant to pay the deficiency. Any payment in response to the invitation must be made directly to the International Bureau within the period set in the invitation.

Section 1.1031(e) provides that payment of the fees referred to in Article 17 and Rule 24 for renewing an international registration (“renewal fees”) is not required to maintain a U.S. patent issuing on an international design application in force and that any renewal fees, if required, must be submitted directly to the International Bureau. Section 1.1031(e) further provides that any renewal fee submitted to the Office will not be transmitted to the International Bureau.

The final rules do not provide for a fee for renewing an international registration with respect to the United States. Article 7 provides for a designation fee for each designated Contracting Party. Article 7(1) provides for a “prescribed” designation fee (also referred to as “standard” designation fee, *see* Rule 11). However, Article 7(2) allows a Contracting Party to make a declaration replacing the prescribed designation fee with an individual designation fee “in connection with any international application in which it is designated, and in connection with the renewal of any international registration resulting from such an international application.” Pursuant to Article 7(2), the amount of the individual designation fee may be fixed by the Contracting Party “for the initial term of protection and for each term of renewal or for the maximum period of protection allowed by the Contracting Party concerned.” Article 7(2) further provides that the individual designation fee may not be higher than the equivalent of the amount that the office of a Contracting Party would be entitled to receive for a grant of protection for an equivalent period to the same number of designs.

Thus, while Article 7(2) permits a Contracting Party to fix an individual designation fee for renewing an international registration in respect of that Contracting Party, it does not require such fee. Rather, the individual designation fee fixed by the Contracting Party may be for the maximum period of protection allowed by the Contracting Party. Furthermore, the PLTIA does not require payment of a fee for renewing an international registration with respect to the United States. In addition, the PLTIA does not require renewal of the

international registration to obtain the maximum period of protection in the United States. *See, e.g.*, 35 U.S.C. 173 as amended by the PLTIA, 126 Stat. at 1532 (“Patents for designs shall be granted for the term of 15 years from the date of grant.”). Accordingly, the final rules do not provide a fee for renewing an international design application with respect to the United States.

The Office notes that Article 17(3) provides that any extension of the initial five-year term of protection accorded by an international registration is subject to renewal. However, the Hague Agreement allows a Contracting Party to provide greater protection under its national law than provided under the Hague Agreement. *See* Article 2(1) (“The provisions of this Act shall not affect the application of any greater protection which may be accorded by the law of a Contracting Party. . . .”). Furthermore, the records of the diplomatic conference adopting the Hague Agreement make clear that renewal of the international registration for a designated Contracting Party that requires payment of a single designation fee for the entire 15-year (or more) period of protection is not required to obtain the full period of protection in that Contracting Party. *See* WIPO, *Records of the Diplomatic Conference for the Adoption of a New Act of the Hague Agreement Concerning the International Deposit of Industrial Design (Geneva Act) June 16 to July 6, 1999*, 254, ¶ 15.08 (2002) (discussing Article 15 of the Basic Proposal presented to the diplomatic conference which, after minor amendment, became Article 17) (“It would be compatible with paragraphs (1) to (3) for a Contracting Party to stipulate a single 15-year (or more) period and to require payment of an initial individual designation fee for the whole period. In such case, protection would be maintained in its territory for that whole period, whether the international registration were renewed or not.”).

**Section 1.1035:** The Office has decided not to adopt § 1.1035 concerning priority in an international design application in this final rule. Section 1.1021(c)(5) in this final rule provides for the inclusion of, as an optional content item, a claim of priority of one or more earlier filed applications in accordance with Article 6 and Rule 7(5)(c) of the Hague Agreement. In addition, §§ 1.55 and 1.78 in this final rule provide for foreign priority and domestic benefit claims with respect to international design applications designating the United States. Accordingly, § 1.1035 is unnecessary.

**Section 1.1041:** Section 1.1041 is added to provide for representation in an international design application. Section 1.1041(a) provides that the applicant may appoint a representative before the International Bureau in accordance with Rule 3. With respect to who may be appointed to represent the applicant before the International Bureau, the Hague Agreement does not provide for any requirement as to professional qualification, nationality, or domicile. The appointment may be made in the international design application or in a separate communication. *See* Rule 3(2).

Requirements as to the appointment of a representative before the office of a Contracting Party are outside the scope of the Hague Agreement and are exclusively a matter for the Contracting Party. Accordingly, § 1.1041(b) is added to provide that applicants of international design applications may be represented before the Office as an office of indirect filing by a practitioner registered (§ 11.6) or granted limited recognition (§ 11.9(a) or (b)) to practice before the Office (§ 11.6). Section 1.1041(b) further provides that such practitioner may act pursuant to § 1.34 or pursuant to appointment by the applicant. The appointment must be in writing signed by the applicant, must give the practitioner power to act on behalf of the applicant, and must specify the name and registration number or limited recognition number of each practitioner. Section 1.1041(b) also provides that an appointment of a representative made in the international design application pursuant to Rule 3(2) that complies with the requirements of this paragraph will be effective as an appointment before the Office as an office of indirect filing. For purposes of representation before the Office during prosecution of an international design application that became a national application (*see* § 1.9(a)(1)), the regulations governing national applications shall apply. *See* § 1.1061(a).

**Section 1.1042:** Section 1.1042 is added to provide that the applicant may specify a correspondence address for correspondence sent by the Office as an office of indirect filing. Where no such address has been specified, the Office will use as the correspondence address the address of applicant's appointed representative (§ 1.1041) or, where no representative is appointed, the address as specified in Administrative Instruction 302.

**Section 1.1045:** Section 1.1045 is added to set forth the procedures for transmittal of international design applications to the International Bureau.

Section 101(a) of the PLTIA adds 35 U.S.C. 382, which states, in subsection (b): “[s]ubject to chapter 17, international design applications shall be forwarded by the Patent and Trademark Office to the International Bureau, upon payment of a transmittal fee.” 126 Stat. at 1528. Rule 13(1) requires an office of indirect filing to notify the applicant and the International Bureau of the receipt date of an international design application and to notify the applicant that the international design application has been transmitted to the International Bureau. Accordingly, § 1.1045(a) is added to provide that, subject to § 1.1045(b) and payment of the transmittal fee set forth in § 1.1031(a), transmittal of the international design application to the International Bureau shall be made by the Office as provided by Rule 13(1). Section 1.1045(a) further provides that at the same time as it transmits the international design application to the International Bureau, the Office shall notify the International Bureau of the date on which it received the application and that the Office shall also notify the applicant of the date on which it received the international design application and the date on which it transmitted the application to the International Bureau.

Because transmittal of the international design application is subject to 35 U.S.C. chapter 17, § 1.1045(b) is added to provide that no copy of an international design application may be transmitted to the International Bureau, a foreign designated office, or other foreign authority by the Office or the applicant, unless the applicable requirements of part 5 of this chapter have been satisfied.

Under the Hague Agreement, formalities review of the international design application is performed by the International Bureau, not the office of indirect filing. The functions of the office of indirect filing are *de minimis*, *i.e.*, receiving and transmitting the international design application and international fees. There is no provision in the Hague Agreement for filing follow-on submissions with the office of indirect filing. Accordingly, § 1.1045(c) is added to provide that once transmittal of the international design application has been effected, except for matters properly before the USPTO as an office of indirect filing or as a designated office, all further correspondence concerning the application should be sent directly to the International Bureau, and that the Office will generally not forward communications to the International Bureau received after

transmittal of the application to the International Bureau. Section 1.1045(c) further provides that any reply to an invitation sent to the applicant by the International Bureau must be filed directly with the International Bureau, and not with the Office, to avoid abandonment or other loss of rights under Article 8.

*Section 1.1051:* Section 1.1051 is added to set forth conditions under which an applicant's failure to act within prescribed time limits in connection with requirements pertaining to an international design application may be excused as to the United States upon a showing of unintentional delay. Section 101(a) of the PLTIA adds 35 U.S.C. 387, which gives the Director authority to prescribe such conditions, including the payment of the fee specified in 35 U.S.C. 41(a)(7), to excuse an applicant's failure to act within prescribed time limits in an international design application as to the United States where the delay was unintentional. 126 Stat. at 1530; *see* discussion of § 1.17(m), *supra*. Under § 1.1051(a), a petition to excuse applicant's failure to act within the prescribed time limits must be accompanied by: (1) A copy of any invitation sent from the International Bureau setting a prescribed time limit for which applicant failed to timely act; (2) the reply required under § 1.1051(c), unless previously filed; (3) the fee as set forth in § 1.17(m); (4) a certified copy of the originally filed international design application, unless a copy of the international design application was previously communicated to the Office from the International Bureau or the international design application was filed with the Office as an office of indirect filing; (5) 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; and (6) a terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section. The Director may require additional information where there is a question whether the delay was unintentional.

The requirements for a copy of the invitation sent from the International Bureau setting a prescribed time limit for which applicant failed to timely act and for a certified copy of the originally filed international design application (unless a copy of the international design application was previously communicated to the Office from the International Bureau or the international design application was filed with the Office as an office of indirect filing) are needed because the Office may not have

a record of the international design application. For example, the Office may not have a record where the international design application was filed directly with the International Bureau and was not published.

Section 1.1051(b) provides that, to be considered timely, any request for reconsideration or review of a decision refusing to excuse the applicant's failure to act within prescribed time limits in connection with an international design application upon petition filed under § 1.1051(a) must be filed within two months of the decision refusing to excuse or within such time as set in the decision. Section 1.1051(b) further provides that, unless a decision indicates otherwise, the two-month time period may be extended under the provisions of § 1.136.

Section 1.1051(c) provides that the reply required may be: (1) The filing of a continuing application and, if the international design application has not been subject to international registration, a grantable petition under § 1.1023(b) to accord the international design application a filing date; or (2) a grantable petition under § 1.1052, where the international design application was filed with the Office as an office of indirect filing.

Under the Hague Agreement, the International Bureau reviews international design applications for compliance with the requirements of the treaty and Regulations. If these requirements have not been met, the International Bureau will invite the applicant to make the required corrections. *See* Hague Agreement Article 8(1). Depending on the correction required, failure to timely comply with the invitation will result in the application being considered abandoned or deemed not to contain the designation of the Contracting Party for which the deficiency relates. *See* Hague Agreement Article 8(2). The Hague Agreement does not provide for continued processing of an international design application that has been abandoned under Article 8 (or for processing the application for a particular Contracting Party after the designation of that Contracting Party has been deemed not to be contained in the application), based on the Office excusing the applicant's failure to timely comply with the invitation pursuant to 35 U.S.C. 387. For example, the Hague Agreement does not provide for forwarding by the International Bureau to the applicant a notification of refusal in an abandoned international application. Accordingly, the Office is providing relief under 35 U.S.C. 387 by permitting the applicant to file a

continuing application claiming benefit to an international design application under the conditions of 35 U.S.C. 386(c) and 120. Upon grant of the petition under this section, applicant's delay will be excused for the purpose of establishing copendency or reinstatement of the U.S. designation in accordance with 35 U.S.C. 120, 386(c), and 388. The ability to file a continuing application is similarly provided in the rule governing the procedure for revival of an abandoned national application. *See* 37 CFR 1.137(c). Alternatively, § 1.1051(c) provides that the reply may be a grantable petition under § 1.1052 to convert the international design application to an application under 35 U.S.C. chapter 16.

Section 1.1051(d) provides that any petition under § 1.1051 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 beginning on the due date for the reply for which applicant failed to timely act and ending on the date of filing of the reply required under paragraph (c) of the section and must also apply to any patent granted on a continuing design application that contains a specific reference under 35 U.S.C. 120, 121, 365(c), or 386(c) to the application for which relief under this section is sought. The requirement under § 1.1051(d) for a terminal disclaimer prevents an inappropriate length of patent term caused by applicant's delay and is consistent with the requirement under § 1.137(d) for a terminal disclaimer in a petition to revive an unintentionally abandoned design application.

*Section 1.1052:* Section 1.1052 is added to set forth a procedure for converting an international design application designating the United States to a design application under 35 U.S.C. chapter 16. Section 101(a) of the PLTIA adds 35 U.S.C. 384(a), the second sentence of which provides: "[n]otwithstanding the provisions of this part, any international design application designating the United States that otherwise meets the requirements of chapter 16 may be treated as a design application under chapter 16." 126 Stat. at 1529. The requirements for a filing date for a design application under 35 U.S.C. chapter 16 are set forth in § 1.53(b). Accordingly, § 1.1052(a) provides that an international design application designating the United States filed with the Office as an office of indirect filing and meeting the requirements under § 1.53(b) for a filing date for an application for a design patent may, on

petition under this section, be converted to an application for a design patent under § 1.53(b) and accorded a filing date as provided therein.

Section 1.1052(a) further provides that the petition must be accompanied by the fee set forth in § 1.17(t) and be filed prior to publication of the international registration under Article 10(3). The requirement that a grantable petition be filed prior to publication under Article 10(3) is necessary in view of the timing requirements under the Hague Agreement to issue a notification of refusal and to avoid expending Office resources processing and examining the application under two different statutory schemes.

Section 1.1052(a) also provides that the conversion of an international design application to an application for a design patent under § 1.53(b) will not entitle applicant to a refund of the transmittal fee or any fee forwarded to the International Bureau, or the application of any such fee toward the filing fee, or any other fee, for the application for a design patent under § 1.53(b). In addition, § 1.1052(a) provides that the application for a design patent resulting from conversion of an international design application must also include the basic filing fee (§ 1.16(b)), the search fee (§ 1.16(l)), the examination fee (§ 1.16(p)), the inventor's oath or declaration (§§ 1.63 or 1.64), and a surcharge if required by § 1.16(f). These provisions are similar to those applicable to converting an application under 35 U.S.C. 111(b) to an application under 35 U.S.C. 111(a). *See* § 1.53(c)(3).

Section 1.1052(b) provides that an international design application will be converted to an application for a design patent under § 1.53(b) if a decision on petition under this section is granted prior to transmittal of the international design application to the International Bureau pursuant to § 1.1045. Otherwise, a decision granting a petition under this section will be effective to convert the international design application to an application for a design patent under § 1.53(b) only for purposes of the designation of the United States. Thus, pursuant to § 1.1052(b), if the Office grants the petition prior to transmittal of the international design application to the International Bureau, the Office will treat the international design application submission as an application for a design patent under § 1.53(b). Once transmittal of the application under § 1.1045 has occurred, the grant of the petition will only be effective as to the United States, and the International Bureau will continue to process the international

design application under the provisions of the Hague Agreement. In such case, because the international design application will have been converted to an application for a design patent under § 1.53(b) with respect to the designation of the United States, the Office will, upon grant of the petition, treat the designation of the United States in the international design application as not being made. To avoid confusion and unnecessary processing, applicants should renounce the designation of the United States pursuant to Article 16 upon grant of the petition for conversion.

Section 1.1052 (c) provides that a petition under § 1.1052 will not be granted in an abandoned international design application absent a grantable petition under § 1.1051.

Section 1.1052(d) provides that an international design application converted under this section is subject to the regulations applicable to a design application filed under 35 U.S.C. chapter 16.

Sections 1.1061–1.1071 relate to national processing of an international design application designating the United States.

*Section 1.1061:* Section 1.1061(a) is added to provide that the rules relating to applications for patents for other inventions or discoveries are also applicable to international design applications designating the United States, except as otherwise provided in chapter I of title 37 of the CFR or required by the Articles or Regulations of the Hague Agreement. Section 1.1061(a) is similar to current § 1.151 with respect to design applications under 35 U.S.C. chapter 16 (“The rules relating to applications for patents for other inventions or discoveries are also applicable to applications for patents for designs except as otherwise provided.”). Section 101(a) of the PLTIA adds 35 U.S.C. 389(b) to provide that all questions of procedures regarding international design applications designating the United States shall be determined as in the case of applications filed under 35 U.S.C. chapter 16, except where otherwise required by the Hague Agreement and the Regulations (126 Stat. at 1530). Section 1.1061(b) is added to identify, consistent with the Hague Agreement and the Regulations, certain regulations that do not apply to international design applications.

*Section 1.1062:* Section 1.1062(a) is added to provide that the Office shall make an examination pursuant to title 35, United States Code, of an international design application designating the United States.

Examination of international design applications designating the United States is mandated by 35 U.S.C. 389(a), which was added by section 101(a) of the PLTIA (126 Stat. at 1530). In accordance with Article 12(1) and 35 U.S.C. 389(b), the Office will not refuse an international design application under examination on grounds that requirements relating to the form or contents of the international design application provided for in the Hague Agreement or the Regulations or additional to, or different from, those requirements have not been satisfied. Accordingly, the Office does not consider it necessary to import the language of Article 12(1) into § 1.1061(a) as originally proposed.

The Office does not consider Article 12(1) to prohibit refusals based on requirements relating to form or contents of the application provided for in the Hague Agreement or Regulations where the International Bureau is not responsible for verifying compliance with such requirements. Such a situation could arise, for example, where the applicant submits amended drawings directly to the Office in an international design application before the Office for examination, as contemplated under Article 14(2)(c). Otherwise, the amended drawings would not be subject to *any* formal requirements. The Office's interpretation is consistent with the intent of Article 12(1). *See, e.g.,* WIPO, *Guide to the International Registration of Industrial Designs under the Hague Agreement*, B.II.36, ¶ 9.03 (Jan. 2014) (“Protection may not be refused on the grounds that the international registration does not satisfy formal requirements, since such requirements are to be considered by each Contracting Party as having already been satisfied *following the examination carried out by the International Bureau*. For example, a designated Office may not refuse protection on the ground that the required fees have not been paid or that the quality of the reproductions is not sufficient, *since such verification is the exclusive responsibility of the International Bureau*.” (emphases added)); WIPO, *Notes on the Basic Proposal for the New Act of the Hague Agreement Concerning the International Registration of Industrial Designs*, H/DC/5, ¶ 11.01 (Dec. 15, 1998) (“*Paragraph (1)* [(referring to Article 11(1) of the Basic Proposal, which became Article 12(1))] affords the Offices of the designated Contracting Parties the right to refuse the effects of international registrations in which they are designated. It is clear, to begin with,

that protection may not be refused on the grounds that the filing does not satisfy the requirements as to form or content of the international application *laid down in the new Act or in the Regulations* to the extent that such requirements are to be considered by each Contracting Party as having already been satisfied under the international procedure.

Additionally, *once the International Bureau has ascertained that those conditions have been satisfied and has proceeded with the international registration*, paragraph (1) stipulates that no Office may refuse the effects of an international registration on the grounds that requirements relating to the form or contents of the international application that are contained in the *legislation of the Contracting Party concerned* and which are additional to or different from the requirements set out in this Act or in the Regulations have not been met.” (third emphasis added). *See also* the discussion of § 1.067(a), *infra* (regarding refusals permitted under the Hague Agreement with respect to optional content items).

Section 1.1062(b) concerns the timing of certain actions in international design applications. Pursuant to Hague Agreement Article 12, where the conditions for the grant of protection under the law of the Contracting Party are not met, a notification of refusal of the effects of international registration must be communicated to the International Bureau within the prescribed period. Rule 18(1) sets forth the period for communicating the notification of refusal. While Rule 18(1)(a) sets forth the prescribed period as six months from the date of publication, this period may be extended by a Contracting Party pursuant to a declaration made under Rule 18(1)(b) (extending the six-month period to twelve months). Furthermore, the declaration under Rule 18(1)(b) may also include, *inter alia*, a statement under Rule 18(1)(c)(ii) (providing for the later communication of a decision regarding the grant of protection where a decision regarding the grant of protection was unintentionally delayed by the office of the Contracting Party).

Section 1.1062(b) is added to provide that, for each international design application to be examined, the Office shall, subject to Rule 18(1)(c)(ii), send to the International Bureau within 12 months from the publication of the international registration under Rule 26(3) a notification of refusal (§ 1.1063) where it appears that the applicant is not entitled to a patent under U.S. law with respect to any industrial design that is the subject of the international

registration. The Office intends to send all notifications of refusal prior to the expiration of the 12-month period set forth in § 1.1062(b). Any failure by the Office to do so would be unintentional pursuant to Rule 18(1)(c)(ii).

The Office does not regard the failure to send the notification of refusal within the period referenced in § 1.1062(b) to confer patent rights or other effect under Article 14(2). The Hague Agreement is not self-executing, and the PLTIA provides for patent rights only upon issuance of a patent. *See* 35 U.S.C. 389(d) added by the PLTIA, 126 Stat. at 1531; *see also* S. Exec. Rep. No. 110–7, at 5 (“The proposed Act makes no substantive changes in U.S. design patent law with the exception of the following: The provision of limited rights to patent applicants between the date that their international design application is published by the IB and the date on which they are granted a U.S. patent based on that application; the extension of a patent term for designs from fourteen to fifteen years from grant; and allowing the USPTO to use a published international design registration as a basis for rejecting a subsequently filed national patent application that is directed at the same or a similar subject matter.”). Furthermore, the PLTIA requires an international design application that designates the United States to be examined by the Office pursuant to title 35, United States Code. *See* 35 U.S.C. 389(a). Patent rights may only arise at the end of the examination process. The absence of a notification of refusal does not confer enforceable rights. *See* 35 U.S.C. 153 (“Patents shall be issued in the name of the United States of America, under the seal of the Patent and Trademark Office, and shall be signed by the Director or have his signature placed thereon and shall be recorded in the Patent and Trademark Office.”).

*Section 1.1063:* Section 1.1063(a) is added to provide, in accordance with Rule 18(2)(b), that a notification of refusal shall contain or indicate: (1) The number of the international registration (Rule 18(2)(b)(ii)); (2) the grounds on which the refusal is based (Rule 18(2)(b)(iii)); (3) a copy of a reproduction of the earlier industrial design and information concerning the earlier industrial design, where the grounds of refusal refer to similarity with an industrial design that is the subject of an earlier application or registration (Rule 18(2)(b)(iv)); (4) where the refusal does not relate to all the industrial designs that are the subject of the international registration, those to which it relates or does not relate (Rule

18(2)(b)(v)); and (5) a time period for reply under §§ 1.134 and 1.136 where a reply to the notification of refusal is required (Rule 18(2)(b)(vi)).

Pursuant to Article 12, the Office communicates the notification of refusal directly to the International Bureau, which then transmits without delay a copy of the notification of refusal to the holder. The grounds of refusal may be in the form of a rejection based on a condition for patentability under title 35, United States Code (*e.g.*, 35 U.S.C. 102, 103, or 112), a requirement for restriction (where more than one independent and distinct design is presented in the application), and/or an objection (where not prohibited by Article 12(1) of the Hague Agreement). The grounds of refusal may also be based on applicant’s action, including cancellation of industrial designs in the international design application by amendment or by an express abandonment of the application pursuant to § 1.138 prior to examination.

The Office will generally forward references used in the grounds of refusal (*e.g.*, a rejection under 35 U.S.C. 102 or 103) with the notification of refusal unless the reference was cited by the applicant in an information disclosure statement.

The notification of refusal communicated by the Office will set a time period for reply under §§ 1.134 and 1.136 to avoid abandonment where a reply to the notification of refusal is required. Not all notifications of refusal will require a reply. For example, where the international registration contains multiple industrial designs and all but one design is cancelled by preliminary amendment prior to examination, and the remaining design is determined by the examiner to be allowable, then a notice of allowance will be sent concurrently with a notification of refusal, refusing the effects of the international registration in the United States with respect to the industrial design or designs that have been cancelled. Such a notification of refusal, otherwise known as a “partial notification of refusal,” will be communicated to the International Bureau but will not set a time period for reply to the notification of refusal, as no reply to the refusal is required.

Section 1.1063(b) is added to provide that any reply to the notification of refusal must be filed directly with the Office and not through the International Bureau. Section 1.1063(b) further provides that the requirements of § 1.111 shall apply to a reply to a notification of refusal. As described above, the notification of refusal may be



a non-final Office action, including a non-final Office action on the merits, after a first examination under § 1.104.

Under the Hague Agreement, any reply to the notification of refusal must be filed directly with the Office. The applicant may not file a reply to a notification of refusal through the International Bureau. Any further correspondence from the Office will normally be sent directly to the applicant. The procedures applicable to design applications under 35 U.S.C. chapter 16 are generally applicable to international design applications after communication of the notification of refusal. *See* Article 12(3)(b) and 35 U.S.C. 389(b); *see also* WIPO, *Guide to the International Registration of Industrial Designs under the Hague Agreement*, B.II.40, ¶ 9.23 (Jan. 2014) (“Where the holder of an international registration receives, through the International Bureau, a notification of refusal, he has the same rights and remedies (such as review of, or appeal against, the refusal) as if the industrial design had been filed directly with the Office that issued the notification of refusal. The international registration is, therefore, with respect to the Contracting Party concerned, subject to the same procedures as would apply to an application for registration filed with the Office of that Contracting Party.”). Thus, for example, the provisions of 35 U.S.C. 133 and §§ 1.134 through 1.136 govern the time to reply to an Office action, including a notification of refusal that requires a reply to avoid abandonment, and the consequence for failure to timely reply (*i.e.*, abandonment).

Because the procedures following the notification of refusal are governed by national practice, the failure of an applicant to renew an international registration pursuant to Article 17(2) does not affect the pendency status of an international design application before the Office. Otherwise, applicants in international design applications would not have the same rights and remedies as applicants in national design applications, as required under Article 12(3)(b) and 35 U.S.C. 389. Similarly, the failure to renew a registration under Article 17(2) does not impact an applicant's ability to file a continuing application under 35 U.S.C. 120, 121, 365(c) or 386(c), as the critical inquiry under 35 U.S.C. 120 is the presence of copendency.

**Section 1.1064:** Section 1.1064(a) is added to provide that only one independent and distinct design may be claimed in a nonprovisional international design application. Subject to the requirements of Article 13, a

Contracting Party whose law at the time it becomes party to the Hague Agreement requires, *inter alia*, that only one independent and distinct design may be claimed in a single application, can refuse the effects of the international registration on grounds of noncompliance with such requirement. U.S. law requires that only one independent and distinct design may be claimed in a single application. *See In re Rubinfeld*, 270 F.2d 391 (CCPA 1959); *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967); MPEP 1504.05. Accordingly, § 1.1064(a) is added to provide that only one independent and distinct design may be claimed in a nonprovisional international design application.

Section 1.1064(b) provides that, if the requirements under § 1.1064(a) are not satisfied, the examiner shall in the notification of refusal or other Office action require the applicant in the reply to that action to elect one independent and distinct design for which prosecution on the merits shall be restricted. Section 1.1064(b) further provides that such requirement will normally be made before any action on the merits but may be made at any time before the final action. Review of any such requirement is provided under §§ 1.143 and 1.144.

**Section 1.1065:** Hague Agreement Rule 22 provides for correction of errors in the International Registration by the International Bureau, acting *ex officio* or at the request of the holder. Under Rule 22(2), a designated Contracting Party has the right to refuse the effects of correction. Accordingly, § 1.1065(a) is added to provide that the effects of any correction in the International Register by the International Bureau pursuant to Rule 22 in a pending nonprovisional international design application shall be decided by the Office in accordance with the merits of each situation, subject to such other requirements as may be imposed. Section 1.1065(a) further provides that a patent may only be corrected in accordance with the provisions of title 35, United States Code, for correcting patents. Such provisions are contained, for example, in 35 U.S.C. chapter 25. Title I of the PLTIA does not provide another mechanism for correcting patents issued on international design applications. Section 1.1065(a) also provides that any correction under Rule 22 recorded by the International Bureau with respect to an abandoned nonprovisional international design application will generally not be acted upon by the Office and shall not be given effect unless otherwise indicated by the Office. Rule 22 does not impose any

requirement on a Contracting Party to give effect to a correction made under Rule 22 in an international design application that is abandoned before that Contracting Party.

Section 1.1065(b) is added to provide that a recording of a partial change in ownership in the International Register pursuant to Rule 21(7) concerning a transfer of less than all designs shall not have effect in the United States. Under the Hague Agreement, a partial change in ownership resulting from an assignment or other transfer of the international registration in respect of only some of the industrial designs or only some of the designated Contracting Parties may be recorded in the International Register pursuant to Rule 21(7). Upon recording of the partial change in ownership, the International Bureau will create a new international registration number for the part that has been assigned or otherwise transferred, and cancel that part under the originally international registration number. Consequently, it is possible that an original international registration may be divided by the International Bureau into a number of international registrations each directed to only some of the designs present in the original registration. Such would present administrative difficulties for the Office. Under Rule 21*bis*, a Contracting Party may declare that a change in ownership recorded in the International Register has no effect in that Contracting Party. Accordingly, § 1.1065(b) is added, consistent with Rule 21*bis*, to provide that a recording of a partial change in ownership in the International Register pursuant to Rule 21(7) concerning a transfer of less than all designs shall not have effect in the United States. Section 1.1065(b) does not limit the right of the owner to assign or otherwise transfer a portion of his or her interest in the application, or to record such transfer in the Office, but rather simply provides that the recording of such a transfer in the International Register will not have effect in the United States.

**Section 1.1066:** Section 1.1066 is added to specify the correspondence address for a nonprovisional international design application. Unlike other types of applications before the Office, an applicant does not need to file any submissions with the Office to initiate examination under § 1.1062 of an international design application designating the United States. Rather, published international design registrations that designate the United States will be systematically received from the International Bureau and examined in due course. Accordingly, § 1.1066(a) sets forth how the Office will

establish the correspondence address for a nonprovisional international design application in the absence of a communication from the applicant changing the correspondence address. Specifically, § 1.1066(a) provides that, unless the correspondence address is changed in accordance with § 1.33(a), the Office will use as the correspondence address in a nonprovisional international design application the address according to the following order: (i) The correspondence address under § 1.1042; (ii) the address of the applicant's representative identified in the publication of the international registration; and (iii) the address of the applicant identified in the publication of the international registration.

Section 1.1066(b) is added to provide that a reference in the rules to the correspondence address set forth in § 1.33(a) shall be construed to include a reference to § 1.1066 for a nonprovisional international design application.

*Section 1.1067:* Section 1.1067(a) is added to provide for a title in a nonprovisional international design application. The Hague Agreement does not require that an international design application contain a title. The Office believes a title that identifies the article in which a design is embodied is helpful to the public in understanding the nature of the article embodying the design after the patent has issued and also aids in identification during public search. In addition, a U.S. patent must contain a title of the invention. *See* 35 U.S.C. 154(a)(1) ("Every patent shall contain a short title of the invention. . . ."). Accordingly, pursuant to § 1.1067(a), the applicant may provide a title of the design that designates the particular article in a nonprovisional international design application. Section 1.1067(a) further provides that, where a nonprovisional international design application does not contain a title of the design, the Office may establish a title. In determining the title, the Office may look to the particular article specified in the claim.

Section 1.1067(a) also provides for a brief description of the drawings in a nonprovisional international design application, as for design applications filed under 35 U.S.C. chapter 16. Section 1.1061(a), discussed *supra*, makes applicable the rules relating to applications for patents to international design applications that designate the United States except as otherwise provided in chapter 37 of the Code of Federal Regulations or required by the Hague Agreement Articles or

Regulations. Section 1.1061(b) in this final rule excludes from applicability to international design applications the requirements set forth in § 1.74 for a description of the drawings. Instead, a requirement for a brief description of the drawings is provided for in § 1.1067(a) in this final rule. The description requirement in § 1.1067(a) is consistent with the description requirement applicable to design applications filed under 35 U.S.C. chapter 16. *See* § 1.153 ("No description, other than a reference to the drawings, is ordinarily required."). The PLTIA provides for parity in the treatment of international design applications designating the United States with design applications under 35 U.S.C. chapter 16, except where otherwise provided by the PLTIA, Hague Agreement, or Regulations. *See, e.g.,* 35 U.S.C. 389(b) ("All questions of substance and, unless otherwise required by the treaty and Regulations, procedures regarding an international design application designating the United States shall be determined as in the case of applications filed under chapter 16."). Rule 7(5)(a) allows an applicant to include in the international design application a brief description of the reproduction even where those items are not required under Article 5(2). The purpose of Rule 7(5)(a) is to allow applicants to include these items in the international design application to avoid a refusal by a designated Contracting Party whose national law requires such items, though not as a filing date requirement. *See, e.g.,* WIPO, *Notes on the Basic Proposal for the New Act of the Hague Agreement Concerning the International Registration of Industrial Designs*, H/DC/5, ¶ 5.09 (Dec. 15, 1998) ("Paragraph (2) [(Article 5(3))] gives applicants the possibility of including in the international application, or accompanying it by, those additional elements which are specified in Rule 7(4) [(Rule 7(5)(a))]. Certain of those elements may be furnished by applicants in order to avoid refusal by a designated Contracting Party. If the international application does not contain an optional element as referred to in Article 5(2) and designates a Contracting Party that imposes the requirement or requirements concerned, regularization will not be carried out with the International Bureau, but with the designated Office that has issued the refusal."). *See also* WIPO, *Records of the Diplomatic Conference for the Adoption of a New Act of the Hague Agreement concerning the International Deposit of Industrial Designs* (Geneva

*Act*) June 16 to July 6, 1999, 480, ¶¶ 793–94 (2002) (discussing Rule 7 at the 1999 Diplomatic Conference). Contracting Parties to the Hague Agreement may require items referred to in Rule 7(5)(a) pursuant to their national law. Applicants are informed of each Contracting Party's national law requirements in the application for international registration form (DM/1 form) and corresponding instructions to the application form. *See, e.g.,* instruction form DM/1.INF, ¶ 38, currently available at <http://www.wipo.int/hague/en/forms/> (advising applicants that if they designate certain Contracting Parties, the applicant must provide the optional item required by such Contracting Party's national law, and that such item will not be reviewed by the International Bureau).

Section 1.1067(b) is added to provide that, if the applicant is notified in a notice of allowability that an oath or declaration in compliance with § 1.63, or a substitute statement in compliance with § 1.64, executed by or with respect to each named inventor has not been filed, the applicant must file each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, no later than the date on which the issue fee is paid to avoid abandonment. This time period is not extendable under § 1.136. As explained above, Hague Agreement Rule 8 accommodates current U.S. law regarding the inventor's oath or declaration. Because the presence of the required inventor's oath or declaration is verified by the International Bureau as part of its formalities review, the need to notify the applicant in a notice of allowability that an inventor's oath or declaration is required should be rare, *e.g.,* where an inventor is added pursuant to § 1.48(a) and an executed an oath or declaration from the inventor has not been received. *See* § 1.48(b). Since the notice of allowability is used whenever an application has been placed in a condition for allowance (*see* MPEP 1302.03), the notice of allowability does not constitute a refusal of the effects of the international registration, and thus is not a notification of refusal, notwithstanding any requirement in the notice of allowability to furnish an item, such as the inventor's oath or declaration pursuant to § 1.1067.

*Section 1.1068:* Section 1.1068 is added to provide that, upon issuance of a patent on an international design application designating the United States, the Office may send to the International Bureau a statement to the effect that protection is granted in the

United States to the industrial design or designs that are the subject of the international registration and covered by the patent. The sending of such a statement is provided for under Hague Agreement Rule 18*bis* and serves the purpose of providing notice to the public and third parties through publication of the statement by the International Bureau in the International Designs Bulletin that protection for an industrial design has been granted in the United States. The statement also serves as a withdrawal, in part or in whole, of any prior refusal with respect to the design covered by the patent. *See* Rule 18*bis*(2).

*Section 1.1069:* The Office has decided not to add § 1.1069 in this final rule. Section 1.1069 concerning a notification of division is not necessary. The requirements relating to a notification of division are clearly set forth in Rule 18(3) and Administrative Instruction 502. Furthermore, having a rule that sets forth requirements contained in an administrative instruction would necessitate the need to amend the rule each time the administrative instruction is changed.

*Section 1.1070:* Section 1.1070 is added to provide for the sending of a notification of invalidation to the International Bureau. Article 15 provides that the office of the Contracting Party in whose territory the effects of the international registration have been invalidated shall, where it is aware of the invalidation, notify the International Bureau of the invalidation ("notification of invalidation"). Rule 20 provides that, where the effects of an international registration are invalidated in a designated Contracting Party and the invalidation is no longer subject to any review or appeal, the office of the Contracting Party whose competent authority has pronounced the invalidation shall, where it is aware of the invalidation, notify the International Bureau accordingly. Rule 20 further specifies the required contents of the notification of invalidation. In accordance with Article 15 and Rule 20, § 1.1070(a) provides that, where a design patent that was granted from an international design application is invalidated in the United States and the invalidation is no longer subject to any review or appeal, the patentee shall inform the Office. Section 1.1070(b) provides that after receiving a notification of invalidation under § 1.1070(a) or through other means, the Office will notify the International Bureau in accordance with Rule 20.

*Section 1.1071:* Section 1.1071 is added to provide that a grant of protection for an industrial design that

is the subject of an international registration shall only arise in the United States through the issuance of a patent pursuant to 35 U.S.C. 389(d) or 171 and in accordance with 35 U.S.C. 153.

*Section 3.1:* Section 3.1 is amended to include an international design application that designates the United States of America within the definition of "application" for purposes of Part 3 of Title 37 of the CFR. The change to the definition of "application" in § 3.1 makes clear that assignments (or other documents affecting title) of international design applications that designate the United States may be submitted to the Office for recording. The change to § 3.1 is in accordance with 35 U.S.C. 385, added under the PLTIA, which provides that an international design application designating the United States has the effect, for all purposes, of an application for patent filed in the Office pursuant to 35 U.S.C. chapter 16. 126 Stat. at 1529.

*Section 3.21:* Section 3.21 is amended to provide that an assignment relating to an international design application that designates the United States must identify the international design application by the international registration number or by the U.S. application number assigned to the international design application.

*Section 5.1:* Section 5.1(b) is amended to change the definition of "application" as used in part 5 of title 37 of the CFR to include international design applications and for consistency with the definitions in § 1.9. Section 5.1(b) is also amended to include a definition of "foreign application" to permit simplification of other rules contained in part 5.

*Section 5.3:* Section 5.3(d) is amended to clarify that an international design application that is subject to a secrecy order will not be mailed, delivered, or otherwise transmitted to the international authorities or the applicant.

*Section 5.11:* The title of § 5.11 is amended to encompass international design applications and to indicate that the license authorizes filing and exporting. Section 5.11(a) is amended to clarify that, just as for filing an international application in the United States Patent and Trademark Office acting as a Receiving Office under the PCT, a foreign filing license is not required to file an international design application in the United States Patent and Trademark Office acting as an office of indirect filing under the Hague Agreement. The Office notes that, pursuant to § 5.12, filing of an international design application

constitutes "a petition for license under 35 U.S.C. 184 for the subject matter of the application." Sections 5.11(b), (c), (e)(3)(i), and (f) are amended to change "foreign patent application" to "foreign application," as the provisions of 35 U.S.C. 184 are not limited to "patent" applications but include other types of applications, e.g., registrations of industrial designs. Section 5.11(b) is also amended for consistency with § 5.11(c) with respect to the citation to regulations contained in other titles under the Code of Federal Regulations. Section 5.11(f) is also amended to refer to the Office as the United States Patent and Trademark Office.

*Section 5.12:* Section 5.12 is amended for consistency with the definition of "application" in § 5.1(b) as amended in this final rule and to indicate that the grant of a foreign filing license may be on an official notice other than the filing receipt, e.g., in the case of international applications filed under the PCT, on the "Notification of the International Application Number and of the International Filing Date" (Form PCT/RO/105).

*Section 5.13:* Section 5.13 is amended to include as a corresponding application for purposes of this section an international design application that has been filed in the United States. Thus, if no corresponding national, international design, or international application has been filed in the United States, the petition for license under § 5.12(b) must also be accompanied by a legible copy of the material upon which a license is desired.

*Section 5.14:* Section 5.14(c) is amended for clarity to provide that a copy of the application to be filed or exported abroad must be furnished with the petition under § 5.14 under the conditions set forth in § 5.14(c). The copy of the application required under § 5.14(c) may be a copy of the international design application to be filed or exported abroad.

*Section 5.15:* Section 5.15(a) introductory text and paragraphs (a)(3), (b), (d) and (e) are amended for consistency with the changes to §§ 5.1(b) and 5.11 as amended in this final rule.

*Section 11.10:* Section 11.10(b)(3)(iii) is amended to include international design application in the definition of patent application for purposes of § 11.10.

*Section 41.200(b):* Section 41.200(b) is added to provide that any reference to 35 U.S.C. 102 or 135 in this subpart refers to the statute in effect on March 15, 2013, unless otherwise expressly indicated, and to provide that any reference to 35 U.S.C. 141 or 146 in this

subpart refers to the statute applicable to the involved application or patent. Section 41.200(b) is added for clarity consistent with the changes made under the first inventor to file provisions of the AIA.

**Section 41.201:** The definition of “constructive reduction to practice” is amended to provide that for a chain of patent applications to be continuous, each subsequent application must comply with the requirements of 35 U.S.C. 119–121, 365, or 386. The amended definition accounts for priority under 35 U.S.C. 386 added by title 1 of the PTLIA as well as priority under 35 U.S.C. 119, 365(b), and 365(c). The definition of “threshold issue” is amended by changing the reference to 35 U.S.C. 112(a) in paragraph (2)(ii) to 35 U.S.C. 112, as the written description requirement under pre-AIA 35 U.S.C. 112, first paragraph, may be applicable in certain cases.

**Comments and Responses to Comments:** The Office published a notice of proposed rulemaking on November 29, 2013, proposing to change the rules of practice to implement title I of the PLTIA. *See Changes To Implement the Hague Agreement Concerning International Registration of Industrial Designs*, 78 FR 71870 (Nov. 29, 2013). The Office received seven written submissions containing comments from intellectual property organizations, academia, a law firm, an individual patent practitioner, and the general public in response to this notice of proposed rulemaking. The summarized comments and the Office’s responses to those comments follow:

#### *Closed System*

**Comment 1:** Several comments requested that the Office clarify whether an international design application that designates the United States can be assigned to a person who is not entitled to file an international design application under the Hague Agreement. One of the comments further suggested that such clarification be made by amending certain rules affected by a limitation on assignment, in particular § 1.46(c) (pertaining to a change in the applicant), §§ 3.21 and 3.24 (pertaining to assignments), and all rules pertaining to actions by the patent owner (*e.g.*, §§ 1.172 and 1.510). Another comment suggested that if assignment is restricted, any patent granted on an international design application should include a notice to the public of the restriction. A further comment questioned whether any restriction in transfer of ownership, if applicable to international design applications, would also apply to continuing applications.

**Response:** The PLTIA does not restrict assignment of international design applications designating the United States, or patents issuing thereon, to persons entitled to file an application under the Hague Agreement. 35 U.S.C. 261 provides that “patents shall have the attributes of personal property,” that “[a]pplications for patent, patents, or any interest therein, shall be assignable in law by an instrument in writing” and that “[t]he applicant, patentee, or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patents, to the whole or any specified part of the United States.” *See also GAIA Techs., Inc. v. Reconversion Techs., Inc.*, 93 F.3d 774, 777–80 (Fed. Cir. 1996), *as amended on reh’g*, 104 F.3d 1296 (Fed. Cir. 1996) (“Patents . . . , like other personal property, may be conveyed from the inventor . . . to others. . . .”). Title I of the PLTIA did not change 35 U.S.C. 261 or otherwise restrict to whom an international design application or patent issuing thereon may be assigned.

The fact that the Hague Agreement is a closed system, in that only persons who meet certain criteria may file an international design application, does not restrict the ability to transfer ownership in the application (or resulting patent) to a person not entitled to file under the system. Similar to Hague applicants, applicants in international applications filed under the PCT must be nationals or residents of PCT Contracting States in order to file international applications. *See* PCT Article 9. Also, U.S. national law does not restrict the ability of PCT applicants to assign PCT applications designating the United States to persons not entitled to file applications under the PCT. *See, e.g.*, § 3.1 (defining “application” for purposes of the rules governing assignments to broadly include “international [PCT] applications that designate the United States”); § 3.21 (specifying only an identification requirement for assignments relating to international patent applications that designate the United States). In contrast, applicants filing for trademark protection under the Madrid Protocol are barred from assigning an extension of protection to a person who is not entitled to file the application under the Madrid Protocol (*see, e.g.*, § 7.22 (providing that Section 10 of the Lanham Act and 37 CFR part 3 are not applicable to assignments or restrictions of international registrations)). This is because the Madrid Protocol Implementation Act of 2002, unlike the PLTIA and legislation implementing the

PCT, expressly restricts assignment. *See* 15 U.S.C. 11411 (“An extension of protection may be assigned, together with the goodwill associated with the mark, only to a person who is a national of, is domiciled in, or has a bona fide and effective industrial or commercial establishment either in a country that is a Contracting Party or in a country that is a member of an intergovernmental organization that is a Contracting Party.”).

Furthermore, Article 16 of the Hague Agreement provides only that the International Bureau shall record changes in ownership of the international registration in the International Register, provided that the new owner is entitled to file an international application under Article 3. *See* Article 16(1)(i). Recording changes in ownership by the International Bureau in the International Register is a separate issue from whether an international design application can be assigned or otherwise transferred under national law. The Hague Agreement does not govern the validity of ownership changes. *See* WIPO, *Guide to the International Registration of Industrial Designs under the Hague Agreement*, B.II.46, ¶ 13.04 (Jan. 2014) (“Furthermore, the issue of the recording of a change in ownership in the International Register must be distinguished from that of the validity of such change in ownership. The Hague Agreement does not set out, for example, the conditions to be met regarding the validity of a deed of assignment relating to an international registration. These conditions are, and remain, governed exclusively by the relevant domestic legislation, and may therefore vary from one Contracting Party to another (*e.g.*, the need for execution of a document in writing certifying the assignment, proof of the age of the parties in order to assess their legal entitlement, etc.).”). *See also id.* at ¶ 13.05 (“The Hague Agreement provides only for the requirements to be complied with in order to validly record a change in ownership in the International Register.”).

One comment suggested amending § 1.46(c) to clarify whether an international design application designating the United States can be amended to name an applicant who is not entitled to file under the Hague Agreement. The Office does not deem clarification necessary. Who qualifies to be an applicant for a designated Contracting Party is a matter of national law. The PLTIA does not expressly state who is qualified to be an applicant for an international design application designating the United States, but

otherwise indicates that a qualified applicant does not differ from a person qualified to be an applicant for a national design application under 35 U.S.C. 171–73. *See* section 101(a) of the PLTIA (adding 35 U.S.C. 389(b) (“All questions of substance and, unless otherwise required by the treaty and Regulations, procedures regarding an international design application designating the United States shall be determined as in the case of applications filed under chapter 16.”); 35 U.S.C. 382(c) (“Except as otherwise provided in this chapter, the provisions of chapter 16 shall apply.”); and 35 U.S.C. 383 (“In addition to any requirements pursuant to chapter 16, the international design application shall contain . . .”). 126 Stat. at 1528–30. Pursuant to 35 U.S.C. 118, as amended under the AIA, an assignee may be an applicant in a patent application. As explained above, the assignee of an international design application designating the United States may be a person not entitled to file an application under the Hague Agreement. In accordance with 35 U.S.C. 118, such person may be named as an applicant in the international design application pursuant to the provisions of § 1.46(c). This is also consistent with applicant changes made pursuant to § 1.46(c) in the U.S. national phase of PCT international applications. Because the Office does not consider the PLTIA to prohibit assigning an international design application designating the United States to a person not entitled to file an application under the Hague system, the rules do not provide for any restriction on assignment.

*Comment 2:* One comment suggested that a U.S. patent issuing from an international design application be identified as an “international design patent” to clarify that rights are subject to the Hague Agreement, with its closed system features, for example, only membership participation, assignment of International Registration rights, and renewal features.

*Response:* A U.S. patent issued on an international design application will include information on the front page that will indicate that the patent issued on an international design application. But identifying a U.S. patent issued on an international design application as an “international design patent” may lead to confusion among the public and others as to the scope of protection arising under the patent. A patent issued on an international design application designating the United States has the force and effect of a patent issued on an application filed

under 35 U.S.C. chapter 16. *See* 35 U.S.C. 389(d).

#### *Continuing Applications, Continued Prosecution Applications, and Converted Applications*

*Comment 3:* One comment requested that the Office provide for continued prosecution applications (CPAs) in international design applications. The comment asserts that CPAs provide for quick resolution of remaining issues in prosecution, have lower filing fees than continuation applications, provide provisional rights, and are required under the PLTIA. Alternatively, the comment requests that the Office either expedite or prioritize examination of a continuation application claiming priority to an international design application in limited circumstances, or provide a conditional petition procedure whereby a petition could be filed after allowance that would permit consideration of an information disclosure statement or other matter after allowance and the petition would constitute the filing of a continuation application if the examiner determines that new issues are raised.

*Response:* The final rules do not provide for the filing of a CPA in an international design application. The Office created CPAs for all applications following the change in patent term for utility applications from 17 years from issuance to 20 years from filing. The primary reason for creating CPAs was to minimize any reduction in patent term for continuing utility applications caused by new application processing by eliminating the need to assign the continuing application a new application number and filing date. *See* 1996 *Changes to Patent Practice and Procedure*, 61 FR 49820, 49825 (Sept. 23, 1996). A CPA is a streamlined continuation or divisional application under 35 U.S.C. 120 whose filing date is the date on which the request for a CPA is filed. *See* § 1.53(d)(2) (providing that the filing date of a continued prosecution application is the date on which a request on a separate paper for an application under this paragraph is filed). A request for a CPA constitutes a request to expressly abandon the earlier application and to use the file jacket and contents of the prior application. *See* § 1.53(d)(2)(iv), (v).

Subsequently, in the American Inventors Protection Act, Congress added request for continued examination (RCE) practice for utility and plant applications, while simultaneously providing for publication of applications 18 months from filing and provisional rights from the date of publication. *See Request for*

*Continued Examination Practice and Changes to Provisional Application Practice*, 65 FR 50092–101 (Aug. 16, 2000); 35 U.S.C. 132(b). Since an RCE is not a new application that is separately published, the provisional rights period continues from the original publication date. *See* 35 U.S.C. 154(d)(1). RCE practice was not extended to U.S. design applications, which are not published. *See* 35 U.S.C. 132 ed. note. The Office eventually eliminated CPA practice for all applications except U.S. design applications. *See Elimination of Continued Prosecution Application Practice as to Utility and Plant Patent Applications*, 68 FR 32376–81 (May 30, 2003).

A patent issuing on a CPA would not be entitled to provisional rights based on the prior publication of the international design application under the treaty, as asserted in the comment. Pursuant to 35 U.S.C. 154(d)(1), provisional rights begin on “the date of publication of the application for such patent” under 35 U.S.C. 122(b). As previously explained, a CPA is a continuation or divisional application of the prior application. *See* § 1.53(d)(1) (providing that a continuation or divisional application (but not a continuation-in-part) of a prior nonprovisional application may be filed as a continued prosecution application under the paragraph); § 1.78(d)(4) (providing that 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-filed application). The filing of a CPA operates as an express abandonment of the prior application as of the filing date of the CPA request. *See* § 1.53(d)(2)(v) (providing that a CPA is a request to expressly abandon the prior application as of the filing date of the request for a CPA). Accordingly, a patent issuing on a CPA obtains provisional rights only from the date of its publication, not from the date of publication of the earlier application. U.S. design applications are not published and do not qualify for provisional rights. *See* 35 U.S.C. 122(b)(2)(A)(iv); 35 U.S.C. 154(d)(1). Thus, even if the filing of a CPA from an international design application were permitted, a design patent issuing from the CPA would not be entitled to provisional rights because the CPA is not published. While an RCE is not a new application, and thus permits extension of the provisional rights period from the date of the earlier publication, RCE practice is not available for U.S. design applications.

A CPA of an earlier U.S. design application is possible because the prior application has already been reviewed

by the Office for compliance with the same statutory and regulatory requirements applicable to the CPA, thus eliminating the need for a separate review of the CPA. See § 1.53(d)(1)(ii) (providing that the prior nonprovisional application is a design application that is complete as defined by § 1.51(b)). No such efficiencies exist so as to permit the filing of a CPA from an international design application. The Office will not be performing a formalities review of international design applications designating the United States prior to examination. Instead, the International Bureau will review international design applications for compliance with the applicable *treaty* requirements. A CPA is a U.S. design application under 35 U.S.C. chapter 16, not an international design application under the Hague Agreement. Consequently, a CPA is subject to different statutory and regulatory requirements than international design applications. Compare 35 U.S.C. 171–173 with 35 U.S.C. 381–390; compare 37 CFR 1.151–1.155 with final rules §§ 1.1001–1.1071. For example, an international design application and CPA are subject to different filing date requirements (compare 35 U.S.C. 171(c) with 35 U.S.C. 384) and different content requirements (e.g., regular U.S. design applications are required under § 1.153 to include a title; no such formal requirement applies to international design applications). In addition, as discussed above, an international design application is published and entitles the holder to provisional rights, whereas a CPA does not. Compare 35 U.S.C. 390 with 35 U.S.C. 122(b)(2)(A)(iv); see also 35 U.S.C. 154(d). Given these differing requirements, the same opportunity for streamlined continuation practice does not exist.

Furthermore, international design applications filed with the Office will be assigned a U.S. application number having a series code unique to international design applications to distinguish such applications from other applications filed with the Office. Allowing a design application filed under 35 U.S.C. chapter 16 to use an application number associated with international design applications may lead to confusion and errors in processing the application under the different requirements applicable to international design applications and applications filed under 35 U.S.C. chapter 16. In addition, use of the same application number for both the CPA and the international design application would significantly complicate the changes needed to the Office's IT

systems to support the small number of applications that would be affected. For example, the notice of allowance, processing of issue fee payments, and formal objections that may be applicable under examination differ between international design applications and design applications filed under 35 U.S.C. chapter 16.

The fees associated with the filing of a CPA are not lower than the fees associated with the filing of a continuing design application, as stated in the comment. Rather, the fees are the same. See § 1.53(d)(3) (providing that the filing fee, search fee, and examination fee for a continued prosecution application filed under this paragraph are the basic filing fee as set forth in § 1.16(b), the search fee as set forth in § 1.16(l), and the examination fee as set forth in § 1.16(p)).

The comment asserts that not permitting CPAs appears to be contrary to the explicit language and intent of 35 U.S.C. chapter 38 and the other portions of the proposed rules. The comment points to, *inter alia*, 35 U.S.C. 382(c), 35 U.S.C. 384(a), and the proposed rules with respect to examination and general filing requirements, which are modeled after the current treatment of 35 U.S.C. chapter 16 applications before the Office. The PLTIA, including the provisions cited to in the comment, generally provides for applicability of the requirements of 35 U.S.C. chapter 16 to international design applications designating the United States except where otherwise provided under title 35, United States Code, or required by the Hague Agreement or Hague Agreement Regulations. CPA practice, however, is not a requirement of 35 U.S.C. chapter 16. Rather, as previously explained, CPAs were created by regulation as a streamlined continuation practice under 35 U.S.C. 120. A CPA is a U.S. application and is just like any other design application filed under 35 U.S.C. chapter 16. Not permitting CPAs claiming priority to international design applications is not inconsistent with any provision of 35 U.S.C. chapter 38.

The Office has not adopted, as recommended by the commentor, rules to prioritize or expedite examination of a continuation application of an international design application in limited circumstances. Prioritizing or expediting examination of continuation applications would present an administrative burden for the Office in identifying those continuation applications that qualify for expedited treatment. Furthermore, Office records show that CPAs are currently filed in less than 3% of design applications. Also, the number of international design

applications is anticipated to be, at least initially, a small fraction of total design applications filed with the Office. In 2013, 2,990 international design applications were filed via the Hague system, whereas 35,077 design applications were filed with the Office under 35 U.S.C. chapter 16. The Office is reluctant to develop new and complicated procedures at this time to accommodate a handful of applications, especially since the procedures could negatively impact administrative efficiency in processing all continuing applications filed with the Office. Applicants desiring expedited examination in continuation applications may utilize the “rocket docket” procedure pursuant to § 1.155.

The Office also has not adopted rules to provide for a conditional petition procedure to allow for consideration of an information disclosure statement (or other issue) after allowance wherein the petition would constitute the filing of a continuation application if the examiner determines a new issue is raised. Section 1.97 currently provides for consideration of an information disclosure statement filed after allowance but on or before payment of the issue fee, when accompanied by the fee set forth in § 1.17(p) and statement required under § 1.97(e). See § 1.97(d). Office records indicate that in 2012, only 14 CPAs were filed with an information disclosure statement on or after the date of payment of the issue fee. Further, this number corresponds to the larger pool of regular design applications and would be expected to be even less for the smaller pool of international design applications. As with the suggestion to expedite continuations, the Office is hesitant to develop new and complicated procedures at this time to account for a nominal number of potentially affected international design applications, as this may negatively impact administrative efficiency in processing all design applications. The Office intends to reconsider the need for further procedures after the Office gains more experience in processing international design applications and as the number of filings increases.

*Comment 4:* One comment questioned whether the filing of a divisional application of an international design application (or electing not to file a divisional application) will have a “file wrapper estoppel” impact on interpretation of the claim of a patent on the international design application, given the recent Federal Circuit decision in the *Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC*, No. 13–1199 (Fed. Cir. Jan. 8, 2014), holding that

principles of file wrapper estoppel are applicable to design patents.

*Response:* The doctrine of file wrapper estoppel is applied by courts to limit the application of the doctrine of equivalents in determining patent infringement. The doctrine of file wrapper estoppel prohibits a patent owner from recapturing subject matter deliberately surrendered during the course of proceedings in the Office to obtain the patent. Since it is the courts, not the Office, that determine the reach of file wrapper estoppel, the Office cannot predict whether courts will apply file wrapper estoppel where an applicant files a divisional application of an international design application or elects not to file a divisional application. The Office notes, however, that the PLTIA generally provides for parity in treatment between design applications filed under 35 U.S.C. chapter 16 and international design applications designating the United States. *See, e.g.*, 35 U.S.C. 389(d) (“The Director may issue a patent based on an international design application designating the United States, in accordance with the provisions of this title. Such patent shall have the force and effect of a patent issued on an application filed under chapter 16.”).

#### Local Representation

*Comment 5:* Several comments expressed concern that unscrupulous persons not registered to practice before the Office (“non-practitioners”) may utilize the Hague system to procure U.S. design patents and not be subject to the U.S. disciplinary rules set forth in 37 CFR part 11 concerning representation of others before the Office. One comment encouraged the Office to work with the International Bureau to implement procedures for disciplining and sanctioning representatives filing international design applications through the International Bureau. The comment also suggested that even if unscrupulous non-practitioners are subject to the disciplinary rules set forth in 37 CFR part 11 or other judicial discipline or sanction, the effectiveness of appropriate discipline or sanction could be reduced where such non-practitioners are based outside the United States. Accordingly, the comment recommends the promotion of high standards of conduct for practitioners and non-practitioners in all jurisdictions. One comment requested the Office to be mindful of new scams that may arise to exploit the Hague Agreement and to work with the International Bureau and Federal Trade Commission to address strategies for

stopping such scams if and when they arise.

*Response:* The Office appreciates the concerns raised in the comment. The Office notes that a party presenting a paper to the Office, whether a practitioner or non-practitioner, certifies, among other things, that statements made are true and formed after an inquiry reasonable under the circumstances. *See* § 11.18(b). The Office maintains jurisdiction over persons not registered or recognized to practice before the Office who provide or offer to provide any legal services before the Office. *See* § 11.19(a). Such jurisdiction extends to practice that may include presentation to the Office or any of its officers or employees relating to a client’s rights, privileges, duties, or responsibilities under the laws or regulations administered by the Office for the grant of a patent and includes preparing necessary documents in contemplation of filing the documents with the Office, corresponding and communicating with the Office, and representing a client through documents or at interviews, hearings, and meetings, as well as communicating with and advising a client concerning matters pending or contemplated to be presented before the Office. *See* § 11.5(b).

The Office recognizes that the provisions of 37 CFR part 11 may not serve to deter all improper activity or conduct in connection with applications filed under the Hague Agreement. The Office will endeavor to explore with the International Bureau steps that may be taken to address the concerns raised in the comment and to promote high standards of conduct for practitioners and non-practitioners in all jurisdictions.

The Office also notes that it maintains a Scam Prevention page on its Web site ([http://www.uspto.gov/inventors/scam\\_prevention/index.jsp](http://www.uspto.gov/inventors/scam_prevention/index.jsp)), which contains relevant information regarding scam prevention and includes links to the Federal Trade Commission Web site where individuals may find information regarding consumer protection resources. Furthermore, under the American Inventors Protection Act of 1999, the Office does provide, through this Web site, a public forum for the publication of complaints concerning invention promoters/promotion firms. In addition, the Web site identifies known scams concerning non-Office solicitations. Warnings of scam solicitations have also been published by the International Bureau in connection with international applications filed under the Patent Cooperation Treaty. *See, e.g.*, WIPO,

*Warning: Requests for Payment of Fees*, [http://www.wipo.int/pct/en/warning/pct\\_warning.html](http://www.wipo.int/pct/en/warning/pct_warning.html).

*Comment 6:* One comment questioned whether the duty of disclosure under § 1.56 is applicable to non-practitioners and the applicants they represent who obtain U.S. design patents on international design applications through dealings exclusively with the International Bureau.

*Response:* Section 1.56(a) provides that each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability. Section 1.56(c) further provides that individuals associated with the filing or prosecution of a patent application for purposes of § 1.56 are: each inventor named in the application; each attorney or agent who prepares or prosecutes the application; and every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, the applicant, an assignee, or anyone to whom there is an obligation to assign the application.

An international design application designating the United States has the effect of a U.S. patent application and thus is subject to § 1.56. *See* 35 U.S.C. 385 (“An international design application designating the United States shall have the effect, for all purposes, from its filing date determined in accordance with section 384, of an application for patent filed in the Patent and Trademark Office pursuant to chapter 16.”). *See also* 35 U.S.C. 389(b) (“All questions of substance and, unless otherwise required by the treaty and Regulations, procedures regarding an international design application designating the United States shall be determined as in the case of applications filed under chapter 16.”). Thus, pursuant to § 1.56(c), non-practitioners who are substantively involved in the preparation or prosecution of an international design application designating the United States and who are associated with the inventor, the applicant, an assignee, or anyone to whom there is an obligation to assign the application, have a duty of disclosure under § 1.56. The duty under § 1.56 does not apply to applicants *per se*, as an applicant may be a legal entity and thus not an “individual” as required under § 1.56(a), but the duty does apply to inventors (who may be applicants) and to every person who is



substantively involved in the preparation or prosecution of the application and who is associated with the inventor, the applicant, an assignee, or anyone to whom there is an obligation to assign the application. *See also* MPEP 2001.01 (“The word ‘with’ appears before ‘the assignee’ and ‘anyone to whom there is an obligation to assign’ to make clear that the duty applies only to individuals, not to organizations. For instance, the duty of disclosure would not apply to a corporation or institution as such. However, it would apply to individuals within the corporation or institution who were substantively involved in the preparation or prosecution of the application, and actions by such individuals may affect the rights of the corporation or institution.”).

#### Examination

*Comment 7:* One comment suggested that a rule should be added to confirm the Office’s ability to continue to prosecute an international design application after the Office sends a notification of refusal, for example, where new prior art is discovered after the notification of refusal is sent.

*Response:* The Office agrees that prosecution may continue in an international design application after the Office sends a notification of refusal and that the Office may, where appropriate, apply newly discovered prior art to reject the claimed invention in a subsequent Office action. International design applications that designate the United States are required to be examined pursuant to title 35, United States Code. *See* 35 U.S.C. 389(a); § 1.1062(a). Reexamination of the application, if applicant persists in his or her claim for a patent after receiving notice of a rejection, is provided by statute. *See* 35 U.S.C. 132. Further, a patent shall issue only if on examination it appears that the applicant is entitled to a patent under the law. *See* 35 U.S.C. 131. Examination procedures and rules applicable to domestic applications apply to international design applications that designate the United States, except as otherwise provided in the rules or required by the Hague Agreement Articles or Regulations. *See* 35 U.S.C. 389(b); § 1.1061. Thus, for example, any reply under § 1.111 to a notification of refusal rejecting the claimed design will be considered and the application again examined, and the applicant notified in an Office action which, if appropriate, may be made final. *See* §§ 1.112, 1.113. Accordingly, no rule changes are necessary.

*Comment 8:* One comment questioned whether consideration has been given as to whether an improper broadening of the disclosure would result where formal drawings are provided to the Office in compliance with U.S. practice that do not include a portion of the design as shown in a photograph (or other depiction) that was originally filed in the international design application, or show a portion of the photograph content in dotted lines. The comment also asked whether guidelines will be forthcoming.

*Response:* International design applications designating the United States are subject to the same substantive conditions for patentability as regular U.S. applications, including the written description requirement under 35 U.S.C. 112(a). The Office will consider whether an amendment to the specification, drawings, or claim is improper under 35 U.S.C. 112(a) or 132 for reasons of new matter in accordance with the MPEP 1504.04 (“An amendment to the claim which has no antecedent basis in the specification and/or drawings as originally filed introduces new matter because that subject matter is not described in the application as originally filed. The claim must be rejected under 35 U.S.C. 112(a) (or for applications [filed] prior to September 16, 2012, 35 U.S.C. 112, first paragraph). An amendment to the disclosure not affecting the claim (such as environment in the title or in broken lines in the drawings), which has no antecedent basis in the application as originally filed, must be objected to under 35 U.S.C. 132 as lacking support in the application as originally filed and a requirement must be made to cancel the new matter.”). The Office will consider whether a particular design application, including any amended drawings, meets the written description requirements on a case-by-case basis.

The Office recently hosted a roundtable discussion regarding application of the written description requirement to amended or continuation design claims. *See Request for Comments and Notice of Roundtable Event on the Written Description Requirement for Design Applications*, 79 FR 7171 (Feb. 6, 2014). The notice and roundtable sought public input regarding specific instances where an amendment in a design application may raise a question as to whether the applicant had possession of the newly claimed design at the time of filing the original application. The Office will consider the written comments received in response to that notice and roundtable and will evaluate when drafting any further guidance.

*Comment 9:* One comment questioned what operative dates will be used for response times for communications transmitted to the International Bureau for forwarding to the applicant.

*Response:* Communications transmitted by the Office to the International Bureau for forwarding to the applicant will indicate a time period for reply, where a reply to the communication is required by the Office. *See, e.g.,* § 1.1063(a)(4).

*Comment 10:* One comment requested that the Office clarify that the rules applicable to design applications filed under chapter 16 apply to design applications that are converted from international design applications pursuant to § 1.1052.

*Response:* This final rule revises § 1.1052 to include a new paragraph (d) to clarify that an international design application converted under § 1.1052 is subject to the regulations applicable to a design application filed under 35 U.S.C. chapter 16.

*Comment 11:* Several comments requested that the Office clarify that continuing applications, including divisional applications, that claim benefit to an international design application under § 1.78 are subject to the rules governing domestic national applications.

*Response:* A continuing application that claims benefit under § 1.78 to an international design application may be filed as a national application or as an international design application. *See* 35 U.S.C. 386(c). A continuing design application, including a divisional design application, filed under 35 U.S.C. chapter 16 is subject to the rules governing domestic national design applications, *e.g.,* §§ 1.151–1.155. In contrast, a continuing application filed as an international design application is subject to the requirements of the Hague Agreement and the rules applicable to international design applications.

*Comment 12:* One comment requested that the Office notify the applicant of the need to file a certified copy of a foreign priority document required under § 1.55 and the time limit to furnish the certified copy. The comment indicated that many applicants may not have retained U.S. counsel and may be unaware of the requirement to provide the certified copy prior to payment of the issue fee.

*Response:* Where an application includes a priority claim under § 1.55 but the required certified copy of the priority document has not been filed, examination procedures provide for applicant notification that the certified copy has not been filed as required by § 1.55. *See* MPEP 214.03, 1302.06. In

addition, the requirement in former § 1.55(g) for payment of the processing fee set forth in § 1.17(i) where the certified copy is filed after the date the issue fee is paid has been eliminated from § 1.55 in this final rule. Furthermore, § 1.55(g) in this final rule sets forth a petition procedure to permit the filing of the certified copy in a patented design application upon a showing of good and sufficient cause for the delay and petition fee set forth in § 1.17(g). The petition procedure in § 1.55(g) corresponds to the petition procedure under § 1.55(f) applicable to utility applications.

*Comment 13:* One comment requested that a continuing application from an international design application not be subject to the petition requirement under § 1.84(a)(2) to accept color drawings and/or photographs, as the drawings and/or photographs would have already been accepted in the international design application. The comment further requests that the Office consider eliminating the petition requirement under § 1.84(a)(2) altogether.

*Response:* This comment has been adopted as to design applications. Section 1.84(a)(2) has been amended to remove the requirement for a petition in order for the Office to accept color drawings or photographs in design applications. Applicants will still be required to include the reference to the color drawings or photographs in the specification as set forth in § 1.84(a)(2)(iii) to provide notice in the patent of the submission of color drawings or photographs. Because there is rarely a need to file color drawings or photographs in utility applications, and there are operational concerns with permitting color drawings or photographs in utility applications, the Office has not eliminated the petition requirement for color drawings or photographs in utility applications at this time but may reconsider the matter at a later date.

#### *International Fees*

*Comment 14:* Several comments requested that the Office quickly transfer international fees paid through the Office to the International Bureau to minimize the risk of currency fluctuations. One comment further requested that the Office receive same-day confirmation of fees received by WIPO in Swiss currency, indicating a concern that fee deficiency may result in a delayed registration date and, consequently, a delayed filing date in the United States under § 1.1023.

*Response:* The Office intends to transfer international fees to the

International Bureau as quickly as possible. The Office plans to transmit international design application fees once the Office receives the international design application, the applicant has paid the Office the transmittal fee, and the Office has transmitted the international design application to the International Bureau. The Office does not transmit fees directly to the International Bureau in Swiss currency. Rather, such fees are forwarded to the Department of Treasury for transmission to the International Bureau. Accordingly, the Office cannot receive same-day confirmation of fees received by the International Bureau in Swiss currency. Applicants may establish a debit account directly with the International Bureau (*see Response to Comment 15*) and receive confirmation upon electronic payment of fees. Alternatively, applicants may simply wait for the invitation from the International Bureau and pay the international fees directly to the International Bureau. The international registration date is not dependent upon the date of payment of the prescribed fees. *See* Article 10(2); Rule 14(2). Accordingly, the later payment of a fee deficiency will not result in a later international registration date and, consequently, will not affect the filing date in the United States under § 1.1023.

*Comment 15:* One comment requested that applicants be advised as to any options pertaining to a deposit account with WIPO to account for fee discrepancies.

*Response:* Section 1.1031(d)(1) provides for payment of international fees directly to the International Bureau and references Administrative Instruction 801, which sets forth the various methods of payment accepted by the International Bureau, including payment by deposit account established with the International Bureau. In addition, the international design application DM/1 form includes a fee payment section that informs applicants of the option to use a deposit account established with the International Bureau.

*Comment 16:* One comment requested that the Office prompt applicants filing international design applications through the Office with a link to pay fees directly to WIPO to avoid fee discrepancies.

*Response:* The system used by the International Bureau to process international design applications and applicable fees does not currently have the capability to electronically accept fees except where applicants file the application directly with the

International Bureau through its e-filing interface. The Office will endeavor to work with the International Bureau to provide for such functionality in the future.

*Comment 17:* One comment requested that the Office amend § 1.1031 to include a provision that international registration renewal fees are not required to maintain a U.S. design patent in force. In addition, to avoid public confusion and detrimental reliance by giving the impression that a U.S. design patent may have lapsed or expired if the registration is not renewed, the comment requests that the Office encourage the International Bureau to adjust its current Certificate of Renewal and renewal system to reflect U.S. practice.

*Response:* This comment is adopted. The final rule revises § 1.1031 to include a new paragraph (e) to provide that payment of the fees referred to in Article 17 and Rule 24 for renewing an international registration (“renewal fees”) is not required to maintain a U.S. patent issuing on an international design application in force. The Office appreciates the concerns with respect to the current Certificate of Renewal process as it relates to U.S. practice and will endeavor to work with the International Bureau on this matter.

*Comment 18:* One comment suggests that the Office provide a new rule expressly stating that the International Bureau handles international registration renewal fees and that the Office will not process those fees.

*Response:* This comment is adopted. The final rule revises § 1.1031 to include a new paragraph (e) to provide that renewal fees, if required, must be submitted directly to the International Bureau and that any renewal fee submitted to the Office will not be transmitted to the International Bureau. Any renewal fee paid to the Office will be refunded.

#### *Miscellaneous*

*Comment 19:* One comment requested the Office to modify proposed rule § 1.1027 by moving the second sentence concerning the prohibition on deferment of publication to a new rule so that the prohibition is made more prominent. The comment also requested that the Office promptly inform applicants of improper requests for deferment of publication.

*Response:* This final rule revises § 1.1027 as suggested and adds a new rule § 1.1028 (“Deferment of publication”) to make more prominent that a request for deferment of publication is not permitted in an international design application that

designates the United States or other country that does not permit deferment of publication. With regard to review of requests for deferment and notification to applicants of improper requests under the Hague Agreement, the International Bureau performs this function. *See* Article 11(3).

*Comment 20:* One comment requested that the Office consider the option under the Hague Agreement of receiving all deferred international registrations at the time of international registration. The comment suggested that a copy of the international registration may be useful in making a determination as to whether the design is “patented” for purposes of 35 U.S.C. 102(a). The comment also raises as a further consideration the prior art effect of a deferred international registration under 35 U.S.C. 102 (pre-AIA and AIA) and suggests that the international registration may be prior art at the time of publication, and consequently, no advance notice of the deferred international registration would be needed for examination as U.S. design examiners have access to the WIPO Bulletin online for search purposes.

*Response:* Where publication of the international registration has been deferred, the Office cannot receive a copy of the international registration at the time of international registration from the International Bureau. While Article 10(5) allows a designated office to obtain a copy of the international registration immediately after registration, the United States cannot be designated where publication has been deferred. *See* § 1.1028.

Where the United States is designated (and thus there is no deferment of publication), the Office will receive the published international registration approximately six months from the date of international registration, or immediately after international registration where immediate publication was requested. *See* Rule 17(1). At the present time, the Office does not plan to obtain a copy of the international registration from the International Bureau prior to publication pursuant to Article 10(5), as the Office is prohibited from sending a notification of refusal prior to publication of the international registration, thus limiting the usefulness in obtaining a copy of the international registration prior to publication. With regard to use of an unpublished international registration as a “patented” invention for purposes of 35 U.S.C. 102(a), a secret patent is not available as prior art under 35 U.S.C. 102(a) until it is available to the public. *See In re Carlson*, 983 F.2d 1032, 1037

(Fed. Cir. 1992); MPEP 2126; *Examination Guidelines for Implementing the First-Inventor-to-File Provisions of the Leahy-Smith America Invents Act*, 77 FR 43759, 43764 (July 26, 2012) (“The phrase ‘patented’ in AIA 35 U.S.C. 102(a)(1) has the same meaning as ‘patented’ in pre-AIA 35 U.S.C. 102(a) and (b).”).

*Comment 21:* One comment complimented the Office on its road show educational programs in general, and particularly the Forum that was held January 14, 2014, to discuss the proposed rule changes to implement the Hague Agreement. The comment suggested that the Office should have more frequent road shows, education programs, and webinars concerning the Hague Agreement.

*Response:* The Office will endeavor to have additional public outreach concerning implementation of the Hague Agreement.

*Comment 22:* One comment requested that the Office provide a rule that states that no design rights under an international design application that designates the United States exist until a U.S. design patent actually issues from the international design application. The comment asserts that there could be instances where a patent does not issue within the period set forth in Rule 18(c), or a refusal is inadvertently not sent during the refusal period, raising an inconsistency between the lack of issuance of a U.S. design patent and Article 14(2)(a).

*Response:* This final rule adds § 1.1071 to clarify that a grant of protection for an industrial design that is the subject of an international registration shall only arise in the United States through the issuance of a patent pursuant to 35 U.S.C. 389(d) or 171, and in accordance with 35 U.S.C. 153. As explained in the notice of proposed rulemaking (*see* 78 FR 71870, 71886) and in this final rule, the Office does not regard the failure to send a notification of refusal within the period referenced in § 1.1062(b) to confer patent rights or other effect under Article 14(2). The PLTIA provides for enforceable rights upon issuance of a patent. *See* 35 U.S.C. 389(d); 35 U.S.C. 385.

*Comment 23:* Two comments suggested that U.S. law should be amended to provide for publication of design applications filed under 35 U.S.C. chapter 16 and that patent term for design patents should be 20 years from filing rather than 15 years from issuance.

*Response:* As the exclusion from publication of design applications filed under 35 U.S.C. chapter 16 and patent

term are statutory provisions (*see* 35 U.S.C. 122(b)(2)(A)(iv); 35 U.S.C. 173), any changes would require legislation.

### Rulemaking Considerations

*A. Administrative Procedure Act:* This rulemaking implements title I of the PLTIA and the Hague Agreement. The changes in this rulemaking (except for the setting of some fees) establish procedures for the filing, processing, and examination of international design applications and revise existing rules of practice to account for international design applications in accordance with title I of the PLTIA and to ensure that the rules of practice are consistent with the Hague Agreement. In addition, as to the applicability dates for certain provisions in existing rules, this final rule makes those applicability dates more accessible by stating them directly in the body of those rules. Therefore, the changes in this rulemaking involve rules of agency practice and procedure, and/or interpretive rules. *See Bachow Commc'ns, Inc. v. FCC*, 237 F.3d 683, 690 (D.C. Cir. 2001) (Rules governing an application process are procedural under the Administrative Procedure Act.); *Inova Alexandria Hosp. v. Shalala*, 244 F.3d 342, 350 (4th Cir. 2001) (Rules for handling appeals are procedural where they do not change the substantive standard for reviewing claims.); *Nat'l Org. of Veterans' Advocates v. Sec'y of Veterans Affairs*, 260 F.3d 1365, 1375 (Fed. Cir. 2001) (Rule that clarifies interpretation of a statute is interpretive.).

Accordingly, prior notice and opportunity for public comment for these changes are not required pursuant to 5 U.S.C. 553(b) or (c) (or any other law). *See Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1336–37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), does not require notice and comment rulemaking for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice” (quoting 5 U.S.C. 553(b)(A))). The Office, however, published the proposed changes for comment because it sought the benefit of the public's views on the Office's implementation of title I of the PLTIA and the Hague Agreement.

*B. Regulatory Flexibility Act:* This final rule revises the rules of practice to implement title I of the PLTIA. The changes to the rules of practice in this final rule involve: (1) The establishment of procedures for the filing, processing, and examination of international design applications; and (2) the revision of existing rules of practice to account for international design applications. In

addition, as to the applicability dates for certain provisions in existing rules, this final rule makes those applicability dates more accessible by stating them directly in the body of those rules. The final rules impose no additional required burdens on any applicant, since seeking design protection by filing an international design application is merely an optional alternative to seeking design protection by filing a national design application. The final rules will benefit applicants by streamlining the process for obtaining international protection of an industrial design in Contracting Parties to the Hague Agreement by the filing of a single, standardized international design application in a single language.

As of 2014, there are over 60 Contracting Parties that are members to the Hague system. In 2013, the most recent year available, 2,990 international design applications were filed via the Hague system. In that same year, 2,734 international design registrations issued through the Hague system. In comparison, in fiscal year 2013, the USPTO received 35,077 design applications and issued 22,453 design patents. Approximately 50% of the design applications filed in 2013 were filed by an entity claiming small entity status. None of the final rules disproportionately affect small entities.

The fees and requirements referenced in this final rulemaking do not have a significant economic impact because they are comparable to the fees and requirements an applicant has in a national design application. Section 385 requires that an "international design application designating the United States shall have the effect, for all purposes from its filing date . . . of an application for patent filed in the Patent and Trademark Office pursuant to chapter 16." Such fees include an issue fee, if applicable, paid directly to the USPTO, and a petition fee for review of a filing date.

The USPTO sets only two new fees based on cost recovery: (i) A transmittal fee, payable to the USPTO for transmitting the international design application to WIPO when an applicant files the application through the USPTO as an office of indirect filing, and (ii) a petition fee when an applicant seeks to have the Office convert an international design application to a national design application under 35 U.S.C. chapter 16. The transmittal fee is set at \$120. The USPTO estimates that approximately 1,000 applications designating the United States will be filed annually either through the USPTO as an office of indirect filing or with WIPO. The USPTO estimates that 900 of these

applications will be filed through the USPTO as an office of indirect filing and will require payment of a transmittal fee. Of these, the Office estimates that approximately 450 will be filed by an entity that is a small entity based on USPTO design application filings in 2013. The petition fee is set at \$180. The USPTO estimates that approximately 20 applicants will pay the petition fee annually, and of these, approximately 10 will be filed by an applicant that is a small entity.

The other fees mentioned in this final rulemaking are not USPTO fees at all, but rather, are created through the treaty process and WIPO's Common Regulations. For example, the USPTO does not collect and retain at the time of payment the following fees: WIPO Basic Fee, WIPO Publication Fee, WIPO Extra Word Fee, and Designation Fees (including the United States individual designation fee first part). Thus, the final rules referencing non-USPTO fees impose no economic impact upon applicants. The petition fee for excusable delay is set forth by statute, 35 U.S.C. 41(a)(7), as amended by 202(b)(1)(A) of the PLTIA, 126 Stat. 1535, at \$850 for small entities and \$1,700 for all other entities, beginning on December 18, 2013.

Finally, it is noted that the Office published a certification under the Regulatory Flexibility Act in the notice of proposed rulemaking. See 78 FR 71870, 71888–89 (Nov. 29, 2013). The Office received no public comments concerning the certification under the Regulatory Flexibility Act. For the reasons set forth herein, the Deputy General Counsel for General Law of the United States Patent and Trademark Office has certified to the Chief Counsel for Advocacy of the Small Business Administration that changes in this final rule will not have a significant economic impact on a substantial number of small entities. See 5 U.S.C. 605(b).

*C. Executive Order 12866 (Regulatory Planning and Review):* This final rule has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

*D. Executive Order 13563 (Improving Regulation and Regulatory Review):* The Office has complied with Executive Order 13563. Specifically, the Office has, to the extent feasible and applicable: (1) Made a reasoned determination that the benefits justify the costs of the rule; (2) tailored the rule to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5)

identified and assessed available alternatives; (6) involved the public in an open exchange of information and perspectives among experts in relevant disciplines, affected stakeholders in the private sector, and the public as a whole, and provided on-line access to the rulemaking docket; (7) attempted to promote coordination, simplification, and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes.

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

*F. Executive Order 13175 (Tribal Consultation):* This rulemaking will not: (1) Have substantial direct effects on one or more Indian tribes; (2) impose substantial direct compliance costs on Indian tribal governments; or (3) preempt tribal law. Therefore, a tribal summary impact statement is not required under Executive Order 13175 (Nov. 6, 2000).

*G. Executive Order 13211 (Energy Effects):* This rulemaking is not a significant energy action under Executive Order 13211 because this rulemaking is not likely to have a significant adverse effect on the supply, distribution, or use of energy. Therefore, a Statement of Energy Effects is not required under Executive Order 13211 (May 18, 2001).

*H. Executive Order 12988 (Civil Justice Reform):* This rulemaking meets applicable standards to minimize litigation, eliminate ambiguity, and reduce burden as set forth in sections 3(a) and 3(b)(2) of Executive Order 12988 (Feb. 5, 1996).

*I. Executive Order 13045 (Protection of Children):* This rulemaking does not concern an environmental risk to health or safety that may disproportionately affect children under Executive Order 13045 (Apr. 21, 1997).

*J. Executive Order 12630 (Taking of Private Property):* This rulemaking will not effect a taking of private property or otherwise have taking implications under Executive Order 12630 (Mar. 15, 1988).

*K. Congressional Review Act:* Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 *et seq.*), prior to

issuing any final rule, the United States Patent and Trademark Office will submit a report containing the final rule and other required information to the United States Senate, the United States House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this document are not expected to result in an annual effect on the economy of 100 million dollars or more, a major increase in costs or prices, or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of United States-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this document is not expected to result in a "major rule" as defined in 5 U.S.C. 804(2).

*L. Unfunded Mandates Reform Act of 1995:* The changes set forth in this document do not involve a Federal intergovernmental mandate that will result in the expenditure by State, local, and tribal governments, in the aggregate, of 100 million dollars (as adjusted) or more in any one year, or a Federal private sector mandate that will result in the expenditure by the private sector of 100 million dollars (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no actions are necessary under the provisions of the Unfunded Mandates Reform Act of 1995. See 2 U.S.C. 1501 *et seq.*

*M. National Environmental Policy Act:* This rulemaking will not have any effect on the quality of the environment and is thus categorically excluded from review under the National Environmental Policy Act of 1969. See 42 U.S.C. 4321 *et seq.*

*N. National Technology Transfer and Advancement Act:* The requirements of section 12(d) of the National Technology Transfer and Advancement Act of 1995 (15 U.S.C. 272 note) are not applicable because this rulemaking does not contain provisions that involve the use of technical standards.

*O. Paperwork Reduction Act:* The Paperwork Reduction Act of 1995 (PRA) (44 U.S.C. 3501 *et seq.*) requires that the Office consider the impact of paperwork and other information collection burdens imposed on the public. This rulemaking involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the PRA. The collection of information involved in this final rule has been submitted as a new information collection under OMB control number 0651-0075 ("International Design Applications (Hague Agreement)"). The

collection will be available at the OMB's Information Collection Review Web site ([www.reginfo.gov/public/do/PRAMain](http://www.reginfo.gov/public/do/PRAMain)).

The Office is submitting this information collection to OMB for its review and approval because this notice of final rulemaking will add the following collections of information for an international design application filed through the Office or filed with the International Bureau and designating the United States as a Contracting Party in which the applicant would like protection:

- (1) Application for International Registration (§ 1.1022)
- (2) Claim and Reproductions (§ 1.1021)
- (3) Transmittal Letter (§§ 1.4, 1.5)
- (4) Appointment of a Representative (§ 1.1041)
- (5) Petition to Excuse a Failure to Comply with a Time Limit (§ 1.1051)
- (6) Petition to Convert to a Design Application under 35 U.S.C. chapter 16 (§ 1.1052)
- (7) Petition to Review a Filing Date (§ 1.1023(b))
- (8) Fee Authorization (§ 1.25)
- (9) Petition to the Commissioner (§§ 1.181, 1.182, and 1.183)
- (10) Transmittal of Issue Fee to USPTO for an International Design Application (§ 1.311)
- (11) Declaration of Inventorship for Purposes of Designation of the United States (§ 1.63)
- (12) Substitute Statement in Lieu of a Declaration of Inventorship for the Purpose of Designating the United States (§ 1.64)
- (13) Assignment Cover Sheet (§§ 3.11, 3.21, 3.24, 3.26, 3.28, 3.31, 3.34, and 3.41)

## I. Summary

This final rule will collect information necessary to process and examine international design applications pursuant to the Hague Agreement and the PLTIA. The Hague Agreement facilitates intellectual property protection for industrial designs through a single standardized application filed directly with the International Bureau of WIPO or indirectly through an appropriate Contracting Party's Office, such as the USPTO. The Hague Agreement is administered by the International Bureau of WIPO located in Geneva, Switzerland.

When an applicant files an international design application pursuant to this rulemaking, the International Bureau ascertains whether the international design application complies with the requirements of the treaty, records the international design

application in the international register, and publishes the international registration in the International Designs Bulletin. The International Bureau then provides a copy of the publication of the international registration to each Contracting Party designated by the applicant, and thus will provide a copy to the USPTO when the United States is designated by the applicant. When the USPTO receives the international registration from the International Bureau, the USPTO will perform the substantive examination of the international design application in the same manner that it examines a domestic design application filed under 35 U.S.C. chapter 16.

Because the new application procedure for international design applications created through this final rule merely provides applicants with a new avenue by which they may file a design application, several items in this collection displace responses that the USPTO counts in other information collections, specifically Information Collections 0651-0032 (Initial Patent Applications), 0651-0043 (Patent and Trademark Financial Transactions), and 0651-0072 (America Invents Act Section 10 Patent Fee Adjustments). As such, the USPTO will temporarily double count those responses in both this collection and their original collections. The USPTO will update the burden inventories of the existing information collections to correct the double counting with the appropriate adjustments to the number of responses.

## II. Data

*Needs and Uses:* This information collection is necessary for design applicants to file an international design application under the Hague Agreement. An applicant may file through the Office as an office of indirect filing pursuant 35 U.S.C. 382, or with the International Bureau directly. In either case, the applicant will designate the Contracting Party(ies) in which the applicant desires protection for the industrial design(s). The Office uses this information to process international design applications designating the United States and filed under the Hague Agreement.

*Title of Collection:* International Design Applications (Hague Agreement).

*OMB Control Number:* 0651-0075.

*Form Number(s):* WIPO DM/1. WIPO is in the process of creating forms for three items covered by this collection of information (declaration of inventorship, substitute statement in lieu of declaration, and assignment cover sheet). Once the USPTO receives

copies of these forms, the Office will provide those forms to OMB for review.

*Type of Review:* New Collection.

*Method of Collection:* By mail, hand delivery, or electronically to the Office.

*Affected Public:* Individuals or households, businesses or other for-profits, not-for-profit institutions, farms, Federal Government, and state, local or tribal governments.

*Estimated Number of Respondents:* 4935 per year.

*Estimated Time per Response:* The Office estimates that the responses in this collection will take the public approximately 15 minutes (0.25 hours) to 6 hours.

*Estimated Total Annual Respondent Burden Hours:* 13,128 hours per year.

*Estimated Total Annual (Hour)*

*Respondent Cost Burden:* \$4,987,992 per year.

*Estimated Total Annual (Non-hour) Respondent Cost Burden:* \$2,740,011 per year. Of the non-hour costs added by this burden, \$2,739,350 are filing fees and \$661 are postage fees. Of the \$2,739,350 filing fees, \$2,130,270 are fees new to this rulemaking, whereas \$609,080 are fees that the USPTO currently counts in other information collections and which the USPTO temporarily double-counts in this collection until it can update its existing collections.

### III. Solicitation

The Office solicited comments to (1) Evaluate whether the proposed information requirement is necessary for the proper performance of the functions of the Office, including whether the information will have practical utility; (2) evaluate the accuracy of the Office's estimate of the burden; (3) enhance the quality, utility, and clarity of the information to be collected; and (4) minimize the burden of collecting the information on those who are to respond, including by using appropriate automated, electronic, mechanical, or other technological collection techniques or other forms of information technology.

The Office received no comments from the members of the public regarding the PRA.

### List of Subjects

#### 37 CFR Part 1

Administrative practice and procedure, Inventions and patents, Reporting and recordkeeping requirements, Small businesses.

#### 37 CFR Part 3

Administrative practice and procedure, Patents, Trademarks.

#### 37 CFR Part 5

Classified information, Foreign relations, Inventions and patents.

#### 37 CFR Part 11

Administrative practice and procedure, Inventions and patents, Lawyers, Reporting and recordkeeping requirements.

#### 37 CFR Part 41

Administrative practice and procedure, Inventions and patents, Lawyers.

For the reasons set forth in the preamble, 37 CFR parts 1, 3, 5, 11, and 41 are 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 1.4 is amended by revising paragraph (a)(2) to read as follows:

#### § 1.4 Nature of correspondence and signature requirements.

(a) \* \* \*

(2) *Correspondence in and relating to a particular application or other proceeding in the Office.* See particularly the rules relating to the filing, processing, or other proceedings of national applications in subpart B of this part; of international applications in subpart C of this part; of *ex parte* reexaminations of patents in subpart D of this part; of supplemental examination of patents in subpart E of this part; of extension of patent term in subpart F of this part; of *inter partes* reexaminations of patents in subpart H of this part; of international design applications in subpart I of this part; and of the Patent Trial and Appeal Board in parts 41 and 42 of this chapter.

\* \* \* \* \*

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

#### § 1.5 Identification of patent, patent application, or patent-related proceeding.

(a) No correspondence relating to an application should be filed prior to receipt of the assigned application number (*i.e.*, U.S. application number, international application number, or international registration number as appropriate). When correspondence directed to the Patent and Trademark Office concerns a previously filed application for a patent, it must identify on the top page in a conspicuous location, the application number (consisting of the series code and the

serial number; *e.g.*, 07/123,456), or the serial number and filing date assigned to that application by the Patent and Trademark Office, or the international application number of the international application, or the international registration number of an international design application. Any correspondence not containing such identification will be returned to the sender where a return address is available. The returned correspondence will be accompanied with a cover letter, which will indicate to the sender that if the returned correspondence is resubmitted to the Patent and Trademark Office within two weeks of the mail date on the cover letter, the original date of receipt of the correspondence will be considered by the Patent and Trademark Office as the date of receipt of the correspondence. Applicants may use either the Certificate of Mailing or Transmission procedure under § 1.8 or the Priority Mail Express® procedure under § 1.10 for resubmissions of returned correspondence if they desire to have the benefit of the date of deposit in the United States Postal Service. If the returned correspondence is not resubmitted within the two-week period, the date of receipt of the resubmission will be considered to be the date of receipt of the correspondence. The two-week period to resubmit the returned correspondence will not be extended. In addition to the application number, all correspondence directed to the Patent and Trademark Office concerning applications for patent should also state the name of the first listed inventor, the title of the invention, the date of filing the same, and if known, the group art unit or other unit within the Patent and Trademark Office responsible for considering the correspondence and the name of the examiner or other person to which it has been assigned.

\* \* \* \* \*

■ 4. Section 1.6 is amended by revising paragraphs (d)(3), (4), and (6) to read as follows:

#### § 1.6 Receipt of correspondence.

\* \* \* \* \*

(d) \* \* \*

(3) Correspondence that cannot receive the benefit of the certificate of mailing or transmission as specified in § 1.8(a)(2)(i)(A) through (D), (F), (I), and (K) and § 1.8(a)(2)(iii)(A), except that a continued prosecution application under § 1.53(d) may be transmitted to the Office by facsimile;

(4) Color drawings submitted under §§ 1.81, 1.83 through 1.85, 1.152, 1.165, 1.173, 1.437, or 1.1026;

\* \* \* \* \*

(6) Correspondence to be filed in an application subject to a secrecy order under §§ 5.1 through 5.5 of this chapter and directly related to the secrecy order content of the application;

\* \* \* \* \*

■ 5. Section 1.8 is amended by revising paragraphs (a)(2)(i)(I) and (J) and adding paragraph (a)(2)(i)(K) to read as follows:

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

(a) \* \* \*

(2) \* \* \*

(i) \* \* \*

(I) The filing of a third-party submission under § 1.290;

(J) The calculation of any period of adjustment, as specified in § 1.703(f); and

(K) The filing of an international design application.

\* \* \* \* \*

■ 6. Section 1.9 is amended by revising paragraphs (a)(1) and (3) and adding paragraphs (l), (m), and (n) to read as follows:

#### **§ 1.9 Definitions.**

(a)(1) A national application as used in this chapter means either a U.S. application for patent which was filed in the Office under 35 U.S.C. 111, an international application filed under the Patent Cooperation Treaty in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid, or an international design application filed under the Hague Agreement in which the Office has received a copy of the international registration pursuant to Hague Agreement Article 10.

\* \* \* \* \*

(3) A nonprovisional application as used in this chapter means either a U.S. national application for patent which was filed in the Office under 35 U.S.C. 111(a), an international application filed under the Patent Cooperation Treaty in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid, or an international design application filed under the Hague Agreement in which the Office has received a copy of the international registration pursuant to Hague Agreement Article 10.

\* \* \* \* \*

(l) Hague Agreement as used in this chapter means the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs adopted at Geneva, Switzerland, on July 2, 1999, and Hague Agreement Article as used in this

chapter means an Article under the Hague Agreement.

(m) Hague Agreement Regulations as used in this chapter means the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement, and Hague Agreement Rule as used in this chapter means one of the Hague Agreement Regulations.

(n) An international design application as used in this chapter means an application for international registration of a design filed under the Hague Agreement. Unless otherwise clear from the wording, reference to “design application” or “application for a design patent” in this chapter includes an international design application that designates the United States.

■ 7. Section 1.14 is amended by revising the introductory text of paragraph (a)(1), revising paragraphs (a)(1)(ii) through (vii) and (a)(2)(iv), and adding paragraph (j) to read as follows:

#### **§ 1.14 Patent applications preserved in confidence.**

(a) \* \* \*

(1) Records associated with patent applications (see paragraph (g) of this section for international applications and paragraph (j) of this section for international design applications) may be available in the following situations:

\* \* \* \* \*

(ii) *Published abandoned applications.* The file of an abandoned published application is available to the public as set forth in § 1.11(a). A copy of the application-as-filed, the file contents of the published application, or a specific document in the file of the published application may be provided to any person upon request and payment of the appropriate fee set forth in § 1.19(b).

(iii) *Published pending applications.* A copy of the application-as-filed, the file contents of the application, or a specific document in the file of a pending published application may be provided to any person upon request and payment of the appropriate fee set forth in § 1.19(b). 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. The Office will not provide access to the paper file of a pending application that has been published, except as provided in paragraph (c) or (i) of this section.

(iv) *Unpublished abandoned applications (including provisional applications) that are identified or relied upon.* The file contents of an unpublished, abandoned application may be made available to the public if the application is identified in a U.S.

patent, a statutory invention registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States. An application is considered to have been identified in a document, such as a patent, when the application number or serial number and filing date, first named inventor, title, and filing date or other application specific information are provided in the text of the patent, but not when the same identification is made in a paper in the file contents of the patent and is not included in the printed patent. Also, the file contents may be made available to the public, upon a written request, if benefit of the abandoned application is claimed under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) in an application that has issued as a U.S. patent, or has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3). A copy of the application-as-filed, the file contents of the application, or a specific document in the file of the application may be provided to any person upon written request and payment of the appropriate fee (§ 1.19(b)).

(v) *Unpublished pending applications (including provisional applications) whose benefit is claimed.* A copy of the file contents of an unpublished pending application may be provided to any person, upon written request and payment of the appropriate fee (§ 1.19(b)), if the benefit of the application is claimed under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) in an application that has issued as a U.S. patent, or in an application that has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3). A copy of the application-as-filed or a specific document in the file of the pending application may also be provided to any person upon written request and payment of the appropriate fee (§ 1.19(b)). The Office will not provide access to the paper file of a pending application, except as provided in paragraph (c) or (i) of this section.



(vi) *Unpublished pending applications (including provisional applications) that are incorporated by reference or otherwise identified.* A copy of the application as originally filed of an unpublished pending application may be provided to any person, upon written request and payment of the appropriate fee (§ 1.19(b)), if the application is incorporated by reference or otherwise identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States. The Office will not provide access to the paper file of a pending application, except as provided in paragraph (c) or (i) of this section.

(vii) *When a petition for access or a power to inspect is required.* Applications that were not published or patented, that are not the subject of a benefit claim under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) in an application that has issued as a U.S. patent, an application that has published as a statutory invention registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3), or are not identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, an international publication of an international application under PCT Article 21(2), or a publication of an international registration under Hague Agreement Article 10(3) of an international design application designating the United States, are not available to the public. If an application is identified in the file contents of another application, but not the published patent application or patent itself, a granted petition for access (see paragraph (c) of this section) is necessary to obtain the application, or a copy of the application.

(2) \* \* \*

(iv) Whether another application claims the benefit of the application (*i.e.*, whether there are any applications that claim the benefit of the filing date under 35 U.S.C. 119(e), 120, 121, 365, or 386 of the application), and if there are any such applications, the numerical identifier of the application, the specified relationship between the applications (*e.g.*, continuation),

whether the application is pending, abandoned or patented, and whether the application has been published under 35 U.S.C. 122(b).

\* \* \* \* \*

(j) *International design applications.*

(1) With respect to an international design application maintained by the Office in its capacity as a designated office (§ 1.1003) for national processing, the records associated with the international design application may be made available as provided under paragraphs (a) through (i) of this section.

(2) With respect to an international design application maintained by the Office in its capacity as an office of indirect filing (§ 1.1002), the records of the international design application may be made available under paragraph (j)(1) of this section where contained in the file of the international design application maintained by the Office for national processing. Also, if benefit of the international design application is claimed under 35 U.S.C. 386(c) in a U.S. patent or published application, the file contents of the application may be made available to the public, or the file contents of the application, a copy of the application-as-filed, or a specific document in the file of the application may be provided to any person upon written request and payment of the appropriate fee (§ 1.19(b)).

■ 8. Section 1.16 is amended by revising the introductory text of paragraphs (b), (l), and (p) to read as follows:

**§ 1.16 National application filing, search, and examination fees.**

\* \* \* \* \*

(b) Basic fee for filing each application under 35 U.S.C. 111 for an original design patent:

\* \* \* \* \*

(l) Search fee for each application under 35 U.S.C. 111 for an original design patent:

\* \* \* \* \*

(p) Examination fee for each application under 35 U.S.C. 111 for an original design patent:

\* \* \* \* \*

■ 9. Section 1.17 is amended by revising paragraphs (f), (g), (i)(1), and (m) and adding paragraph (t) to read as follows:

**§ 1.17 Patent application and reexamination processing fees.**

\* \* \* \* \*

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

By a micro entity (§ 1.29) .....	\$100.00
By a small entity (§ 1.27(a)) .....	200.00
By other than a small or micro entity .....	400.00

§ 1.36(a)—for revocation of a power of attorney by fewer than all of the applicants.

§ 1.53(e)—to accord a filing date.

§ 1.182—for decision on a question not specifically provided for in an application for patent.

§ 1.183—to suspend the rules in an application for patent.

§ 1.741(b)—to accord a filing date to an application under § 1.740 for extension of a patent term.

§ 1.1023—to review the filing date of an international design application.

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

By a micro entity (§ 1.29) .....	\$50.00
By a small entity (§ 1.27(a)) .....	100.00
By other than a small or micro entity .....	200.00

§ 1.12—for access to an assignment record.

§ 1.14—for access to an application.

§ 1.46—for filing an application on behalf of an inventor by a person who otherwise shows sufficient proprietary interest in the matter.

§ 1.55(f)—for filing a belated certified copy of a foreign application.

§ 1.55(g)—for filing a belated certified copy of a foreign application.

§ 1.57(a)—for filing a belated certified copy of a foreign application.

§ 1.59—for expungement of information.

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

§ 1.136(b)—for review of a request for extension of time when the provisions of § 1.136(a) are not available.

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

§ 1.550(c)—for patent owner requests for extension of time in *ex parte* reexamination proceedings.

§ 1.956—for patent owner requests for extension of time in *inter partes* reexamination proceedings.

§ 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 fees.* (1) For taking action under one of the following sections which refers to this paragraph:

By a micro entity (§ 1.29) .....	\$35.00
By a small entity (§ 1.27(a)) .....	70.00
By other than a small or micro entity .....	140.00

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

§ 1.29(k)(3)—for processing a non-itemized fee deficiency based on an error in micro entity status.

§ 1.41(b)—for supplying the name or names of the inventor or joint inventors in an application without either an application data sheet or the inventor's oath or declaration, 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.

§ 1.53(c)(3)—to convert a provisional application filed under § 1.53(c) into a nonprovisional application under § 1.53(b).

§ 1.71(g)(2)—for processing a belated amendment under § 1.71(g).

§ 1.102(e)—for requesting prioritized examination of an application.

§ 1.103(b)—for requesting limited suspension of action, continued prosecution application for a design patent (§ 1.53(d)).

§ 1.103(c)—for requesting limited suspension of action, request for continued examination (§ 1.114).

§ 1.103(d)—for requesting deferred examination of an application.

§ 1.291(c)(5)—for processing a second or subsequent protest by the same real party in interest.

§ 3.81—for a patent to issue to assignee, assignment submitted after payment of the issue fee.

(m) For filing a petition for the revival of an abandoned application for a patent, for the delayed payment of the fee for issuing each patent, for the delayed response by the patent owner in any reexamination proceeding, for the delayed payment of the fee for maintaining a patent in force, for the delayed submission of a priority or benefit claim, for the extension of the twelve-month (six-month for designs) period for filing a subsequent application (§§ 1.55(c), 1.55(e), 1.78(b), 1.78(c), 1.78(e), 1.137, 1.378, and 1.452), or for filing a petition to excuse applicant's failure to act within prescribed time limits in an international design application (§ 1.1051):

By a small entity (§ 1.27(a)) or micro entity (§ 1.29) .....	\$850.00
By other than a small or micro entity .....	1,700.00

\* \* \* \* \*

(t) For filing a petition to convert an international design application to a design application under 35 U.S.C. chapter 16 (§ 1.1052): \$180.00.

■ 10. Section 1.18 is amended by adding paragraph (b)(3) to read as follows:

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

\* \* \* \* \*

(b) \* \* \*

(3) For an international design application designating the United States, where an issue fee is paid through the International Bureau (Hague Agreement Rule 12(3)(c)) as an alternative to paying the issue fee under paragraph (b)(1) of this section: The amount specified on the Web site of the World Intellectual Property Organization, currently available at <http://www.wipo.int/hague>, at the time the fee is paid.

\* \* \* \* \*

■ 11. Section 1.25 is amended by revising paragraph (b) to read as follows:

**§ 1.25 Deposit accounts.**

\* \* \* \* \*

(b) Filing, issue, appeal, international-type search report, international application processing, international design application fees, petition, and post-issuance fees may be charged against these accounts if sufficient funds are on deposit to cover such fees. A general authorization to charge all fees, or only certain fees, set forth in §§ 1.16 through 1.18 to a deposit account containing sufficient funds may be filed in an individual application, either for the entire pendency of the application or with a particular paper filed. A general authorization to charge fees in an international design application set forth in § 1.1031 will only be effective for the transmittal fee (§ 1.1031(a)). An authorization to charge fees under § 1.16 in an international application entering the national stage under 35 U.S.C. 371 will be treated as an authorization to charge fees under § 1.492. An authorization to charge fees set forth in § 1.18 to a deposit account is subject to the provisions of § 1.311(b). An authorization to charge to a deposit account the fee for a request for reexamination pursuant to § 1.510 or 1.913 and any other fees required in a reexamination proceeding in a patent may also be filed with the request for reexamination, and an authorization to charge to a deposit account the fee for a request for supplemental examination pursuant to § 1.610 and any other fees required in a supplemental examination proceeding in a patent may also be filed with the request for supplemental examination. An authorization to charge a fee to a deposit account will not be considered payment of the fee on the date the authorization to charge the fee

is effective unless sufficient funds are present in the account to cover the fee.

\* \* \* \* \*

■ 12. Section 1.27 is amended by revising paragraph (c)(3) introductory text to read as follows:

**§ 1.27 Definition of small entities and establishing status as a small entity to permit payment of small entity fees; when a determination of entitlement to small entity status and notification of loss of entitlement to small entity status are required; fraud on the Office.**

\* \* \* \* \*

(c) \* \* \*

(3) *Assertion by payment of the small entity basic filing, basic transmittal, basic national fee, international search fee, or individual designation fee in an international design application.* The payment, by any party, of the exact amount of one of the small entity basic filing fees set forth in § 1.16(a), (b), (c), (d), or (e), the small entity transmittal fee set forth in § 1.445(a)(1), the small entity international search fee set forth in § 1.445(a)(2) to a Receiving Office other than the United States Receiving Office in the exact amount established for that Receiving Office pursuant to PCT Rule 16, or the small entity basic national fee set forth in § 1.492(a), will be treated as a written assertion of entitlement to small entity status even if the type of basic filing, basic transmittal, or basic national fee is inadvertently selected in error. The payment, by any party, of the small entity first part of the individual designation fee for the United States to the International Bureau (§ 1.1031) will be treated as a written assertion of entitlement to small entity status.

\* \* \* \* \*

■ 13. Section 1.29 is amended by revising paragraph (e) to read as follows:

**§ 1.29 Micro entity status.**

\* \* \* \* \*

(e) Micro entity status is established in an application by filing a micro entity certification in writing complying with the requirements of either paragraph (a) or (d) of this section and signed either in compliance with § 1.33(b), in an international application filed in a Receiving Office other than the United States Receiving Office by a person authorized to represent the applicant under § 1.455, or in an international design application by a person authorized to represent the applicant under § 1.1041 before the International Bureau where the micro entity certification is filed with the International Bureau. Status as a micro entity must be specifically established in each related, continuing and reissue

application in which status is appropriate and desired. Status as a micro entity in one application or patent does not affect the status of any other application or patent, regardless of the relationship of the applications or patents. The refiling of an application under § 1.53 as a continuation, divisional, or continuation-in-part application (including a continued prosecution application under § 1.53(d)), or the filing of a reissue application, requires a new certification of entitlement to micro entity status for the continuing or reissue application.

■ 14. Section 1.32 is amended by revising paragraph (d) introductory text to read as follows:

**§ 1.32 Power of attorney.**

(d) A power of attorney from a prior national application for which benefit is claimed under 35 U.S.C. 120, 121, 365(c), or 386(c) in a continuing application may have effect in the continuing application if a copy of the power of attorney from the prior application is filed in the continuing application unless:

■ 15. Section 1.41 is amended by adding paragraph (f) to read as follows:

**§ 1.41 Inventorship.**

(f) The inventorship of an international design application designating the United States is the creator or creators set forth in the publication of the international registration under Hague Agreement Article 10(3). Any correction of inventorship must be pursuant to § 1.48.

■ 16. Section 1.46 is amended by revising paragraph (b) introductory text and paragraph (c) to read as follows:

**§ 1.46 Application for patent by an assignee, obligated assignee, or a person who otherwise shows sufficient proprietary interest in the matter.**

(b) If an application under 35 U.S.C. 111 is made by a person other than the inventor under paragraph (a) of this section, the application must contain an application data sheet under § 1.76 specifying in the applicant information section (§ 1.76(b)(7)) the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter. If an application entering the national stage under 35 U.S.C. 371, or a nonprovisional international design application, is applied for by a person

other than the inventor under paragraph (a) of this section, the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter must have been identified as the applicant for the United States in the international stage of the international application or as the applicant in the publication of the international registration under Hague Agreement Article 10(3).

(c)(1) *Correction or update in the name of the applicant.* Any request to correct or update the name of the applicant under this section must include an application data sheet under § 1.76 specifying the correct or updated name of the applicant in the applicant information section (§ 1.76(b)(7)) in accordance with § 1.76(c)(2). A change in the name of the applicant recorded pursuant to Hague Agreement Article 16(1)(ii) will be effective to change the name of the applicant in a nonprovisional international design application.

(2) *Change in the applicant.* Any request to change the applicant under this section after an original applicant has been specified must include an application data sheet under § 1.76 specifying the applicant in the applicant information section (§ 1.76(b)(7)) in accordance with § 1.76(c)(2) and comply with §§ 3.71 and 3.73 of this title.

■ 17. Section 1.53 is amended by revising paragraph (b) introductory text and paragraphs (c)(4) and (d)(1)(ii) to read as follows:

**§ 1.53 Application number, filing date, and completion of application.**

(b) *Application filing requirements—Nonprovisional application.* The filing date of an application for patent filed under this section, other than an application for a design patent or a provisional application under paragraph (c) of this section, is the date on which a specification, with or without claims, is received in the Office. The filing date of an application for a design patent filed under this section, except for a continued prosecution application under paragraph (d) of this section, is the date on which the specification as prescribed by 35 U.S.C. 112, including at least one claim, and any required drawings are received in the Office. No new matter may be introduced into an application after its filing date. A continuing application, which may be a continuation, divisional, or continuation-in-part application, may be filed under the conditions specified in

35 U.S.C. 120, 121, 365(c), or 386(c) and § 1.78.

(c) \* \* \*  
(4) A provisional application is not entitled to the right of priority under 35 U.S.C. 119, 365(a), or 386(a) or § 1.55, or to the benefit of an earlier filing date under 35 U.S.C. 120, 121, 365(c), or 386(c) or § 1.78 of any other application. No claim for priority under 35 U.S.C. 119(e) or § 1.78(a) may be made in a design application based on a provisional application. The requirements of §§ 1.821 through 1.825 regarding application disclosures containing nucleotide and/or amino acid sequences are not mandatory for provisional applications.

(d) \* \* \*

(1) \* \* \*

(ii) The prior nonprovisional application is a design application, but not an international design application, that is complete as defined by § 1.51(b), except for the inventor's oath or declaration if the application is filed on or after September 16, 2012, and the prior nonprovisional application contains an application data sheet meeting the conditions specified in § 1.53(f)(3)(i); and

■ 18. Section 1.55 is revised to read as follows:

**§ 1.55 Claim for foreign priority.**

(a) *In general.* An applicant in a nonprovisional application may claim priority to one or more prior foreign applications under the conditions specified in 35 U.S.C. 119(a) through (d) and (f), 172, 365(a) and (b), and 386(a) and (b) and this section.

(b) *Time for filing subsequent application.* The nonprovisional application must be:

(1) Filed not later than twelve months (six months in the case of a design application) after the date on which the foreign application was filed, subject to paragraph (c) of this section (a subsequent application); or

(2) Entitled to claim the benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) of a subsequent application that was filed within the period set forth in paragraph (b)(1) of this section.

(c) *Delayed filing of subsequent application.* If the subsequent application has a filing date which is after the expiration of the period set forth in paragraph (b)(1) of this section, but within two months from the expiration of the period set forth in paragraph (b)(1) of this section, the right of priority in the subsequent application may be restored under PCT Rule 26bis.3

for an international application, or upon petition pursuant to this paragraph, if the delay in filing the subsequent application within the period set forth in paragraph (b)(1) of this section was unintentional. A petition to restore the right of priority under this paragraph filed on or after May 13, 2015, must be filed in the subsequent application, or in the earliest nonprovisional application claiming benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the subsequent application, if such subsequent application is not a nonprovisional application. Any petition to restore the right of priority under this paragraph must include:

(1) The priority claim under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 386(a) or (b) in an application data sheet (§ 1.76(b)(6)), identifying the foreign application to which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, unless previously submitted;

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

(3) A statement that the delay in filing the subsequent application within the period set forth in paragraph (b)(1) of this section was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(d) *Time for filing priority claim*—(1) *Application under 35 U.S.C. 111(a)*. The claim for priority must be filed 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 in an original application filed under 35 U.S.C. 111(a), except as provided in paragraph (e) of this section. The claim for priority must be presented in an application data sheet (§ 1.76(b)(6)) and must identify the foreign application to which priority is claimed by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. The time periods in this paragraph do not apply if the later-filed application is:

(i) An application for a design patent; or

(ii) An application filed under 35 U.S.C. 111(a) before November 29, 2000.

(2) *Application under 35 U.S.C. 371*. The claim for priority must be made within the time limit set forth in the PCT and the Regulations under the PCT in an international application entering the national stage under 35 U.S.C. 371, except as provided in paragraph (e) of this section.

(e) *Delayed priority claim*. Unless such claim is accepted in accordance

with the provisions of this paragraph, any claim for priority under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 386(a) or 386(b) not presented in the manner required by paragraph (d) or (m) of this section during pendency and within the time period provided by paragraph (d) of this section (if applicable) is considered to have been waived. If a claim for priority is considered to have been waived under this section, the claim may be accepted if the priority claim was unintentionally delayed. A petition to accept a delayed claim for priority under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 386(a) or 386(b) must be accompanied by:

(1) The priority claim under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 386(a) or 386(b) in an application data sheet (§ 1.76(b)(6)), identifying the foreign application to which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, unless previously submitted;

(2) A certified copy of the foreign application, unless previously submitted or an exception in paragraph (h), (i), or (j) of this section applies;

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

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

(f) *Time for filing certified copy of foreign application*—(1) *Application under 35 U.S.C. 111(a)*. A certified copy of the foreign application must be filed 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, in an original application under 35 U.S.C. 111(a) filed on or after March 16, 2013, except as provided in paragraphs (h), (i), and (j) of this section. The time period in this paragraph does not apply in a design application.

(2) *Application under 35 U.S.C. 371*. A certified copy of the foreign application must be filed within the time limit set forth in the PCT and the Regulations under the PCT in an international application entering the national stage under 35 U.S.C. 371. If a certified copy of the foreign application is not filed during the international stage in an international application in which the national stage commenced on or after December 18, 2013, a certified copy of the foreign application must be filed within the later of four months

from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or sixteen months from the filing date of the prior foreign application, except as provided in paragraphs (h), (i), and (j) of this section.

(3) If a certified copy of the foreign application is not filed within the time period specified paragraph (f)(1) of this section in an application under 35 U.S.C. 111(a) or within the period specified in paragraph (f)(2) of this section in an international application entering the national stage under 35 U.S.C. 371, and an exception in paragraph (h), (i), or (j) of this section is not applicable, the certified copy of the foreign application must be accompanied by a petition including a showing of good and sufficient cause for the delay and the petition fee set forth in § 1.17(g).

(g) *Requirement for filing priority claim, certified copy of foreign application, and translation in any application*. (1) 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 within the pendency of the application, unless filed with a petition under paragraph (e) or (f) of this section, or with a petition accompanied by the fee set forth in § 1.17(g) which includes a showing of good and sufficient cause for the delay in filing the certified copy of the foreign application in a design application. If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323.

(2) The Office may require that the claim for priority and the certified copy of the foreign application be filed earlier than otherwise provided in this section:

(i) When the application is involved in an interference (see § 41.202 of this chapter) or derivation (see part 42 of this chapter) proceeding;

(ii) When necessary to overcome the date of a reference relied upon by the examiner; or

(iii) When deemed necessary by the examiner.

(3) An English language translation of a non-English language foreign application is not required except:

(i) When the application is involved in an interference (see § 41.202 of this chapter) or derivation (see part 42 of this chapter) proceeding;

(ii) When necessary to overcome the date of a reference relied upon by the examiner; or

(iii) When specifically required by the examiner.

(4) If an English language translation of a non-English language foreign application is required, it must be filed together with a statement that the translation of the certified copy is accurate.

(h) *Certified copy in another U.S. patent or application.* The requirement in paragraphs (f) and (g) of this section for a certified copy of the foreign application will be considered satisfied in a reissue application if the patent for which reissue is sought satisfies the requirement of this section for a certified copy of the foreign application and such patent is identified as containing a certified copy of the foreign application. The requirement in paragraphs (f) and (g) of this section for a certified copy of the foreign application will also be considered satisfied in an application if a prior-filed nonprovisional application for which a benefit is claimed under 35 U.S.C. 120, 121, 365(c), or 386(c) contains a certified copy of the foreign application and such prior-filed nonprovisional application is identified as containing a certified copy of the foreign application.

(i) *Foreign intellectual property office participating in a priority document exchange agreement.* The requirement in paragraphs (f) and (g) of this section for a certified copy of the foreign application to be filed within the time limit set forth therein will be considered satisfied if:

(1) The foreign application was filed in a foreign intellectual property office participating with the Office in a bilateral or multilateral priority document exchange agreement (participating foreign intellectual property office), or a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy;

(2) The claim for priority is presented in an application data sheet (§ 1.76(b)(6)), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, and the applicant provides the information necessary for the participating foreign intellectual property office to provide the Office with access to the foreign application;

(3) The copy of the foreign application is received by the Office from the participating foreign intellectual property office, or a certified copy of the

foreign application is filed, within the period specified in paragraph (g)(1) of this section; and

(4) The applicant files in a separate document a request that the Office obtain a copy of the foreign application from a participating intellectual property office that permits the Office to obtain such a copy where, although the foreign application was not filed in a participating foreign intellectual property office, a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy. The request must identify the participating intellectual property office and the subsequent application by the application number, day, month, and year of its filing in which a copy of the foreign application was filed. The request must be filed within the later of sixteen months from the filing date of the prior foreign application, four months from the actual filing date of an application under 35 U.S.C. 111(a), four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), or four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or the request must be accompanied by a petition under paragraph (e) or (f) of this section.

(j) *Interim copy.* The requirement in paragraph (f) of this section for a certified copy of the foreign application to be filed within the time limit set forth therein will be considered satisfied if:

(1) A copy of the original foreign application clearly labeled as "Interim Copy," including the specification, and any drawings or claims upon which it is based, is filed in the Office together with a separate cover sheet identifying the foreign application by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, and stating that the copy filed in the Office is a true copy of the original application as filed in the foreign country (or intellectual property authority);

(2) The copy of the foreign application and separate cover sheet are filed within the later of sixteen months from the filing date of the prior foreign application, four months from the actual filing date of an application under 35 U.S.C. 111(a), four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or with a petition under paragraph (e) or (f) of this section; and

(3) A certified copy of the foreign application is filed within the period specified in paragraph (g)(1) of this section.

(k) *Requirements for certain applications filed on or after March 16, 2013.* If a nonprovisional application filed on or after March 16, 2013, other than a nonprovisional international design application, claims priority to a foreign application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date as defined in § 1.109 that is on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the nonprovisional application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior foreign application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the nonprovisional application. An applicant is not required to provide such a statement if the applicant reasonably believes on the basis of information already known to the individuals designated in § 1.56(c) that the nonprovisional application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

(l) *Inventor's certificates.* An applicant in a nonprovisional application may under certain circumstances claim priority on the basis of one or more applications for an inventor's certificate in a country granting both inventor's certificates and patents. To claim the right of priority on the basis of an application for an inventor's certificate in such a country under 35 U.S.C. 119(d), the applicant, when submitting a claim for such right as specified in this section, must include an affidavit or declaration. The affidavit or declaration must include a specific statement that, upon an investigation, he or she is satisfied that to the best of his or her knowledge, the applicant, when filing the application for the inventor's certificate, had the option to file an application for either a patent or an inventor's certificate as to the subject matter of the identified claim or claims forming the basis for the claim of priority.

(m) *Time for filing priority claim and certified copy of foreign application in an international design application designating the United States.* In an international design application

designating the United States, the claim for priority may be made in accordance with the Hague Agreement and the Hague Agreement Regulations. In a nonprovisional international design application, the priority claim, unless made in accordance with the Hague Agreement and the Hague Agreement Regulations, must be presented in an application data sheet (§ 1.76(b)(6)), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. In a nonprovisional international design application, the priority claim and certified copy must be furnished in accordance with the time period and other conditions set forth in paragraph (g) of this section.

(n) *Applications filed before September 16, 2012.* Notwithstanding the requirement in paragraphs (d)(1), (e)(1), and (i)(2) of this section that any priority claim be presented in an application data sheet (§ 1.76), this requirement in paragraphs (d)(1), (e)(1), and (i)(2) of this section will be satisfied by the presentation of such priority claim in the oath or declaration under § 1.63 in a nonprovisional application filed under 35 U.S.C. 111(a) before September 16, 2012, or resulting from an international application filed under 35 U.S.C. 363 before September 16, 2012. The provisions of this paragraph do not apply to any priority claim submitted for a petition under paragraph (c) of this section to restore the right of priority to a foreign application.

(o) *Priority under 35 U.S.C. 386(a) or (b).* The right of priority under 35 U.S.C. 386(a) or (b) with respect to an international design application is applicable only to nonprovisional applications, international applications, and international design applications filed on or after May 13, 2015, and patents issuing thereon.

(p) *Time periods in this section.* The time periods set forth in this section are not extendable, but are subject to 35 U.S.C. 21(b) (and § 1.7(a)), PCT Rule 80.5, and Hague Agreement Rule 4(4). ■ 19. Section 1.57 is amended by revising paragraph (a)(4) and the introductory text of paragraph (b) and adding paragraph (b)(4) to read as follows:

**§ 1.57 Incorporation by reference.**

(a) \* \* \*

(4) A certified copy of the previously filed application must be filed in the Office, unless the previously filed application is an application filed under 35 U.S.C. 111 or 363, or the previously

filed application is a foreign priority application and the conditions set forth in § 1.55(i) are satisfied with respect to such foreign priority application. The certified copy of the previously filed application, if required by this paragraph, must be filed within the later of four months from the filing date of the application or sixteen months from the filing date of the previously filed application, or be accompanied by a petition including a showing of good and sufficient cause for the delay and the petition fee set forth in § 1.17(g).

(b) Subject to the conditions and requirements of this paragraph, if all or a portion of the specification or drawing(s) is inadvertently omitted from an application, but the application contains a claim under § 1.55 for priority of a prior-filed foreign application or a claim under § 1.78 for the benefit of a prior-filed provisional, nonprovisional, international application, or international design application, that was present on the filing date of the application, and the inadvertently omitted portion of the specification or drawing(s) is completely contained in the prior-filed application, the claim under § 1.55 or 1.78 shall also be considered an incorporation by reference of the prior-filed application as to the inadvertently omitted portion of the specification or drawing(s).

\* \* \* \* \*

(4) Any amendment to an international design application pursuant to paragraph (b)(1) of this section shall be effective only as to the United States and shall have no effect on the filing date of the application. In addition, no request under this section to add the inadvertently omitted portion of the specification or drawings in an international design application will be acted upon by the Office prior to the international design application becoming a nonprovisional application.

\* \* \* \* \*

■ 20. Section 1.63 is amended by revising paragraph (d)(1) to read as follows:

**§ 1.63 Inventor's oath or declaration.**

\* \* \* \* \*

(d)(1) A newly executed oath or declaration under § 1.63, or substitute statement under § 1.64, is not required under §§ 1.51(b)(2) and 1.53(f), or under §§ 1.497 and 1.1021(d), for an inventor in a continuing application that claims the benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) in compliance with § 1.78 of an earlier-filed application, provided that an oath or declaration in compliance with this section, or

substitute statement under § 1.64, was executed by or with respect to such inventor and was filed in the earlier-filed application, and a copy of such oath, declaration, or substitute statement showing the signature or an indication thereon that it was executed, is submitted in the continuing application.

\* \* \* \* \*

■ 21. Section 1.76 is amended by revising paragraphs (a), (b)(5), and (b)(6) to read as follows:

**§ 1.76 Application data sheet.**

(a) *Application data sheet.* An application data sheet is a sheet or sheets that may be submitted in a provisional application under 35 U.S.C. 111(b), a nonprovisional application under 35 U.S.C. 111(a), a nonprovisional international design application, or a national stage application under 35 U.S.C. 371 and must be submitted when required by § 1.55 or 1.78 to claim priority to or the benefit of a prior-filed application under 35 U.S.C. 119, 120, 121, 365, or 386. An application data sheet must be titled "Application Data Sheet." An application data sheet must contain all of the section headings listed in paragraph (b) of this section, except as provided in paragraph (c)(2) of this section, with any appropriate data for each section heading. If an application data sheet is provided, the application data sheet is part of the application for which it has been submitted.

(b) \* \* \*

(5) *Domestic benefit information.* This information includes the application number, the filing date, the status (including patent number if available), and relationship of each application for which a benefit is claimed under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c). Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120 and § 1.78.

(6) *Foreign priority information.* This information includes the application number, country (or intellectual property authority), and filing date of each foreign application for which priority is claimed. Providing this information in the application data sheet constitutes the claim for priority as required by 35 U.S.C. 119(b) and § 1.55.

\* \* \* \* \*

■ 22. Section 1.78 is revised to read as follows:

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

(a) *Claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional*

*application*. An applicant in a nonprovisional application, other than for a design patent, or an international application designating the United States may claim the benefit of one or more prior-filed provisional applications under the conditions set forth in 35 U.S.C. 119(e) and this section.

(1) The nonprovisional application or international application designating the United States must be:

(i) Filed not later than twelve months after the date on which the provisional application was filed, subject to paragraph (b) of this section (a subsequent application); or

(ii) Entitled to claim the benefit under 35 U.S.C. 120, 121, or 365(c) of a subsequent application that was filed within the period set forth in paragraph (a)(1)(i) of this section.

(2) Each prior-filed provisional application must name the inventor or a joint inventor named in the later-filed application as the inventor or a joint inventor. In addition, each prior-filed 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(d) must have been paid for such provisional application within the time period set forth in § 1.53(g).

(3) Any nonprovisional application or international application designating the United States that claims the benefit of one or more prior-filed provisional applications must contain, or be amended to contain, a reference to each such prior-filed provisional application, identifying it by the provisional application number (consisting of series code and serial number). If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76(b)(5)).

(4) The reference required by paragraph (a)(3) of this section must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed provisional application. If the later-filed application is a nonprovisional application entering the national stage from an international application under 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or sixteen months

from the filing date of the prior-filed provisional application. Except as provided in paragraph (c) of this section, failure to timely submit the reference is considered a waiver of any benefit under 35 U.S.C. 119(e) of the prior-filed provisional application. The time periods in this paragraph do not apply if the later-filed application is:

(i) An application filed under 35 U.S.C. 111(a) before November 29, 2000; or

(ii) An international application filed under 35 U.S.C. 363 before November 29, 2000.

(5) If the prior-filed provisional application was filed in a language other than English and both an English-language translation of the prior-filed provisional application and a statement that the translation is accurate were not previously filed in the prior-filed provisional application, the applicant will be notified and given a period of time within which to file, in the prior-filed provisional application, the translation and the statement. If the notice is mailed in a pending nonprovisional application, a timely reply to such a notice must include the filing in the nonprovisional application of either a confirmation that the translation and statement were filed in the provisional application, or an application data sheet (§ 1.76(b)(5)) eliminating the reference under paragraph (a)(3) of this section to the prior-filed provisional application, or the nonprovisional application will be abandoned. The translation and statement may be filed in the provisional application, even if the provisional application has become abandoned.

(6) If a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a provisional application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date as defined in § 1.109 that is on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the nonprovisional application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior-filed provisional application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the nonprovisional application. An applicant is not required to provide such a statement if the applicant reasonably believes on the basis of

information already known to the individuals designated in § 1.56(c) that the nonprovisional application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

(b) *Delayed filing of the subsequent nonprovisional application or international application designating the United States*. If the subsequent nonprovisional application or international application designating the United States has a filing date which is after the expiration of the twelve-month period set forth in paragraph (a)(1)(i) of this section but within two months from the expiration of the period set forth in paragraph (a)(1)(i) of this section, the benefit of the provisional application may be restored under PCT Rule 26bis.3 for an international application, or upon petition pursuant to this paragraph, if the delay in filing the subsequent nonprovisional application or international application designating the United States within the period set forth in paragraph (a)(1)(i) of this section was unintentional.

(1) A petition to restore the benefit of a provisional application under this paragraph filed on or after May 13, 2015, must be filed in the subsequent application, and any petition to restore the benefit of a provisional application under this paragraph must include:

(i) The reference required by 35 U.S.C. 119(e) to the prior-filed provisional application in an application data sheet (§ 1.76(b)(5)) identifying it by provisional application number (consisting of series code and serial number), unless previously submitted;

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

(iii) A statement that the delay in filing the subsequent nonprovisional application or international application designating the United States within the twelve-month period set forth in paragraph (a)(1)(i) of this section was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(2) The restoration of the right of priority under PCT Rule 26bis.3 to a provisional application does not affect the requirement to include the reference required by paragraph (a)(3) of this section to the provisional application in a national stage application under 35 U.S.C. 371 within the time period provided by paragraph (a)(4) of this section to avoid the benefit claim being considered waived.

(c) *Delayed claims under 35 U.S.C. 119(e) for the benefit of a prior-filed*



*provisional application.* If the reference required by 35 U.S.C. 119(e) and paragraph (a)(3) of this section is presented in an application after the time period provided by paragraph (a)(4) of this section, the claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application may be accepted if the reference identifying the prior-filed application by provisional application number was 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:

(1) The reference required by 35 U.S.C. 119(e) and paragraph (a)(3) of this section to the prior-filed provisional application, unless previously submitted;

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

(3) A statement that the entire delay between the date the benefit claim was due under paragraph (a)(4) of this section and the date the benefit claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(d) *Claims under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed nonprovisional application, international application, or international design application.* An applicant in a nonprovisional application (including a nonprovisional application resulting from an international application or international design application), an international application designating the United States, or an international design application designating the United States may claim the benefit of one or more prior-filed copending nonprovisional applications, international applications designating the United States, or international design applications designating the United States under the conditions set forth in 35 U.S.C. 120, 121, 365(c), or 386(c) and this section.

(1) Each prior-filed application must name the inventor or a joint inventor named in the later-filed application as the inventor or a joint inventor. In addition, each prior-filed application must either be:

(i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States;

(ii) An international design application entitled to a filing date in accordance with § 1.1023 and designating the United States; or

(iii) A nonprovisional application under 35 U.S.C. 111(a) that is entitled to

a filing date as set forth in § 1.53(b) or (d) for which the basic filing fee set forth in § 1.16 has been paid within the pendency of the application.

(2) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application, international application designating the United States, or international design application designating the United States that claims the benefit of one or more prior-filed nonprovisional applications, international applications designating the United States, or international design applications designating the United States must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number), international application number and international filing date, or international registration number and filing date under § 1.1023. If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76(b)(5)). The reference also must identify the relationship of the applications, namely, whether the later-filed application is a continuation, divisional, or continuation-in-part of the prior-filed nonprovisional application, international application, or international design application.

(3)(i) The reference required by 35 U.S.C. 120 and paragraph (d)(2) of this section must be submitted during the pendency of the later-filed application.

(ii) If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the later-filed application is a nonprovisional application entering the national stage from an international application under 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or sixteen months from the filing date of the prior-filed application. The time periods in this paragraph do not apply if the later-filed application is:

(A) An application for a design patent;

(B) An application filed under 35 U.S.C. 111(a) before November 29, 2000; or

(C) An international application filed under 35 U.S.C. 363 before November 29, 2000.

(iii) Except as provided in paragraph (e) of this section, failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (d)(2) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the prior-filed application.

(4) 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-filed application. The identification of an application by application number under this section is the identification of every application assigned that application number necessary for a specific reference required by 35 U.S.C. 120 to every such application assigned that application number.

(5) Cross-references to other related applications may be made when appropriate (see § 1.14), but cross-references to applications for which a benefit is not claimed under title 35, United States Code, must not be included in an application data sheet (§ 1.76(b)(5)).

(6) If a nonprovisional application filed on or after March 16, 2013, other than a nonprovisional international design application, claims the benefit of the filing date of a nonprovisional application or an international application designating the United States filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date as defined in § 1.109 that is on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior-filed application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the later-filed application. An applicant is not required to provide such a statement if either:

(i) The application claims the benefit of a nonprovisional application in which a statement under § 1.55(k), paragraph (a)(6) of this section, or this paragraph that the application contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013 has been filed; or

(ii) The applicant reasonably believes on the basis of information already known to the individuals designated in § 1.56(c) that the later filed application does not, and did not at any time, contain a claim to a claimed invention

that has an effective filing date on or after March 16, 2013.

(7) Where benefit is claimed under 35 U.S.C. 120, 121, 365(c), or 386(c) to an international application or an international design application which designates but did not originate in the United States, the Office may require a certified copy of such application together with an English translation thereof if filed in another language.

(e) *Delayed claims under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed nonprovisional application, international application, or international design application.* If the reference required by 35 U.S.C. 120 and paragraph (d)(2) of this section is presented after the time period provided by paragraph (d)(3) of this section, the claim under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed copending nonprovisional application, international application designating the United States, or international design application designating the United States may be accepted if the reference required by paragraph (d)(2) of this section was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed application must be accompanied by:

(1) The reference required by 35 U.S.C. 120 and paragraph (d)(2) of this section to the prior-filed application, unless previously submitted;

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

(3) A statement that the entire delay between the date the benefit claim was due under paragraph (d)(3) of this section and the date the benefit claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(f) *Applications containing patentably indistinct claims.* Where two or more applications filed by the same applicant or assignee contain patentably indistinct claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

(g) *Applications or patents under reexamination naming different inventors and containing patentably indistinct claims.* If an application or a patent under reexamination and at least one other application naming different inventors are owned by the same person and contain patentably indistinct claims, and there is no statement of record indicating that the claimed inventions were commonly owned or subject to an obligation of assignment to

the same person on the effective filing date (as defined in § 1.109), or on the date of the invention, as applicable, of the later claimed invention, the Office may require the applicant or assignee to state whether the claimed inventions were commonly owned or subject to an obligation of assignment to the same person on such date, and if not, indicate which named inventor is the prior inventor, as applicable. Even if the claimed inventions were commonly owned, or subject to an obligation of assignment to the same person on the effective filing date (as defined in § 1.109), or on the date of the invention, as applicable, of the later claimed invention, the patentably indistinct claims may be rejected under the doctrine of double patenting in view of such commonly owned or assigned applications or patents under reexamination.

(h) *Applications filed before September 16, 2012.* Notwithstanding the requirement in paragraphs (a)(3) and (d)(2) of this section that any specific reference to a prior-filed application be presented in an application data sheet (§ 1.76), this requirement in paragraph (a)(3) and (d)(2) of this section will be satisfied by the presentation of such specific reference in the first sentence(s) of the specification following the title in a nonprovisional application filed under 35 U.S.C. 111(a) before September 16, 2012, or resulting from an international application filed under 35 U.S.C. 363 before September 16, 2012. The provisions of this paragraph do not apply to any specific reference submitted for a petition under paragraph (b) of this section to restore the benefit of a provisional application.

(i) *Petitions required in international applications.* If a petition under paragraph (b), (c), or (e) of this section is required in an international application that was not filed with the United States Receiving Office and is not a nonprovisional application, then such petition may be filed in the earliest nonprovisional application that claims benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the international application and will be treated as having been filed in the international application.

(j) *Benefit under 35 U.S.C. 386(c).* Benefit under 35 U.S.C. 386(c) with respect to an international design application is applicable only to nonprovisional applications, international applications, and international design applications filed on or after May 13, 2015, and patents issuing thereon.

(k) *Time periods in this section.* The time periods set forth in this section are not extendable, but are subject to 35

U.S.C. 21(b) (and § 1.7(a)), PCT Rule 80.5, and Hague Agreement Rule 4(4).

■ 23. Section 1.84 is amended by revising paragraphs (a)(2) and (y) to read as follows:

#### § 1.84 Standards for drawings.

(a) \* \* \*

(2) *Color.* Color drawings are permitted in design applications. Where a design application contains color drawings, the application must include the number of sets of color drawings required by paragraph (a)(2)(ii) of this section and the specification must contain the reference required by paragraph (a)(2)(iii) of this section. 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 patent application. 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). The Office will accept color drawings in utility patent applications 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) One (1) set of color drawings if submitted via the Office electronic filing system or three (3) sets of color drawings if not submitted via the Office electronic filing system; and

(iii) 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 Office upon request and payment of the necessary fee.

\* \* \* \* \*

(y) *Types of drawings.* See § 1.152 for design drawings, § 1.1026 for international design reproductions, § 1.165 for plant drawings, and § 1.173(a)(2) for reissue drawings.

■ 24. Section 1.85 is amended by revising paragraph (c) to read as follows:

#### § 1.85 Corrections to drawings.

\* \* \* \* \*

(c) If a corrected drawing is required or if a drawing does not comply with § 1.84 or an amended drawing submitted under § 1.121(d) in a nonprovisional international design application does not comply with

§ 1.1026 at the time an application is allowed, the Office may notify the applicant in a notice of allowability and set a three-month period of time from the mail date of the notice of allowability within which the applicant must file a corrected drawing in compliance with § 1.84 or 1.1026, as applicable, to avoid abandonment. This time period is not extendable under § 1.136 (see § 1.136(c)).

■ 25. Section 1.97 is amended by revising paragraphs (b)(3) and (4) and adding paragraph (b)(5) to read as follows:

**§ 1.97 Filing of information disclosure statement.**

\* \* \* \* \*

(b) \* \* \*

(3) Before the mailing of a first Office action on the merits;

(4) Before the mailing of a first Office action after the filing of a request for continued examination under § 1.114; or

(5) Within three months of the date of publication of the international registration under Hague Agreement Article 10(3) in an international design application.

\* \* \* \* \*

■ 26. Section 1.105 is amended by revising the introductory text of paragraph (a)(1) to read as follows:

**§ 1.105 Requirements for information.**

(a)(1) In the course of examining or treating a matter in a pending or abandoned application, in a patent, or in a reexamination proceeding, including a reexamination proceeding ordered as a result of a supplemental examination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

\* \* \* \* \*

■ 27. Section 1.109 is revised to read as follows:

**§ 1.109 Effective filing date of a claimed invention under the Leahy-Smith America Invents Act.**

(a) The effective filing date for a claimed invention in a patent or application for patent, other than in a reissue application or reissued patent, is the earliest of:

(1) The actual filing date of the patent or the application for the patent containing a claim to the invention; or

(2) The filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority or the benefit of an earlier filing date under 35 U.S.C. 119, 120, 121, 365, or 386.

(b) The effective filing date for a claimed invention in a reissue application or a reissued patent is determined by deeming the claim to the invention to have been contained in the patent for which reissue was sought.

■ 28. Section 1.114 is amended by revising paragraphs (e)(3) through (5) and adding paragraph (e)(6) to read as follows:

**§ 1.114 Request for continued examination.**

\* \* \* \* \*

(e) \* \* \*

(3) An international application filed under 35 U.S.C. 363 before June 8, 1995, or an international application that does not comply with 35 U.S.C. 371;

(4) An application for a design patent;

(5) An international design application; or

(6) A patent under reexamination.

■ 29. Section 1.121 is amended by revising paragraph (d) introductory text to read as follows:

**§ 1.121 Manner of making amendments in applications.**

\* \* \* \* \*

(d) *Drawings.* One or more application drawings shall be amended in the following manner: Any changes to an application drawing must be in compliance with § 1.84 or, for a nonprovisional international design application, in compliance with §§ 1.84(c) and 1.1026 and must be submitted on a replacement sheet of drawings which shall be an attachment to the amendment document and, in the top margin, labeled "Replacement Sheet." Any replacement sheet of drawings shall include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. Any new sheet of drawings containing an additional figure must be labeled in the top margin as "New Sheet." All changes to the drawings shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper.

\* \* \* \* \*

■ 30. Section 1.130 is amended by revising paragraph (d) to read as follows:

**§ 1.130 Affidavit or declaration of attribution or prior public disclosure under the Leahy-Smith America Invents Act.**

\* \* \* \* \*

(d) *Applications and patents to which this section is applicable.* The provisions of this section apply to any application for patent, and to any patent issuing thereon, that contains, or contained at any time:

(1) A claim to a claimed invention that has an effective filing date as defined in § 1.109 that is on or after March 16, 2013; or

(2) A specific reference under 35 U.S.C. 120, 121, 365(c), or 386(c) to any patent or application that contains, or contained at any time, a claim to a claimed invention that has an effective filing date as defined in § 1.109 that is on or after March 16, 2013.

■ 31. Section 1.131 is amended by revising paragraph (d) to read as follows:

**§ 1.131 Affidavit or declaration of prior invention or to disqualify commonly owned patent or published application as prior art.**

\* \* \* \* \*

(d) The provisions of this section apply to any application for patent and to any patent issuing thereon, that contains, or contained at any time:

(1) A claim to an invention that has an effective filing date as defined in § 1.109 that is before March 16, 2013; or

(2) A specific reference under 35 U.S.C. 120, 121, 365(c), or 386(c) to any patent or application that contains, or contained at any time, a claim to an invention that has an effective filing date as defined in § 1.109 that is before March 16, 2013.

\* \* \* \* \*

■ 32. Section 1.137 is amended by revising paragraphs (d)(1)(ii) and (d)(2) to read as follows:

**§ 1.137 Revival of abandoned application, or terminated or limited reexamination prosecution.**

\* \* \* \* \*

(d) \* \* \*

(1) \* \* \*

(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, 365(c), or 386(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 before June 8, 1995, or a continuing design application, that contains a specific reference under 35 U.S.C. 120, 121, 365(c), or 386(c) to the application for which revival is sought.

\* \* \* \* \*

■ 33. Section 1.155 is amended by revising paragraph (a)(1) to read as follows:

**§ 1.155 Expedited examination of design applications.**

(a) \* \* \*

(1) The application must include drawings in compliance with § 1.84, or for an international design application that designates the United States, must have been published pursuant to Hague Agreement Article 10(3);

\* \* \* \* \*

■ 34. Section 1.175 is amended by revising paragraph (f)(1) introductory text to read as follows:

**§ 1.175 Inventor's oath or declaration for a reissue application.**

\* \* \* \* \*

(f)(1) The requirement for the inventor's oath or declaration for a continuing reissue application that claims the benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) in compliance with § 1.78 of an earlier-filed reissue application may be satisfied by a copy of the inventor's oath or declaration from the earlier-filed reissue application, provided that:

\* \* \* \* \*

■ 35. Section 1.211 is amended by revising paragraph (b) to read as follows:

**§ 1.211 Publication of applications.**

\* \* \* \* \*

(b) Provisional applications under 35 U.S.C. 111(b) shall not be published, and design applications under 35 U.S.C. chapter 16, international design applications under 35 U.S.C. chapter 38, and reissue applications under 35 U.S.C. chapter 25 shall not be published under this section.

\* \* \* \* \*

■ 36. Subpart I to part 1 is added to read as follows:

**Subpart I—International Design Application**

**General Information**

Sec.

- 1.1001 Definitions related to international design applications.
- 1.1002 The United States Patent and Trademark Office as an office of indirect filing.
- 1.1003 The United States Patent and Trademark Office as a designated office.
- 1.1004 The International Bureau.
- 1.1005 Display of currently valid control number under the Paperwork Reduction Act.

**Who May File an International Design Application**

- 1.1011 Applicant for international design application.
- 1.1012 Applicant's Contracting Party.

**The International Design Application**

- 1.1021 Contents of the international design application.
- 1.1022 Form and signature.
- 1.1023 Filing date of an international design application in the United States.
- 1.1024 The description.
- 1.1025 The claim.

- 1.1026 Reproductions.
- 1.1027 Specimens.
- 1.1028 Deferment of publication.

**Fees**

- 1.1031 International design application fees.

**Representation**

- 1.1041 Representation in an international design application.
- 1.1042 Correspondence respecting international design applications filed with the Office as an office of indirect filing.

**Transmittal of the International Design Application to the International Bureau**

- 1.1045 Procedures for transmittal of international design application to the International Bureau.

**Relief From Prescribed Time Limits; Conversion to a Design Application Under 35 U.S.C. Chapter 16**

- 1.1051 Relief from prescribed time limits.
- 1.1052 Conversion to a design application under 35 U.S.C. chapter 16.

**National Processing of International Design Applications**

- 1.1061 Rules applicable.
- 1.1062 Examination.
- 1.1063 Notification of Refusal.
- 1.1064 One independent and distinct design.
- 1.1065 Corrections and other changes in the International Register.
- 1.1066 Correspondence address for a nonprovisional international design application.
- 1.1067 Title, description, and the inventor's oath or declaration.
- 1.1068 Statement of grant of protection.
- 1.1070 Notification of Invalidation.
- 1.1071 Grant of protection for an industrial design only upon issuance of a patent.

**Subpart I — International Design Application**

**General Information**

**§ 1.1001 Definitions related to international design applications.**

(a) *Article* as used in this subpart means an article of the Hague Agreement;

(b) *Regulations* as used in this subpart, when capitalized, means the "Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement";

(c) *Rule* as used in this subpart, when capitalized, means one of the Regulations;

(d) *Administrative Instructions* as used in this subpart means the Administrative Instructions referred to in Rule 34;

(e) *1960 Act* as used in this subpart means the Act signed at the Hague on November 28, 1960, of the Hague Agreement;

(f) Other terms and expressions in subpart I not defined in this section are as defined in Article 1, Rule 1, and 35 U.S.C. 381.

**§ 1.1002 The United States Patent and Trademark Office as an office of indirect filing.**

(a) The United States Patent and Trademark Office, as an office of indirect filing, shall accept international design applications where the applicant's Contracting Party is the United States.

(b) The major functions of the United States Patent and Trademark Office as an office of indirect filing include:

- (1) Receiving and according a receipt date to international design applications;
- (2) Collecting and, when required, transmitting fees due for processing international design applications;
- (3) Determining compliance with applicable requirements of part 5 of this chapter; and
- (4) Transmitting an international design application to the International Bureau, unless prescriptions concerning national security prevent the application from being transmitted.

**§ 1.1003 The United States Patent and Trademark Office as a designated office.**

(a) The United States Patent and Trademark Office will act as a designated office ("United States Designated Office") for international design applications in which the United States has been designated as a Contracting Party in which protection is sought.

(b) The major functions of the United States Designated Office include:

- (1) Accepting for national examination international design applications which satisfy the requirements of the Hague Agreement, the Regulations, and the regulations;
- (2) Performing an examination of the international design application in accordance with 35 U.S.C. chapter 16; and
- (3) Communicating the results of examination to the International Bureau.

**§ 1.1004 The International Bureau.**

(a) The International Bureau is the World Intellectual Property Organization located at Geneva, Switzerland. It is the international intergovernmental organization which acts as the coordinating body under the Hague Agreement and the Regulations.

(b) The major functions of the International Bureau include:

- (1) Receiving international design applications directly from applicants and indirectly from an office of indirect filing;

(2) Collecting required fees and crediting designation fees to the accounts of the Contracting Parties concerned;

(3) Reviewing international design applications for compliance with prescribed formal requirements;

(4) Translating international design applications into the required languages for recordation and publication;

(5) Registering international designs in the International Register where the international design application complies with the applicable requirements;

(6) Publishing international registrations in the International Designs Bulletin; and

(7) Sending copies of the publication of the international registration to each designated office.

**§ 1.1005 Display of currently valid control number under the Paperwork Reduction Act.**

(a) Pursuant to the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*), the collection of information in this subpart has been reviewed and approved by the Office of Management and Budget under control number 0651-0075.

(b) 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 Office of Management and Budget control number. This section constitutes the display required by 44 U.S.C. 3512(a) and 5 CFR 1320.5(b)(2)(i) for the collection of information under Office of Management and Budget control number 0651-0075 (*see* 5 CFR 1320.5(b)(2)(ii)(D)).

**Who May File an International Design Application**

**§ 1.1011 Applicant for international design application.**

(a) Only persons who are nationals of the United States or who have a domicile, a habitual residence, or a real and effective industrial or commercial establishment in the territory of the United States may file international design applications through the United States Patent and Trademark Office.

(b) Although the United States Patent and Trademark Office will accept international design applications filed by any person referred to in paragraph (a) of this section, an international design application designating the United States may be refused by the Office as a designated office if the

applicant is not a person qualified under 35 U.S.C. chapter 11 to be an applicant.

**§ 1.1012 Applicant's Contracting Party.**

In order to file an international design application through the United States Patent and Trademark Office as an office of indirect filing, the United States must be applicant's Contracting Party (Articles 4 and 1(xiv)).

**The International Design Application**

**§ 1.1021 Contents of the international design application.**

(a) *Mandatory contents.* The international design application shall be in English, French, or Spanish (Rule 6(1)) and shall contain or be accompanied by:

(1) A request for international registration under the Hague Agreement (Article 5(1)(i));

(2) The prescribed data concerning the applicant (Article 5(1)(ii) and Rule 7(3)(i) and (ii));

(3) The prescribed number of copies of a reproduction or, at the choice of the applicant, of several different reproductions of the industrial design that is the subject of the international design application, presented in the prescribed manner; however, where the industrial design is two-dimensional and a request for deferment of publication is made in accordance with Article 5(5), the international design application may, instead of containing reproductions, be accompanied by the prescribed number of specimens of the industrial design (Article 5(1)(iii));

(4) An indication of the product or products that constitute the industrial design or in relation to which the industrial design is to be used, as prescribed (Article 5(1)(iv) and Rule 7(3)(iv));

(5) An indication of the designated Contracting Parties (Article 5(1)(v));

(6) The prescribed fees (Article 5(1)(vi) and Rule 12(1));

(7) The Contracting Party or Parties in respect of which the applicant fulfills the conditions to be the holder of an international registration (Rule 7(3)(iii));

(8) The number of industrial designs included in the international design application, which may not exceed 100, and the number of reproductions or specimens of the industrial designs accompanying the international design application (Rule 7(3)(v));

(9) The amount of the fees being paid and the method of payment, or instructions to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the

payment or giving the instructions (Rule 7(3)(vii)); and

(10) An indication of applicant's Contracting Party as required under Rule 7(4)(a).

(b) *Additional mandatory contents required by certain Contracting Parties.*

(1) Where the international design application contains the designation of a Contracting Party that requires, pursuant to Article 5(2), any of the following elements, then the international design application shall contain such required element(s):

(i) Indications concerning the identity of the creator of the industrial design that is the subject of that application (Rule 11(1));

(ii) A brief description of the reproduction or of the characteristic features of the industrial design that is the subject of that application (Rule 11(2));

(iii) A claim (Rule 11(3)).

(2) Where the international design application contains the designation of a Contracting Party that has made a declaration under Rule 8(1), then the international application shall contain the statement, document, oath or declaration specified in that declaration (Rule 7(4)(c)).

(c) *Optional contents.* The international design application may contain:

(1) Two or more industrial designs, subject to the prescribed conditions (Article 5(4) and Rule 7(7));

(2) A request for deferment of publication (Article 5(5) and Rule 7(5)(e)) or a request for immediate publication (Rule 17);

(3) An element referred to in item (i) or (ii) of Article 5(2)(b) of the Hague Agreement or in Article 8(4)(a) of the 1960 Act even where that element is not required in consequence of a notification in accordance with Article 5(2)(a) of the Hague Agreement or in consequence of a requirement under Article 8(4)(a) of the 1960 Act (Rule 7(5)(a));

(4) The name and address of applicant's representative, as prescribed (Rule 7(5)(b));

(5) A claim of priority of one or more earlier filed applications in accordance with Article 6 and Rule 7(5)(c);

(6) A declaration, for purposes of Article 11 of the Paris Convention, that the product or products which constitute the industrial design or in which the industrial design is incorporated have been shown at an official or officially recognized international exhibition, together with the place where the exhibition was held and the date on which the product or products were first exhibited there and,

where less than all the industrial designs contained in the international design application are concerned, the indication of those industrial designs to which the declaration relates or does not relate (Rule 7(5)(d));

(7) Any declaration, statement or other relevant indication as may be specified in the Administrative Instructions (Rule 7(5)(f));

(8) A statement that identifies information known by the applicant to be material to the eligibility for protection of the industrial design concerned (Rule 7(5)(g));

(9) A proposed translation of any text matter contained in the international design application for purposes of recording and publication (Rule 6(4)).

(d) *Required contents where the United States is designated.* In addition to the mandatory requirements set forth in paragraph (a) of this section, an international design application that designates the United States shall contain or be accompanied by:

(1) A claim (§§ 1.1021(b)(1)(iii) and 1.1025);

(2) Indications concerning the identity of the creator (*i.e.*, the inventor, see § 1.9(d)) in accordance with Rule 11(1); and

(3) The inventor's oath or declaration (§§ 1.63 and 1.64). The requirements in §§ 1.63(b) and 1.64(b)(4) to identify each inventor by his or her legal name, mailing address, and residence, if an inventor lives at a location which is different from the mailing address, and the requirement in § 1.64(b)(2) to identify the residence and mailing address of the person signing the substitute statement will be considered satisfied by the presentation of such information in the international design application prior to international registration.

#### **§ 1.1022 Form and signature.**

(a) The international design application shall be presented on the official form (Rules 7(1) and 1(vi)).

(b) The international design application shall be signed by the applicant.

#### **§ 1.1023 Filing date of an international design application in the United States.**

(a) Subject to paragraph (b) of this section, the filing date of an international design application in the United States is the date of international registration determined by the International Bureau under the Hague Agreement (35 U.S.C. 384 and 381(a)(5)).

(b) Where the applicant believes the international design application is entitled under the Hague Agreement to

a filing date in the United States other than the date of international registration, the applicant may petition the Director under this paragraph to accord the international design application a filing date in the United States other than the date of international registration. Such petition must be accompanied by the fee set forth in § 1.17(f) and include a showing to the satisfaction of the Director that the international design application is entitled to such filing date.

#### **§ 1.1024 The description.**

An international design application designating the United States must include a specification as prescribed by 35 U.S.C. 112 and preferably include a brief description of the reproduction pursuant to Rule 7(5)(a) describing the view or views of the reproductions.

#### **§ 1.1025 The claim.**

The specific wording of the claim in an international design application designating the United States shall be in formal terms to the ornamental design for the article (specifying name of article) as shown, or as shown and described. More than one claim is neither required nor permitted for purposes of the United States.

#### **§ 1.1026 Reproductions.**

Reproductions shall comply with the requirements of Rule 9 and Part Four of the Administrative Instructions.

#### **§ 1.1027 Specimens.**

Where a request for deferment of publication has been filed in respect of a two-dimensional industrial design, the international design application may include specimens of the design in accordance with Rule 10 and Part Four of the Administrative Instructions. Specimens are not permitted in an international design application that designates the United States or any other Contracting Party which does not permit deferment of publication.

#### **§ 1.1028 Deferment of publication.**

The international design application may contain a request for deferment of publication, provided the application does not designate the United States or any other Contracting Party which does not permit deferment of publication.

#### **Fees**

#### **§ 1.1031 International design application fees.**

(a) International design applications filed through the Office as an office of indirect filing are subject to payment of a transmittal fee (35 U.S.C. 382(b) and Article 4(2)) in the amount of \$120.

(b) The Schedule of Fees annexed to the Regulations (Rule 27(1)), a list of individual designation fee amounts, and a fee calculator may be viewed on the Web site of the World Intellectual Property Organization, currently available at <http://www.wipo.int/hague>.

(c) The following fees required by the International Bureau may be paid either directly to the International Bureau or through the Office as an office of indirect filing in the amounts specified on the World Intellectual Property Organization Web site described in paragraph (b) of this section:

(1) International application fees (Rule 12(1)); and

(2) Fee for descriptions exceeding 100 words (Rule 11(2)).

(d) The fees referred to in paragraph (c) of this section may be paid as follows:

(1) Directly to the International Bureau in Swiss currency (*see* Administrative Instruction 801); or

(2) Through the Office as an office of indirect filing, provided such fees are paid no later than the date of payment of the transmittal fee required under paragraph (a) of this section. Any payment through the Office must be in U.S. dollars. Applicants paying the fees in paragraph (c) of this section through the Office may be subject to a requirement by the International Bureau to pay additional amounts where the conversion from U.S. dollars to Swiss currency results in the International Bureau receiving less than the prescribed amounts.

(e) Payment of the fees referred to in Article 17 and Rule 24 for renewing an international registration ("renewal fees") is not required to maintain a U.S. patent issuing on an international design application in force. Renewal fees, if required, must be submitted directly to the International Bureau. Any renewal fee submitted to the Office will not be transmitted to the International Bureau.

#### **Representation**

#### **§ 1.1041 Representation in an international design application.**

(a) The applicant may appoint a representative before the International Bureau in accordance with Rule 3.

(b) Applicants of international design applications may be represented before the Office as an office of indirect filing by a practitioner registered (§ 11.6) or granted limited recognition (§ 11.9(a) or (b)) to practice before the Office in patent matters. Such practitioner may act pursuant to § 1.34 or pursuant to appointment by the applicant. The appointment must be in writing signed

by the applicant, must give the practitioner power to act on behalf of the applicant, and must specify the name and registration number or limited recognition number of each practitioner. An appointment of a representative made in the international design application pursuant to Rule 3(2) that complies with the requirements of this paragraph will be effective as an appointment before the Office as an office of indirect filing.

**§ 1.1042 Correspondence respecting international design applications filed with the Office as an office of indirect filing.**

The applicant may specify a correspondence address for correspondence sent by the Office as an office of indirect filing. Where no such address has been specified, the Office will use as the correspondence address the address of applicant's appointed representative (§ 1.1041) or, where no representative is appointed, the address as specified in Administrative Instruction 302.

**Transmittal of International Design Application to the International Bureau**

**§ 1.1045 Procedures for transmittal of international design application to the International Bureau.**

(a) Subject to paragraph (b) of this section and payment of the transmittal fee set forth in § 1.1031(a), transmittal of the international design application to the International Bureau shall be made by the Office as provided by Rule 13(1). At the same time as it transmits the international design application to the International Bureau, the Office shall notify the International Bureau of the date on which it received the application. The Office shall also notify the applicant of the date on which it received the application and of the transmittal of the international design application to the International Bureau.

(b) No copy of an international design application may be transmitted to the International Bureau, a foreign designated office, or other foreign authority by the Office or the applicant, unless the applicable requirements of part 5 of this chapter have been satisfied.

(c) Once transmittal of the international design application has been effected under paragraph (a) of this section, except for matters properly before the United States Patent and Trademark Office as an office of indirect filing or as a designated office, all further correspondence concerning the application should be sent directly to the International Bureau. The United States Patent and Trademark Office will generally not forward communications

to the International Bureau received after transmittal of the application to the International Bureau. Any reply to an invitation sent to the applicant by the International Bureau must be filed directly with the International Bureau, and not with the Office, to avoid abandonment or other loss of rights under Article 8.

**Relief From Prescribed Time Limits; Conversion to a Design Application Under 35 U.S.C. Chapter 16**

**§ 1.1051 Relief from prescribed time limits.**

(a) If the delay in an applicant's failure to act within prescribed time limits under the Hague Agreement in connection with requirements pertaining to an international design application was unintentional, a petition may be filed pursuant to this section to excuse the failure to act as to the United States. A grantable petition pursuant to this section must be accompanied by:

(1) A copy of any invitation sent from the International Bureau setting a prescribed time limit for which applicant failed to timely act;

(2) The reply required under paragraph (c) of this section, unless previously filed;

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

(4) A certified copy of the originally filed international design application, unless a copy of the international design application was previously communicated to the Office from the International Bureau or the international design application was filed with the Office as an office of indirect filing, and a translation thereof into the English language if it was filed in another language;

(5) 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

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

(b) Any request for reconsideration or review of a decision refusing to excuse the applicant's failure to act within prescribed time limits in connection with requirements pertaining to an international design application upon petition filed pursuant to this section, to be considered timely, must be filed within two months of the decision refusing to excuse 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.

(c) *Reply.* The reply required may be:

(1) The filing of a continuing application. If the international design application has not been subject to international registration, the reply must also include a grantable petition under § 1.1023(b) to accord the international design application a filing date; or

(2) A grantable petition under § 1.1052, where the international design application was filed with the Office as an office of indirect filing.

(d) *Terminal disclaimer.* Any petition pursuant to this section 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 beginning on the due date for the reply for which applicant failed to timely act and ending on the date of filing of the reply required under paragraph (c) of this section and must also apply to any patent granted on a continuing design application that contains a specific reference under 35 U.S.C. 120, 121, 365(c) or 386(c) to the application for which relief under this section is sought.

**§ 1.1052 Conversion to a design application under 35 U.S.C. chapter 16.**

(a) An international design application designating the United States filed with the Office as an office of indirect filing and meeting the requirements under § 1.53(b) for a filing date for an application for a design patent may, on petition under this section, be converted to an application for a design patent under § 1.53(b) and accorded a filing date as provided therein. A petition under this section must be accompanied by the fee set forth in § 1.17(t) and be filed prior to publication of the international registration under Article 10(3). The conversion of an international design application to an application for a design patent under § 1.53(b) will not entitle applicant to a refund of the transmittal fee or any fee forwarded to the International Bureau, or the application of any such fee toward the filing fee, or any other fee, for the application for a design patent under § 1.53(b). The application for a design patent resulting from conversion of an international design application must also include the basic filing fee (§ 1.16(b)), the search fee (§ 1.16(l)), the examination fee (§ 1.16(p)), the inventor's oath or declaration (§ 1.63 or 1.64), and a surcharge if required by § 1.16(f).

(b) An international design application will be converted to an



application for a design patent under § 1.53(b) if a decision on petition under this section is granted prior to transmittal of the international design application to the International Bureau pursuant to § 1.1045. Otherwise, a decision granting a petition under this section will be effective to convert the international design application to an application for a design patent under § 1.53(b) only for purposes of the designation of the United States.

(c) A petition under this section will not be granted in an abandoned international design application absent a grantable petition under § 1.1051.

(d) An international design application converted under this section is subject to the regulations applicable to a design application filed under 35 U.S.C. chapter 16.

### **National Processing of International Design Applications**

#### **§ 1.1061 Rules applicable.**

(a) The rules relating to applications for patents for other inventions or discoveries are also applicable to international design applications designating the United States, except as otherwise provided in this chapter or required by the Articles or Regulations.

(b) The provisions of § 1.74, § 1.84, except for § 1.84(c), and §§ 1.152 through 1.154 shall not apply to international design applications.

#### **§ 1.1062 Examination.**

(a) *Examination.* The Office shall make an examination pursuant to title 35, United States Code, of an international design application designating the United States.

(b) *Timing.* For each international design application to be examined under paragraph (a) of this section, the Office shall, subject to Rule 18(1)(c)(ii), send to the International Bureau within 12 months from the publication of the international registration under Rule 26(3) a notification of refusal (§ 1.1063) where it appears that the applicant is not entitled to a patent under the law with respect to any industrial design that is the subject of the international registration.

#### **§ 1.1063 Notification of refusal.**

(a) A notification of refusal shall contain or indicate:

(1) The number of the international registration;

(2) The grounds on which the refusal is based;

(3) A copy of a reproduction of the earlier industrial design and information concerning the earlier industrial design, where the grounds of refusal refer to similarity with an

industrial design that is the subject of an earlier application or registration;

(4) Where the refusal does not relate to all the industrial designs that are the subject of the international registration, those to which it relates or does not relate; and

(5) A time period for reply under §§ 1.134 and 1.136, where a reply to the notification of refusal is required.

(b) Any reply to the notification of refusal must be filed directly with the Office and not through the International Bureau. The requirements of § 1.111 shall apply to a reply to a notification of refusal.

#### **§ 1.1064 One independent and distinct design.**

(a) Only one independent and distinct design may be claimed in a nonprovisional international design application.

(b) If the requirements under paragraph (a) of this section are not satisfied, the examiner shall in the notification of refusal or other Office action require the applicant in the reply to that action to elect one independent and distinct design for which prosecution on the merits shall be restricted. Such requirement will normally be made before any action on the merits but may be made at any time before the final action. Review of any such requirement is provided under §§ 1.143 and 1.144.

#### **§ 1.1065 Corrections and other changes in the International Register.**

(a) The effects of any correction in the International Register by the International Bureau pursuant to Rule 22 in a pending nonprovisional international design application shall be decided by the Office in accordance with the merits of each situation, subject to such other requirements as may be imposed. A patent issuing from an international design application may only be corrected in accordance with the provisions of title 35, United States Code, for correcting patents. Any correction under Rule 22 recorded by the International Bureau with respect to an abandoned nonprovisional international design application will generally not be acted upon by the Office and shall not be given effect unless otherwise indicated by the Office.

(b) A recording of a partial change in ownership in the International Register pursuant to Rule 21(7) concerning a transfer of less than all designs shall not have effect in the United States.

#### **§ 1.1066 Correspondence address for a nonprovisional international design application.**

(a) Unless the correspondence address is changed in accordance with § 1.33(a), the Office will use as the correspondence address in a nonprovisional international design application the address according to the following order:

(1) The correspondence address under § 1.1042;

(2) The address of applicant's representative identified in the publication of the international registration; and

(3) The address of the applicant identified in the publication of the international registration.

(b) Reference in the rules to the correspondence address set forth in § 1.33(a) shall be construed to include a reference to this section for a nonprovisional international design application.

#### **§ 1.1067 Title, description, and inventor's oath or declaration.**

(a) The title of the design must designate the particular article. Where a nonprovisional international design application does not contain a title of the design, the Office may establish a title. No description, other than a reference to the drawing, is ordinarily required in a nonprovisional international design application.

(b) An international design application designating the United States must include the inventor's oath or declaration. *See* § 1.1021(d). If the applicant is notified in a notice of allowability that an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each named inventor has not been filed, the applicant must file each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, no later than the date on which the issue fee is paid to avoid abandonment. This time period is not extendable under § 1.136 (*see* § 1.136(c)).

#### **§ 1.1068 Statement of grant of protection.**

Upon issuance of a patent on an international design application designating the United States, the Office may send to the International Bureau a statement to the effect that protection is granted in the United States to those industrial design or designs that are the subject of the international registration and covered by the patent.

#### **§ 1.1070 Notification of Invalidation.**

(a) Where a design patent that was granted from an international design

application is invalidated in the United States, and the invalidation is no longer subject to any review or appeal, the patentee shall inform the Office.

(b) After receiving a notification of invalidation under paragraph (a) of this section or through other means, the Office will notify the International Bureau in accordance with Hague Rule 20.

**§ 1.1071 Grant of protection for an industrial design only upon issuance of a patent.**

A grant of protection for an industrial design that is the subject of an international registration shall only arise in the United States through the issuance of a patent pursuant to 35 U.S.C. 389(d) or 171, and in accordance with 35 U.S.C. 153.

**PART 3—ASSIGNMENT, RECORDING AND RIGHTS OF ASSIGNEE**

■ 37. The authority citation for part 3 continues to read as follows:

**Authority:** 15 U.S.C. 1123; 35 U.S.C. 2(b)(2).

■ 38. Section 3.1 is amended by revising the definition of “Application” to read as follows:

**§ 3.1 Definitions.**

\* \* \* \* \*

*Application* means a national application for patent, an international patent application that designates the United States of America, an international design application that designates the United States of America, or an application to register a trademark under section 1 or 44 of the Trademark Act, 15 U.S.C. 1051, or 15 U.S.C. 1126, unless otherwise indicated.

\* \* \* \* \*

■ 39. Section 3.21 is revised to read as follows:

**§ 3.21 Identification of patents and patent applications.**

An assignment relating to a patent must identify the patent by the patent number. An assignment relating to a national patent application must identify the national patent application by the application number (consisting of the series code and the serial number; *e.g.*, 07/123,456). An assignment relating to an international patent application which designates the United States of America must identify the international application by the international application number; *e.g.*, PCT/US2012/012345. An assignment relating to an international design application which designates the United States of America must identify the international design application by the

international registration number or by the U.S. application number assigned to the international design application. If an assignment of a patent application filed under § 1.53(b) of this chapter is executed concurrently with, or subsequent to, the execution of the patent application, but before the patent application is filed, it must identify the patent application by the name of each inventor and the title of the invention so that there can be no mistake as to the patent application intended. If an assignment of a provisional application under § 1.53(c) of this chapter is executed before the provisional application is filed, it must identify the provisional application by the name of each inventor and the title of the invention so that there can be no mistake as to the provisional application intended.

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

■ 40. The authority citation for 37 CFR part 5 continues 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.*; 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), as well as the Export Administration Act of 1979, 50 U.S.C. app. 2401 *et seq.*; the International Emergency Economic Powers Act, 50 U.S.C. 1701 *et seq.*; E.O. 12938, 59 FR 59099, 3 CFR, 1994 Comp., p. 950; E.O. 13222, 66 FR 44025, 3 CFR, 2001 Comp., p. 783; Notice of August 2, 2005, 70 FR 45273 (August 5, 2005).

■ 41. Section 5.1 is amended by revising paragraph (b) to read as follows:

**§ 5.1 Applications and correspondence involving national security.**

\* \* \* \* \*

(b) *Definitions.* (1) Application as used in this part includes provisional applications (§ 1.9(a)(2) of this chapter), nonprovisional applications (§ 1.9(a)(3)), international applications (§ 1.9(b)), or international design applications (§ 1.9(n)).

(2) Foreign application as used in this part includes, for filing in a foreign country, foreign patent office, foreign patent agency, or international agency (other than the United States Patent and Trademark Office acting as a Receiving Office for international applications (35 U.S.C. 361, § 1.412) or as an office of

indirect filing for international design applications (35 U.S.C. 382, § 1.1002)) any of the following: An application for patent, international application, international design application, or application for the registration of a utility model, industrial design, or model.

\* \* \* \* \*

■ 42. Section 5.3 is amended by revising paragraph (d) to read as follows:

**§ 5.3 Prosecution of application under secrecy orders; withholding patent.**

\* \* \* \* \*

(d) International applications and international design applications under secrecy order will not be mailed, delivered, or otherwise transmitted to the international authorities or the applicant. International applications under secrecy order will be processed up to the point where, if it were not for the secrecy order, record and search copies would be transmitted to the international authorities or the applicant.

\* \* \* \* \*

■ 43. Section 5.11 is amended by revising the section heading and paragraphs (a) through (c), (e)(3)(i), and (f) to read as follows:

**§ 5.11 License for filing in, or exporting to, a foreign country an application on an invention made in the United States or technical data relating thereto.**

(a) A license from the Commissioner for Patents under 35 U.S.C. 184 is required before filing any application for patent including any modifications, amendments, or supplements thereto or divisions thereof or for the registration of a utility model, industrial design, or model, in a foreign country, foreign patent office, foreign patent agency, or any international agency (other than the United States Patent and Trademark Office acting as a Receiving Office for international applications (35 U.S.C. 361, § 1.412) or as an office of indirect filing for international design applications (35 U.S.C. 382, § 1.1002)), if the invention was made in the United States, and:

(1) An application on the invention has been filed in the United States less than six months prior to the date on which the application is to be filed; or

(2) No application on the invention has been filed in the United States.

(b) The license from the Commissioner for Patents referred to in paragraph (a) of this section would also authorize the export of technical data abroad for purposes relating to the preparation, filing or possible filing and prosecution of a foreign application without separately complying with the

regulations contained in 22 CFR parts 120 through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR parts 730 through 774 (Export Administration Regulations of the Bureau of Industry and Security, Department of Commerce), and 10 CFR part 810 (Assistance to Foreign Atomic Energy Activities Regulations of the Department of Energy).

(c) Where technical data in the form of a patent application, or in any form, are being exported for purposes related to the preparation, filing or possible filing and prosecution of a foreign application, without the license from the Commissioner for Patents referred to in paragraphs (a) or (b) of this section, or on an invention not made in the United States, the export regulations contained in 22 CFR parts 120 through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR parts 730 through 774 (Export Administration Regulations of the Bureau of Industry and Security, Department of Commerce), and 10 CFR part 810 (Assistance to Foreign Atomic Energy Activities Regulations of the Department of Energy) must be complied with unless a license is not required because a United States application was on file at the time of export for at least six months without a secrecy order under § 5.2 being placed thereon. The term "exported" means export as it is defined in 22 CFR part 120, 15 CFR part 734, and activities covered by 10 CFR part 810.

\* \* \* \* \*

(e) \* \* \*

(3) \* \* \*

(i) A license is not, or was not, required under paragraph (e)(2) of this section for the foreign application;

\* \* \* \* \*

(f) A license pursuant to paragraph (a) of this section can be revoked at any time upon written notification by the United States Patent and Trademark Office. An authorization to file a foreign application resulting from the passage of six months from the date of filing of a United States patent application may be revoked by the imposition of a secrecy order.

■ 44. Section 5.12 is amended by revising paragraph (a) to read as follows:

**§ 5.12 Petition for license.**

(a) Filing of an application on an invention made in the United States will be considered to include a petition for license under 35 U.S.C. 184 for the subject matter of the application. The filing receipt or other official notice will indicate if a license is granted. If the initial automatic petition is not granted,

a subsequent petition may be filed under paragraph (b) of this section.

\* \* \* \* \*

■ 45. Section 5.13 is revised to read as follows:

**§ 5.13 Petition for license; no corresponding application.**

If no corresponding national, international design, or international application has been filed in the United States, the petition for license under § 5.12(b) must also be accompanied by a legible copy of the material upon which a license is desired. This copy will be retained as a measure of the license granted.

■ 46. Section 5.14 is amended by revising paragraph (c) to read as follows:

**§ 5.14 Petition for license; corresponding U.S. application.**

\* \* \* \* \*

(c) Where the application to be filed or exported abroad contains matter not disclosed in the United States application or applications, including the case where the combining of two or more United States applications introduces subject matter not disclosed in any of them, a copy of the application as it is to be filed or exported abroad, must be furnished with the petition. If, however, all new matter in the application to be filed or exported is readily identifiable, the new matter may be submitted in detail and the remainder by reference to the pertinent United States application or applications.

\* \* \* \* \*

■ 47. Section 5.15 is amended by revising paragraphs (a) introductory text, (a)(3), (b), (d), and (e) to read as follows:

**§ 5.15 Scope of license.**

(a) Applications or other materials reviewed pursuant to §§ 5.12 through 5.14, which were not required to be made available for inspection by defense agencies under 35 U.S.C. 181, will be eligible for a license of the scope provided in this paragraph. This license permits subsequent modifications, amendments, and supplements containing additional subject matter to, or divisions of, a foreign application, if such changes to the application do not alter the general nature of the invention in a manner that would require the United States application to have been made available for inspection under 35 U.S.C. 181. Grant of this license authorizes the export and filing of an application in a foreign country or to any foreign patent agency or international patent agency when the subject matter of the foreign application

corresponds to that of the domestic application. This license includes authority:

\* \* \* \* \*

(3) To take any action in the prosecution of the foreign application provided that the adding of subject matter or taking of any action under paragraph (a)(1) or (2) of this section does not change the general nature of the invention disclosed in the application in a manner that would require such application to have been made available for inspection under 35 U.S.C. 181 by including technical data pertaining to:

(i) Defense services or articles designated in the United States Munitions List applicable at the time of foreign filing, the unlicensed exportation of which is prohibited pursuant to the Arms Export Control Act, as amended, and 22 CFR parts 120 through 130; or

(ii) Restricted Data, sensitive nuclear technology or technology useful in the production or utilization of special nuclear material or atomic energy, dissemination of which is subject to restrictions of the Atomic Energy Act of 1954, as amended, and the Nuclear Non-Proliferation Act of 1978, as implemented by the regulations for Assistance to Foreign Atomic Energy Activities, 10 CFR part 810, in effect at the time of foreign filing.

(b) Applications or other materials which were required to be made available for inspection under 35 U.S.C. 181 will be eligible for a license of the scope provided in this paragraph. Grant of this license authorizes the export and filing of an application in a foreign country or to any foreign patent agency or international patent agency. Further, this license includes authority to export and file all duplicate and formal papers in foreign countries or with foreign and international patent agencies and to make amendments, modifications, and supplements to, file divisions of, and take any action in the prosecution of the foreign application, provided subject matter additional to that covered by the license is not involved.

\* \* \* \* \*

(d) In those cases in which no license is required to file or export the foreign application, no license is required to file papers in connection with the prosecution of the foreign application not involving the disclosure of additional subject matter.

(e) Any paper filed abroad or transmitted to an international patent agency following the filing of a foreign application that changes the general nature of the subject matter disclosed at

the time of filing in a manner that would require such application to have been made available for inspection under 35 U.S.C. 181 or that involves the disclosure of subject matter listed in paragraph (a)(3)(i) or (ii) of this section must be separately licensed in the same manner as a foreign application. Further, if no license has been granted under § 5.12(a) on filing the corresponding United States application, any paper filed abroad or with an international patent agency that involves the disclosure of additional subject matter must be licensed in the same manner as a foreign application.

\* \* \* \* \*

#### **PART 11—REPRESENTATION OF OTHERS BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE**

■ 48. The authority citation for 37 CFR part 11 continues to read as follows:

**Authority:** 5 U.S.C. 500, 15 U.S.C. 1123, 35 U.S.C. 2(b)(2), 32, 41.

■ 49. Section 11.10 is amended by revising paragraph (b)(3)(iii) to read as follows:

#### **§ 11.10 Restrictions on practice in patent matters.**

\* \* \* \* \*

(b) \* \* \*

(3) \* \* \*

(iii) Particular patent or patent application means any patent or patent

application, including, but not limited to, a provisional, substitute, international, international design, continuation, divisional, continuation-in-part, or reissue patent application, as well as any protest, reexamination, petition, appeal, interference, or trial proceeding based on the patent or patent application.

\* \* \* \* \*

#### **PART 41—PRACTICE BEFORE THE PATENT TRIAL AND APPEAL BOARD**

■ 50. The authority citation for part 41 continues to read as follows:

**Authority:** 35 U.S.C. 2(b)(2), 3(a)(2)(A), 21, 23, 32, 41, 134, 135, and Pub. L. 112–29.

■ 51. Section 41.200 is revised by adding paragraph (b) to read as follows:

#### **§ 41.200 Procedure; pendency.**

\* \* \* \* \*

(b) Any reference to 35 U.S.C. 102 or 135 in this subpart refers to the statute in effect on March 15, 2013, unless otherwise expressly indicated. Any reference to 35 U.S.C. 141 or 146 in this subpart refers to the statute applicable to the involved application or patent.

\* \* \* \* \*

■ 52. Section 41.201 is amended by revising the definition of “Constructive reduction to practice” and paragraph (2)(ii) of the definition for “Threshold issue” to read as follows:

#### **§ 41.201 Definitions.**

\* \* \* \* \*

*Constructive reduction to practice* means a described and enabled anticipation under 35 U.S.C. 102(g)(1), in a patent application of the subject matter of a claim. Earliest constructive reduction to practice means the first constructive reduction to practice that has been continuously disclosed through a chain of patent applications including in the involved application or patent. For the chain to be continuous, each subsequent application must comply with the requirements of 35 U.S.C. 119–121, 365, or 386.

\* \* \* \* \*

*Threshold issue* means an issue that, if resolved in favor of the movant, would deprive the opponent of standing in the interference. Threshold issues may include:

\* \* \* \* \*

(2) \* \* \*

(ii) Unpatentability for lack of written description under 35 U.S.C. 112 of an involved application claim where the applicant suggested, or could have suggested, an interference under § 41.202(a).

Dated: March 16, 2015.

**Michelle K. Lee,**

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

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