Changes to Patent Practice and Procedure- Final Rule
(Effective Date: December 1, 1997)

Index Term(s) 37 CFR §

Address, mandatory location in oath/declaration
   Residence 1.63; 1.33(a);
   Post Office

Amendments after final action
   amended for clarification 1.116

Amendment and revision requirements 1.121

Amendment of claims, in general - transferred
   from 1.119 to 1.121 1.121

Amendment of disclosure - new matter
   transferred from 1.118 to 1.121 1.121

Amendments - manner of making 1.121(a)-(c)

Amendments - entry and consideration of [deleted] 1.122 1.121

Amendments to the drawing - transferred from
   1.123 to 1.121 1.121

Amendment of amendments - transferred from
   1.124 to 1.121 1.121

Amendment of Rules of Practice
   deletes 1.352 as internal instructions 1.352

Appeals to the Board of Patent Appeals & Int.
   Clarification of the record 1.196(d)
   Limits on Examiner’s Answer: New
      ground of rejection not permitted 1.193(a)(2)
   Notice of appeal, signature & ID of claims

1 The regulations cited above are published in the Federal Register (62 Fed. Reg. 53131, October 10, 1997) and in the Official Gazette (1203 Off. Gaz. Pat. Office 63, October 21, 1997). Both of these sources provide an explanatory preamble to the regulations, in numeric order, followed by a full statement of the modified regulations themselves, again in numeric order.
no longer needed therein 1.191(b)
Oral hearing not req'd - notification 1.194(c)
Oral hearing requests - separate paper 1.194(b)
Pending claims rejected by Board 1.196

Reconsideration time limit change 1.197(b)
Reinstatement of the appeal 1.193(b)(2)
Reopening of Prosecution after Appeal 1.193(b)(2)
Reply Briefs 1.193(b)(1)
Requests for rehearing & appeal 1.196(b)(2)

Applicant (PCT)
Filing by other than inventor
Deletion of several requirements which may be submitted by petition under 1.47 in the National stage 1.425

Application filing
All others 1.53(b)
CPA 1.53(d)
filng by fax 1.6, 1.8

Assignee
Deletion of review and certification of evidentiary documents requirement based on 1.4(d) requirement 3.73(b)

Assistance in Preparation statement required 1.4(g)

Certifications
Implicit 1.4(d), 10.18

Confidentiality of Applications 1.14, 1.47

Correspondence with the Office
Certifications required by §10.18 1.4(d)
Sanctions for violations of 1.4(d)

Declarations 1.63

Deletion of certain rules of practice
1.60 (Continuation/ Divisional) see 1.53(b)
1.62 (FWC) - replaced by Continued
Prosecution Application practice 1.53(d)

Design Patents
  Color Drawings and Color Photographs 1.152
  New Matter 1.152(b)
  Arrangement & specification 1.154
  Issue and term [much is deleted due to changes to 1.137] 1.155(b)-(f)

Examination (order, nature, action) 1.104
  [1.104,1.105,1.106,1.107,1.109 combined]

Exhibits and Models not generally admitted 1.91,1.92

Expungement/Return of material in application file 1.59

Extension of time
  Petitions, for fifth month 1.17,1.136(a)(1)
  General authorization 1.136(a)(3)

Filing date requirements
  Deletion of requirement that application be filed in name of a actual inventors 1.41(a),1.53

Filing Receipts
  Not mailed for CPAs 1.54

Filing Requirements
  Continuing applications 1.53(b)
  Continued Prosecution Applications 1.53(d)
  Provisional Applications 1.53(c)

Government Interest in Patents, Register of
  Removed and reserved Part 7, as it has been incorporated into Part 3. 7.1

Incomplete responses
  - time period for reply 1.135(c)

Inventorship
  Applicants
    Full names no longer required for filing date 1.41,1.53
    In continuing applications 1.53(b)
### Corrections

- Diligence Requirement deleted 1.48(a)
- Factual showings - deceptive intent deleted
- Oath or declaration can change inventorship in certain circumstances 1.48(f)
- Provisional applications 1.48(d)
- Reissue excluded 1.48
- Requirement for other information by Office regarding correction 1.48(g)
- Requirement re unclaimed subject matter in nonprovisional application and unnamed inventor(s) 1.48(c)
- Signature on Oath or Declaration during Interference (ref. to 1.634) 1.48(a), 1.48(b)
- Statement re lack of deceptive intent (no longer requires statement of facts in support, just statement) 1.48(a)(1)
- Written consent of assignee requirements 1.48(a)(4), 1.48(c)(4), 1.48(e)(3)

### Named Inventor

- Full name 1.63

### Notification of national publication of a patent based on an international application

[1.318 removed]

### Oath/Declaration

1.63, 1.48(f)

### Petitions

- for extension of time fifth month 1.17, 1.136(a)
- expungement and return of papers 1.17(1), 1.59

### Petitions to the Commissioner

- "Other requirements may be imposed" added 1.182
- Removal of 1.184 (Reconsideration of cases decided by former commissioners) 1.184

### Photographs

- Black and white in design applications 1.152, 1.84
Plant Patents
Changes for clarification 1.163

Post Office Address 1.163

Protests
Deletes blanket limitation of one protest per protester 1.291(c)

Reconsideration prior to final Office action 1.112

Reissue
Assignee requirement to establish ownership 1.172
Content of reissue oath/declaration simplified 1.175
Requirement to surrender patent moved 1.178
Title report requirement deleted 1.171

Reply by Applicant or Patent Owner to Office action - Form and content 1.111(b)

Restriction practice
Clarifying amendments 1.144; 1.146

Revival of abandoned applications or lapsed patents 1.137
Elimination of time period requirement for filing a 1.137(b) petition 1.137(b)
Time period clarified 1.137(a) & (b)
Terminal disclaimer requirement modified 1.137(c)

Secrecy - word replaced by "confidence" 1.14(a) and (b)

Secrecy Order
Replaced with material from §5.7 5.1,5.7

Small entity statement errors 1.28

Specification, Substitute
deletion of verification requirement re statement of no new matter in view of 1.4(d)(2) 1.125

Treatment of applications filed under Rule 1.60 after that rule is deleted 1.53(b)
Treatment of applications filed under Rule 1.62 after that rule is deleted 1.53(b),1.53(d)

Verification of statements/showings
  Removal of requirement 1.4(d)

Verification of translation
  Requirement deleted (but accuracy statement required in Part I rules) 1.52(a) and (e) 1.69(b) 3.26