



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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Changes to Patent Practice of Procedure - Final Rule

62 Fed. Reg. 53131 (October 10, 1997);
1203 Off. Gaz. Pat. Office 63 (October 21, 1997)

Condensed - Subject Matter Summary II

The following represents highlights from the final rule "Changes to Patent Practice and Procedure."

Filing of Applications

All applications are now to be filed under rule 53 as prior rules 60 and 62, for filing of continuing applications (continuations, divisions and continuations-in-part), are eliminated:

continuation and divisional applications, similar to old rule 60, may continue to be filed with a copy of an oath or declaration and with the ability to delete one or more inventors, under § 1.53(b).

A new type of application, a continued prosecution application, CPA has been created, § 1.53(d), which:

will be processed directly in the Group rather than in Office of Initial Patent Examination as it utilizes the same file jacket, application no. and filing date as the prior complete application:

fax submission direct to the Group is permitted (with the filing date being the date of receipt if the receipt and transmission dates differ).

A CPA application:

can name the same or fewer than all the inventors named in the prior application,

* can have an immediate prior application filed before, on, or after June 8, 1995,

but may not:

be a CIP application.

The naming of the actual inventors is no longer required to obtain a filing date for an application pursuant to amendments to §§ 1.41 and 1.53. Where an application is filed without an executed oath or declaration under § 1.63 but sets forth an inventor's name:

the subsequent submission of an oath or declaration with a different inventive entity will set forth the inventorship, § 1.48(f), eliminating the need for a § 1.48(a) petition, and

where an inventor's name is not originally set forth, until such time as an executed oath or declaration is submitted, an alphanumeric identifier should be used.

Deceptive Intent Issues

The separate verification requirements have been eliminated in rules 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, due to amendment of §§ 1.4 and 10.18.

Reissue oaths or declarations under § 1.175 have been simplified:

only one error being corrected need be identified instead of all errors,

only a general statement as to a lack of deceptive intent is required instead of a detailed showing of facts and circumstances as to how each error arose or occurred, and

only one supplemental oath or declaration need be supplied prior to allowance stating all errors not covered by the original oath or declaration arose without deceptive intent instead of a new oath or declaration with each amendment.

Petitions to correct inventorship in pending applications other than reissue applications, § 1.48, and in patents, § 1.324, have been liberalized:

diligence requirement for filing of petition deleted,

parties submitting a statement of facts as to how the error occurred changed to those being added or deleted rather than all (§ 1.324 requires statement of agreement or nondisagreement from the other inventors), and

statements of facts may now simply state lack of deceptive intent rather than supply facts and circumstances, and are not required to be verified.

Small entity status can be obtained without a new statement in CPA and reissue applications, and payment of a small entity fee in a continuing or reissue application substitutes for the required reference to the statement in the prior application or patent, § 1.28(a).