



Date: September 10, 2004

To: Technology Center Directors

From: /s/ by Robert J. Spar for Steve Kunin  
Stephen G. Kunin  
Deputy Commissioner for  
Patent Examination Policy

Subject: Clarification of the Effective Date Provision in the Rules of Practice before the Board of Patent Appeals and Interferences (Final Rule) and the Provision of Revised or New forms for Implementation of the Final Rule

Effective Date:

The USPTO will be publishing an Official Gazette notice clarifying the effective date provision in the Rules of Practice before the Board of Patent Appeals and Interferences (Final Rule) (hereinafter BPAI final rule) and providing numerous examples. A signed copy of this notice is attached to this memorandum.

Generally, any paper filed by applicants or mailed by the Office on or after September 13, 2004 must comply with the rules as set forth in the BPAI final rule. Appeal briefs filed prior to September 13, 2004 must either comply with former § 1.192 or new § 41.37. A certificate of mailing or transmission in compliance with § 1.8 will be applicable to determine if a paper was filed prior to the effective date of September 13, 2004 in order to determine which rule applies.

Revised and New Forms:

For implementation of the BPAI final rule, the forms pertaining to advisory actions and appeals (PTOL-303, PTOL-461, PTOL-462, PTOL-462R, PTOL-467, PTOL-468, PTOL-469, PTOL-2066, PTOL-2067, PTOL-2068, and PTOL-2073) are revised and two new advisory forms (PTOL-304 and PTOL-467A) are provided for replies or responses filed with or after the appeal brief. Forms PTOL-303 and PTOL-467 are limited to replies or responses filed prior to the filing of the appeal brief. All revised and new forms have a revision date of September 2004. These forms must be used to reply to communications subject to the rules in the BPAI final rule.

Examiners can access these revised or new forms either by following the instructions in the attachment to upload the forms into the custom form paragraph folder in OACS or downloading the Word files to their computers from the Intranet site for Patent Examination Policy Internal Notice at <http://ptoweb/patents/opla/>. In addition, the Notice of Non-Compliant Amendment (37 CFR 1.121) is also provided with the revised forms for use with advisory actions when appropriate.

These revised and new forms will be incorporated into OACS as soon as possible. In addition, Form Paragraphs pertaining to advisory actions and appeals will be revised and distributed to Examining Corps personnel as soon as possible.

For further information, please contact Kery Fries, Senior Legal Advisor in the Office of Patent Legal Administration, at (703) 308-0687, or (571) 272-7704 on or after September 29, 2004, or by e-mail at [Kery.Fries@USPTO.gov](mailto:Kery.Fries@USPTO.gov).

Attachments:

Signed Official Gazette Notice entitled “Clarification of the Effective Date Provision in the Rules of Practice before the Board of Patent Appeals and Interferences (Final Rule)”  
Instructions to upload forms into OACS custom form paragraphs