

## Highlights of the PBG - Final Rule

Federal Register 65 Fed. Reg. 54603 (September 8, 2000)  
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### 1. Examiner Requirements for Information (§ 1.105):

Examiners are provided with explicit authority to require such information as may be reasonably necessary to properly examine an application. The rule specifically provides for requesting information regarding:

- the existence of any particularly relevant commercial data base known to any of the inventors that could be searched for a particular aspect of the invention;
- whether any prior art search was made, and if so, what was searched;
- any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention;
- any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application;
- any non-patent literature, published application, or patent (U.S. or foreign) used in the invention process, such as by designing around or providing a solution to accomplish an invention result;
- what is being improved upon by the claimed invention; and
- any use of the claimed invention which use was known to any of the inventors at the time the application was filed notwithstanding the date of the use.

The Office intends to encourage examiners and the Technology Centers to use this tool where appropriate to improve the quality of searches and examinations. Examiners shall be trained and provided with guidelines so as to ensure appropriate usage of this authority.

### 2. Amendment Practice (§ 1.121):

The method of making amendments to the specification/claims is changed to require “clean” replacement paragraphs (or sections), and “clean” rewritten claims. A marked up version is also required to aid the examiner in identification of changes. An entire paragraph/claim can be deleted by an instruction. Paragraph numbering is not required and the location of any change can be identified by any convenient technique. A single, separate clean version of all of the claims pending in the application may be submitted by applicant.

An exception is provided for an examiner's amendment, e.g., to add a few words in a paragraph or claim without supplying a clean replacement version. Also, an examiner's amendment may include as an attachment, a printed portion from an e-mail or a fax from an applicant of a replacement or additional portion of a paragraph or claim, to be entered into the record.

This change in practice will substantially reduce occurrences of hard to scan brackets, underlining, and red ink additions to an application, thereby providing a substantially clean version to be employed in the patent publication process, which, in turn, should result in fewer errors in printed patents and fewer certificates of correction. Implementation will be phased in and compliance will be permitted as of the effective date of the rule but will not be required until March 1, 2001.

3. Electronic Submission of: Computer Program Listings, Nucleotide and/or Amino Acid Sequences, and Tables (§§ 1.96, 1.821+, 1.52(e), 1.58):

Computer program listings (§ 1.96) will no longer be permitted in microfiche format, and must be on CD-ROM or CD-R as the official copy if over 300 lines.

For nucleotide and/or amino acid sequences (§ 1.821+), no change is made to the current CRF practice under § 1.821(e), but the current paper version under § 1.821(c) can continue, or the information can be presented on CD-ROM or CD-R.

For tables of data (§ 1.58) of more than 50 pages, a CD-ROM or CD-R can be used instead of submitting the information on paper.

Implementation for both §§ 1.96 and 1.821 will be phased in and compliance will be permitted as of the effective date of the rule but is not required until March 1, 2001.

4. Establishment of Small Entity Status (§ 1.27):

Small entity status is obtained by a simple written assertion of entitlement to such status. Specific forms or specific averments are no longer required. The Office will liberally construe any written reference to small entity status as a request for such status.

The parties who can request small entity status are expanded to include: a registered practitioner (who need not actually be of record), one of the inventors (instead of all the inventors), or a partial assignee (instead of all the assignees). Note: An assignee assertion must be filed by a § 1.33(b) party, § 1.27(c)(2)(iii).

Payment of the exact small entity basic filing or basic national fee will be construed as an assertion of small entity status. Note: Payment of any other fee in its exact small entity amount will not result in small entity status absent a written assertion.

5. Drawing Corrections (§ 1.84): While the requirements for formal drawing will mostly remain

the same (to provide information on how to obtain a high quality drawing), the Office will implement the rule more liberally. The Office will focus on having a drawing that can communicate the invention to the examiner and on the scannability of the drawings so as to produce readable drawings in published applications and patents. The number of requirements for corrections of drawings are expected to decrease.

6. Design Applications (§ 1.155):

An expedited procedure for design applications will be created in view of their sometimes short economic life. Treatment by the Office will be expeditious from the time an application is filed until it is issued, including both examination and processing.

The (additional) requirements to obtain expedited treatment are: a \$900 fee, drawings in compliance with § 1.84, a preexamination search, a statement that the preexamination search was conducted with an indication of the field of search, and an information disclosure statement under §§ 1.97 and 1.98 based on the preexamination search.

7. Corrected Filing Receipts (§ 1.19(h)): The \$25 fee for obtaining a corrected filing receipt is removed as the service is now performed without cost.

8. Application Data Sheet (ADS) (§1.76):

Bibliographic as well as foreign application information may be in an application data sheet (ADS) under § 1.76 rather than in the § 1.63 oath or declaration, thereby permitting easier corrections, additions, and updating of such information. §1.63(c).

A format, for an ADS, (not a form) is provided to supply bibliographic information so that it can be inputted into Office records more accurately by scanning. This should reduce errors in filing receipts. § 1.76.

Applicant may submit, as part of an electronic ADS, the class/subclass, and Technology Center where the application should be classified and examined, a suggested drawing figure for publication, and the Latin name of the genus and species of a plant and the variety denomination. §§ 1.76, 1.163(c)(4) and (5).

The priority reference under 35 U.S.C. 120 may be in the ADS rather than in the first sentence of the specification. § 1.78.

9. Miscellaneous:

- Section 1.14. The section permitting status information to be given for and access

granted to applications is completely rewritten so as to be easier to understand. It is clarified that a practitioner named in a representative capacity in the application papers can grant a power to inspect if an oath or declaration under § 1.63 has not yet been filed (§1.14(d)(4)). Access is no longer given to an abandoned application simply because it claims benefit of the filing date of another application that is open to public inspection (former § 1.14(a)(3)(iv)(C) is dropped).

- Section 1.33. The correspondence address can be changed by the party filing the application prior to submission of an executed § 1.63 oath/declaration. A request has been added for a daytime telephone number.
- Section 1.44 is deleted. The authority of a legal representative may simply be stated on the oath/declaration (by use of the title, Legal Representative, next to the signature) without proof thereof by court certificate.
- Section 1.53(f)(5). The application retention fee (an alternative to the filing fee where the application is to be refiled) must now be submitted during the pendency of the prior application rather than within a one year period from the date of notification to pay the application filing fee.
- Section 1.55(a). A claim for foreign priority filed after the issue fee is paid will be placed in the file but not reviewed. The printed patent will not contain a priority claim, but a certificate of correction can be filed for Office review of the priority claim.
- Section 1.63(a). Clarifies that there is no (minimum) age requirement for signing an oath/declaration (competency to understand what is being signed is the issue). The expression “mailing address” replaces “post office address” to improve clarity.
- Section 1.67. Supplemental oaths or declarations under § 1.63 may be supplied by less than all the inventors if the error to be corrected applies to less than all the inventors.
- Section 1.72(b). The abstract is decreased to no more than 150 words from 250.
- Section 1.85. Extensions of time are eliminated for filing corrected or formal drawings.
- Section 1.97(d). Eliminates 3 month window for filing Information Disclosure Statements (IDSs) in § 1.53(d) CPA applications.
- Sections §§ 1.97(c) and (d). The fees for IDS submissions, both before and after a final rejection, are now a uniform \$180.
- Section 1.98(a)(2). Copies of U.S. patent applications that are being cited in IDSs must be supplied.
- Sections 1.111 and 1.115. Second supplemental replies and any preliminary amendment (not filed with a § 1.53(d) CPA or within three months of a § 1.53(b) application) may be disapproved, if they unduly interfere with an examiner’s preparation of an Office action.
- Sections 1.131 and 1.132. Rejections based on prior knowledge or use under 35 U.S.C. 102(a) can be avoided under §§ 1.131 and 1.132 (in addition to e.g.,

- rejections based on patents and printed publications).
- Sections 1.163(c)(4) and (5). The Latin name of the genus and species of a plant, and the variety denomination must be supplied, optionally in the § 1.76 ADS.
- For reissue applications:
  - Section 1.173(a)(1). The specification and claims are now to be supplied in double column format (applicant now just copies the patent, eliminating the prior requirement to cut up the patent to produce a single column format);
  - Section 1.173(a)(1). A copy of any disclaimer (§ 1.321), certificate of correction (§§ 1.322-324), or reexamination certificate (§ 1.570) is to be submitted along with the reissue application.
  - Section 1.173(c). The status of all claims, and an explanation of support in the disclosure of the patent must be submitted when changes to the claims are made at filing (in addition to the previous requirement of when an amendment is made during prosecution);
  - Section 1.178(a). An offer to surrender a patent is no longer required on filing of a reissue application (although the patent must be surrendered before the reissue application is allowed).
  - Section 1.178(b). The Office's attention is to be called to any prior or concurrent proceedings in which the patent is or was involved, such as interferences, reissues, reexaminations, or litigation, and the results of such proceedings.
- For divisional reissues:
  - Section 1.176. Restriction is now possible between the original patent claims and any added claims that are directed to previously unclaimed subject matter. There will be a constructive election of the original patent claims unless all the original patent claims are disclaimed on filing of the reissue; and
  - Section 1.177. Eliminated requirements: to limit divisional reissues to separate and distinct claims, for simultaneous issuance unless otherwise excepted, for a petition to avoid simultaneous issue, and referral to the Commissioner upon filing.
- Section 1.311(b). Authorizations to charge the issue fee may only be filed after the mailing of the notice of allowance.
- Section 1.322. Clarifies that while third parties may request that the Office consider issuing a certificate of correction, they have no standing to require that it be done.
- Sections 3.71 and 3.73. Defines single and partial assignees as being of record, clarifies how to become of record and thereby intervene to control prosecution, and clarifies how to show who is the appropriate assignee and that such requirement is separate from the action taking requirement.
- Section 3.81(b). For issuance of a patent to an assignee, no longer must an assignment be recorded as applicant can rely on a § 3.73(b) statement.

9. Further information: Robert J. Spar, Director ((703) 308-5107), Hiram H. Bernstein ((703) 305-8713), or Robert Bahr ((703) 305-0471), Senior Legal Advisors, Office of Patent Legal Administration.