

Highlights

“Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan,” 69 Fed. Reg. 56481 (September 21, 2004) (Final Rule)

The more significant changes in the Strategic Plan final rule making are as follows:

- § 1.4 - S-signatures and EFS character coded signatures: S-signatures and EFS character coded signatures, signatures other than handwritten permanent ink signatures, such as electronic signatures, have been provided for in patent correspondence.
- § 1.6 - Drawings: Drawings may be facsimile filed at any time (after application has been filed).
- § 1.17 - Petition fees: Three tier petition fee structure of \$130, \$200 and \$400 is established.
- § 1.19 - Document supply fees: Copies supplied in paper or electronic form.
- § 1.27 - Small entity relief: A security interest will not bar entitlement to small entity status, and foreign applicants do not have to meet certain SBA requirements to qualify as small entity.
- § 1.57 - Incorporation by reference (new rule): (1) A priority/benefit claim submitted on filing will act as a limited incorporation by reference for inadvertently omitted material. (2) For essential or nonessential material: specific language is required to trigger an incorporation by reference. (3) Definitions of “essential” and “non-essential” material are provided.
- §§ 1.58, 1.83 - Table duplication: Tables and listings must not be in both specification and drawings.
- § 1.76 - Application Data Sheet - Supplemental application data sheets must supply all appropriate information (not just what is being changed) and identify the changes.
- § 1.78 - Benefit claims: Multiple sentences are now permitted for making benefit claims.
- § 1.84 - Drawings: Requirement for black and white copies of color drawings and photos eliminated.
- §§ 1.91, 94 - Models, exhibits, and specimens: (1) Photos must be supplied with physical models and exhibits. (2) Perishables will be disposed of unless return is timely requested.
- § 1.98 - IDS: (1) Copies of U.S. patents and PG Pubs no longer required to be supplied with an IDS. (2) Required format items established for non-PTO IDS forms.
- § 1.102 - Advancement of examination: Counter terrorism no fee petition to make special established.
- § 1.105 - Requirements for information: Applicant may be required to supply technical/factual information concerning the related art, the disclosure, the claims, other factual information pertinent to patentability, or the accuracy of the examiner’s position of such items.
- § 1.111 - Supplemental replies: Like after final amendments, approval of examiner is needed for entry.
- § 1.115 - Preliminary amendments: If present on filing date, preliminary amendments are part of original disclosure. If they contain subject matter not otherwise present in the specification, they must be referred to in a § 1.63 oath/declaration.
- §§ 1.175, 1.178, 1.179 - Reissue: A continuation reissue must identify an error not identified by the pending parent application. Eliminated requirements to: (a) physically surrender original “ribboned” letters patent, and (b) place notices in original patent file.
- § 1.215 - PG Pubs: Amendments to claims, abstract and drawings may be included in publications.
- § 1.291 - Protests: Additional protests by a party must explain why additional cited art is significantly different, and why they were not earlier presented.