

which unauthorized vessels and persons may not enter.

DATES: Comments must be submitted on or before April 24, 2003.

FOR FURTHER INFORMATION CONTACT: Mr. Frank Torbett, Headquarters Regulatory Branch at (202) 761-4618 or Mr. Jack Kennedy, Corps Seattle District, at (206) 764-6907.

SUPPLEMENTARY INFORMATION: Pursuant to its authorities in Section 7 of the Rivers and Harbors Act of 1917 (40 Stat. 266; 33 U.S.C. 1) and Chapter XIX of the Army Appropriation Act of 1919 (40 Stat. 892; 33 U.S.C. 3) the Corps proposes to amend the regulations in 33 CFR Part 334 by establishing a new restricted area at § 334.1244, in the waters of Rich Passage and Puget Sound surrounding the Manchester Fuel Depot at Manchester, Washington. The points defining the proposed restricted area were selected to avoid interference with ferryboats and other users of the adjacent traffic lanes of Rich Passage, and to minimize the restricted area's interference with nearby fish pens in Clam Bay and Rich Passage. In addition to the publication of this proposed rule, the Seattle District Engineer is concurrently soliciting public comment on these proposed rules by distribution of a public notice to all known interested parties.

Procedural Requirements

a. Review Under Executive Order 12866

This proposed rule is issued with respect to a military function of the Defense Department and the provisions of Executive Order 12866 do not apply.

b. Review Under the Regulatory Flexibility Act

This proposed rule has been reviewed under the Regulatory Flexibility Act (Pub. L. 96-354), which requires the preparation of a regulatory flexibility analysis for any regulation that will have a significant economic impact on a substantial number of small entities (*i.e.*, small businesses and small governments). The Corps expects that the economic impact of the establishment of this restricted area would have no impact on the public, no anticipated navigational hazard or interference with existing waterway traffic, and accordingly, certifies that this proposal, if adopted, will have no significant economic impact on small entities.

c. Review Under the National Environmental Policy Act

The Seattle District has prepared a preliminary Environmental Assessment (EA) for this action. The preliminary EA

concluded that this action will not have a significant impact on the human environment. After receipt and analysis of comments from this **Federal Register** posting and the Seattle District's concurrent Public Notice, the Corps will prepare a final environmental document detailing the scale of impacts this action will have upon the human environment. The EA will be available for review at the Seattle District office listed at the end of the **FOR FURTHER INFORMATION CONTACT** paragraph above.

d. Unfunded Mandates Act

This proposed rule does not impose an enforceable duty among the private sector and, therefore, is not a Federal private sector mandate and is not subject to the requirements of Section 202 or 205 of the Unfunded Mandates Act. We have also found under Section 203 of the Act that small governments will not be significantly and uniquely affected by this rulemaking.

List of Subjects in 33 CFR Part 334

Danger zones, Marine safety, Navigation (water), Restricted areas, Waterways.

For the reasons set out in the preamble, we propose to amend 33 CFR Part 334 as follows:

PART 334—DANGER ZONE AND RESTRICTED AREA REGULATIONS

1. The authority citation for Part 334 continues to read as follows:

Authority: 40 Stat. 266; (33 U.S.C. 1) and 40 Stat. 892; (33 U.S.C. 3).

2. Section 334.1244 is added to read as follows:

§ 334.1244 Rich Passage, Manchester Fuel Depot, Manchester, Washington; Naval Restricted Area.

(a) *The area.* The waters of Rich Passage and Puget Sound surrounding the Manchester Fuel Depot Point A, a point along the northern shore of the fuel depot at latitude 47°34' 03" North, longitude 122°32' 17" West; thence to latitude 47°34' 00" North, longitude 122°31' 50" West (Point B); thence to latitude 47°33' 37" North, longitude 122°31' 50" West (Point C); thence to latitude 47°33' 32" North, longitude 122°32' 06" West (Point D); thence to latitude 47°33' 45" North, longitude 122°32' 20" West (Point E), a point in Puget Sound on the southern shoreline of the Manchester Fuel Depot.

(b) *The regulation.* (1) All persons and vessels are prohibited from entering the waters within the restricted area for any reason without prior written permission from the Officer in Charge of the Manchester Fuel Depot.

(2) Mooring, anchoring, fishing, transit and/or swimming shall not be allowed within the restricted area without prior written permission from the Officer in Charge of the Manchester Fuel Depot.

(c) *Enforcement.* The regulation in this section shall be enforced by the Officer in Charge of the Manchester Fuel Depot, and such agencies and persons as he/she shall designate.

Approved: February 20, 2003.

Lawrence A. Lang,

Acting Chief, Operations Division, Directorate of Civil Works.

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DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Part 1

[Docket No.: 2003-P-007]

RIN 0651-AB59

Changes To Implement Electronic Maintenance of Official Patent Application Records

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice of proposed rule making.

SUMMARY: The United States Patent and Trademark Office (Office) has established a 21st Century Strategic Plan to transform the Office into a quality-focused, highly productive, responsive organization supporting a market-driven intellectual property system. One priority of the 21st Century Strategic Plan is the beginning-to-end electronic processing of patent applications. The Office is proposing changes to the rules of practice in this notice to adapt to a patent electronic image management system. Specifically, the changes proposed in this notice facilitate electronic data capture and processing, streamline the patent application process, and simplify and clarify the pertinent provisions of the rules of practice.

DATES: To be ensured of consideration, written comments must be received on or before April 24, 2003. No public hearing will be held.

ADDRESSES: Comments should be sent by electronic mail message over the Internet addressed to: PatentEFW.comments@uspto.gov. Comments may also be submitted by mail addressed to: Box Comments—Patents, Commissioner for Patents, Washington, DC 20231; or by facsimile

to (703) 872-9411, marked to the attention of Robert Clarke. Although comments may be submitted by mail or facsimile, the Office prefers to receive comments via the Internet. If comments are submitted by mail, the Office would prefer that the comments be submitted on a DOS formatted 3 1/2 inch disk accompanied by a paper copy.

The comments will be available for public inspection at the Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy, located at Room 3D65 of Crystal Plaza 3/4, 2201 South Clark Place, Arlington, Virginia, and will be available through anonymous file transfer protocol (ftp) via the Internet (address: <http://www.uspto.gov>). Since comments will be made available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included in the comments.

FOR FURTHER INFORMATION CONTACT:

Robert A. Clarke ((703) 305-9177), Senior Legal Advisor, or Robert J. Spar ((703) 308-5107), Director, Office of Patent Legal Administration (OPLA), directly by phone, or by facsimile to (703) 305-1013, marked to the attention of Mr. Clarke, or by mail addressed to: Box Comments—Patents, Commissioner for Patents, Washington, DC 20231.

SUPPLEMENTARY INFORMATION: The Office is increasing the integrity of its internal patent application record maintenance by adopting a new electronic data processing system for the storage and maintenance of all the records associated with patent applications. Because the system is consistent with the data processing system used by the European Patent Office (EPO), it will also improve information exchange among the Intellectual Property Offices.

The system will use image technology to replace the standard paper processing of patent applications currently used in the Office. The paper document application file contents (including the specification, oath or declaration, drawings, information disclosure statements, amendments, Office actions, and file jacket notations) of pending applications will be scanned into electronic image files. All processing and examination will be performed with the electronic image files, instead of the paper source documents, by all Office personnel.

The system will affect applicants minimally during the patent application process, because the program affects internal operations and not external communications. Applicants will continue to send and receive Office

correspondence in paper form, although the Office encourages use of the existing alternative electronic filing system resources for application filings and certain information disclosure statement submissions. The proposed changes to the rules of practice in title 37 of the Code of Federal Regulations (CFR) are designed to improve internal operations' use of the electronic format, primarily by easing the requirements upon applicants in amendment practice and information disclosure statement submissions. The electronic nature of patent records permits their viewing by the public through the Patent Application Information Retrieval (PAIR) system, which has a number of advantages: it provides notice to applicants of certain examination processing activities (e.g., mailing of Office actions); it assures confidence in the integrity of the Office records; it reduces the handling of the records; and it allows parallel processing of the application by various parts of the Office.

The technology and procedures for the new system are similar to those used at the EPO, but adapted to the Office's legal requirements and existing computer systems. The Office has incorporated the experience and lessons learned from the previously announced prototype program (*USPTO Announces Prototype of Image Processing*, 1265 *Off. Gaz. Pat. Office* 87 (December 17, 2002)) into a production system for all patent applications.

The electronic format of applications will reduce delays in moving information within the Office and between the Office, the applicant, other Intellectual Property (IP) Offices and other parties having authority to view the records. It will also reduce the potential for loss of records and misfiling, provide the capacity for multiple parties to access the records simultaneously, improve the efficiency of the publication process, and set the Office up for subsequent improvements in electronic communication related to applications between the Office, the applicant, and other parties.

It is also anticipated that the system will facilitate the sharing of information between the Office and other IP Offices. The Office anticipates that agreements to electronically transmit priority documents to certain other IP Offices as well as search results and other application information will be negotiated shortly. Transmission of priority documents electronically directly to the other IP Offices on request of the applicant is anticipated to reduce the overall costs to the applicant and to the other IP Offices (which

would receive the certified copy in a format that is easily stored and retrieved on demand). In tandem with this effort is a parallel effort to promote the sharing of information (e.g., search results) concerning related applications by the various IP Offices in order to reduce duplication of efforts, improve the efficiency and quality of examination efforts, and decrease workload. Thus, it is anticipated that the Office's migration to an electronic environment together with international negotiations will improve the efficiency and work quality of the Office.

Discussion of Specific Rules

Section 1.3: Section 1.3 is proposed to be amended to provide that papers presented in violation of the decorum and courtesy requirement will not be entered. The Office is capturing electronic images of all documents (papers) that will be the official records of certain applications. If the Office has captured the image as an electronic sheet(s), the Office would electronically remove the document from the Official file (the collection of documents related to a patent application or patent and which would be in this instance an electronic file) and from the Office computer systems. If the Office has not captured the image, the paper would not be entered in the Official file (which would in this instance be a paper file). In either event, the Office would provide notice in the Official file that the paper will not be available to the public. If the paper is intended as a reply to an Office action, the reply will not be considered a *bona fide* reply under § 1.135(c) and the period set in the prior Office action will continue to run. Similarly, a paper submitted in violation of § 10.10(b) that is intended as a reply will not be entered in the Official file and will not be treated as an unsigned reply (nor as a signed reply). Therefore, the reply will not toll the time period set in a prior Office action.

Section 1.9: Section 1.9 is proposed to be amended to clarify that the word "paper" and "papers" refer to a document or documents, which may be electronic records or physical paper sheet(s).

Section 1.14: Section 1.14 explains that applications for patents are generally preserved in confidence, and sets forth the special circumstances (35 U.S.C. 122(a)) under which a member of the public may have information about, copies of, or access to a patent application. Section 1.14 is proposed to be revised to clarify the rule and to expand the rule to provide for electronic files and electronic exchange of documents.

Paragraph (a)(1) has been rewritten to list the records that are available. The term “file wrapper and contents” has been replaced with the term “file contents” to avoid confusion with the paper (non-electronic) file jacket and its contents. Paragraph (a)(1) rephrases the provisions of current §§ 1.14(c) and (e) to assist the public in understanding what applications are available to the public. Accordingly, paragraph (a)(1), as rewritten, is divided into paragraphs (a)(1)(i) through (a)(1)(vi) listing different types of application files and explaining whether any part of the file content is available to the public. For example, paragraph (a)(1)(iii) explains that published pending applications are available to the public, upon written request, and payment of the appropriate fee, and that the original paper file of the pending application that was published as a patent application publication is not available to the public. In addition, it is proposed in the new paragraphs (a)(1)(iv) and (a)(1)(v) that where the benefit of an application is relied upon pursuant to 35 U.S.C. 119(e), 120, 121 or 365 in certain applications, the application will be available in the same manner that the application would have been had the application been referenced in a U.S. patent or U.S. patent application publication. As a result of this proposed rule change if an application is filed as a continuation of an earlier application, and the USPTO publishes the continuation as a patent application publication without a reference to the earlier application, the earlier-filed application will still be available to the public (either the originally filed application or the entire application file, depending upon whether the earlier-filed application is abandoned).

Paragraph (a)(2) is proposed to be revised to combine and restate current §§ 1.14(a)(1) and (b). The application number of any application that claims the benefit of the filing date of a patent or an application that has been published may be obtained from the Patent Application Information Retrieval (PAIR) system on the Office's web site at: <http://pair.uspto.gov>.

Section 1.14 is also proposed to be amended to have a new paragraph (b), to explain that electronic access may be provided to all or part of certain applications. Following migration to an electronic image file as the Official file of patent applications, access will be provided solely to the electronic Official file and not to the original paper document sheets used to create electronic images within the Official file.

Proposed § 1.14(c) is the same as current § 1.14(d). Paragraph (d) of current § 1.14 is proposed to be redesignated as § 1.14(c).

Proposed § 1.14(d) is the same as current § 1.14(f). Paragraph (f) of current § 1.14 is proposed to be redesignated as § 1.14(d).

Section 1.14 is also proposed to be amended to have a new paragraph (e), to provide that the Office may share its electronic application files that have not been published or otherwise made available to the public with another Intellectual Property (IP) Office pursuant to an agreement between the Office and another IP Office and if the applicant expressly consents. The written consent must be filed in the Office for the Office to transmit, or allow access by the other IP Office, to the application or other records associated with the application. The migration to an electronic environment will allow the Office to participate with other IP Offices in more rapid exchange of information, such as priority documents, between IP Offices. It should be noted that following publication, or where the application is otherwise available to the public, the written consent of applicant is not required before access to the application file is provided.

Paragraph (f) of § 1.14 corresponds to paragraph (g) of current § 1.14, which is proposed to be amended to move the text from (g) and of paragraph (g)(1) to paragraph (2), and to provide in the new paragraph (1) that any action of the Board of Patent Appeals and Interferences (BPAI), or any decision on petition, may be published or made available for public inspection without applicant's or patent owner's permission if rendered in a file open to the public pursuant to § 1.11 or available pursuant to § 1.14(e)(2), an application that has been published in accordance with §§ 1.211 through 1.221, or in an application claiming priority to, or the benefit of, an earlier filing date under 35 U.S.C. 119(a)–(d), 120, 121 or 365 of an application that has been published or patented. In paragraph (2), the rule would provide that an action of the BPAI, or any decision on petition, not publishable under paragraph (1) of this section, may be published or made available for public inspection if the Director believes the action or decision involves an interpretation of patent laws or regulations that would be of important precedential value; and the applicant, or any party involved in the interference, does not within two months after being notified of the intention to make the action or decision public, object in writing on the ground

that the decision discloses a trade secret or other confidential information and states that such information is not otherwise publicly available. If an action or decision discloses such information, the applicant or party shall identify the deletions in the text of the action or decision considered necessary to protect the information. If the applicant or the party considers that the entire action or decision must be withheld from the public to protect such information, the applicant or party must explain why. Applicants or parties will be given time, not less than twenty days, to request reconsideration and seek court review before any portions of actions or decisions are made public over their objection. This procedure is the same as that of current paragraph (g)(2), but has been reworded for clarity and also to use the terminology “any action” of the BPAI or “decision on petition” would be publishable, whereas the current rule uses the terminology “decision by the Director or the BPAI”.

Generally, patent applications are maintained in confidence unless the Director finds “special circumstances” due to which information about an application or the application itself may be released. See 35 U.S.C. 122(a). Section 1.14 sets forth when some such “special circumstances” have been found, and specifies when release of information about an application or access to all or part of an application may be provided without a petition. Accordingly, as one example of a “special circumstance,” as proposed to be amended with new paragraph (f)(1), a BPAI decision would be published, even if the decision does not involve an interpretation of patent laws or regulations that would be precedential so long as the application claims priority to or the benefit of an earlier application that has been published or patented (e.g., a Japanese patent application). The BPAI decision would be published even if the application in which the decision was made requests nonpublication of the application, and the application is not itself patented.

Proposed § 1.14(g) is the same as current § 1.14(h), which is proposed to be redesignated as § 1.14(g).

Proposed paragraph (h) of § 1.14 corresponds to current § 1.14(i), and is further proposed to be amended to explain the meaning of the terms “Home Copy,” “Search Copy,” and “Examination Copy,” and by inserting “of the publication” after “English language translation” in paragraph (b)(2). Section 13204 of Public Law 107–273 made a technical change to the provisional rights provisions of the

patent statute as to international applications to clarify that a translation of the international publication, as opposed to the international application, is required to be filed in order for a patent owner to obtain provisional rights pursuant to 35 U.S.C. 154(d). In view of this change to the statute, the corresponding reference to the translation in § 1.14 is proposed to be changed to add “a publication of an international patent application” after “English language translation of.” In addition, it is proposed that the parenthetical phrase at the end of paragraph (h)(1), referencing the fee for a copy of an international application file, or a copy of a document in a file, be changed from a reference to § 1.19(b) rather than § 1.19(b)(2) or § 1.19(b)(3), the fees for the contents of a file or a CD, and the parenthetical phrase at the end of paragraph (h)(2), referencing the fee for a copy of an English language translation in a file, be corrected to refer to § 1.19(b)(4), the fee for a document, rather than § 1.19(b)(2) or § 1.19(b)(3).

Proposed § 1.14(i) is the same as current § 1.14(j), which is proposed to be redesignated as § 1.14(i).

As proposed to be amended, § 1.14 will apply to all patent applications filed before, on, or after the date that the amendment to § 1.14 becomes final.

Section 1.17: Section 1.17 is proposed to be amended to eliminate the reference to returning information in paragraph (h) because expunged information will not be returned under § 1.59 as proposed to be amended.

Section 1.19: Section 1.19 is proposed to be amended by revising paragraph (b)(1) to eliminate the fee for providing an electronic copy of an application as filed to another IP Office if applicant consents in writing by filing an authorization under 35 U.S.C. 122(a) to permit the Office to exchange information related to the entire file record of the application with the other IP Office. The electronic transmission would serve as the certified copies of applications as filed that can be required by the other IP Offices under Article 4(D)(3) of the Paris Convention.

Section 1.52: Section 1.52 is proposed to be amended to clarify the requirement for proper paper sizes in paper communications submitted to the Office and to set forth the analogous requirements for electronic communications.

The Office plans to capture electronic images of all documents that form the record of patent examination. These images will form the Official file of the application. Applicants will have the option of submitting application documents and other communications

to the Office on paper, by facsimile transmission, or via the Office's electronic filing system (EFS). The existing requirements for paper and facsimile submissions (as well as the prohibition against filing patent applications by facsimile, see § 1.6(d)(3)) are retained, and the requirements for electronic submissions are added. One newly added requirement for paper submissions requires that the papers not be permanently bound because the papers must be readily separable for scanned entry into the image system. The use of binder clips or standard office staples will generally be acceptable. The detailed requirements for electronic submissions are provided in the Office's EFS documentation (available electronically at www.uspto.gov) and the proposed amendments direct the affected party's attention to those requirements.

Paragraph (a)(1) of § 1.52 is proposed to be amended to clarify that it pertains to paper and facsimile submissions, and that such submissions not be permanently bound together.

Paragraph (a)(2) of § 1.52 is proposed to be amended to clarify that it pertains to paper and facsimile submissions.

Paragraph (a)(3) of § 1.52 is proposed to be amended to clarify that it pertains to paper and facsimile submissions.

Paragraph (a)(5) of § 1.52 is proposed to be amended to clarify that it pertains to paper and facsimile submissions.

Paragraph (a) of § 1.52 is also proposed to be amended by adding paragraphs (a)(6) and (a)(7) to set forth that papers submitted electronically must comply with the Office's EFS requirements and that failure to comply will result in a requirement for correction.

Paragraphs (b)(3) and (b)(4) of § 1.52 are proposed to be amended to clarify that the requirements for the abstract and claims to begin on a separate sheet on physical paper are similarly required to begin on a separate electronic page in an electronic submission.

Paragraph (b)(7) of § 1.52 is proposed to be amended to explain the consequences of a failure to provide compliant papers within the set time period. That is, as proposed to be amended, the rule will provide that compliant papers must be provided within the set time period in order to avoid abandonment of the application in the case of an applicant for patent, termination of proceedings in the case of a patent owner in a reexamination proceeding, or refusal of consideration of the papers in the case of a third party requester in a reexamination proceeding.

Section 1.59: Section 1.59 is proposed to be amended to eliminate references to returning documents that have been expunged to recognize that, with electronic Official files, there will be nothing to return when a paper is expunged. The Office is capturing electronic images of all documents that form the Official file. Where the image is generated from a physical source document, the originating document may be disposed of once the electronic image accuracy is verified. Therefore, if a document is to be expunged from the record, the only operation that will be required will be removal of the image from the Official file. Paragraph (a)(1) of § 1.59 is proposed to be amended by deleting the phrase “and returned” from the first sentence, and deleting the second sentence. Paragraph (b) of § 1.59 is proposed to be amended by deleting the phrase “and return” from each of the first and second sentences.

Section 1.71: Section 1.71 is proposed to be amended by adding a new paragraph (f) to require that the first page of a specification commence on a new sheet and to require that no sheet including part of the text of the specification include any other material. Claims must also commence on a new sheet and in accordance with the proposed changes to § 1.75, must not include other parts of the application.

Section 1.72: Paragraph (b) of § 1.72 is proposed to be amended to prohibit the paper presenting the abstract to include any other portions of the application or other material. Presentation of material other than the abstract on the same page as the abstract makes the electronic indexing of the application more difficult. In addition, it is proposed to remove the last sentence of paragraph (b) to eliminate the prohibition on using the abstract to be used to interpret the claims to conform the rule to be consistent with Federal Circuit case law. *See Hill-Rom Co. v. Kinetic Concepts, Inc.*, 209 F.3d 1337, 1341 n. *, 54 USPQ2d 1437, 1440 n.1 (Fed. Cir. 2000).

Section 1.75: Paragraph (h) of § 1.75 is proposed to be amended to prohibit a paper presenting claims from including any other portions of the application or other material. Presentation of material other than the claims on the same page as one or more claims makes the electronic indexing of the application more difficult.

Section 1.97: Section 1.97 is proposed to be amended to move the last date on which an information disclosure statement (IDS) may be filed to the day prior to the mailing of the next Office action from the Office.

Sections 1.97(b) and (c) are proposed to be amended to move the last date on

which an IDS may be filed from the day of mailing of an Office action to the day before the mailing of an Office action.

Section 1.97(b)(3) is proposed to be amended to require filing of an IDS before the day of the mailing of the first Office action.

Section 1.97(b)(4) is proposed to be amended to require filing of an IDS before the day of the mailing of the first Office action after the filing of a request for continued examination under § 1.114.

Section 1.97(c) is proposed to be amended to require filing of an IDS before the day of the mailing of any of a final action under § 1.113, a notice of allowance under § 1.311, or an action that otherwise closes prosecution in the application, provided it is accompanied by one of: (1) The statement specified in § 1.97(e); or (2) the fee set forth in § 1.17(p).

With PAIR, applicants can easily determine when Office actions are mailed by reviewing the change of status information for an application that is available over the Internet. Unless applicants are required to submit an IDS before Office actions are mailed, applicants may unfairly delay prosecution to meet their short-term needs by mailing an IDS on the same day as Office actions are mailed upon seeing that a mailing occurred through PAIR. Therefore, in order to promote efficient processing and provide the benefits of PAIR, a change in the "mailing rule" is being proposed.

Section 1.98: Section 1.98 is proposed to be amended by adding a new paragraph (e), which provides that the requirement in § 1.98(a)(2)(i) for a copy of all listed U.S. patents and U.S. patent application publications does not apply to any IDS submitted in compliance with the Office's electronic filing system. Thus, for any IDS submitted to the Office via the Office's EFS, paper copies of U.S. patents and U.S. application publications cited in the IDS would no longer have to be supplied by applicants.

An EFS software upgrade has added an IDS, submitted under the provisions of §§ 1.97 and 1.98, as a type of electronic submission that may be made via the Office's EFS. Currently, the EFS may only be used to submit: (1) Certain non-provisional utility patent applications; (2) provisional applications; (3) biotechnology sequence listings; (4) copies of patent applications for purposes of having the copies of the patent application published (redacted publication, republication as amended, or voluntary publication); (5) assignments of patents and applications; and (6) Information

Disclosure Statements. *See Legal Framework for the Use of the Electronic Filing System*, 1263 *Off. Gaz. Pat. Office* 60, 61 (Oct. 8, 2002). With the EFS software upgrade, an applicant is able to electronically transmit an IDS with the filing of a new utility patent application, or as a subsequent filing. This EFS software upgrade is NOT usable for third party information disclosure submissions under § 1.99. The IDS submission via EFS is the only electronic substitute for a paper IDS submission contemplated. EFS has been available to the general public for limited electronic filing since October 2000. *See Electronic Filing System Available to Public*, 1240 *Off. Gaz. Pat. Office* 45 (Nov. 14, 2000).

Applicants may file an IDS via EFS by (1) entering the references' citation information in a fillable electronic form, equivalent to the paper PTO-1449 form (or revised form PTO/SB/08A and 08B) by using EFS software; and (2) transmitting the fillable electronic form data to the Office via EFS. This electronic EFS form currently allows only citations for U.S. patents and U.S. patent application publications. If any references to foreign patent documents or non-patent literature documents or unpublished U.S. applications are to be cited, then applicants will continue to submit those citations on a separate, conventional paper PTO-1449 form (or equivalent form) delivered with a printed copy of each cited foreign patent document, non-patent literature document and unpublished U.S. application via mail, facsimile transmission, or hand delivery. Applicants need not send the Office copies of any U.S. patent or U.S. application publication documents cited on a fillable electronic IDS form that is electronically transmitted to the Office via EFS. In those instances in which an applicant sends an IDS on the same day by EFS and by conventional delivery, and a fee under § 1.97 is due, only one fee will be due if the applicant informs the Office in the conventional submission that such a submission is associated with an electronic submission on the same day in which the fee was paid.

The EFS software provides a fillable electronic IDS form equivalent to a paper PTO-1449, Information Disclosure Statement form, in which citations for up to 50 U.S. patents and up to 50 U.S. patent application publications may be entered. This EFS fillable form has fields where statements of relevance and where notifications that the documents were cited in a communication from a foreign patent Office in accordance with § 1.97(e) may

be given. The EFS upgrade validates the format of data entered into the fillable electronic IDS form and provides the means to specify whether this fillable EFS IDS form is to be linked to an accompanying new application filing or is being filed in a previously filed application, and transmit the XML formatted IDS data on the fillable electronic form to the Office. The EFS software also provides fields to enter required fee payment information under §§ 1.97(c)(2) and (d)(2).

The fillable, EFS IDS form will be entered as a paper (but will actually be part of an electronic database) into the application file contents indicating that it was received on the date the complete transmission containing the form was received in the Office via EFS. This is the date the Office will refer to in considering compliance with § 1.97.

Examiners will consider the U.S. patents and U.S. application publications cited on an EFS transmitted IDS form provided the remaining requirements of §§ 1.97 and 1.98 are met, by reviewing electronic or printed copies produced from the Office's electronic databases. It will be most important that the cited patent and application publication numbers be accurate and devoid of transcription error. There will be no applicant-provided copies of the disclosed documents in the application file for the examiner to review. Instead, because the Office will electronically retrieve the patents and application publications so identified by those numbers, the examiner will only be able to consider the documents so identified. As a corollary, examiners will only consider what is actually cited. Where, for example, an error is made in transcribing a U.S. patent number, and the examiner, after retrieving the patent associated with the number as entered in the IDS, determines that the patent associated with the number as entered in the IDS is not the correct number, because the inventor's name and issue date entered in the IDS does not match the corresponding data on the patent associated with the patent number entered in the IDS, the examiner will follow the procedure regarding the handling of non-complying information disclosure statements set forth in section 609 III(C)(1) of the *Manual of Patent Examination Procedure* (8th ed. 2001) (MPEP). The examiner may either initial the paper copy printed from the electronic IDS to indicate that the erroneously cited patent has been reviewed or line through the citation as not in compliance with § 1.98.

The only procedure for having such documents considered when an

erroneous patent or application publication number is cited in an eIDS will be by citing the correct document identifying number in a subsequent IDS, either paper or electronic, that conforms to the requirements of §§ 1.97 and 1.98, as specified in MPEP 609 III(C)(1) regarding corrections of the information in non-complying information disclosure statements.

The IDS may be submitted as part of an EFS electronic application filing, or subsequent to an application filing, either in paper or via EFS. The ePAVE program will prompt the filer to associate an IDS file with a new application file and to provide payment information, where either is appropriate. As with the other types of electronic submissions, ePAVE will validate the format, display it to the filer, prompt for the filer's electronic signature, use the filer's digital certificate (a digital certificate may be obtained from the Office's Electronic Business Center), to encrypt the whole package, and transmit the submission to the Office. Upon receipt, the Office will send to the filer an electronic post card "Acknowledgement Receipt", including a server date stamp, a unique server number, the application number, and confirmation of the number of the files received by the Office. If the IDS submission is subsequent to the application filing, the filer will be required to enter both an application number and a confirmation number. A confirmation number is an additional four-digit identifier assigned to an application, and can be found in the upper left-hand corner of the official filing receipt. A filer will be required to have a customer number, obtained from the Office's Electronic Business Center, and an Office provided digital certificate to use EFS as with current practice.

Section 1.99: Section 1.99 is proposed to be amended to provide that the Office will not enter any explanation of the patents or publications, or any other information (that is not limited to patents or publications) included in a submission. The Office will also not enter a submission that is not in compliance with the requirements of this section. The Office is capturing electronic images of all documents that form the Official file of certain applications and the original paper documents, if stored, will be stored off-site and will not be easily accessible, and if destroyed, will not be available. Therefore, any submission, or part of the submission, that is not in compliance with this section would not be captured as electronic images and, if such documents have been entered into the Official file, the Office will

electronically remove the documents from the Official file.

Paragraph (d) of § 1.99 is proposed to be amended by deleting the word "dispose of" and replacing it with "not enter." Paragraph (e) of § 1.99 is proposed to be amended by deleting the phrase "returned or discarded" and replacing it with "will not be entered".

Section 1.121: The manner of making amendments to the specification, claims and drawings is being revised with proposed changes to § 1.121. While the process of making amendments would generally remain the same, relying on the use of replacement versions of the specification, claims and drawing figures, the process for submitting amendments is simplified. The submission of two versions (clean and marked-up) of amended subject matter, and the attendant editorial difficulties associated with this practice, will no longer be required other than for substitute specifications. For amending the specification (§ 1.121(b)(1) and (b)(2)), applicants would be required to submit a replacement paragraph or section marked-up to show changes relative to the immediate prior version. No clean version of replacement paragraphs or sections would be required. When the specification is to be amended extensively, a substitute specification marked-up to show changes relative to the immediate prior version would be submitted, as per § 1.125 which is invoked by § 1.121(b)(3). In this situation, a clean version of the specification would also be required, as per current § 1.125(c). For amending the claims (§ 1.121(c)), applicants would be required to provide replacement claims (marked-up to show changes relative to the immediate prior version) as part of a complete listing of all the claims in the application each time a claim is amended, which listing would include the status of each claim, and the text of each pending claim under examination. No separate clean version would be required at the time a claim is amended. For amending drawing figures (§ 1.121(d)), applicants would be required to submit a replacement figure with the changes made. No pre-approval of proposed changes in red ink will be required. In each situation, an explanation of the changes must be supplied.

This proposed revised process for amending the specification, claims and drawing figures of pending patent applications will further facilitate the advent of electronic examination in the Office. The principal feature of this proposal, and the one which would most significantly impact the examination process, would require that

a complete listing of claims (which includes the status of all claims and the text of pending claims under examination) be submitted as part of each amendment document that includes any amendments to the claims, with the complete listing totally replacing any and all previous versions of claims throughout an application. The conversion of all paper-based application files into electronic image format, together with the proposed changes to amendment practice, will enable the complete listing of all of the claims to be conveniently located and easily accessed on a computer screen for review by a patent examiner or the applicant, or where the application is open to the public.

In order to promote uniformity and consistency of practice, the Office, in the proposed changes to § 1.121, would require applicants to utilize only strike-through for deleted subject matter and underlining for added subject matter as markings to show changes made. No other method of markings will be permitted.

As a result of the adoption of the proposed changes to § 1.121, applicants will, in most cases, no longer be required to reproduce lengthy segments of the specification in both clean and marked-up versions. Only a marked-up version of a replacement paragraph or section will be required. Where a substitute specification has been provided because of extensive amendments, the substitute specification should be supplied as a clean replacement version, which will be entered. A marked-up version is also necessary to the examination process to show the examiner the changes that were made. These requirements are the same as the current requirements of § 1.125(b) and (c) for submitting a substitute specification. With respect to the claims, the proposed changes will result in the filing of a complete listing of all of the claims in the application, and the status of each claim (in the listing), in a single amendment document each time an amendment to the claims is made. The status of every claim will be indicated in a parenthetical expression following each claim number, using the identifiers "(original)", "(previously amended)", "(currently amended)", etc. Only the claims being changed at the time an amendment is filed will include the markings to show the changes. Claims not currently amended will be presented in the same amendment document in clean version. Applicants will no longer be required to submit both a clean version and a separate marked-up version of claims being

changed. Further, the submission of a clean version in addition to a marked-up version is strongly discouraged. Dual versions (clean and marked-up) may get confused and the wrong version may get entered into the application file. In such an event, an incorrect message would be given, as providing any claim text in clean version will be taken to be an assertion by applicants that no changes have been made relative to the immediate prior version. The burden of ensuring accuracy between the most recent and the prior versions would be borne by applicants.

Amendments to a drawing figure will be made by submitting the actual changes in a replacement drawing sheet which is in compliance with § 1.84. If multiple drawing figures are on a single drawing sheet, the replacement drawing sheet should include the figures which have not been revised as well as the revised drawing figure(s). A detailed explanation of each of the changes made to a drawing figure must also be provided in a separate section of the amendment document. If the changes are not acceptable to or approved by the examiner, the applicant would be notified and given a requirement for corrective action in the next Office action. In the absence of an objection to the drawings, no further drawing submission by applicant will be required.

The proposed changes to amendment practice, if adopted in the final rule, will provide amendments ready for scanning and indexing into an electronic image format and incorporated into an electronic file wrapper that will be available and accessible to examiners on their individual PCs for further examination. Due to the large backfile of pending applications in the Office, the implementation of the scanning system and the creation of electronic file wrappers will be phased into the technology centers over a period of time. The proposed changes to the rule will require applicants to consolidate all of the claims of any currently pending application into a single amendment document each time any claim is amended, or a new claim is added. In the final rule, if it is adopted as proposed, all amendment documents will be required to include the full text of all pending claims (except for withdrawn claims) with their status in parentheses after the claim numbers, as well as an indication of the status of any claims which have been currently or previously canceled or withdrawn.

Section 1.121(b) is proposed to be amended to clarify that applicants must make amendments to the specification

by use of (1) replacement paragraph, or (2) replacement section. Provisions for submitting a substitute specification have been cross-referenced to § 1.125. Provisions for amending claims are provided for in other sections of this rule (paragraph (c)).

It is proposed that paragraphs (b)(1)(ii), (b)(2)(ii) and (b)(3)(ii) be changed to require that the amendment include a version of the amended paragraph, section or substitute specification (by reference to § 1.125) marked-up to show the changes by using "strike-through" as the method for showing deletions of subject matter in the specification. Similarly the Office proposes to require underlining to show additions of subject matter. Only strike-through and underlining should be used as the method to show changes.

It is further proposed to eliminate current paragraphs (b)(1)(iii), (b)(2)(iii) and (b)(3)(iii).

It is proposed to add new paragraph (b)(5) to indicate that precise instructions as to location of the changes must be provided for entry of amendments to the specification. Deletion of a paragraph or section may be made by instruction to cancel only; no actual text to be canceled should be submitted. Once an amended paragraph, section, or substitute specification is presented in an amendment document, there is no further need for the applicant to re-present the amended submission in a subsequently filed amendment document.

It is proposed to replace current paragraphs (c)(1) through (c)(3) with revised paragraphs (c) and (c)(1) through (c)(5). Paragraph (c) as revised would provide for a total rewriting of a claim each time the claim is amended, including markings to show the changes being made relative to the immediate prior version of the claim. This section would also require submitting a complete listing of all pending claims in the application, including the status of each and every claim in every amendment document that includes an amendment to the claims. This listing would replace all prior versions of the claims (except for any withdrawn claims), and listings of the claims in the application. The claim status required with each amendment document would be indicated in a parenthetical expression following the claim number. The status of all claims in the application, even those previously canceled or withdrawn, would be indicated with each amendment document.

In order to promote uniformity and consistency, only the following defined identifiers should be used to indicate

the status of the claims (in parentheses after the claim number):

- (Original): Claim filed with the application
- (Currently amended): Claim being amended in the current amendment document
- (Previously amended): Claim not being currently amended, but which was amended in a previous amendment document
- (Canceled): Claim deleted from the application
- (Withdrawn): Claim still in the application, but in a nonelected status
- (Previously added): Claim added in an earlier amendment document
- (New): Claim being added in the current amendment document
- (Reinstated—formerly claim # _): Claim deleted in an earlier amendment document, but represented with a new claim number in current amendment
- (Previously reinstated): Claim deleted in an earlier amendment and reinstated in an earlier amendment document
- (Re-presented "formerly dependent claim # _): Dependent claim re-presented in independent form in current amendment document
- (Previously re-presented): Dependent claim re-presented in independent form in an earlier amendment, but not currently amended

As a result of this proposed change, each amendment document would be self-contained, *i.e.*, it would include a complete set of claims for examination and would provide the status of all of the claims in one location in the file.

An example of how the claims, and the status of the claims, would be presented is as follows (use of the word "claim" before the claim number is optional):

- Claims 1–5 (canceled) (Note: consecutive canceled or withdrawn claims may be aggregated)
- Claim 6 (withdrawn)
- Claim 7 (previously amended): A bucket with a handle
- Claim 8 (currently amended): A bucket with a green blue handle
- Claim 9 (withdrawn)
- Claim 10 (original): A bucket with a wooden handle
- Claim 11: (new): A bucket with plastic sides and bottom

Paragraph (c)(1) would require the use of strike-through (for deletions) and underlining (for additions) to indicate how an amended claim differs from its immediate prior version. The proposed amendment to this section eliminates the previously accepted use of equivalent marking systems. No other

method of markings or comparison (other than strike-through and underlining) would be permitted. Only claims of the status "currently amended" would include markings showing changes made.

Paragraph (c)(2) would require that the current amendment document include not only the marked-up version of claims being currently amended, but also the submission of a clean version of pending claims not being amended in the current amendment document. The presentation of clean text (not underlined) in any claim would constitute an assertion that no changes have been made from the immediate prior version of the same claim. This would relieve the Office of the burden of cross-reading various versions of the same claim to ensure accuracy of rewritten claims. The text of canceled or withdrawn claims should not be presented in each amendment document; these claims should be indicated as being in the status of "(canceled)" or "(withdrawn)".

Paragraph (c)(3) would provide for the cancellation of any claim by mere instructions to cancel. If no instructions to cancel a specific claim were submitted in an amendment paper, listing the claim as canceled in the claim status would constitute an instruction to cancel the claim; no other instruction would be necessary. Any added claims (in the current amendment document) should be merely identified in the status parenthetical expression as "(new)" and should not be underlined.

As proposed in paragraph (c)(4), the claims should be presented in ascending numerical order. This would prevent the grouping of claims by status (all new claims together, all amended claims together, etc.), and ensure a complete set of claims in numerical order, regardless of status. Consecutive claims of the same status, however, could be aggregated (e.g., "Claims 1-5 (previously canceled)"). Further, it is proposed to revise paragraph (c)(4) to require that any sheet of an amendment paper including part of the text of a claim shall not include material directed to any other part of the amendment or any remarks concerning the claims. This requirement will facilitate indexing of the application papers.

Paragraph (c)(5) would require that a claim canceled in its entirety could only be reinstated if presented as a new claim with a new claim number.

Paragraph (d) would require that any drawing changes be submitted in compliance with § 1.84 on replacement sheets in an attachment to an

amendment document. An accompanying detailed explanation of all of the changes would be provided on a separate sheet in the drawing amendments or remarks section of the amendment document. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant would be notified and informed of any required corrective action in the next Office action. No further drawing submission of the amended drawing figure(s) by applicant would be required, unless applicant is so notified.

As proposed in paragraph (d)(1), the applicant would be permitted to provide a marked-up copy of any figure being amended with the amendment document. This mark-up would be used by the Office to determine the changes being made in the drawings.

As proposed in paragraph (d)(2), examiners would be permitted to require a marked-up copy of a figure that has been or is required to be revised. The examiner may make the requirement in an Office action requiring a drawing correction, or after a drawing amendment has been made.

A change is proposed to the last line of paragraph (g) in order to bring it into conformity with earlier changes, "(c)(1)" is changed to "(c) and (c)(1) through (c)(5)".

It is proposed that paragraph (h) be added to require that each section of an amendment (e.g., amendments to the claims, amendments to the specification, replacement drawings, remarks) begin on a separate sheet of the amendment paper.

Paragraphs (h), (i), and (j) have been renamed as (i), (j), and (k), respectively.

Section 1.125: Paragraph (b) is proposed to be revised to add a cross-reference to § 1.312 to remind applicants that for submissions of substitute specifications filed after the notice of allowance has been mailed and up to the time of payment of the issue

fee, entry of the substitute specification is not a matter of right.

Paragraphs (c) of § 1.125 is proposed to be revised to require the presentation by applicant of both a marked-up version of the specification (using strike-through to indicate deleted subject matter and underlining to indicate added subject matter) and a clean version without markings.

Section 1.823: Section 1.823 is proposed to be amended by revising paragraph (a)(1) to require that any sheet including a part of a sequence listing not include material other than part of a sequence listing. This change is to facilitate indexing of the specification.

Rule Making Considerations

Administrative Procedure Act: This notice proposes changes to the rules of practice that facilitate electronic image record management of patent application files to support the beginning-to-end electronic processing of patent applications. The changes proposed in this notice are limited to the format for and the manner of making amendments to patent applications, the handling of patent applications and other papers within the Office, the manner of filing information disclosure statements, and the procedures for electronic exchange of priority documents with other intellectual property offices. Therefore, these changes involve rules of agency practice and procedure under 5 U.S.C. 553(b)(A). *See Bachow Communications Inc. v. FCC*, 237 F.3d 683, 690 (D.C. Cir. 2001). Therefore, prior notice and opportunity for public comment are not required pursuant to 5 U.S.C. 553(b) or (c) (or any other law). Nevertheless, the Office is providing this opportunity for public comment on the changes proposed in this notice because the Office desires the benefit of public comment on these proposed changes.

Regulatory Flexibility Act: As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 (or any other law), an initial regulatory flexibility analysis under the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*) is not required. *See* 5 U.S.C. 603.

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

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

Paperwork Reduction Act: This proposed rule involves information collection requirements which are

subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*). The collections of information involved in this proposed rule have been reviewed and previously approved by OMB under the following control numbers 0651-0021, 0651-0031, 0651-0032 and 0651-0033. The United States Patent and Trademark Office is not resubmitting an information collection package to OMB for its review and approval because the changes in this proposed rule would not affect the information collection requirements associated with the information collection under OMB control numbers 0651-0021, 0651-0031, 0651-0032 and 0651-0033.

The title, description and respondent description of each of the information collections is shown below with an estimate of the annual reporting burdens. Included in the estimate is the time for reviewing instructions, gathering and maintaining the data needed, and completing and reviewing the collection of information. The principal impacts of the changes in this proposed rule are to (1) expressly provide for the electronic submission of an information disclosure statement; (2) provide for a slight change in the format of an application being filed in order to accommodate for the scanning and indexing of different sections of the application file; and (3) provide for a change in the manner of making amendments to an application consistent with the Office's efforts to establish a patent electronic image management system.

OMB Number: 0651-0021.

Title: Patent Cooperation Treaty.

Form Numbers: PCT/RO/101, ANNEX/134/144, PTO-1382, PCT/IPEA/401, PCT/IB/328, PTO/SB/61/PCT, PTO/SB/64/PCT.

Type of Review: Approved through December of 2003.

Affected Public: Individuals or Households, Business or Other For-Profit, Federal Agencies or Employees, Not-for-Profit Institutions, Small Businesses or Organizations, farms, and State, Local or Tribal Government.

Estimated Number of Respondents: 331,407.

Estimated Time Per Response: 0.25 (15 minutes) to 4.0 (4 hours).

Estimated Total Annual Burden Hours: 401,202 hours.

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

procedure and a standardized application format.

OMB Number: 0651-0031.

Title: Patent Processing (Updating).

Form Numbers: PTO/SB//08A/08B/21/22/23/24/25/26/27/30/31/32/35/37/36/42/43/6161/PCT/62/63/6464/PCT/67/68/91/92/96/97 PTO-2053-A/B PTO-2054-A/B PTO-2055-A/B.

Type of Review: Approved through April of 2003.

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

Estimated Number of Respondents: 2,247,270.

Estimated Time Per Response: 1 minute 48 seconds to 4 hours.

Estimated Total Annual Burden Hours: 1,021,822 hours.

Needs and Uses: During the processing for an application for a patent, the applicant/agent may be required or desire to submit additional information to the United States Patent and Trademark Office concerning the examination of a specific application. The specific information required or which may be submitted includes: Information Disclosure Statements; Submission of priority documents and Amendments.

OMB Number: 0651-0032.

Title: Initial Patent Application.

Form Number: PTO/SB/01-07/13PCT/16-19/29/101-110.

Type of Review: Approved through April of 2003.

Affected Public: Individuals or Households, Business or Other For-Profit Institutions, Not-For-Profit Institutions, farms, Federal Government, and State, Local, or Tribal Governments.

Estimated Number of Respondents: 319,350.

Estimated Time Per Response: 24 minutes to 10 hours and 75 minutes.

Estimated Total Annual Burden Hours: 2,984,360 hours.

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

OMB Number: 0651-0033.

Title: Post Allowance and Refiling.

Form Numbers: PTO/SB/44/50/51, 51S/52/53/55/56/57/58, PTOL-85B.

Type of Review: Approved through January of 2004.

Affected Public: Individuals or Households, Business or Other For-Profit Institutions, Not-For-Profit Institutions, farms, State, Local and Tribal Governments, and Federal Government.

Estimated Number of Respondents: 205,480.

Estimated Time Per Response: 0.03 (2 minutes) to 2.0 (2 hours).

Estimated Total Annual Burden Hours: 63,640 hours.

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

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

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

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

List of Subjects in 37 CFR Part 1

Administrative practice and procedure, Courts, Freedom of information, Inventions and patents,

Reporting and record keeping requirements, Small businesses.

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

PART 1—RULES OF PRACTICE IN PATENT CASES

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

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

2. Section 1.3 is revised to read as follows:

§ 1.3 Business to be conducted with decorum and courtesy.

Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. Complaints against examiners and other employees must be made in correspondence separate from other papers.

3. Section 1.9 is amended by adding paragraph (R) to read as follows:

§ 1.9 Definitions.

* * * * *

(R) Paper as used in this Chapter means a document that may exist in electronic, computer readable form or in physical form, and therefore does not necessarily imply physical sheets of paper.

* * * * *

4. Section 1.14 is revised to read as follows:

§ 1.14 Patent applications preserved in confidence.

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

(1) Records associated with patent applications other than international applications (see paragraph (h) of this section for international applications) shall be available in the following situations:

(i) *Patented applications and Statutory Invention Registrations.* The file of an application that has issued as a patent or published as a statutory invention registration is available to the

public as set forth in § 1.11(a). A copy of the patent application-as-filed, the file contents of the application, or a specific document in the file of such an application shall be provided upon request and payment of the appropriate fee set forth in § 1.19(b).

(ii) *Published abandoned applications.* The file of an abandoned application that has been published as a patent application publication 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 shall 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 published application, or a specific document in the file of a pending application that has been published as a patent application publication shall 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 referenced in certain documents.* The file contents of an abandoned application that is referenced in a U.S. patent, Statutory Invention Registration, a U.S. patent application publication, or an international patent application publication of an international application that was published in accordance with PCT Article 21(2) are available to the public, if a written request is submitted. Also, the file contents of an abandoned application that is relied upon under 35 U.S.C. 119(e), 120, 121, or 365 by an application that has issued as a U.S. patent, or in an application that has published as a Statutory Invention Registration, U.S. patent application publication, or an international patent application publication that was published in accordance with PCT Article 21(2) are available to the public, if a written request is submitted. A copy of the application-as-filed, the file contents of the application, or a specific document in the file of the application shall be provided to any person upon written request, and payment of the appropriate fee (§ 1.19(b)).

(v) *Unpublished pending applications that are referenced in certain documents.* A copy of the application-as-filed of a pending application that is referenced in a U.S. patent, Statutory Invention Registration, a U.S. patent application publication, or an international patent application publication that was published in accordance with PCT Article 21(2) shall be provided to any person upon written request, including the fee set forth in § 1.19(b)(1). Also, a copy of the application-as-filed of a pending application that is relied upon under 35 U.S.C. 119(e), 120, 121, or 365 by 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, or an international patent application publication that was published in accordance with PCT Article 21(2) shall be provided to any person upon written request, including the fee set forth in § 1.19(b)(1). Until the application is abandoned, patented, or published as a Statutory Invention Registration or a U.S. patent application publication, a granted petition for access (see paragraph (i) of this section), or a power to inspect (see paragraph (c) of this section) is necessary to obtain the file of the application.

(vi) *Applications that were not published or patented, and are not referenced in a U.S. patent, a Statutory Invention Registration, a U.S. patent application publication, or an international patent application publication that was published in accordance with PCT Article 21(2), or relied upon under 35 U.S.C. 119(e), 120, 121, or 365 in an application that has issued as a U.S. patent, or been published as a Statutory Invention Registration, a U.S. patent application publication, or an international patent application publication that was published in accordance with PCT Article 21(2).* Applications that were not published or patented, and are not referenced in a U.S. patent, a Statutory Invention Registration, a U.S. patent application publication, or an international patent application publication that was published in accordance with PCT Article 21(2) are not available to the public, unless the application that issued as the U.S. patent or was published as the Statutory Invention Registration, U.S. patent application publication, or an international patent application publication that was published in accordance with PCT Article 21(2) claims the benefit of the application under 35 U.S.C. 119(e), 120, 121, or 365.

A granted petition for access (see paragraph (i) of this section), or a power to inspect (see paragraph (c) of this section) is necessary to obtain the application, or a copy of the application.

(2) Information concerning a patent application may be communicated to the public if the patent application is identified in paragraphs (a)(1)(i) through (a)(1)(v) of this section. The information that may be communicated to the public (*i.e.*, status information) includes:

(i) Whether the application is pending, abandoned, or patented;

(ii) Whether the application has been published under 35 U.S.C. 122(b);

(iii) The application "numerical identifier" which may be:

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

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

(iv) Whether an 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 or 365 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).

(b) *Electronic access to an application.* Where a copy of the application papers or access to the application is available pursuant to paragraphs (a)(1)(i) through (a)(1)(v) of this section, the Office may at its discretion provide access only to an electronic copy of the specification, drawings, and file contents of the application.

(c) *Power to inspect a pending or abandoned application.* Access to an application shall be provided to any person if the application file is available, and the application contains written authority (*e.g.*, a power to inspect) granting access to such person. The written authority must be signed by:

(1) An applicant;

(2) An attorney or agent of record;

(3) An authorized official of an assignee of record (made of record pursuant to § 3.71 of this chapter); or

(4) A registered attorney or agent named in the papers accompanying the application papers filed under § 1.53 or the national stage documents filed under § 1.495, if an executed oath or

declaration pursuant to § 1.63 or § 1.497 has not been filed.

(d) *Applications reported to Department of Energy.* Applications for patents which appear to disclose, purport to disclose or do disclose inventions or discoveries relating to atomic energy are reported to the Department of Energy, which Department will be given access to the applications. Such reporting does not constitute a determination that the subject matter of each application so reported is in fact useful or is an invention or discovery, or that such application in fact discloses subject matter in categories specified by 42 U.S.C. 2181(c) and (d).

(e) *Unpublished applications provided to other Intellectual Property Offices.* Before a patent application is published or otherwise becomes available to the public pursuant to paragraphs (a)(1)(i) through (a)(1)(iv) of this section, the Office may, pursuant to an agreement between the Office and another Intellectual Property (IP) Office, provide the other IP Office with access to the electronic record of the application without charge to applicant, if applicant consents. After an application has been published, such consent is not required.

(f) *Decisions by the Director or the Board of Patent Appeals and Interferences.*

(1) Any action of the Board of Patent Appeals and Interferences, or any decision on petition, may be published or made available for public inspection without applicant's or patent owner's permission if rendered in a file open to the public pursuant to § 1.11 or available pursuant to § 1.14(e)(2), in an application that has been published in accordance with §§ 1.211 through 1.221, or in an application claiming benefit of an earlier filing date under 35 U.S.C. 119(a)–(d), 120, 121 or 365 of an application that has been published or patented.

(2) Any action of the Board of Patent Appeals and Interferences, or any decision on petition not publishable under paragraph (f)(1) of this section, may be published or made available for public inspection if the Director believes the action or decision involves an interpretation of patent laws or regulations that would be of important precedential value; and the applicant, or any party involved in the interference, does not within two months after being notified of the intention to make the action or decision public, object in writing on the ground that the decision discloses a trade secret or other confidential information and states that such information is not otherwise

publicly available. If an action or decision discloses such information, the applicant or party shall identify the deletions in the text of the action or decision considered necessary to protect the information. If the applicant or the party considers that the entire action or decision must be withheld from the public to protect such information, the applicant or party must explain why. Applicants or parties will be given time, not less than twenty days, to request reconsideration and seek court review before any portions of actions or decisions are made public over their objection. See § 2.27 for trademark applications.

(g) *Publication pursuant to § 1.47.* Information as to the filing of an application will be published in the Official Gazette in accordance with § 1.47(c).

(h) *International applications.* (1) Copies of international application files for international applications which designate the U.S. and which have been published in accordance with PCT Article 21(2), or copies of a document in such application files, will be furnished in accordance with PCT Articles 30 and 38 and PCT Rules 94.2 and 94.3, upon written request including a showing that the publication of the application has occurred and that the U.S. was designated, and upon payment of the appropriate fee (*see* § 1.19(b)), if:

(i) With respect to the Home Copy (the copy of the international application kept by the Office in its capacity as the Receiving Office, *see* PCT Article 12(1)), the international application was filed with the U.S. Receiving Office;

(ii) With respect to the Search Copy (the copy of the international application kept by the Office in its capacity as the International Preliminary Searching Authority, *see* PCT Article 12(1)), the U.S. acted as the International Searching Authority; or

(iii) With respect to the Examination Copy (the copy of an international application kept by the Office in its capacity as the International Preliminary Examining Authority), the United States acted as the International Preliminary Examining Authority, an International Preliminary Examination Report has issued, and the United States was elected.

(2) A copy of an English language translation of a publication of an international patent application which has been filed in the United States Patent and Trademark Office pursuant to 35 U.S.C. 154(2)(d)(4) will be furnished upon written request including a showing that the publication of the application in

accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate fee (§ 1.19(b)(4)).

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

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

(5) Access to international application files under paragraphs (a)(1)(i)-(iv) and (h)(3) of this section will not be permitted with respect to the Examination Copy in accordance with PCT Article 38.

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

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

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

5. Section 1.17 is amended by revising paragraph (h) to read as follows:

§ 1.17 Patent application and reexamination processing fees.

* * * * *

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

§ 1.12—for access to an assignment record

§ 1.14—for access to an application

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

§ 1.53(e)—to accord a filing date

§ 1.59—for expungement of information

§ 1.84—for accepting color drawings or photographs

§ 1.91—for entry of a model or exhibit

§ 1.102—to make an application special

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

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

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

§ 1.183—to suspend the rules

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

§ 1.313—to withdraw an application from issue

§ 1.314—to defer issuance of a patent

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

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

§ 1.644(e)—for petition in an interference

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

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

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

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

§ 5.12—for expedited handling of a foreign filing license

§ 5.15—for changing the scope of a license

§ 5.25—for retroactive license

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6. Section 1.19 is amended by revising paragraph (b)(1) to read as follows:

§ 1.19 Document supply fees.

* * * * *

(b) * * *

(1) Certified or uncertified copy of the paper portion of patent application as filed, except for a certified copy provided pursuant to an agreement between the Office and another Intellectual Property (IP) Office when the certified copy is provided to the other IP Office in electronic form and when written authorization under 35 U.S.C. 122(a) to permit access to file information by the other IP Office receiving the priority document is given by applicant for which there is no fee:

(i) Regular service—\$15.00

(ii) Expedited regular service—\$30.00

* * * * *

7. Section 1.52 is amended by revising paragraphs (a) and (b) to read as follows:

§ 1.52 Language, paper, writing, margins, compact disc specifications.

(a) Papers that are to become a part of the permanent United States Patent and

Trademark Office records in the file of a patent application or a reexamination proceeding.

(1) All papers, other than drawings, that are submitted on paper or by facsimile transmission, and are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding, must be on sheets of paper that are the same size, not permanently bound together, and:

(i) Flexible, strong, smooth, non-shiny, durable, and white;

(ii) Either 21.0 cm by 29.7 cm (DIN size A4) or 21.6 cm by 27.9 cm (8½ by 11 inches), with each sheet including a top margin of at least 2.0 cm (¾ inch), a left side margin of at least 2.5 cm (1 inch), a right side margin of at least 2.0 cm (¾ inch), and a bottom margin of at least 2.0 cm (¾ inch);

(iii) Written on only one side in portrait orientation;

(iv) Plainly and legibly written either by a typewriter or machine printer in permanent dark ink or its equivalent; and

(v) Presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by use of digital imaging and optical character recognition.

(2) All papers that are submitted on paper or by facsimile transmission and are to become a part of the permanent records of the United States Patent and Trademark Office should have no holes in the sheets as submitted.

(3) The provisions of this paragraph and paragraph (b) of this section do not apply to the pre-printed information on paper forms provided by the Office, or to the copy of the patent submitted on paper in double column format as the specification in a reissue application or request for reexamination.

(4) See § 1.58 for chemical and mathematical formulae and tables, and § 1.84 for drawings.

(5) If papers that are submitted on paper or by facsimile transmission do not comply with paragraph (a)(1) of this section and are submitted as part of the permanent record, other than the drawings, applicant, or the patent owner, or the requester in a reexamination proceeding, will be notified and given a period of time within which to provide substitute papers that comply with paragraph (a)(1) of this section in order to avoid abandonment of the application in the

