

Changes to Patent Practice and Procedure - Final Rule

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Rule-by-Rule - Summary IV

The final rule entitled "Changes to Patent Practice and Procedure" would adopt changes to 37 CFR 1.4, 1.6, 1.8-1.11, 1.14, 1.16, 1.17, 1.21, 1.26-1.28, 1.33, 1.41, 1.47, 1.48, 1.51-1.55, 1.59, 1.60, 1.62, 1.63, 1.67, 1.69, 1.78, 1.84, 1.91, 1.92, 1.97, 1.101-1.109, 1.111-1.113, 1.115-1.119, 1.121-1.126, 1.133-1.137, 1.139, 1.142, 1.144, 1.146, 1.152, 1.154, 1.155, 1.163, 1.167, 1.171, 1.172, 1.175, 1.182, 1.184, 1.191-1.194, 1.196, 1.197, 1.291, 1.293, 1.294, 1.304, 1.312, 1.316-1.318, 1.324, 1.352, 1.366, 1.377, 1.378, 1.425, 1.484, 1.485, 1.488, 1.492, 1.494, 1.495, 1.510, 1.530, 1.550, 1.770, 1.785, 1.804, 1.805, 3.11, 3.21, 3.26, 3.27, 3.31, 3.41, 3.51, 3.58, 3.73, 5.1-5.8, 5.11-5.20, 5.25, 5.31-5.33, Part 7, 10.18, and 10.23.

The following is a summary of the changes:

§ 1.4 - Nature of correspondence and signature requirements.

Paragraph (d)(1)(ii) of § 1.4 "direct or indirect" is added to clarify ability to submit a copy of a copy.

Paragraph (d)(2) of § 1.4 provides that any person (practitioner or *pro se*) presenting correspondence to the PTO is making the certifications set forth in § 10.18(b) and may be subject to the sanctions set forth in § 10.18(c) for violations of § 10.18(b).

The changes represented by § 1.4(d)(2) in combination with the change to § 10.18 will permit the PTO to eliminate the separate verification requirements contained in §§ 1.6, 1.8, 1.10, 1.27, 1.28, 1.48, 1.52, 1.55, 1.69, 1.102, 1.125, 1.137, 1.377, 1.378, 1.804, 1.805, 3.26, and 5.4 for any party submitting a paper thereunder.

New paragraph (g) of § 1.4 is transferred from § 1.33(b).

§ 1.6 - Receipt of correspondence.

Paragraph (d)(3) of § 1.6 provides that continued prosecution applications (CPA) of § 1.53(d) may be transmitted to the Office by facsimile. The filing date of the CPA will be the receipt date not the transmission date should the two differ.

Paragraph (e)(2) of § 1.6 verification requirement is removed in view of changes to § 1.4(d)(2).

Paragraph (f) of § 1.6 provides a petition remedy for the situation where the Office has no evidence of receipt of a continued prosecution application transmitted by facsimile, but the transmission will only be accorded the receipt date not the transmission date.

§ 1.8 - Certificate of mailing or transmission.

Paragraph (a)(2)(i)(A) of § 1.8 makes clear that the date of a facsimile transmission of a continued prosecution application does not control the filing date of the application. The filing date, should the transmission start date and the transmission receipt date differ, would be the date of receipt of the facsimile transmission that is not a Saturday, Sunday or Federal holiday within the District of Columbia.

Paragraph (b)(3) of § 1.8 verification requirement is removed in view of changes to § 1.4(d)(2).

§ 1.9 - Definitions.

In paragraph (d) of § 1.9 a reference to a specific size standard for small business of not exceeding 500 employees is replaced with a generic reference to the size standards in 13 CFR Part 121.

Paragraph (f) of § 1.9 is amended by the addition of "eligible for reduced patent fees" to clarify how the term "small entity" is used.

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

Paragraphs (d)(3) and (e)(4) of § 1.10 verification requirement is removed in view of changes to § 1.4(d)(2).

§ 1.11 - Files open to the public.

Paragraph (b) of § 1.11 provides that the filing of a continued prosecution application under § 1.53(d) of a reissue application will not be announced in the O.G..

§ 1.14 - Patent applications preserved in confidence.

Paragraph (a) of § 1.14 is amended generally for clarification.

Paragraph (a)(1)(i)(B) of § 1.14 allows for status information to be provided for applications identified, by application or serial number and a filing date, in a U.S. application open to public inspection.

Paragraph (a)(2) of § 1.14 removes the need for a petition under § 1.14(e) to obtain a copy of an application as filed that is incorporated by reference in a U.S. patent.

Paragraph (f) of § 1.14 is added to recognize the exceptions to maintaining an application in secrecy added to § 1.47(a) and (b) that provide public notice to nonsigning inventors of a patent application by publication in the O.G.

§ 1.16 - **National application filing fees.**

Section 1.16 is reformatted to incorporate unassociated text following paragraphs (d) and (l) into new paragraphs (m) and (n).

§ 1.17 - **Patent application processing fees.**

Paragraphs (a)-(g) of § 1.17, relating to fee amounts, have been reformatted as § 1.17(a)-(d).

Paragraph (a) of § 1.17 now provides for a fifth month extension of time for reply to nonstatutory periods and for reply to statutory periods provided the statutory maximum of six months is not exceeded.

Paragraph (h) of § 1.17 deletes petition fees related to §§ 1.47, 1.48 and 1.84, which fees have been placed in paragraph (i).

Paragraph (i) of § 1.17 is amended to include petition fees related to §§ 1.41(a)(1), 1.47, 1.48, 1.59, 1.84 and 1.91, and to delete petition fees related to §§ 1.60 and 1.62 (in view of the cancellation of these sections).

Paragraph (q) of § 1.17 is amended to add a petition fee related to § 1.41(a)(2).

Section 1.17 as well as §§ 1.103, 1.112, 1.113, 1.133-1.136, 1.142, 1.144, 1.146, 1.191, 1.192, 1.291, 1.294, 1.484, 1.485, 1.488, 1.494, 1.495, 1.770, 1.785, and

5.3 are amended to replace the phrases "response" and "respond" with the term "reply" for consistency with § 1.111.

§ 1.21 - **Miscellaneous fees and charges.**

Paragraph (l) of § 1.21 is amended to reflect the change to § 1.53(f).

Paragraph (n) of § 1.21 is amended to reflect the change from former §§ 1.60 and 1.62 to § 1.53(e).

§ 1.26 - **Refunds.**

Paragraph (a) of § 1.26 is amended to better track the statutory language of 35 U.S.C. 42(d) and to add back language relating to refunds of fees paid that were not "required," which language was inadvertently dropped from a previous publication.

§ 1.27 - **Statement of status as small entity.**

Paragraphs (a)-(d) of § 1.27 are amended to remove verification requirement in view of changes to § 1.4(d)(2), and to replace "aver" and "averring" with "state" and "stating."

§ 1.28 - **Effect on fees of failure to establish status, or change status, as a small entity.**

Paragraph (a) of § 1.28 provides that a new small entity statement is not required for a continuing application (including a continued prosecution application (CPA)) or a reissue application.

Paragraph (a) of § 1.28 also provides that payment of the small entity basic filing fee in a continuing application (including a CPA) or a reissue application will substitute for the required reference to the small entity statement in the prior application or patent being reissued.

Paragraph (a) of § 1.28 also clarifies that the filing of a continuing application (including a CPA) or a reissue application requires a new determination by applicant of entitlement to status.

Paragraph (c) of § 1.28 is amended to provide that an explanation for an erroneous payment of a small entity fee is no longer required; and that payment of a fee

deficiency, *per se*, is deemed to constitute a representation that prior small entity status was requested in good faith.

§ 1.33 - **Correspondence address respecting patent applications, reexamination proceedings, and other proceedings.**

Paragraph (a) of § 1.33 is amended for clarification purposes. Paragraph (a) no longer permits the residence and post office address of the applicant to appear elsewhere than in the oath or declaration under § 1.63 in conformance with the change to § 1.63 paragraph (a).

Former paragraph (b) of § 1.33 language is transferred to new § 1.4(g). New paragraph (b) now contains clarification language regarding who may sign amendments and other papers filed in an application.

§ 1.41 - **Applicant for patent.**

Paragraph (a) of § 1.41 (and § 1.53) is amended so that naming of the actual inventors is no longer required for an application to be entitled to a filing date. Paragraph (a)(1) of § 1.41 provides that the inventorship of a nonprovisional application is set forth in an oath or declaration under § 1.63, except as provided for in § 1.53(d)(3) and § 1.63(d) where a continuing application is filed containing a statement requesting deletion of inventors. Paragraph (a)(1) of § 1.41 also provides that if an executed oath or declaration under § 1.63 is not filed during the pendency of an application, the inventorship is that set forth in the original application papers (§ 1.53(b)), or may be set forth or corrected by petition under this paragraph.

Paragraph (a)(2) of § 1.41 provides that the inventorship of a provisional application is governed in the following order: by the § 1.51(c) cover sheet (if present), the § 1.53(c) application papers, or by petition pursuant to this paragraph.

Paragraph (a)(3) of § 1.41 recites that when a nonprovisional application is filed without an executed oath or declaration under § 1.63, the names of the inventor(s) should be provided as an application identifier. However, if no names of the inventor(s) are provided, an alphanumeric application identifier should be supplied to aid in matching of papers before issuance of an application number.

§ 1.47 - **Filing when an inventor refuses to sign or cannot be reached.**

Paragraphs (a) and (b) of § 1.47 provide for publication of a notice, in the *Official Gazette*, for all applications under § 1.47, except for continued prosecution applications. Previously, a notice was published only if a mailed notice to the nonsigning inventor of the filing was returned or if the address for mailing a notice was unknown.

Paragraphs (a) and (b) of § 1.47 are amended for clarification purposes, including the application of paragraph (b) only where paragraph (a) does not apply.

§ 1.48 - **Correction of inventorship in a patent application.**

Title and paragraphs (a)-(c) of § 1.48 are amended to clarify that the rule is directed to applications other than reissue applications rather than to patents.

Paragraphs (a)-(c) of § 1.48 requirement for diligence in filing petition is deleted.

Paragraph (a) of § 1.48 requirement for factual showings as to a lack of deceptive intent is deleted in favor of a statement of a lack of deceptive intent.

Paragraph (a) of § 1.48 statements from each original named inventor are no longer required, but are only required from inventor(s) to be deleted or added.

Paragraphs (a) and (b) of § 1.48 add a reference to interference rule § 1.634.

Paragraphs (a) and (c) of § 1.48 add references to §§ 1.42, 1.43 and 1.47.

Paragraphs (a), (c) and (e) of § 1.48 have the requirement for verification removed in view of changes to § 1.4(d)(2).

Paragraph (c) of § 1.48 is clarified to no longer follow the correction of inventorship error requirements of former paragraph (a), but now only requires a statement from the person being added recognizing that the person is being added in view of amendment of claim(s), and that the error occurred without deceptive intent on the part of the person being added.

Paragraphs (d) and (e) of § 1.48 language is clarified.

Paragraph (e) of § 1.48 requirement for factual showings as to a lack of deceptive intent is deleted in favor of a statement of a lack of deceptive intent.

Paragraph (f)(1) of § 1.48 is added to provide that, in a nonprovisional application filed without an executed oath or declaration, the later-filed (executed) oath or

declaration will act to correct the inventorship (automatically without the need for petition) in the event that the application sets forth an inventive entity different from that named in the later-filed (executed) oath or declaration.

Paragraph (f)(2) of § 1.48 is added to provide that in a provisional application filed with an incorrect inventive entity, the later submission of a cover sheet will act to correct the inventorship.

Paragraph (g) of § 1.48 is added to specifically recognize that the Office may require such other information as may be deemed appropriate.

§ 1.51 - **General requisites of an application.**

Paragraphs (a), (a)(1), (a)(2), and (b) of § 1.51 are rewritten as paragraphs (a), (b), (c) and (d), respectively, for clarity, and so that paragraphs (b) and (c) of § 1.51 will correspond to paragraphs (b) and (c) of § 1.53. Current paragraph (c) of § 1.51 is deleted as unnecessary in view of § 1.25(b).

§ 1.52 - **Language, paper, writing, margins.**

Paragraphs (a) and (d) of § 1.52 verification requirement is removed in view of changes to § 1.4(d)(2), and further clarified to include the requirement of an accurate translation (§ 1.69).

Paragraph (c) of § 1.52 clarifies that alterations to the application papers made after the oath/declaration is signed must be supported by a supplemental oath/declaration.

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

Paragraph (a) of § 1.53 is amended to state that any papers received purporting to be an application will receive an application number for identification purposes.

Requirement for filing in the name of the actual inventor to receive a filing date is deleted in view of the change to § 1.41(a).

Filing requirements are now set forth for:

provisional applications in § 1.53(c);

continued prosecution applications (CPAs) in § 1.53(d); and

all other applications, including CPIs, and continuations and divisional applications including those with a copy of an oath or declaration from a prior application (§ 1.63(d)(1)(iv)) in § 1.53(b) (and should contain a sentence specifically incorporating the prior application by reference to guard against filing a specification copy that is missing a page) as filings under §§ 1.60 and 1.62 will no longer be possible in that these two sections have been deleted.

Continued prosecution application (CPA)(§ 1.53(d)): Provides for the filing of a request to continue prosecution of an application *via* a continuing application (as did former § 1.62 practice), but significantly simplifies and streamlines the requirements for and processing of such a continuing application (*vis-a-vis* former § 1.62 practice). It will also facilitate a virtually seamless transition to the procedures for requesting further examination of an application, upon payment of a required fee, set forth in pending legislation.

Continued prosecution application (CPA) (§ 1.53(d)):

Requirements/Attributes

Must be a continuation or division
(CIPs are not permitted to be filed under § 1.53(d), but are proper under § 1.53(b)).

Prior application must be complete under § 1.51(b).

Not for a pre-June 8, 1995 (pre-URAA) immediate prior application, § 1.53(d)(1)(i) (where there is an immediate prior application that was filed on or after June 8, 1995, then an earlier application in the chain may be pre-June 8, 1995).

Must name as inventors the same or fewer than all the inventors named in the prior application. (to delete an inventor, a statement requesting deletion is necessary, § 1.53(d)(4)).

The CPA will utilize the file jacket (including the same application number and filing date) and contents of the prior application to constitute the new application. A new oath or declaration under § 1.63 is not required. The application number of the prior application will be used for identification purposes and a new application number will not be assigned.

A CPA is a request to expressly abandon the prior application, but the

abandoned status of the prior application will not operate to make the file open to public inspection, § 1.14(a)(3)(iv).

A CPA must be timely filed in accordance with § 1.53(d)(1)(ii).

A new application filing fee is required.

The request for filing is considered as the specific reference required by 35 U.S.C. 120 and no amendment of the specification to include a reference to the prior application is necessary. Therefore, a specific reference to a prior application need not and should not be added to the first line of the specification of the CPA. Section 1.53(d)(7).

The CPA will be completely processed in and by the Group. (the Office of Initial Patent Examination will not be involved with the processing of the CPA).

The filing date of the CPA and CPA continuing data will not be listed on the face of the file jacket. The Request for a CPA and its filing date will only be an entry in the "Contents" on the file jacket.

Papers that carryover to the CPA from the prior application: Information Disclosure Statements, Terminal Disclaimers, affidavits under §§ 1.130, 1.131, and 1.132, § 3.73(b) certifications, unacted upon § 1.48 petitions where correction is still required, U.S. and foreign priority claims, general authorizations to charge a deposit account, and an election where the CPA is a continuation unless otherwise indicated.

Papers that do not carryover to the CPA from the prior application: small entity status requests, and an election where the CPA is a divisional.

Paragraph (e)(1) of § 1.53 provides that if an application deposited under paragraphs (b)-(d) of this section is not entitled to a filing date, applicants will be so notified and given an opportunity to correct the filing error.

Paragraph (e)(2) of § 1.53 provides that any notification made pursuant to paragraph (e)(1) of this section may be reviewed by filing a petition under § 1.181 along with a fee per § 1.17(i). Otherwise, the filing date will be the date the filing error is corrected.

Paragraph (e)(3) of § 1.53 provides that if an applicant fails to correct the filing error notified of in paragraph (e)(1) of this section, the "proceedings" will be

terminated and the application may be disposed of.

Paragraph (f) of § 1.53 sets forth completion of filing requirements for nonprovisional applications accorded a filing date, including a provision that an oath or declaration for a continuation or divisional application may be a copy of the oath or declaration filed in a prior application.

Paragraph (g) of § 1.53 sets forth completion of filing requirements for provisional applications accorded a filing date.

Paragraphs (h), (i) and (j) of § 1.53 contain material transferred from former § 1.53 paragraphs (e)(1), (e)(2) and (f).

§ 1.54 - **Parts of application to be filed together; filing receipt.**

Paragraphs (a) and (b) of § 1.54 are amended to reflect changes to § 1.53, and to indicate that filing receipts will not be issued for continued prosecution applications.

§ 1.55 - **Claim for foreign priority.**

Paragraph (a) of § 1.55 verification requirement is removed in view of changes to § 1.4(d)(2).

§ 1.59 - **Expungement of information or copy of papers in application file.**

Paragraph (b) of § 1.59 contains an explicit provision for petitions to expunge information from the file record other than the original disclosure, rather than treating such requests under § 1.182 as is current practice. The petition to expunge standard is a showing to the satisfaction of the Commissioner that return is appropriate. The section is intended to cover information that was intentionally and/or unintentionally submitted. Most petitions to expunge may now be decided in the examining groups rather than in the Office of Petitions.

§ 1.60 - **Continuation or divisional application for invention disclosed in a prior nonprovisional application.**

[Deleted and Reserved] (Note: A continuation or divisional application may be filed under § 1.53(b) using a copy of an oath or declaration of a prior application under the provisions of § 1.63(d), and § 1.53(b)(1) provides that the same or less than all of the inventors named in the prior application may be named).

§ 1.62 - **File wrapper continuing procedure.**

[Deleted and Reserved] (Note: A continuation or divisional application, which uses the same file jacket as the parent application, will now only be available with the CPA practice in § 1.53(d). Continuation or divisional applications may also be filed under § 1.53(b). CIP applications may only be filed under § 1.53(b).

Application filings under § 1.53(b) require that a new file jacket be established.

1.63 - **Oath or declaration.**

Paragraph (a)(3) of § 1.63 now requires that the post office address appear in the oath or declaration rather than elsewhere (§ 1.33), and contains the full name requirement transferred from § 1.41(a).

Paragraph (d)(1)(iv) of § 1.63 provides for the use of a copy of the executed oath or declaration from a prior application in a continuation or divisional application that names the same as or fewer than all of the inventors named in the prior application. The copy may either show a signature or contain an indication thereon that it was signed. This provision will provide the benefits former § 1.60 practice (namely eliminating the requirement for a newly executed oath or declaration), without the "true copy" requirement of former § 1.60.

Paragraph (d)(2) of § 1.63 provides for requesting deletion of one or more inventors when a copy of an executed oath or declaration filed in a prior application is submitted in a (non-CPA) continuation or divisional application filed under § 1.53(b).

Paragraph (d)(3)(i) of § 1.63 requires that where § 1.47 status was accorded in a prior application, a copy of the decision according status must be submitted in a divisional or continuation application claiming benefit under 35 U.S.C. 120, 121, or 365(c) of the prior application unless all nonsigning inventors have subsequently joined in the prior application.

Paragraph (d)(3)(ii) of § 1.63 requires that where a continuation or divisional application claims benefit under 35 U.S.C. 120, 121 or 365(c) of a prior application that has been accorded status under § 1.47 and an inventor has subsequently joined the prior application, a copy of the oath or declaration filed by the joining inventor must be submitted in the continuation or divisional application along with the required submissions under paragraph (d)(3)(i) of this section.

Paragraph (d)(4) of § 1.63 requires that where the power of attorney or correspondence address was changed in a prior application from that on the executed oath or declaration, the change must be identified in a continuation or divisional application.

§ 1.67 -Supplemental oath or declaration.

Paragraph (b) of § 1.67 is changed for consistency with amended § 1.53.

§ 1.69 -Foreign language oaths and declarations.

Paragraph (b) of § 1.69 is clarified to require an accurate translation (§ 1.52 paragraphs (a) and (b)) and the verification requirement is removed in view of changes to § 1.4(d)(2).

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

Paragraph (a) of § 1.78 is amended for consistency with changes to § 1.53, and to remove references to canceled §§ 1.60 and 1.62.

Paragraph (a)(1) is further amended to include a reference to an international application.

Paragraph (a)(2) of § 1.78 is amended to clarify that the request for a continued prosecution application is itself the specific reference required by 35 U.S.C. 120 to the prior application. An amendment to the first sentence of the specification containing a reference to the prior application is not required for a continued prosecution application.

§ 1.84 -Standards for drawings.

Paragraph (b) of § 1.84 a reference to the filing of black and white photographs in design applications is removed as unnecessary in view of a reference in § 1.52 to § 1.84(b).

Paragraphs (c) and (g) of § 1.84 are amended for consistency with regard to English equivalents.

§ 1.91 -Models or exhibits not generally admitted as part of application or patent.

Title and section are clarified to identify the type of material not generally admitted.

Paragraph (a)(3) of § 1.91 is added to provide an explicit petition remedy for entry of a model or exhibit.

Paragraph (b) of § 1.91 is material transferred from former § 1.92.

§ 1.92 -**Model or exhibit may be required.**

[Deleted and Reserved] The material was transferred to § 1.91(b).

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

Paragraphs (c) - (e) of § 1.97 are amended by replacement of "certification" with "statement" in view of changes to § 1.4(d)(2), and the current use of "statement" is clarified by the addition of "information disclosure." Paragraph (c) is also amended to correct an unassociated text error (language beginning "provided . . ."), and to create parallel structure with paragraph (d).

Paragraph (e)(2) of § 1.97 is further amended by replacement of "or" with "and" to clarify that the submission of an information disclosure statement must contain both statements (not alternatively) that no item was cited by a foreign patent office *and* that no item was known by a § 1.56(c) individual more than three months prior to the filing of the information disclosure statement.

§ 1.101- **Order of examination.**

[Deleted and Reserved] The material related to internal Office instructions.

§ 1.102- **Advancement of examination.**

Paragraph (a) of § 1.102 verification requirement is removed in view of changes to § 1.4(d)(2).

§ 1.103- **Suspension of action.**

Paragraph (a) of § 1.103 replaces "response" with "reply" for consistency with § 1.111.

§ 1.104 - **Nature of examination.**

A number of rules that relate to internal practice (§§ 1.104, 1.105, 1.106, 1.107, 1.109) have been combined into a single rule (§ 1.104) to reduce the number of rules while responding to customer requests that the rules of practice set forth at least the fundamentals of the PTO's examination of an application.

§ 1.105- **Completeness of examiner's action.**

[Deleted and Reserved] The subject matter is transferred to § 1.104(b).

§ 1.106- **Rejection of claims.**

[Deleted and Reserved] The subject matter is transferred to § 1.104(c).

§ 1.107- **Citation of references.**

[Deleted and Reserved] The subject matter is transferred to § 1.104(d).

§ 1.108- **Abandoned applications not cited.**

[Deleted and Reserved] The material related to internal Office instructions.

§ 1.109- **Reasons for allowance.**

[Deleted and Reserved] The subject matter is transferred to § 1.104(e).

§ 1.111- **Reply by applicant or patent owner.**

Paragraph (b) of § 1.111 is amended to explicitly recognize that a reply must be reduced to a writing which must point out the specific distinctions believed to render the claims, including any newly presented claims, patentable.

§ 1.112- **Reconsideration before final action.**

The title is amended for clarification by addition of "reconsideration."

The section is amended to remove an unnecessary statement that restricted responses to the rejection, objections, or requirements set forth in a nonfinal Office action, which is contrary to the current practice of right of entry prior to a final rejection or final action.

§ 1.113- **Final rejection or action.**

Paragraphs (a) and (b) of § 1.113 are amended for clarity and in paragraph (a) "response" is replaced with "reply" for consistency with § 1.111.

§ 1.115- **Amendment.**

[Deleted and Reserved] The material proposed to be included in the section is

transferred to § 1.121

§ 1.116- **Amendments after final action or appeal.**

The title is amended by addition of "or appeal" to clarify that the current practice is that paragraphs (b) and (c) of § 1.116 apply to amendments submitted after appeal regardless of whether the application was subject to a final rejection prior to an appeal.

Paragraph (a) of § 1.116 is amended for clarity, to reflect current practice, by defining any requirement of form as that being expressly set forth in a previous Office action.

§ 1.117- **Amendment and revision required.**

[Deleted and Reserved] The subject matter is transferred to § 1.121.

§ 1.118- **Amendment of disclosure.**

[Deleted and Reserved] The subject matter is transferred to § 1.121.

§ 1.119- **Amendment of claims.**

[Deleted and Reserved] The subject matter is transferred to § 1.121.

§ 1.121 - **Manner of making amendments.**

Section 1.121 consolidates requirements for making amendments in all types of applications into a single rule (and contains a cross-reference to § 1.530 for making amendments in reexamination proceedings). New § 1.121 makes the manner of making amendments for reissue applications consistent with the manner of making amendments in reexamination proceedings. Section 1.121 is separated into:

§ 1.121(a) for non-reissue applications,

§ 1.121(b) for reissue applications, and

§ 1.121(c) referencing § 1.530 for reexamination proceedings.

Paragraph (a) of § 1.121 for amendments to non-reissue applications:

Maintains *status quo* for non-reissue applications with respect to changes to the written specification and claims.

Paragraph (a)(1) of § 1.121 applies to amendments to the written specification other than the claims in non-reissue applications.

Paragraph (a)(1)(iii) is added to provide for the reinstatement of matter previously deleted.

Paragraph (a)(2) of § 1.121 applies to amendments to the claims in non-reissue applications.

Paragraph (a)(3) of § 1.121 applies to amendments to the drawings in non-reissue applications:

Paragraph (a)(3) requires that amendments to the drawings are to be made by way of substitute sheets.

Paragraph (b) of § 1.121 for amendments to reissue applications.

The manner of making amendments in reissue applications is made consistent with the manner of making amendments in reexamination proceedings under § 1.530(d).

Paragraph (b)(1) of § 1.121 applies to amendments to the written specification other than the claims in reissue applications:

Amendments (additions or deletions) are made only by submission of the entire text of the rewritten paragraph(s), with bracketing and underlining for deletions and additions, respectively, except that an entire paragraph may be deleted (without it being rewritten in brackets). Paragraph (b)(1)(i). Note: Amendments in existing reissue applications, where the amendments were previously made by inserting or deleting specific words (per former § 1.121(e)(2)), should not be changed to conform to the new practice.

Paragraph (b)(2) of § 1.121 applies to amendments to the claims in reissue applications:

Claims can only be amended by rewriting or by a request to delete text; hand-entry by the PTO to insert five or less words will no longer be permitted. Paragraph (b)(2)(i)(A).

Each amendment of the claims submission must set forth the status, as of the date of the submission, of all patent and of all added claims, even those added claims subsequently canceled. Paragraph (b)(2)(ii).

Each claim amendment, when originally submitted, must be accompanied by an explanation of the support in the disclosure of the patent for the amendment change. Paragraph (b)(2)(iii).

Paragraph (b)(3) of § 1.121 applies to amendments to drawings in reissue applications:

Clarifies that amendments to the drawings are to be made by way of substitute sheets.

Paragraph (b)(5) of § 1.121 clarifies that no reissue patent will be granted enlarging the scope of the claims unless applied for within two years from the grant of the original patent.

Paragraph (b)(6) of § 1.121 clarifies that all amendments in reissue applications must be made relative to the patent specification in effect as of the date of the filing of the reissue application (and not relative to the prior amendment).

Section 1.121, paragraph (a)(5) for non-reissue applications and paragraph (b)(4) for reissue applications have a modified requirement that the correspondence between the specification, including the claims, and the drawings be in "substantial correspondence."

Paragraph (c) of § 1.121 for reexamination proceedings - cites to § 1.530(d) for similar changes for amendments made in reexamination proceedings.

§ 1.122- **Entry and consideration of amendments.**

[Deleted and Reserved] The material related to internal Office instructions.

§ 1.123- **Amendments to the drawing.**

[Deleted and Reserved] Subject matter transferred to § 1.121.

§ 1.124- **Amendment of amendments.**

[Deleted and Reserved] Subject matter transferred to § 1.121.

§ 1.125 - **Substitute specification.**

Paragraph (b) of § 1.125 provides, by rule, a right to submit a substitute specification, in other than a reissue application, so long as it is accompanied by a statement that new

matter is not included and a marked-up copy.

Verification requirement is deleted in view of changes to § 1.4(d)(2).

§ 1.126- **Numbering of claims.**

Section 1.126 is amended for consistency with the change to § 1.121.

§ 1.133- **Interviews.**

Paragraph (b) of § 1.133 replaces "response" with "reply" for consistency with § 1.111.

§ 1.134- **Time period for reply to an Office action.**

Section 1.134 replaces "response" with "reply" for consistency with § 1.111.

§ 1.135 - **Abandonment for failure to reply within time period.**

The one month time limit (or grace period) practice set forth in former § 1.135(c), for permitting the completion of a bona fide but incomplete reply, is eliminated. The time limit (or grace period) practice was a source of confusion both in the PTO and with its customers. Instead, amended § 1.135(c), which continues to apply to replies to nonfinal actions, provides that a reply may be accepted as a reply, and an action setting forth a requirement and giving a new time period for reply may be mailed. Providing a new time period would permit extensions of such period under § 1.136 and clarify the date of abandonment in the event of a failure to reply.

Paragraphs (a) and (c) of § 1.134 replace "response" with "reply" for consistency with § 1.111.

§ 1.136 - **Extension of time.**

Paragraph (a)(1) of § 1.136 is amended to provide for paid extensions of time up to five months (formerly limited to four months), subject to any maximum statutory period for response.

Paragraphs (a)(1) and (a)(2) of § 1.136 replace "response" with "reply" for consistency with § 1.111.

Paragraph (a)(3) of § 1.136 permits a general authorization to treat any future reply requiring an extension of time as incorporating a request therefor. Any request or

petition for an extension of time will be treated as requesting the appropriate length of time notwithstanding an inadvertent reference in the petition to a shorter period of time. Papers will be liberally interpreted as petitions for extensions of time. The mere submission of an extension fee will be interpreted as a constructive petition for an extension of time.

Paragraph (a)(3) of § 1.136 also treats a general authorization to charge all required fees or fees under § 1.17 as a constructive petition for an extension of time for a concurrent or future reply requiring an extension of time.

Paragraph (b) of § 1.136 is amended for clarity and "response" is replaced with "reply" for consistency with § 1.111.

§ 1.137 - **Revival of abandoned application or lapsed patent.**

Section 1.137 combines revival subject matter from § 1.139 (responses to requirements in provisional applications), § 1.155 (issue fees in design applications), § 1.316 (issue fees in utility or plant applications), and § 1.317 (payment of outstanding balances of issue fees).

Paragraph (a)(3) of § 1.137 clarifies that the time period for unavoidable delay must be from the due date of the reply that was not submitted to the date of filing a grantable petition under this paragraph.

Paragraphs (a) and (b) delete verification requirements in view of changes to § 1.4(d)(2).

Paragraph (b) of § 1.137 eliminates the one year filing period requirement for unintentional delay petitions, but clarifies that the rule continues to require that the entire delay, from the due date for the reply that was not submitted until the filing date of a grantable petition, has been unintentional for the applicant to obtain revival based upon "unintentional" delay. Unintentional delay petitions will now be considered on a case by case basis based on the merits rather than being artificially limited to a one year period, which period has the effect of misleading practitioners into believing that delay for a year is acceptable.

Paragraph (c) of § 1.137 expands the current terminal disclaimer requirement, from only being applicable to petitions for unavoidable delay under paragraph (a) of this section, to petitions for unintentional delay under paragraph (b) of this section. A terminal disclaimer will be required for all design applications, and for all utility and plant applications filed prior to June 8, 1995. The former six month grace period before which a terminal disclaimer was required has been eliminated.

§ 1.139- **Revival of provisional application.**

[Deleted and Reserved] Subject matter was transferred to § 1.121.

§ 1.142- **Requirement for restriction.**

Paragraph (a) of § 1.142 replaces "response" with "reply" for consistency with § 1.111.

§ 1.144- **Petition from requirement for restriction.**

Section 1.144 is amended for clarification purposes.

§ 1.146- **Election of species.**

Section 1.146 is amended for clarification purposes.

§ 1.152 - **Design drawings.**

Paragraph (a) of § 1.152 has the term "article" replaced with the term "design" as 35 U.S.C.171 requires that the claim be directed to "the design of an article" not the article per se.

Paragraph (a)(2) of § 1.152 removes the prohibition of color drawings and photographs in design applications. A petition procedure for their entry has been established in recognition of emerging new technologies.

Paragraph (b) of § 1.152 clarifies that all matter (color, indicia) in original informal drawings or photographs is an integral part of the disclosure and claim, and therefore cannot be removed without raising the issue of new matter, unless disclaimed in the original application papers as provided for in paragraph (b)(1).

§ 1.154 - **Arrangement of application elements.**

The title of § 1.154 is amended to include "of application elements" replacing "of specification" for consistency with §§ 1.77 and 1.163.

Paragraph (a)(3) of § 1.154 now requests on a voluntary basis for design applications a brief description of the article in which the design is embodied.

§ 1.155- **Issue of design patents.**

§ 1.155 paragraphs (b)-(f) subject matter is transferred to § 1.137.

§ 1.163- **Specification and arrangement of application elements.**

The title of § 1.163 is amended to include "and arrangement of application elements" for consistency with §§ 1.77 and 1.154.

Paragraph (b) of § 1.163 is amended to remove an outmoded reference to "legible carbon copy of the original" specification for plant applications.

§ 1.167- **Examination.**

Paragraph (b) of § 1.167 is removed as unnecessary in view of § 1.132.

§ 1.171 - **Application for reissue.**

Paragraph (a) of § 1.171 is amended to remove requirements for: (1) an order for a title report in reissue applications (replaced by § 1.172); and (2) an offer to surrender the patent (redundant in view of § 1.178).

§ 1.172 - **Applicants, assignees.**

Paragraph (a) of § 1.172 requires assignee in a reissue application to establish ownership pursuant to § 3.73(b) (replaces requirement for a title report deleted from § 1.171).

§ 1.175 - **Reissue oath or declaration.**

This rule has been completely revised. Former paragraphs (a) & (b) have been replaced with paragraphs (a)-(d).

Paragraph (a)(1) of § 1.175 has been completely rewritten such that the former requirements for particularly and distinctly specifying all errors being corrected is reduced to a requirement for identification of at least one error in the original patent as the basis for reissue.

Paragraph (a)(2) of § 1.175, the former requirements for a detailed showing of the facts and circumstances as to how each error arose or occurred is replaced by a requirement for a general statement that the errors arose without deceptive intent.

Paragraph (b)(1) of § 1.175 now provides for the submission of a supplemental oath or declaration prior to allowance generally stating that all errors being corrected, which were not covered by the original or a previously submitted oath or declaration, arose without deceptive intent. This replaces the former requirement (set forth in MPEP 1444) for a supplemental oath or declaration specifically identifying all subsequent errors being corrected every time an amendment was submitted.

Paragraph (b)(2) of § 1.175 notes that a supplemental oath or declaration as in (b)(1) of § 1.175 must accompany all errors sought to be corrected after allowance.

Paragraph (c) of § 1.175 clarifies that the supplemental oath or declaration of paragraph (b) of § 1.175 need not specifically identify any error being corrected, unless all error(s) previously identified as the basis for reissue are no longer being corrected. In that case, a different error must be identified as the basis for reissue.

Paragraph (d) of § 1.175 clarifies that an original oath or declaration required under this section need not be submitted at the time of filing the reissue application in order to obtain a filing date.

§ 1.182 - **Questions not specifically provided for.**

Section 1.182 is amended to add language that a petition under this section may be granted subject to such other requirements as may be imposed.

§ 1.184- **Reconsideration of cases decided by former Commissioners.**

[Deleted and Reserved] The material related to internal Office instructions.

§ 1.191- **Appeal to Board of Patent Appeals and Interferences.**

Paragraph (a) of § 1.191 is amended by replacing "response" with "reply" for consistency with § 1.111, to better track the language of 35 U.S.C. 134, and by citing to § 1.17(b) (rather than § 1.17(e)).

Paragraph (b) of § 1.191 deletes the former requirements that the appeal identify the rejected claim or claims appealed and that the appeal be signed.

§ 1.192- **Appellant's brief.**

Paragraph (a) of § 1.192 is amended to replace "response" with "reply" for consistency with § 1.111, and to cite to § 1.17 (c) (rather than § 1.17(f)).

§ 1.193 - **Examiner's Answer and substitute brief.**

Former paragraph (a), now paragraphs (a)(1), and(a)(2) of § 1.193, contained a superfluous reference to § 1.181 that is now deleted.

Paragraph (a)(2) of § 1.193 prohibits the inclusion of a new ground of rejection in an examiner's answer; the examiner must reopen prosecution to add a new ground of rejection. However, if an amendment under § 1.116 is approved for entry for appeal purposes and appellant was advised which rejection(s) set forth in the action appealed from would be used to reject the claims as amended, then appellant has given consent that the appeal proceed on the claims as amended under § 1.116 subject to one or more individual rejections set forth in the appealed action. Accordingly, the Brief must address the different rejection(s) as appellant was advised of, and the Examiner's Answer may include the different rejection(s).

Paragraph (b)(1) of § 1.193 provides appellant with the right to file a timely reply brief, regardless of whether the examiner's answer raises new points of argument, thereby always giving appellant the right of making a last submission prior to review by the BPAI; the examiner must enter the reply brief, and either acknowledge its receipt and entry, or reopen prosecution to respond to new issues raised in the reply brief.

Paragraph (b)(2) of § 1.193 provides that when prosecution is reopened after an appeal or a reply brief has been filed, appellant must either file a reply under §§ 1.111 or 1.113, or request reinstatement of the appeal accompanied by a supplemental appeal brief.

§ 1.194- **Oral hearing.**

Paragraph (b) of § 1.194 provides that a request for an oral hearing must be filed in a separate paper, and is revised to cite to § 1.17(d) (rather than § 1.17(g)).

Paragraph (c) of § 1.194 provides that appellant will be notified when a requested oral hearing is unnecessary, such as when the application is to be remanded.

§ 1.196 - **Decision by Board of Patent Appeals and Interferences.**

Paragraph (b) of § 1.196 provides authority for the BPAI to enter a rejection of any pending claim, which includes allowed claims that have not been appealed, in place of the former requirement for a binding recommendation to the examiner.

Paragraph (b) of § 1.196 also provides a two month period for requesting rehearing by the Board or reconsideration by the examiner rather than the current one month period.

Paragraph (b)(2) of § 1.196 is amended to change "reconsideration" to "rehearing" for consistency with 35 U.S.C. 7(b).

Paragraph (d) of § 1.196 provides authority for the BPAI to require appellant to clarify the record.

§ 1.197 - **Action following decision.**

Paragraph (b) of § 1.197 provides a two month period (rather than one month) for filing a request for rehearing of a Board decision for consistency with new § 1.196.

Paragraph (b) of § 1.197 is amended to change "reconsideration" to "rehearing" for consistency with 35 U.S.C. 7(b).

§ 1.291 - **Protests by the public against pending applications.**

Paragraph (c) of § 1.291 eliminates the blanket prohibition of one protest per protester and allows for entry of additional prior art submissions. The change does not alter the need to submit the protest as soon as possible.

Paragraph (c) of § 1.291 also is amended to replace "response" with "reply" for consistency with § 1.111 and to delete superfluous language.

§ 1.293- **Statutory invention registration.**

Paragraph (c) of § 1.293 is amended to replace a reference to § 1.106(e) with a reference to § 1.104(c)(5) to reflect a transfer of material.

§ 1.294- **Examination of request for publication of a statutory invention registration and patent application to which the request is directed.**

Paragraph (b) of § 1.294 replaces "response" with "reply" for consistency with § 1.111.

§ 1.304- **Time for appeal or civil action.**

Paragraph (a)(1) of § 1.304 is amended to change "consideration" to "rehearing or reconsideration" for consistency with §§ 1.196, 1.197 and subpart E.

§ 1.312- **Amendments after allowance.**

Paragraph (b) of § 1.312 is amended to add a reference to § 1.175(b).

§ 1.316- **Application abandoned for failure to pay issue fee.**

Section 1.316 is amended by transferring subject matter of former paragraphs (b)-(f) to § 1.137 in order to combine subject matter on revival.

§ 1.317- **Lapsed patents; delayed payment of balance of issue fee.**

Section 1.317 is amended by transferring former paragraphs (b), (c), (e), and (f) to § 1.137 in order to combine subject matter on revival.

§ 1.318- **Notification of national publication of a patent based on an international application.**

[Deleted and Reserved] The material related to internal Office instructions.

§ 1.324 - **Correction of inventorship in patent.**

Section 1.324 is amended to create paragraphs (a) and (b) that explicitly set forth the requirements of a petition thereunder (rather than require petitioner to recognize that the requirements set forth in § 1.48 must be complied with).

Paragraphs (a) and (b) of § 1.324 do not require that a petition be diligently filed as was previously required for a § 1.324 petition.

Paragraph (b)(1) of § 1.324 requires a statement of a lack of deceptive intent rather than the former practice of factual showings as to a lack of deceptive intent. The statement is required from each person being added or deleted as an inventor rather than from each original named inventor as the former practice required.

Paragraph (b)(2) of § 1.324 requires a statement from current inventors (prior to the correction being made), who have not submitted a statement under paragraph (b)(1) of this section, either agreeing to the requested change or stating that they have no disagreement with the requested change.

Paragraph (b)(3) of § 1.324 requires a statement from all assignees of the parties submitting statements per paragraphs (b)(1) and (b)(2) of § 1.324 agreeing to the change, and a clarifying reference to § 3.73(b) is made therein.

The former practice of requiring a new oath or declaration under § 1.63 is not maintained.

§ 1.352- **Publication of notice of proposed amendments.**

[Deleted and Reserved] The material related to internal Office instructions.

§ 1.366- **Submission of maintenance fees.**

Paragraph (b) of § 1.366 removes the term "certificate" as unnecessary.

Paragraph (c) of § 1.366 replaces "serial number" with "application number."

Paragraph (d) of § 1.366 removes the requirement to supply the issue date of the patent and the filing date of the application as unnecessary, and "serial" is also changed to "application."

§ 1.377- **Review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of patent.**

Paragraph (c) of § 1.377 verification requirement is removed in view of changes to § 1.4(d)(2).

§ 1.378- **Acceptance of delayed payment of maintenance fee in expired patent to reinstate patent.**

Paragraph (d) of § 1.378 verification requirement is removed in view of changes to § 1.4(d)(2).

§ 1.425 - **Filing by other than inventor.**

Section 1.425 is amended to delete the distinction between one or all inventors refusing to cooperate in the signing of a request for an international application.

Section 1.425 is also amended to replace current specific requirements (for proof of facts concerning refusal to cooperate, sufficient proprietary interest, showing that such action is necessary to preserve the rights of the parties to prevent irreparable damage, and statement of last known address) with a general requirement consistent with the PCT rules for a statement explaining to the satisfaction of the Commissioner the lack of the signature concerned.

§ 1.484- **Conduct of international preliminary examination.**

Paragraphs (d)-(f) of § 1.484 replaces "response" with "reply" for consistency with § 1.111.

§ 1.485- **Amendments by applicant during international preliminary examination.**

Paragraph (a) of § 1.485 replaces "response" with "reply" for consistency with § 1.111.

§ 1.488- **Determination of unity of invention before the International Preliminary Examining Authority.**

Paragraph (b) of § 1.488 replaces "response" with "reply" for consistency with § 1.111.

§ 1.492- **National stage fee.**

Paragraph (g) of § 1.492 is added to reflect § 1.16(m).

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

Paragraph (c) of § 1.494 replaces "response" with "reply" for consistency with § 1.111.

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

Paragraph (c) of § 1.494 replaces "response" with "reply" for consistency with § 1.111.

§ 1.510- **Request for reexamination.**

Paragraph (e) of § 1.510 is amended to replace a reference to § 1.121(f) with one to § 1.530(d).

§ 1.530- **Statement; amendment by patent owner.**

The title of § 1.530 is amended by addition of a semicolon to clarify that the section covers not only amendments submitted with the statement but also amendments submitted at any other stage of the reexamination proceedings.

Paragraph (d) of § 1.530 is replaced, in view of the deletion of § 1.121(f), with paragraphs (d)(1)-(d)(8) that set forth the manner for making amendments in reexamination proceedings. Note: the manner of making amendments in reexams and

in reissues is now the same.

Paragraph (d)(1) of § 1.530 relates to amendments to the written specification other than the claims in reexaminations. Paragraph (d)(1)(i) of § 1.530 provides an exception to amendments being submitted with the entire text, whereby an entire paragraph may be deleted from the specification without it being rewritten in brackets.

Paragraph (d)(2) of § 1.530 relates to amendments to the claims in reexaminations.

Each amendment of the claims must set forth the status, as of the date of the submission, of all patent claims and of all new claims currently or previously proposed, even those new claims subsequently canceled. Paragraph (d)(2)(ii).

Each claim amendment when originally submitted must be accompanied by an explanation of the support in the disclosure of the patent for the amendment. Paragraph (d)(2)(iii).

Paragraph (d)(5) of § 1.530 provides the criteria for the form of amendments.

Paragraph (d)(6) of § 1.530 relates to amendments to the drawings in reexaminations.

This paragraph clarifies that new drawings must be presented by way of a new sheet (MPEP 2250.01), and added figures must be identified as "new." Paragraph (d)(6)(i).

Drawing change procedure applied to reexaminations has been transferred from deleted § 1.123. Paragraph (d)(6)(ii).

Paragraph (d)(7) of § 1.530 clarifies that the modified requirement for substantial correspondence between the specification including the claims, and the drawings applies to reexaminations.

Paragraph (d)(8) of § 1.530 clarifies that all amendments in reexaminations must be made relative to the patent document as it exists as of the date of filing of the request.

§ 1.550- **Conduct of reexamination proceedings.**

Paragraph (a) of § 1.550 is amended to modify a previous reference to §§ 1.104-1.119 in view of a transfer of material.

Paragraphs (b) and (e) of § 1.550 are amended for clarification purposes with

paragraph (e) clarifying the current practice of requiring, after the filing of a request for reexamination by a third party requester, the service of any document filed by either the patent owner or the third party requester on the other party.

§ 1.770- **Express withdrawal of application for extension of patent term.**

Section 1.770 replaces "response" with "reply" for consistency with § 1.111.

§ 1.785- **Multiple applications for extension of term of the same patent or of different patents for the same regulatory review period for a product.**

Paragraph (d) of § 1.785 replaces "response" with "reply" for consistency with § 1.111.

§ 1.804- **Time of making an original deposit.**

Paragraph (b) of § 1.804 verification requirement is deleted in view of changes to § 1.4(d)(2).

§ 1.805- **Replacement or supplement of deposit.**

Paragraph (c) of § 1.805 is amended to delete the verification requirement in view of changes to § 1.4(d)(2) and unnecessary language noting that an attorney or agent registered to practice need not verify their statements.

§ 3.11 - **Documents which will be recorded.**

Section 3.11 is amended to add paragraphs (a) for former subject matter and paragraph (b) to cite to the executive order requiring that several departments and other executive agencies of the Government forward items for recording.

§ 3.21 -**Identification of patents and patent applications.**

Section 3.21 is amended to replace a reference to "§ 1.53(b)(1)" with a reference to "§ 1.53(b)," and to delete a reference to canceled § 1.62.

§ 3.26 -**English language requirement.**

Section 3.26 verification requirement is deleted in view of changes to § 1.4(d)(2).

§ 3.27 -**Mailing address for submitting documents to be recorded.**

Section 3.27 is amended to add paragraphs (a) for former subject matter and paragraph (b) to cite to Executive Order 9424 and identify the proper mailing address.

§ 3.31 -Cover sheet content.

Paragraph (c) of § 3.31 is amended to set forth additional requirements as mandated by Executive Order 9424.

§ 3.41 -Recording fees.

Section 3.41 is amended to add paragraphs (a) for former subject matter and paragraph (b) to specify when no recording fee is required pursuant to Executive Order 9424.

§ 3.51 -Recording date.

Section 3.51 removes "certification" as unnecessary in view of changes to § 1.4(d)(2).

§ 3.58 -Governmental registers.

Section 3.58 is added to provide in paragraph (a) for maintaining of a Department Register to record Government interests pursuant to Executive Order 9424 and in paragraph (b) for a Secret Register.

§ 3.73 - Establishing right of assignee to prosecute.

Paragraph (b) of § 3.73 deletes the requirement that an assignee specifically state that the evidentiary documents have been reviewed, and to certify that title is in the assignee seeking to take action.

Paragraph (b) of § 3.73 is also amended to provide for partial assignees to submit evidence of ownership (as partial assignees can act when they all join) by replacing the language "assignee of the entire right, title and interest" with "assignee."

Paragraph (b) is clarified to require submission in the Office file, related to the matter in which action is sought to be taken, documentary evidence of the chain of title or specify where such evidence is recorded in the Office.

§ 5.1 - Correspondence.

Section 5.1 is amended by replacement of the former subject matter with material from § 5.33.

§ 5.2 - Secrecy order.

Paragraph (b) of § 5.2 is amended by replacement of the former subject matter with material from § 5.7.

Former paragraphs (c) and (d) of § 5.2 are removed as repetitive.

§ 5.3 - Prosecution of application under secrecy orders; withholding patent.

Paragraph (c) of § 5.3 replaces "response" with "reply" for consistency with § 1.111.

§ 5.4 - Petition for rescission of secrecy order.

Paragraph (a) of § 5.4 removes unnecessary subject matter.

Paragraph (d) of § 5.4 verification is deleted in view of changes to § 1.4(d)(2), and material transferred from § 5.8.

§ 5.5 - Permit to disclose or modification of secrecy order.

Paragraph (b) of § 5.5 removes unnecessary subject matter.

Paragraph (e) of § 5.5 is replaced with subject matter from § 5.6(a).

§ 5.6 - General and group permits.

[Deleted and Reserved] Subject matter of § 5.6(a) transferred to § 5.5(e).

§ 5.7 - Compensation.

[Deleted and Reserved] First sentence of § 5.7 transferred to § 5.2(b).

§ 5.8 - Appeal to Secretary.

[Deleted and Reserved] First and second sentences of § 5.8 transferred to § 5.4(d).

§ 5.11 -License for filing in a foreign country an application on an invention made in the United

States or for transmitting international application.

Paragraphs (b) and (c) of § 5.11 are amended to update the references to other parts of the CFR.

§ 5.12 -Petition for license.

Paragraph (b) of § 5.12 clarifies that the petition fee is required only when expedited handling is sought.

§ 5.13 -Petition for license; no corresponding application.

Section 5.13 is amended to delete unnecessary language.

§ 5.14 -Petition for license; corresponding U.S. application.

Paragraph (a) of § 5.14 is amended to remove unnecessary language and to replace "serial number" with "application number."

§ 5.15 -Scope of license.

Paragraph (a) of § 5.15 is amended to remove unnecessary language and to update the references to other parts of the CFR.

§ 5.16 -Effect of secrecy order.

[Deleted and Reserved] The material is removed as unnecessary.

§ 5.17 -Who may use license.

[Deleted and Reserved] The material is removed as unnecessary.

§ 5.18 -Arms, ammunition, and implements.

Paragraphs (a) and (b) of § 5.18 are amended to update the references to other parts of the CFR.

§ 5.19 -Export of technical data.

Paragraphs (a) and (b) of § 5.19 are amended to update the references to other parts of the CFR.

Paragraph (c) of § 5.19 is removed as unnecessary.

§ 5.20 - **Export of technical data relating to sensitive nuclear technology.**

Section 5.20 is amended to retain only the language of former paragraph (a).

§ 5.31 -**Effect of modification, rescission or license.**

[Deleted and Reserved] The material is removed as unnecessary.

§ 5.32 -**Papers in English language.**

[Deleted and Reserved] The material is removed as unnecessary.

§ 5.33 -**Correspondence.**

[Deleted and Reserved] The material is transferred to § 5.1.

Part 7 - **REGISTER OF GOVERNMENT INTERESTS IN PATENTS**

[Deleted and Reserved] The subject matter is incorporated into Part 3.

§ 10.18 - **Signature and certificate for correspondence filed in the Patent and Trademark Office.**

The title is amended to reflect that the rule as amended applies to correspondence.

Paragraph (a) of § 10.18 clarifies that all correspondence filed in the Office by a practitioner, other than correspondence required to be signed by the applicant or party, must bear a signature personally signed by the practitioner.

Paragraph (b) of § 10.18 provides the standards for correspondence presented under § 1.4(d). By presenting to the PTO any paper, the party presenting such paper (practitioner or *pro se*): (1) acknowledges that such paper is subject to the provisions of 18 U.S.C. § 1001 concerning willful false statements; and (2) makes the certifications of Rule 11 of the Federal Rules of Civil Procedures. The former § 10.18 was limited to practitioners, but the rule is amended so that it now applies to anyone (practitioner or pro-se) who submits correspondence to the Office.

Paragraph (c) of § 10.18 provides that sanctions may be imposed for violations of § 10.18(b).

§ 10.23 - **Misconduct.**

Paragraph (c)(15) of § 10.23 is amended to change "knowingly signing" to "signing" for consistency with § 10.18, which does not contain a "knowingly" requirement.