



Training Book Slides on the Changes to Patent Practice and Procedure - Final Rule



Introduction to the Patent Practice and Procedure Changes

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Reasons for the Changes

- This rulemaking is the PTO's response to the National Performance Review's mandate to reinvent government and reduce regulatory burden on the public.
- The changes in this rulemaking:
 - 1) Streamline the processing and examination of applications;
 - 2) Reduce procedural burdens on applicants; and
 - 3) Simplify and condense the requirements of the rules of practice.



Final Rule: Changes to Patent Practice and Procedure

- Effective Date: *December 1, 1997*
- Published in the Federal Register
62 Fed. Reg. 53131 (October 10, 1997)
- Published in the Official Gazette
1203 Off. Gaz. Pat. Office 63 (October 21, 1997)
- Errata:
 - *62 Fed. Reg. 61235 (November 17, 1997)*
 - *1204 Off. Gaz. Pat. Office 90 (November 25, 1997)*
- Mod: § 1.53(d): *63 Fed. Reg. 5732 (2/4/98); 1207 O.G.83 (2/24/98)*



Notebook Materials

1. Changes to Patent Practice and Procedure - Final Rule and Index of Final Rule
2. Subject Matter Summary I - Highlights
3. Subject Matter Summary II - Condensed
4. Subject Matter Summary III - Detailed
5. Rule-by-Rule Summary IV
6. Training Slides
7. Application Filing Forms
8. Questions and Answers
9. Selected Form Paragraphs for Examiner Use
10. CPA Application Processing Flowchart
11. Reissue/Reexam Amendment Handout



Topic 1: Application Filing

3 Major Rules have been revised

- 37 C.F.R. § 1.53 Application Number, filing date and completion of application
 - Including Continued Prosecution Application
- 37 C.F.R. § 1.63 Oath or declaration
- 37 C.F.R. § 1.41 Applicant for patent

2 Rules deleted: 37 C.F.R. §§ 1.60; 1.62



Application Filing - 37 C.F.R. § 1.53

Major Changes

Entire rule substantially revised

- All applications will be filed under § 1.53
- Filing under § 1.60 and § 1.62 (FWC) abolished
- Applications similar to § 1.60 filed under §1.53(b)
 - with a copy of the prior oath/dec under § 1.63
 - with the same or fewer inventors - §1.53(b)(1)
- Applications similar to FWCs (§ 1.62) filed as CPAs under § 1.53(d)



Application Filing - 37 C.F.R. § 1.53

Paragraph Overview

- § 1.53(c) Provisional Applications
 - § 1.53(d) Continued Prosecution Applications - CPAs
 - Former FWCs (Rule 62)
 - Not for CIPs
 - § 1.53(b) Everything else*
 - new applications, with new oath/dec
 - continuation/divisional applications, with copy of oath/dec
 - CIPs, with new oath/dec
- * except PCT applications



Application Filing - 37 C.F.R. § 1.53(b) Dec.'s

Oath and Declaration Requirements

- Only § 1.53(b) filings require an oath/dec
- Oath/dec may be an orig. or copy (§ 1.63(d))
 - copy from a prior application, or
 - newly executed for this application
- Oath/dec need not be submitted on filing (§1.53(f))
- Newly executed oath/dec needed for CIP application or a non-continuing application



Application Filing - 37 C.F.R. § 1.53(b) Spec's

Specification Requirements for Non- Continuing (new) Applications

- No change
- Any specification presentation permitted



Application Filing - 37 C.F.R. § 1.53(b) Spec's

Specification Requirements for Cont/Div cases using a copy of the Oath/dec (§ 1.63(d))

- Commandment: May not contain new matter
- “True Copy” requirement of Rule 60 dropped
- May be edited, rearranged, reformatted - whatever
- Examiners’ responsibilities concerning the status as a continuing case stay the same

Specification should include an incorporation-by-reference of prior application (to avoid inadvertent loss of subject matter)



Application Filing - 37 C.F.R. § 1.53(b) Wreck's

- Cases designated as Rule 60- Treat as § 1.53(b)
- § 1.53(b) is the default home for filing; unless specifically designated as a CPA, a § 371 or a provisional application
- Problem cases will end up under this paragraph



Application Filing - 37 C.F.R. § 1.53(d) CPAs

Continued Prosecution Applications

- Replace Rule 62 FWC
- Only Basic Requirement
 - Cannot include new matter

Note: Immediate prior application may be filed before, on or after 6/8/95

- See ___ F.R.____; ___ O.G._____



How to Recognize a CPA

- Application File Wrapper:
 - (a) Typical Contents Entry -
 #11 Request for CPA 12/15/98
 - (b) Face of File: “CPA” label
CPA
- PALM: “Contents” column of 2952 screen - look for “ACPA”(continuation) or “DCPA” (divisional)
- Form paragraph will be in the first action of CPA
- If Notice of Abandonment is received- CPA was not established!
- Patent will include statement re: CPA & 20 yr. patent term



Application Filing - 37 C.F.R. § 1.53(d) CPAs (cont)

CPA Application Attributes

- Uses the file jacket and contents of the prior application
- Uses same application number as prior application
- Prior application is expressly abandoned as of filing date of CPA request



Application Filing - 37 C.F.R. § 1.53(d) CPA (cont)

CPA Filing

- May be filed by fax (§ 1.6(d)(3)) or hand delivered to group
- Certificate of transmission/ mailing under § 1.8 does not apply to filing of CPA
- Filing date is date of receipt of complete facsimile transmission



Application Filing - 37 C.F.R. § 1.53(d) CPA (cont)

CPA Processing in PTO:

- Processing will be performed in Group where prior application assigned
- No new filing receipt issued
- No Office action or interview until filing fees paid.



Application Filing - 37 C.F.R. § 1.53(d) CPA (cont)

Four CPA Requirements for a Filing Date

- 1) Must file request for CPA on a separate paper
 - request for CPA cannot be submitted within papers filed for another purpose
 - "conditional" request for a CPA submitted (as a separate paper) with an amendment after final treated as an unconditional request
- 2) Must identify application number of immediately prior application



Application Filing - 37 C.F.R. § 1.53(d) CPA (cont)

CPA Requirements for a Filing Date (cont)

3) Prior application must be either:

- a complete application
 - including a prior CPA or
- the national stage of an international application in compliance with 35 U.S.C. 371

Note: prior application may have been filed before, on or after
6/8/95

4) Must be filed before earlier of:

- payment of issue fee on the prior application, unless a petition under § 1.313(b)(5) granted;
- abandonment of prior application



Application Filing - 37 C.F.R. § 1.53(d) CPA (cont)

If CPA does not meet filing date requirements

- Group will notify applicant, and
- Corrective options will be explained
 - Petition to revive
 - Petition to convert to § 1.53(b)

Handled by Office of Petitions



Application Filing - 37 C.F.R. § 1.53(d)

CPA (cont)

CPA Filing Fee

- Sum of:
 - basic filing fee and
 - any additional claim fees due
- CPA may be filed without filing fee
 - A "Notice To File Missing Parts" will be prepared & mailed by group requiring filing fee and surcharge



Application Filing - 37 C.F.R. § 1.53(d)

CPA (cont)

Amendments in CPAs

- No new matter may be introduced
- All changes must be made in the form of an amendment to the prior application (§ 1.121)
 - New specification filed with CPA will not be considered part of original application papers - treated as substitute specification
- Prior non-entered § 1.116 amendments will be entered only if requested
- Even if IDS not considered in prior case, must be considered by examiner in CPA- No resubmission or request required.



Application Filing - 37 C.F.R. § 1.53(d) CPA (cont)

CPA: 35 USC 120 Benefits

- The first sentence of the specification need not, and may not, refer to the prior application.
- The effective filing date is (at least) the filing date of the parent.



Application Filing - 37 C.F.R. § 1.53(d) CPA (cont)

CPA Shifting Claimed Invention

- CPA may be filed with amendment adding claims to patentably distinct invention
- Examiner may require restriction/election of species
- If CPA filed as continuation, an election made in the parent application carries over to the CPA
 - unless the CPA indicates otherwise



Carry-Over Documents

CPA (cont)

Papers in the prior application that do **CARRY OVER** to, and will be considered in, a CPA:

- Affidavits/declarations under 37 C.F.R. §§ 1.130-1.132
- Information Disclosure Statements
- Terminal Disclaimers
- Petitions under 37 C.F.R. § 1.48
- Priority claims (foreign and domestic)
- Deposit Account charge authorizations
- Elections
 - unless the CPA is a divisional or indicates otherwise
- Ownership submissions under 37 C.F.R. § 3.73(b)



Carry-Over Documents

CPA (cont)

Papers in the prior application that do **NOT** carry-over to a CPA

- Small Entity Status
 - small entity status must be specifically established in a continuing application, but may be established by payment of the small entity basic filing fee
- Elections
 - where the CPA is a divisional or otherwise indicates that the election in the prior application does not carry over



Application Filing - 37 C.F.R. § 1.63 Oath or Declaration

Per § 1.63, the oath/dec is now required to include:

- Full name of each inventor
- Post office address

Requirement for the post office address has been moved from 37 C.F.R. § 1.33(a), which did not state where in the application the post office address had to be provided.



Application Filing - 37 C.F.R. § 1.63 (d)(1)-(2) Oath or Declaration

A newly executed oath or declaration IS NOT required in a continuation or divisional application.

- A copy of the executed oath or declaration from the prior application may be submitted
- unless a person is named as an inventor who was not named as an inventor in the prior application.



Application Filing - 37 C.F.R. § 1.63 (d)(1)-(2) Oath or Declaration

Continuations and Divisionals

- 37 C.F.R. § 1.63(d) retains benefits of 37 C.F.R. § 1.60 without its drawbacks
- A copy of the oath/dec from the previous application may be used in a continuation or divisional application



Application Filing - 37 C.F.R. § 1.63

Oath or Declaration

When a new oath/dec IS required:

- New applications
- CIPs
- Continuations and divisionals naming a new inventor



37 C.F.R. § 1.63(d)(3)
(Copy of declaration from prior application)

If a petition under § 1.47 was granted in the prior application, a copy of the decision according status under § 1.47 is required...

unless the non-signing inventor(s) subsequently joined in the prior application, in which case only the declaration executed by all of the inventors in the prior application is required.



Application Filing - 37 C.F.R. § 1.41(a) Inventorship

The executed oath/dec names the inventorship:

- Inventor's name is no longer needed for a filing date
- Executed oath/dec sets the names of the inventors
- If no name of an actual inventor is provided with the application papers, an identifier consisting of alphanumeric characters is requested (e.g., attorney docket number)



Application Filing - 37 C.F.R. § 1.53(d) Inventorship

Changes of Inventorship in CPA

- To Delete Inventors: Append a statement to the CPA request deleting the non-inventor(s).
- To Add Inventors: Submit a petition under 37 C.F.R. § 1.48. If a CPA names additional inventors, they are not added except and until a § 1.48 petition is filed and granted.



Application Filing - 37 C.F.R. § 1.41(a) Inventorship

Inventorship in a nonprovisional application is set forth in the executed oath/dec filed under § 1.63 during the pendency of the application:

- IF a signed § 1.63 oath/declaration was not filed during pendency, inventorship will be established from the application papers filed under § 1.53(b)



Application Filing - 37 C.F.R. § 1.41(a) Inventorship

Inventorship in provisional application identified in:

- Cover sheet; or in the
- Application papers under § 1.53(c), IF the cover sheet was not filed during pendency of the provisional application; or in a
- Petition under § 1.41(a)(2) for change of names or inventors.



Application Filing Changes:

- 37 C.F.R. § 1.60 and 1.62 eliminated
- 37 C.F.R. § 1.63(d) provides for the use of a copy of the executed oath/declaration from a prior application in a continuation or divisional (filed under 37 C.F.R. § 1.53(b))
 - *Replaces practice under 37 C.F.R. § 1.60*
- 37 C.F.R. § 1.53(d) provides for Continued Prosecution Applications (CPAs)
 - *Replaces practice under 37 C.F.R. § 1.62*



Application Filing

Continuation/Divisional using a copy of the oath/declaration of the prior application

- Former Practice
(37 C.F.R. § 1.60)
 - new application number assigned
 - *true copy of prior application*
 - *true copy statement*
 - continuing data in first sentence of the specification
- New Practice
(37 C.F.R. § 1.53(b))
 - new application number assigned
 - **copy of prior application or new specification and drawings**
 - continuing data in first sentence of the specification



Filing Requirements

Former 37 C.F.R. § 1.60

- reference to filing under 37 C.F.R. § 1.60 (Rule 60)
- true copy of prior application (specification, claims, drawings, signed oath/declaration)
- true copy statement
- same or fewer than all inventors named in prior application
- filed prior to patenting, abandonment, or termination of proceeding on prior application

New 37 C.F.R. § 1.53(b)

- **no reference to any rule**
- **copy of prior application or new specification, claims, drawings with signed oath/declaration of prior application**
- same or fewer than all inventors named in prior application
- filed prior to patenting, abandonment, or termination of proceeding on prior application



Comparison of new and former sections

Disadvantages of former 37

C.F.R. § 1.60

- If true copy of prior application or true copy statement omitted, NO filing date - loss of patent term while filing date petition is being decided
- must file any “corrected” specification as a substitute specification (more paper in the application file)

Advantages of new 37

C.F.R. § 1.53(b)

- Permits the filing of a continuation/divisional using a copy of the oath declaration of the prior application, without the true copy requirement
- no need to reference any specific rule
- one section (37 C.F.R. § 1.53) for filing all applications



Application Filing

Continued Prosecution Application (CPA)

Former Practice (37 C.F.R. §1.62)

- may be used to file continuation, divisional, or CIP
- new application number assigned
- request for an FWC must be filed
- file jacket and content of prior application used in new file jacket
- newly executed oath/declaration required for CIP
- continuing data in first sentence of specification

New Practice (37 C.F.R. § 1.53(d))

- may be used to file continuation or divisional, but not a CIP
- the immediate prior application may have been filed before, on or after June 8, 1995
- no new application number assigned
- request for a CPA must be filed
- file jacket and content of prior application used for CPA
- no continuing data in first sentence of specification



Filing Requirements

Former 37 C.F.R. § 1.62

- Request for *FWC*
 - must be signed
 - must identify prior application
- Must be filed prior to payment of issue fee, abandonment, or termination of proceedings on prior application
- prior application must be complete

New 37 C.F.R. § 1.53(d)

- Request for **CPA**
 - must be signed
 - must identify prior application
- Must be filed prior to payment of issue fee, abandonment, or termination of proceedings on prior application
- prior application must be complete **and may have been filed before, on or after June 8, 1995**



Comparison of new and former sections

Disadvantages of **former**

37 C.F.R. § 1.62

Loss of potential patent term due to following delays:

- If the FWC request is filed with a new (or copy of prior) specification, NO filing date
- identification of wrong application, NO filing date
- processed by OIPE as a new application

Advantages of **new**

37 C.F.R. § 1.53(d)

- If the CPA request is filed with a new (or copy of prior) specification, treated as substitute specification, NOT a filing date issue
- identification of wrong application: submitter contacted to determine corrected application number, NOT a filing date issue
- processed by Group as a submission in the prior application (no pre-examination delays)



Topic 2: Deceptive Intent

- 37 C.F.R. § 1.4 Verification of correspondence
- 37 C.F.R. § 1.48 & 1.324 Correction of inventorship
- 37 C.F.R. § 1.171 & 1.175 Reissues.
- 37 C.F.R. § 3.73(b) Establishing right of assignee to prosecute.
- 37 C.F.R. § 1.28 Small Entity Status



Deceptive Intent - 37 C.F.R. § 1.4

37 C.F.R. § 1.4 and 10.18:

- Puts inventors on the same plane as attorneys and agents
- An explicit verification is not required for certain submissions, e.g. small entity statements (§ 1.27), correction of inventorship (§ 1.48), substituted specifications (§ 1.125).
- The verification requirement is retained in certain sections (*e.g.*, 37 C.F.R. § 1.63 oaths, §§ 1.130, 1.131, and 1.132 affidavits).



Deceptive Intent - 37 C.F.R. § 1.48 & 1.324

Correction of inventorship in applications & patents

- Eliminated factual showing requirements
- Eliminated diligence requirements
- Narrowed and changed parties who must submit statements

37 C.F.R. §§ 1.48 and 1.324: statements re: deceptive intent required only from inventors to be added to or deleted from application

- § 1.324 additionally requires statement of acquiescence from other original named inventors
- § 1.63 oath/dec no longer needed under § 1.324



Deceptive Intent - Reissue

Requirement for title report in 37 C.F.R. § 1.171
is eliminated

Reissue oath/dec (37 C.F.R. § 1.175) simplified:

only one error being corrected need be identified

...instead of all errors

only a general statement as to lack of deceptive intent is required

... instead of a detailed showing of facts as to how the errors
arose or occurred



Deceptive Intent - 37 C.F.R. § 1.175(b)&(c) (Reissue Oath or Declaration- cont)

- Supplemental Oath or Declaration:
- Only required at allowance
- Should cover all errors corrected after initial declaration
- Need not identify any errors unless the originally identified error no longer remains as basis for reissue



Deceptive Intent - 37 C.F.R. § 1.175 (Reissue Oath or Declaration -Transition)

Between publication and when new rules become effective:

- * If there is a petition under § 1.183 to waive 37 C.F.R. § 1.175, send to Petitions Office
- * Evaluate oath/declaration under current standards: if acceptable, then allow; if not, then depending upon timing, send out suspension letter or just wait for effective date.

After new rules become effective:

- * All pending reissue applications (even if filed under old rules) are only subject to requirements of new rules



Deceptive Intent - 37 C.F.R. § 3.73

The assignee's ownership interest is established by filing a statement under 37 C.F.R.

§ 3.73(b) :

37 C.F.R. § 3.73(b) no longer requires that an assignee

- specifically state that the evidentiary documents have been reviewed, and
- certify that title is in the assignee seeking to take action



Deceptive Intent - 37 C.F.R. § 1.28 (a)(2)

Small Entity Status

The payment of the small entity basic statutory filing fee will be treated as the required reference to a small entity statement in a prior application or in a patent in:

- continuing applications, and
- reissue applications



Topic 3: Appeal Process

- 37 C.F.R. § 1.191 Notice of Appeal
- 37 C.F.R. § 1.193 Examiner's Answer & Reply Brief
- 37 C.F.R. § 1.196 Decision by the Board



Appeal Process - 37 C.F.R. § 1.191

No Longer Require a Notice of Appeal to

- be signed
- identify the appealed claims



Appeal Process - 37 C.F.R. § 1.193 Examiner's Answer

While § 1.193 precludes New Grounds of rejection
in an Examiner's Answer,

IF

1. an amendment under §1.116 is submitted, and
2. advisory action indicates the § 1.116 amendment would be entered for appeal purposes, and which individual rejections in final would be used to reject the new or amended claims,

THEN

3. Appeal brief must address the indicated rejections, and
4. Examiner's Answer may include such rejections

Prosecution reopened for new ground(s) of rejection.



Appeal Process - 37 C.F.R. § 1.193

Where prosecution is reopened, under § 1.193(b)(2), appellant must:

- file an appropriate reply to the Office action; or
- request reinstatement of the appeal
 - request must be accompanied by a supplemental appeal brief
- reinstatement option will avoid need for a final Office action when applicant chooses to go back to the Board of Appeals

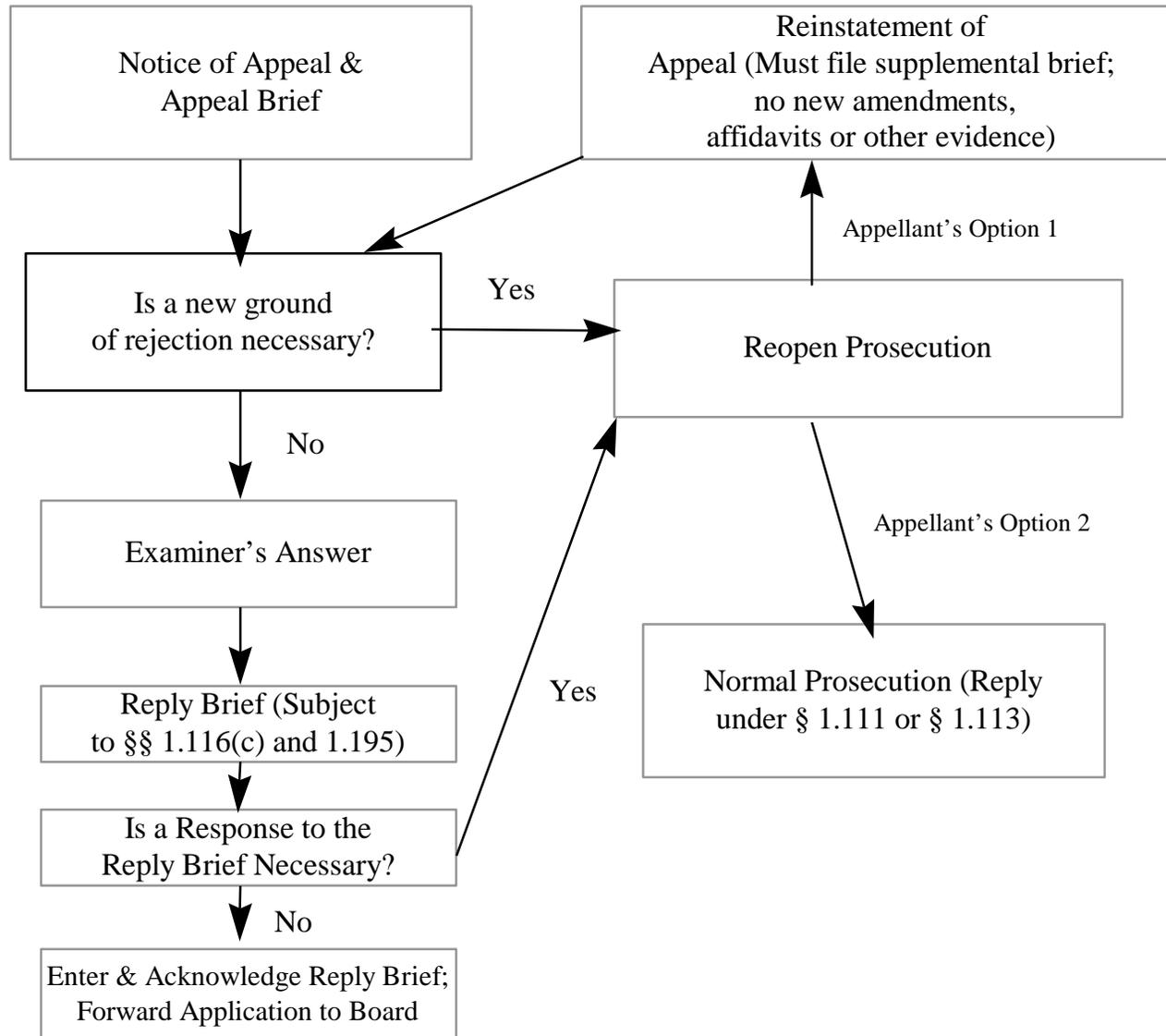


Appeal Process - 37 C.F.R. § 1.193

- Timely reply brief always entered--§ 1.193(b)(1)
 - New amendments, affidavits, declarations, or exhibits are not entered except as permitted by §§ 1.116 and 1.195.
 - Examiner must:
 - acknowledge and enter the reply brief; or
 - reopen prosecution to respond to the reply brief
- Supplemental examiner's answer not permitted



Appeal Process Flowchart





Appeal Process - 37 C.F.R. § 1.196

Decision by Bd. Pat. App. & Int.

Where the Board would have recommended a rejection of allowed claims under 37 C.F.R. § 1.196(d)...

the Board must now expressly reject the claims(s) under 37 C.F.R. § 1.196(b).



Topic 4: Time to Reply

- 37 C.F.R. § 1.135 Abandonment for failure to reply within time period.
- 37 C.F.R. § 1.136 Extensions of time.
- 37 C.F.R. § 1.137 Revival of abandoned application or lapsed patent.



Time to Reply - 37 C.F.R. § 1.135(c)

Treatment of bona fide but incomplete replies to non-final Office action.

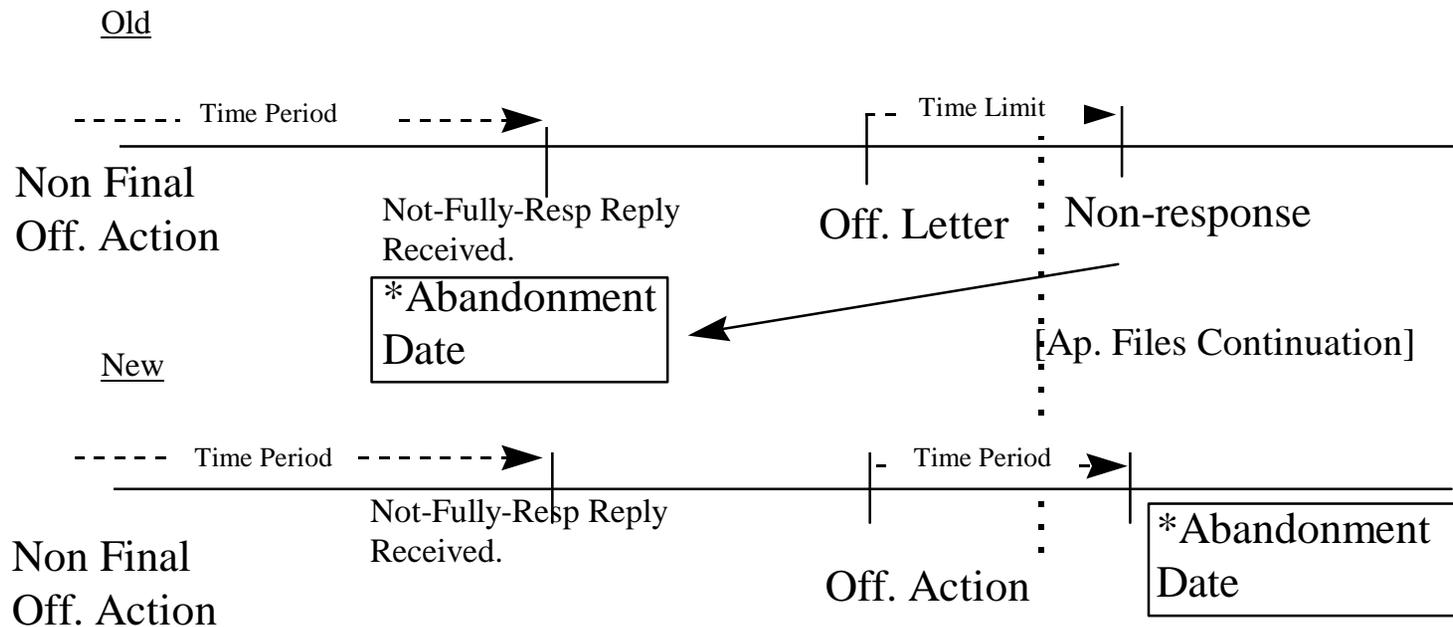
May be accepted and treated by:

- 1) Acting on the merits of the reply; or
- 2) Requiring the omission to be supplied prior to acting on the merits of the reply.
 - new extendible time period (not time limit)
may be given
 - remaining time period if sufficient



Time to Reply - 37 C.F.R. § 1.135(c)

Comparison of Old to New





Time to Reply - 37 C.F.R. § 1.135(c)

Exception:

- Does **not** apply after a **final** Office action, not even if the omission is:
 - 1) a lack of a signature; or
 - 2) a lack of additional claims fee
- An applicant must supply any omission in a reply to a **final** Office action within the period for reply to the **final** Office action.



Time to Reply - 37 C.F.R. § 1.136

- The cap is now five months
- Separate and specific petition is no longer needed.
 - a petition will be construed whenever possible
- Five Months is possible for
 - 1) one month restrictions
 - 2) one month periods under § 1.135(c)
 - 3) appeal briefs (up to 7- not subject to stat. period)



Time to Reply- 37 C.F.R. § 1.17 Paragraphs

Former

New

- 1.17(a) 1.17(a)(1) - reply within 1st month
- 1.17(b) 1.17(a)(2) - reply within 2nd month
- 1.17(c) 1.17(a)(3) - reply within 3rd month
- 1.17(d) 1.17(a)(4) - reply within 4th month
- ---- 1.17(a)(5) - reply within 5th month
- 1.17(e) 1.17(b) - notice of appeal fee
- 1.17(f) 1.17(c) - appeal brief fee
- 1.17(g) 1.17(d) - oral hearing fee



Time to Reply - 37 C.F.R. § 1.137

Abandonment and Revival:

- Removal of one-year cap for filing a petition based on unintentional delay. (37 C.F.R. § 1.137(b))
 - Emphasizes that the entire delay must have been unintentional to preclude intentional delay or abuse of the revival procedure (*e.g.*, submarine patents).
 - Long abandoned applications will receive greater scrutiny
- Terminal disclaimer required for all applications not subject to 20 year term



Topic 5: Miscellaneous

- 37 C.F.R. § 1.14(a)(2) Access to file
- 37 C.F.R. § 1.59 Petitions to expunge
- 37 C.F.R. § 1.121 Manner of making amendments
- 37 C.F.R. § 1.125 Substitute specification
- 37 C.F.R. § 1.152 Design patent applications
- 37 C.F.R. § 1.291 Protests by the public against pending applications



Miscellaneous- 37 C.F.R. § 1.14(a)(2)

Access

If a pending application has been incorporated by reference in a U.S. Patent, then a copy of the original disclosure can be supplied without a petition for access, as was the former requirement.

- written request required, with payment of required fee (§ 1.19(b)(2))
- applicant not notified



Miscellaneous - 37 C.F.R. § 1.59

Expungement

- Will continue practice of not expunging information forming part of the original disclosure from the application file
- Now provided for by 37 C.F.R. § 1.59 rather than under the general 37 C.F.R. § 1.182



Miscellaneous - 37 C.F.R. § 1.59

Petition to Expunge (cont)

- Group determines whether the information is “material to patentability” or “important to a reasonable examiner in deciding whether to allow the application to issue as a patent.”



Miscellaneous - 37 C.F.R. § 1.121

Manner of Making Amendments

- Applications other than reissues 37 C.F.R. § 1.121(a)
 - (a) (1) - spec
 - (a) (2) - claims
 - (a) (3) - drawings
- Reissue Applications 37 C.F.R. § 1.121(b)
 - (b) (1) - spec
 - (b) (2) - claims
 - (b) (3) - drawings
- Reexaminations 37 C.F.R. § 1.121(c)



Miscellaneous - 37 C.F.R. § 1.121

- No change in substance for applications other than reissues
- Reissue practice made to conform to reexamination
- Disclosure must be amended when required to ensure *substantial* correspondence between the specification (including the claims) and the drawings.



Miscellaneous - 37 C.F.R. § 1.121(b)

Reissues:

Specification is amended only by rewriting *entire* paragraphs showing underlining and bracketing - but entire paragraphs may be deleted by an instruction.

Claims are amended only by

- rewriting the *entire* claim showing underlining and bracketing or
- request to delete the claim

Hand entry of less than five words no longer allowed



Miscellaneous - 37 C.F.R. § 1.121(b)

Reissues:

37 C.F.R. § 1.121(b)(2)(ii) & (iii):

Each amendment submission must include

- status of all claims
- support in disclosure for amendatory material, i.e. additions and deletions

37 C.F.R. § 1.121(b)(3): Amend drawings with new sheets labeling new figures as -new- or -amended-



Miscellaneous - 37 C.F.R. § 1.121(b)

Transition-Reissue Amendments:

Old rules control for amendments filed prior to effective date of Final Rule.



Miscellaneous - 37 C.F.R. § 1.125 (Substitute Specification)

This section codifies that a substitute specification is permitted as follows:

- 1) it is submitted in clean form in the desired language without changes being indicated;
- 2) it is accompanied by a statement that it includes no new matter;
- 3) it is accompanied by a “marked up” copy of the specification, for reference purposes only, which indicates all changes from the last amended version.



Miscellaneous - 37 C.F.R. § 1.152

Design Patent Applications

- the prohibition against color drawings and photographs is replaced by a petition procedure (§ 1.152(a)(2))
- all details of informal drawings must be present in the final drawings unless originally disclaimed



Miscellaneous - 37 C.F.R. § 1.291(c)

Protests by the public against pending applications.

- More than 1 prior art submission (protest) by a single party is now permitted
- Timeliness of submission is still a factor



Summaries

- Topic 1. Application Filing
- Topic 2. Deceptive Intent
- Topic 3. Appeal Process
- Topic 4. Time-to-Reply
- Topic 5. Miscellaneous



Filing of Applications (summary)

- All applications under 35 U.S.C. § 111 filed under 37 C.F.R. § 1.53
 - 37 C.F.R. §§ 1.60 and 1.62 eliminated
- Continuations/divisionals may be filed using copy of an oath/dec. from prior application
- P.O. Address must be in oath/dec.
- Names of the inventors not needed for a filing date
 - The inventorship is named in the executed oath/dec.



Filing of Applications (summary)

- Continued Prosecution Application (CPA) under 37 C.F.R. § 1.53(d)
 - Immediate prior application may be filed before, on or after June 8, 1995*
 - No C-I-P permitted
 - Same application number/file jacket as prior application
 - No “first sentence” reference to prior application
 - Front of file jacket will not show CPA continuing data
 - Will be processed entirely by Group
 - **May be filed by facsimile**
- *Note: See ____F.R.____; ____ O.G.____



Deceptive Intent (summary)

- Separate verification requirement eliminated in a number of sections
- Requirements for a reissue oath/dec. simplified
- Requirements for a petition to correct inventorship simplified
- The payment of the small entity filing fee in a continuing or reissue application substitutes for a reference to the small entity statement in the prior application or patent



Appeals (summary)

- No new ground of rejection in an examiner's answer but permitted to apply individual rejections of final to claims of §1.116 amendment
- Any new ground of rejection on appeal or response to a reply brief must be via reopening of prosecution
 - The applicant may request reinstatement of the appeal in reply to reopening of prosecution
- Reply briefs must be admitted if timely
- Supplemental Examiner's Answer not permitted



Time Frames (summary)

- Applicants may be given an extendible time period to supply an omission to a *bona fide* but incomplete reply to a non-final action
- Extensions for up to five (5) months now permitted under 37 C.F.R. § 1.136(a)
- Fee authorization or fee itself is a constructive petition under 37 C.F.R. § 1.136(a)
- One year filing period requirement for revival based upon unintentional delay (37 C.F.R. § 1.137(b)) eliminated
- Multiple prior art protests permitted if timely



Miscellaneous (summary)

- Reissue amendments (37 C.F.R. § 1.121(b)) made the same as reexamination amendments
- Substitute specification permitted if accompanied by a “no new matter” statement
- Color drawings and photographs in design drawings permitted upon petition
 - 37 C.F.R. § 1.152 clarifies that all non-disclaimed matter in original drawings is an integral part of the disclosure/claim and cannot be removed
- Petitions to expunge explicitly provided for in 37 C.F.R. § 1.59



For Further Information Contact

Section

Legal Advisor(s)

§§ 1.4, 1.33

Robert Bahr

§§ 1.6, 1.41, 1.53

John Gonzales/ Fred Silverberg/ Robert Bahr

§§ 1.48, 1.324

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§§ 1.14, 1.59, 1.63

Karin Tyson/ Jay Lucas

§§ 1.104, 1.152

Romulo Delmendo

§§ 1.84, 1.91, 1.121, 1.125

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§§ 1.135, 1.136, 1.137

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§§ 1.11, 1.171, 1.172, 1.175

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§§ 1.191, 1.193, 1.196

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§ 1.291

John Gonzales/ Fred Silverberg

§ 3.73(b)

Kenneth Schor/ Hiram Bernstein

§§ 1.510, 1.530, 1.550

Gerald Dost/ Kenneth Schor



Final Rule: Changes to the Patent Practice and Procedure

Effective Date:

December 1, 1997

Thank you.