

need to generate another copy of the specification by photocopying or by computer is not a great burden when balanced against the advantage of increased processing speed for CPAs made possible by the prohibition of new matter filings.

B) Filing of applications under new § 1.53(b)

All the types of applications that could be filed under the former rules for filing applications (§§ 1.53, 1.60 and 1.62) can all be filed under amended § 1.53, with the one exception of § 1.62 CIPs:

- continuation, divisional and continuation-in-part applications that are filed with a new specification and a § 1.63 oath or declaration continue to be filed under § 1.53, § 1.53(b),
- provisional applications previously filed under § 1.53(b)(2) are now to be filed under § 1.53(c),
- continuation and divisional applications that are filed with a specification that contains no new matter and with a copy of an executed oath or declaration from a prior application (§ 1.63(d)(1)(iv)) are to now be filed under § 1.53(b) rather than under former § 1.60 (and should contain a sentence specifically incorporating the prior application by reference to guard against filing a specification copy that is missing a page), and
- the exception is continuation-in-part applications previously permitted under former § 1.62, with a new § 1.63 oath or declaration and only a preliminary amendment for the newly added subject matter, must now be filed under § 1.53(b), which requires that an entire specification rather than an amendment to a previous specification (and a new § 1.63 oath or declaration) be submitted.

C) Continued Prosecution Applications (CPA)

Newly created CPA applications, § 1.53(d), replace continuation and divisional applications under former § 1.62. A new specification and oath or declaration are not needed for a CPA.

Not permitted under CPA practice are:

- * - CIP applications.

Attributes:

- CPA filings will be completely processed by the Group (the Office of Initial Patent Examination will not be involved with the processing of a CPA)
 - a request for a CPA can be faxed directly to a Group, but the filing date will be the date of receipt not the date of transmission should the two differ,
 - a CPA will utilize the following materials from the prior application:
 - the same file jacket,
 - the same application number and the same filing date
 - the actual filing date of the CPA will be indicated on the file jacket by a Contents entry for the Request for filing, and
 - a patent issuing from a CPA will only indicate the application number and filing date of the prior parent application,
 - a CPA can name the same or fewer than all the inventors named in the prior application,
- * - the prior application, can be filed prior to, on or after June 8, 1995, and must be complete as defined by § 1.51(b), including an oath or declaration and filing fee,
- ** - the CPA is a request to expressly abandon the prior application, but the abandoned status of the prior application will not operate to make the file open to public inspection, 37 CFR 1.14(a)(3)(iv),
 - must be timely filed,

- a specific reference to a prior application need not and should not be added to the first line of the specification of the CPA as the request for CPA filing is considered as the specific reference required by 35 U.S.C. 120,
- papers that carryover to the CPA from the prior application: Information Disclosure Statements, Terminal Disclaimers, affidavits under §§ 1.130, 1.131 and 1.132, § 3.73(b) certifications, unacted upon § 1.48 petitions where correction is still required, U.S. and foreign priority claims, general authorizations to charge a deposit account, and an election where the CPA is a continuation unless otherwise indicated, and
- papers that do not carryover to the CPA from the prior application: small entity status requests, and an election where the CPA is a division.

* Any patent, except reissues or designs, issuing on a CPA application will include a notice that: (1) the patent issued on a CPA; and (2) the patent is subject to the twenty-year patent term set forth in 35 U.S.C. 154(a)(2).

The creation of the CPA will also facilitate a virtually seamless transition to the procedures for requesting further examination of an application, upon payment of a fee, set forth in pending legislation.

D) Oath or declaration

Paragraph (a)(3) of § 1.63 now requires that the post office address appear in the oath or declaration rather than elsewhere (§ 1.33), and that the oath or declaration contain the full name(s) of the inventor(s), a requirement which has been transferred from § 1.41(a).

Paragraph (d)(1)(iv) of § 1.63 permits the use of a copy of the executed oath or declaration from a prior application in a continuation or divisional application filed under § 1.53(b) that names the same as or fewer than all of the inventors named in the prior application. The copy must either show the signature or have some indication that it was signed.

Paragraph (d)(4) of § 1.63 provides where the power of attorney or correspondence address was changed in a prior application from that on the executed oath or declaration, the change must be identified in a continuation or divisional application.

E) Inventorship

The naming of the inventors is no longer required to obtain a filing date for an application as a result of amendments to §§ 1.41 and 1.53. The inventor's name was used to identify an application prior to issuance of a filing receipt (along with the Application No.) under the former rules. Thus, if an application is now filed under the amended rules without any identification of the inventors, an alphanumeric identifier should be supplied, § 1.41(a)(3), so that papers, e.g., information disclosure statements, submitted prior to issuance of the filing receipt can be matched with the file. The Office recommends that the inventors' names continue to be used as the application identifier.

For applications filed without an oath or declaration, the filing of an executed oath or declaration under § 1.63, will serve to set forth or correct the application's inventorship. 37 CFR 1.48(f). Thus, a whole class of § 1.48(a) petitions will be eliminated. Under the old rules, a petition was required if the later submitted executed oath or declaration identified a different inventive entity from the inventive entity originally set forth in the unexecuted application. New § 1.48(f) is not a petition remedy that must be requested; rather, it operates to automatically establish the inventorship.

II. Deceptive Intent Issues

The generation of partial facts simply to generate an incomplete record for later review by others is not seen as adequate justification for the effort to which applicants have been required to undergo. Thus, the burden on applicants is further reduced with respect to inquiries which bear on deceptive intent issues.

A) Verification of statements

Under the old rules, statements of facts presented by practitioners were not required to be verified, e.g., §1.68, due to the operation of Part 10 of the rules.