Paperwork Reduction Act

This rule does not contain information collections requirements that require approval by OMB under the Paperwork Reduction Act (44 U.S.C. 3507 *et seq.*).

Regulatory Flexibility Act

The Department of the Interior has determined that this rule will not have a significant economic impact on a substantial number of small entities under the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*). The State submittal which is the subject of this rule is based upon counterpart Federal regulations for which an economic analysis was prepared and certification made that such regulations would not have a significant economic effect upon a substantial number of small entities. Accordingly, this rule will ensure that existing requirements previously promulgated by OSM will be implemented by the State. In making the determination as to whether this rule would have a significant economic impact, the Department relied upon the data and assumptions for the counterpart Federal regulations.

Unfunded Mandates

This rule will not impose a cost of $100 million or more in any given year on any governmental entity or the private sector.

List of Subjects in 30 CFR Part 946

Intergovernmetal relations, Surface mining, Underground mining.

Dated: July 30, 1996.

Allen D. Klein,

Regional Director, Appalachian Regional Coordinating Center.

For the reasons set out in the preamble, title 30, chapter VII, subchapter T of the Code of Federal Regulations is amended as set forth below:

PART 946—VIRGINIA

1. The authority citation for part 946 continues to read as follows:

Authority: 30 U.S.C. 1201 *et seq.*

2. In § 946.15, paragraph (kk) is added to read as follows:

§ 946.15 Approval of regulatory program amendments

* * * * *

(kk) The amendment to the Virginia program concerning the sudden release of accumulated water from underground coal mine voids as submitted to OSM on April 17, 1996, is approved effective August 19, 1996.

[FR Doc. 96–21083 Filed 8–16–96; 8:45 am]
BILLING CODE 4310–05–M

DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Part 1

[Docket No: 950620162–6014–02]
RIN 0651–AA75

Miscellaneous Changes in Patent Practice

AGENCY: Patent and Trademark Office, Commerce.

ACTION: Final rule.

SUMMARY: The Patent and Trademark Office (Office) is amending the rules of practice in patent cases to implement a number of miscellaneous changes proposed in the rulemaking entitled ''Changes to Implement 18-Month Publication of Patent Applications'' (Notice of Proposed Rulemaking), published in the Federal Register at 60 FR 42352 (August 15, 1995), and in the Patent and Trademark Office Official Gazette 1177 Off. Gaz. Pat. Office 61 (August 15, 1995), that are not directly related to the 18-month publication of patent applications. While the proposed rule changes in the Notice of Proposed Rulemaking were designed primarily to implement the changes in practice related to the publication of patent applications provided for in H.R. 1733, these miscellaneous proposed changes clarify current rules of practice, without regard to the publication of patent applications.

DATES: *Effective Date:* September 23, 1996.

Applicability Date: Sections 1.52 (a) and (b), 1.58, 1.72 (b), 1.75 (g), (h) and (i), 1.77, 1.84 (c), (f), (g) and (x), 1.96, 1.154, and 1.163 of 37 CFR apply to applications filed on or after September 23, 1996.

FOR FURTHER INFORMATION CONTACT: Stephen G. Kunin by telephone at (703) 305–8850, by facsimile at (703) 305–8825, by electronic mail at rbahr@uspto.gov, or Jeffrey V. Nase by telephone at (703) 305–9285, or by mail marked to the attention of Stephen G. Kunin, addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231. For copies of the forms discussed in this final rule package, contact the Customer Service Center of the Office of Initial Patent Examination at (703) 308–1214.

SUPPLEMENTARY INFORMATION: This final rule package is designed to implement the miscellaneous changes set forth in the proposed rulemaking entitled ''Changes to Implement 18-Month Publication of Patent Applications'' (Notice of Proposed Rulemaking) that are not directly related to 18-month publication of patent applications and that are considered desirable even in the absence of an 18-month publication system.

The Notice of Proposed Rulemaking indicated that, in addition to implementing the 18-month publication of patent applications, the Office also proposed to: (1) Clarify which applications claiming the benefit of prior applications, or which prior applications for which a benefit is claimed in a later application, will be preserved in confidence; (2) amend the rules pertaining to the format and standards for application papers and drawings to improve the standardization of patent applications; (3) provide for those instances in which inventions of a pending application or patent under reexamination and inventions of a patent held by a single party are not identical, but not patentably distinct; (4) clarify the practice for the delivery or mailing of patents; (5) expedite the entry of international applications into the national stage; and (6) amend a number of rules for consistency and clarity. The Notice of Proposed Rulemaking stated that these proposed rule changes may be adopted as final rules even in the absence of an 18-month publication system, and advised interested persons to comment on any proposed rule change, regardless of whether H.R. 1733 is enacted.

To avoid delays in the implementation of rule changes considered desirable even in the absence of an 18-month publication system, this final rule package provides for changes to 37 CFR 1.12(c), 1.14, 1.52 (a) and (b), 1.54, 1.58, 1.62 (e) and (f), 1.72(b), 1.75(g), 1.77, 1.78 (a) and (c), 1.84 (c), (f), (g) and (x), 1.96, 1.97, 1.107, 1.110, 1.131, 1.132, 1.154, 1.163, 1.291, 1.292, 1.315, 1.321 and 1.497, and adds new §§ 1.5(f), 1.75 (h) and (i), and 1.130, all of which are based upon the changes proposed in the Notice of Proposed Rulemaking.

Implementation of 18-Month Publication Held in Abeyance Pending Congressional Action on H.R. 1733

The Notice of Proposed Rulemaking also proposed changes to 37 CFR 1.4, 1.5(a), 1.9, 1.11, 1.12 (a) and (b), 1.13, 1.16, 1.17, 1.18, 1.19, 1.20, 1.24, 1.51, 1.52(d), 1.53, 1.55, 1.60, 1.78(a), 1.84(j), 1.85, 1.98, 1.108, 1.136, 1.138, 1.492, 1.494, 1.495, 1.701, 1.808, 3.31, 5.1, new §§ 1.5(g), 1.306 through 1.308 and 5.9,

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and further changes to §§ 1.14, 1.54, 1.62, 1.107, 1.131, 1.132, 1.291 and 1.292 to implement the 18-month publication of patent applications as contained in H.R. 1733 and provide procedures for the treatment of national security classified applications. The adoption of changes to these rules is held in abeyance pending Congressional action on H.R. 1733.

The proposed rule changes in the Notice of Proposed Rulemaking to provide new procedures for the treatment of national security classified applications are also being held in abeyance. These proposed rule changes are separable from the implementation of 18-month publication; however, they are sufficiently related to the implementation of 18-month publication that they are also being held in abeyance pending Congressional action on H.R. 1733.

In the event that H.R. 1733 is enacted, a final rule package to implement this legislation will be published. Final rules to implement 18-month publication of patent applications based upon the Notice of Proposed Rulemaking and the comments received in response to the Notice of Proposed Rulemaking may be adopted without either an additional public hearing or an additional proposal being published for comment.

Implementation of the Miscellaneous Changes Proposed in the Notice of Proposed Rulemaking

The following paragraphs of this section include: (1) A discussion of the rules being added or amended in this final rule package, (2) the reasons for those additions and amendments, and (3) an analysis of the comments received in response to the Notice of Proposed Rulemaking.

Changes to Proposed Rules

These final rules contain a number of changes to the text of the rules as proposed for comment. The significant changes are discussed below. Familiarity with the Notice of Proposed Rulemaking is assumed.

Sections 1.14 (a) and (b) have been re-written for clarity. Section 1.14(a)(1) provides that patent applications are generally preserved in confidence. Section 1.14(a)(2) sets forth the circumstances under which status information concerning an application may be supplied, and § 1.14(a)(3) sets forth the circumstances under which access to, or copies of, an application may be provided. Section 1.14(b) provides that abandoned applications may be destroyed after 20 years from their filing date. The reference to paragraph (b) in § 1.14(e) has been deleted for consistency with the changes to paragraphs (a) and (b) of § 1.14.

Section 1.52(a) is being changed to provide that all papers which are to become a part of the permanent records of the Patent and Trademark Office must be legibly ''written either by a typewriter or mechanical printer in permanent dark ink or its equivalent,'' rather than ''typed in permanent dark ink.'' This change will permit the filing of papers printed by any computer operated printer, such as a laser printer which uses toner rather than ink, and will avoid a conflict between § 1.52(a) and Patent Cooperation Treaty (PCT) Rule 11.9. The phrase ''when required by the Office'' was also added to § 1.52(a).

Section 1.52(b) is being changed to provide that: (1) The application papers must be plainly written with each page printed on only one side of a sheet of paper, with the claim or claims commencing on a separate sheet and the abstract commencing on a separate sheet; (2) the lines of the specification, and any amendments to the specification, must be 1½ or double spaced; and (3) the pages of the specification including claims and abstract must be numbered consecutively, starting with 1, the numbers being centrally located above or preferably, below, the text. This change will clarify: (1) The separate sheet requirement for both the claims and abstract, (2) that the lines of the papers not comprising the specification and amendments thereto need not be 1½ or double spaced, and (3) that the specification, and not the transmittal sheets or other forms, must be numbered.

Section 1.58 is being changed to provide that chemical and mathematical formulae and tables must be presented in compliance with §§ 1.52 (a) and (b), except that chemical and mathematical formulae or tables may be placed in a landscape orientation if they cannot be presented satisfactorily in a portrait orientation. This replaces the requirement that ''[t]o facilitate camera copying when printing, the width of formulas and tables as presented should be limited normally to 12.7 cm. (5 inches) so that it may appear as a single column in the printed patent.'' However, chemical and mathematical formulae and tables must still otherwise comply with §§ 1.52 (a) and (b). This change will avoid a conflict between § 1.58 and PCT Rule 11.10(d). Section 1.58 is also being changed to require ''0.21 cm.'' rather than ''2.1 mm.'' to ensure consistency.

Section 1.72 is being changed to provide that the abstract must commence on a separate sheet, preferably following the claims. This change will avoid renumbering pages of a specification submitted in the arrangement set forth in § 1.77 when filing the application as an international application.

Section 1.75(h) is being changed to provide that the claim or claims must commence on a separate sheet. This change will clarify that § 1.75 requires that the claim or claims commence or begin on a separate sheet, rather than requiring that all of the claims must be on a single separate sheet or that each claim must be on a separate sheet.

Section 1.77 is being changed to position the abstract as element ''(12)'' following the claims, rather than element ''(3)'' prior to the first page of the specification to conform to § 1.72.

Section 1.78(a)(2) is being changed to replace the reference to § 1.14(b) with a reference to § 1.14(a).

Section 1.78(c) is being changed to replace the phrase ''[w]here an application or a patent under reexamination and an application or a patent'' with the phrase ''[w]here an application or a patent under reexamination and at least one other application,'' since conflicting claims between an application or a patent under reexamination and a patent will be provided for in new § 1.130. Section 1.78(c) is also being changed to delete the sentence ''[i]n addition to making said statement, the assignee may also explain why an interference should or should not be declared,'' since the Office will not, unless good cause is shown, declare or continue an interference when the application(s) and patent are owned by a single party.

Section 1.78(d) is removed. The provisions of § 1.78(d), as proposed, are in new § 1.130(b), since § 1.130 provides for conflicting claims between an application or a patent under reexamination and a patent.

Section 1.84(x) is being changed from ''[n]o holes should be provided in the drawings sheets'' to ''[n]o holes should be made by the applicant in the drawing sheets'' to clarify that the application papers, including drawings, should be submitted by the applicant without holes provided therein, but that the Office will drill holes through the application papers during the pre-examination processing of the application.

Section 1.96(b) is being changed to provide that a listing submitted as part of the specification ''must be direct printouts (*i.e.,* not copies) from the computer's printer'' for clarity.

Section 1.96(c) is being changed to substitute a reference to 36 CFR Part

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1230 (Micrographics) for the enumerated American National Standards Institute (ANSI) and National Micrographics Association (NMA) standards. As 36 CFR Part 1230 sets forth the micrographic requirements for government records, it is appropriate to reference this provision, rather than promulgate separate standards for micrographics employed in patent applications.

Section 1.97 is being changed to delete any reference to a reexamination proceeding or a patent owner. The submission of an information disclosure statement during a reexamination proceeding is governed by § 1.555(a).

Section 1.97(a) is being changed from ''[i]n order for an applicant for patent or for reissue of a patent to have information considered by the Office during the pendency of a patent application, an information disclosure statement in compliance with § 1.98 should be filed in accordance with this section'' to ''[i]n order for an applicant for a patent or for a reissue of a patent to have an information disclosure statement in compliance with § 1.98 considered by the Office during the pendency of the application, it must satisfy paragraph (b), (c), or (d) of this section'' for clarity. Sections 1.97 (c) and (d) are also being changed to clarify the conditions in § 1.97(c) under which a certification as specified in § 1.97(e) or the fee set forth in § 1.17(p) is required, and the conditions in § 1.97(d) under which a certification as specified in § 1.97(e), a petition, and the petition fee set forth in § 1.17(i) are required.

Section 1.110 is amended to change the reference to § 1.78(d) to a reference to § 1.130 for consistency.

The proposed addition of a new § 1.131(a)(3) is being withdrawn in this final rule package. This proposed change, as well as the provisions of former § 1.78(d), has been re-written as a new § 1.130. New § 1.130(a) will provide a procedure for the disqualification of a commonly owned patent claiming a patentably indistinct but not identical invention. New § 1.130(b) will include the provisions of former § 1.78(d).

Section 1.131(a) is being changed to replace the phrase ''U.S. patent to another'' with ''U.S. patent to another or others.''

Section 1.154(a)(7) is being changed to add ''[f]eature'' prior to ''[d]escription,'' and § 1.154(a)(8) is being changed to add ''a single'' prior to ''claim.''

Section 1.163 is being changed to position the abstract as element ''(11)'' following the claims, rather than element ''(3)'' prior to the first page of the specification. This change will parallel the change to § 1.77. In addition, § 1.163(c)(10) is being changed to add ''a single'' prior to ''claim.''

Section 1.497(b)(2) is being changed to provide that ''[i]f the person making the oath or declaration is not the inventor, the oath or declaration shall state the relationship of the person to the inventor, the facts required by §§ 1.42, 1.43 or 1.47, and, upon information and belief, the facts which the inventor would have been required to state'' to better set forth the requirements of an oath or declaration by a person who is not the inventor. Section 1.497(c) is being changed to delete the initial phrase ''[t]he oath or declaration must comply with the requirements of § 1.63; however,'' since it is unnecessary.

Discussion of Specific Rules

Title 37 of the Code of Federal Regulations, Part 1 is amended as follows:

Section 1.5(f) is added to provide that a paper concerning a provisional application must identify the application as such and by the application number.

Section 1.12 is amended to revise paragraph (c) to read ''preserved in confidence under § 1.14'' for consistency with § 1.14.

Section 1.14 is amended to revise the title and paragraphs (a) and (e) to read ''preserved in confidence'' for consistency with the language in 35 U.S.C. 122.

Section 1.14(a) is amended to add a paragraph (a)(1) to provide that patent applications are generally preserved in confidence pursuant to 35 U.S.C. 122, and that no information will be given concerning the filing, pendency, or subject matter of any application for patent, and no access will be given to, or copies furnished of, any application or papers relating thereto, except as set forth in § 1.14.

Section 1.14(a) is also amended to add a paragraph (a)(2) to provide that status may be supplied: (1) Concerning an application or any application claiming the benefit of the filing date of the application, if the application has been identified by application number or serial number and filing date in a published patent document; (2) concerning the national stage application or any application claiming the benefit of the filing date of a published international application, if the United States of America has been indicated as a Designated State in the international application; or (3) when it has been determined by the Commissioner to be necessary for the proper conduct of business before the Office. Status information includes information such as whether the application is pending, abandoned, or patented, as well as the application number and filing date. The inclusion of applications claiming the benefit of the filing date of applications so identified is to avoid misleading the public in instances in which the application identified as set forth in § 1.14(a)(2) is abandoned, but an application claiming the benefit of the filing date of the identified application (*e.g.*, a continuing application) is pending.

Section 1.14(a) is also amended to add a new paragraph (a)(3) to provide that access to, or copies of, an application may be provided: (1) When the application is open to the public as provided in § 1.11(b); (2) when written authority in that application from the applicant, the assignee of the application, or the attorney or agent of record has been granted; (3) when it has been determined by the Commissioner to be necessary for the proper conduct of business before the Office, or (4) to any person on written request, without notice to the applicant, when the application is abandoned and available and is: (a) Referred to in a U.S. patent, (b) referred to in an application open to public inspection, (c) an application which claims the benefit of the filing date of an application open to public inspection, or (d) an application in which the applicant has filed an authorization to lay open the complete application to the public.

Section 1.14(b) is amended to provide that complete applications (§ 1.51(a)) which are abandoned may be destroyed and hence may not be available for access or copies as permitted by paragraph (a)(3)(iv) of this section after 20 years from their filing date, except those to which particular attention has been called and which have been marked for preservation. The sentence in § 1.14(b) concerning the non-return of abandoned applications is deleted as duplicative of the provision in § 1.59, which provides that papers in an application which has received a filing date will not be returned, and is unrelated to the preservation of applications in confidence under § 1.14.

Section 1.52(a) is amended to provide that all papers which are to become a part of the permanent records of the Office must be legibly written by a typewriter or mechanical printer in permanent dark ink or its equivalent in portrait orientation on flexible, strong, smooth, non-shiny, durable and white paper. Section 1.52(a) is further amended to provide that the application papers must be presented in a form

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having sufficient clarity and contrast between the paper and the writing thereon to permit electronic reproduction by use of digital imaging and optical character recognition, as well as the direct photocopy reproduction currently provided for. Section 1.52(a) is further amended to provide that substitute typewritten or mechanically printed papers ''will'' be required if the original application papers are not of the required quality. As any substitute typewritten or mechanically printed papers containing the subject matter of the originally filed application papers would constitute a substitute specification, the provisions of § 1.125 governing the entry of a substitute specification would be applicable, and § 1.52(a) is amended to include a specific reference to § 1.125.

Section 1.52(b) is amended to provide that the claim or claims must commence on a separate sheet and the abstract must commence on a separate sheet. Section 1.72(b) provides that the abstract must commence on a separate sheet, and § 1.75(h) provides that the claim or claims must commence on a separate sheet. Section 1.52(b) is amended to provide that the sheets of paper must all be the same size and either 21.0 cm. by 29.7 cm. (DIN size A4) or 21.6 cm. by 27.9 cm. (8½ by 11 inches), with a top margin of at least 2.0 cm. (¾ inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 2.0 cm. (¾ inch), and a bottom margin of at least 2.0 cm. (¾ inch), and that no holes should be made in the submitted paper sheets. Section 1.52(b) is further amended to provide that the lines of the specification, and any amendments to the specification, ''must'' be 1½ or double spaced, and that the pages of the specification ''must'' be numbered consecutively, starting with page one, with the numbers being centrally located above or below the text. Finally, § 1.52(b) is amended to specifically reference drawings to clarify that drawings are part of the application papers, but that the standards for drawings are set forth in § 1.84.

The proposed changes to §§ 1.52 (a) and (b), 1.58, 1.72(b), 1.75 (g), (h), and (i), 1.77, 1.84 (c), (f), (g), and (x), 1.96, 1.154, and 1.163 pertaining to the format and standards for application papers and drawings in the Notice of Proposed Rulemaking are considered desirable, regardless of whether H.R. 1733 is enacted.

While the vast majority of applications currently comply with §§ 1.52 (a) and (b), 1.58, 1.72(b), 1.75(h), 1.84 (c), (f), (g), and (x), and 1.96 as adopted in this final rule, those applications which do not comply with §§ 1.52 (a) and (b), 1.58, 1.84 (c), (f), (g), and (x), and 1.96 as adopted in this final rule (*e.g.*, applications containing hand-written papers) create an inordinate administrative burden on the Office during the initial processing, examination, and publishing of the application as a patent. In addition, the Office plans to replace or augment the current microfilming process with electronic data capture of at least the technical content (*i.e.*, the specification, abstract, claims and drawings) of the application-as-filed for internal Office use, regardless of whether H.R. 1733 is enacted. Therefore, the Office will no longer permit these relatively few applicants to submit application papers and drawings that do not meet the standards set forth in §§ 1.52 (a) and (b), 1.58, 1.84 (c), (f), (g), and (x), and 1.96 as adopted in this final rule.

The application format set forth in §§ 1.75 (g) and (i), 1.77, 1.154, and 1.163 as adopted in this final rule merely expresses the Office's preferences for format of utility, design and plant applications. They do not set forth mandatory requirements for application papers and drawings.

Section 1.54(b) is amended to change ''application serial number'' to ''application number'' for consistency with § 1.5(a).

Section 1.58(b) is removed and is reserved as unnecessary in view of the amendments to §§ 1.52 (a) and (b).

Section 1.58(c) is amended to provide that chemical and mathematical formulae and tables must be presented in compliance with §§ 1.52 (a) and (b), except that chemical and mathematical formulae or tables may be placed in a landscape orientation if they cannot be presented satisfactorily in a portrait orientation. Section 1.58(c) is further amended to delete the following sentences to conform to the writing and paper size and orientation limitations in §§ 1.52 (a) and (b): (1) ''[t]o facilitate camera copying when printing, the width of formulas and tables as presented should be limited normally to 12.7 cm. (5 inches) so that it may appear as a single column in the printed patent''; (2) ''[i]f it is not possible to limit the width of a formula or table to 5 inches (12.7 cm.), it is permissible to present the formula or table with a maximum width of 10¾ inches (27.3 cm.) and to place it sideways on the sheet''; and (3) ''[h]and lettering must be neat, clean, and have a minimum character height of 0.08 inch (2.1 mm.).'' Section 1.58(c) is further amended to insert ''chosen'' between ''must be'' and ''from a block (nonscript) type font.'' Section 1.58(c) is further amended to provide metric dimensions with English equivalents in parentheticals, rather than *vice versa.*

Section 1.62(e) is amended to change ''application serial number'' to ''application number'' for consistency with § 1.5(a).

Section 1.62(f) is amended to change ''secrecy'' to ''confidence'' as is found in 35 U.S.C. 122 and § 1.14, and change ''37 CFR 1.14'' to ''§ 1.14'' for consistency.

Section 1.72(b) is amended to provide that the abstract must ''commence,'' rather than ''be set forth,'' on a separate sheet. This change will conform the ''separate sheet'' requirement for the abstract with that for the claims.

Section 1.75 is amended to include an amendment to paragraph (g), and would add two new paragraphs. Section 1.75(g) is amended to add the phrase ''[t]he least restrictive claim should be presented as claim number 1'' to the beginning of the paragraph. Section 1.75(h) is added to provide that the claim or claims must commence on a separate sheet. Section 1.75(i) is added to provide that where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.

Section 1.77 is amended to provide that the elements of the application, if applicable, should appear in the following order: (1) Utility Application Transmittal Form; (2) Fee Transmittal Form; (3) title of the invention; or an introductory portion stating the name, citizenship, and residence of the applicant, and the title of the invention; (4) cross-reference to related applications; (5) statement regarding federally sponsored research or development; (6) reference to a ''Microfiche appendix; (7) background of the invention; (8) brief summary of the invention; (9) brief description of the several views of the drawing; (10) detailed description of the invention; (11) claim or claims; (12) abstract of the disclosure; (13) drawings; (14) executed oath or declaration; and (15) sequence listing.

The phrase ''if applicable'' is inserted in the heading, rather than associated with any particular listed element, to clarify that § 1.77 does not *per se* require that an application include all of the listed elements, but merely provides that any listed element included in the application should appear in the order set forth in § 1.77. Section 1.77 is further amended to provide that the (1) title of the invention; (2) cross-reference to related applications; (3) statement regarding federally sponsored research or development; (4) background of the invention; (5) brief summary of the

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invention; (6) brief description of the several views of the drawing; (7) detailed description of the invention; (8) claim or claims; (9) abstract of the disclosure; and (10) sequence listing, should appear in upper case, without underlining or bold type, as section headings, and if no text follows the section heading, the phrase ''Not Applicable'' should follow the section heading. Finally, § 1.77 is amended to change the reference to § 1.96(b) in § 1.77(a)(6) to § 1.96(c) for consistency with § 1.96.

Section 1.78(a)(2) is amended to replace the reference to § 1.14(b) with a reference to § 1.14(a) for consistency with §§ 1.14 (a) and (b) as amended.

Section 1.78(c) is amended to change ''two or more applications, or an application and a patent'' to ''an application or a patent under reexamination and at least one other application'' such that the provisions of § 1.78(c) will also be applicable to a patent under reexamination. Section 1.78(c) is also amended to correct ''inventors and owned by the same party contain conflicting claims'' to read ''inventors are owned by the same party and contain conflicting claims.'' Section 1.78(c) is also amended to delete the sentence ''[i]n addition to making said statement, the assignee may also explain why an interference should or should not be declared.''

Section 1.78(d) is removed. The provisions of former § 1.78(d), as proposed, are in new § 1.130(b).

Section 1.84(c) is amended to provide that a reference to the application number, or, if an application number has not been assigned, the inventor's name, may be included in the left-hand corner of the drawing sheet, provided that reference appears within 1.5 cm. (9/16 inch) from the top of the sheet.

Section 1.84(f) is amended to provide that the size of all drawing sheets in an application must be either 21.0 cm. by 29.7 cm. (DIN size A4) or 21.6 cm. by 27.9 cm. (8½ by 11 inches) to conform to the requirement in § 1.52(b) concerning papers in an application.

Section 1.84(g) is amended to delete the margin requirements for the sheet sizes that are no longer acceptable in view of the changes to § 1.84(f). Section 1.84(g) is further amended to provide that the sheets should have scan targets (cross-hairs) on two catercorner margin corners. Finally, § 1.84(g) is amended to increase the bottom and side margins such that each sheet must include a top margin of at least 2.5 cm. (1 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 1.5 cm. (9/16 inch), and a bottom margin of at least 1.0 cm. (3/8 inch), thereby leaving a sight no greater than 17.0 cm. by 26.2 cm. on 21.0 cm. by 29.7 cm. (DIN size A4) drawing sheets, and a sight no greater than 17.6 cm. by 24.4 cm. (6 15/16 by 9 5/8 inches) on 21.6 cm. by 27.9 cm. (8½ by 11 inch) drawing sheets.

Section 1.84(x) is amended to delete the provisions indicating the proper location for holes in a drawing sheet, and provide that no holes should be provided in the drawing sheets.

Section 1.96 is amended to designate the text preceding current paragraph (a) as paragraph (a) ''*General,*'' and would redesignate current paragraphs (a) and (b) as paragraphs (b) and (c), respectively. New § 1.96(a) is further amended to insert a period between ''specification'' and ''[a] computer,'' to change ''these rules'' to ''this section,'' and to change ''may be submitted in patent applications in the following forms'' to ''may be submitted in patent applications as set forth in paragraphs (b) and (c) of this section.''

New § 1.96(b) is further amended to: (1) Change the sentences ''[t]he listing may be submitted as part of the specification in the form of computer printout sheets (commonly 14 by 11 inches in size) for use as 'camera ready copy' when a patent is subsequently printed'' and ''[s]uch computer printout sheets must be original copies from the computer with dark solid black letters not less than 0.21 cm. high, on white, unshaded and unlined paper, the printing on each sheet must be limited to an area 9 inches high by 13 inches wide, and the sheets should be submitted in a protective cover'' to ''[a]ny listing submitted as part of the specification must be direct printouts (*i.e.*, not copies) from the computer's printer with dark solid black letters not less than 0.21 cm. high, on white, unshaded and unlined paper, and the sheets should be submitted in a protective cover''; (2) delete the sentence ''[w]hen printed in patents, such computer printout sheets will appear at the end of the description but before the claims and will usually be reduced about 1/2 in size with two printout sheets being printed as one patent specification page''; and (3) delete the phrase ''if the copy is to be used for camera ready copy.'' New § 1.96(b)(1) provides that the requirements of § 1.84 apply to computer program listings submitted as sheets of drawings, and new § 1.96(b)(2) provides that the requirements of § 1.52 apply to computer program listings submitted as part of the specification.

New § 1.96(c) is amended to: (1) Change the references to § 1.77(c)(2) in § 1.96(c) to § 1.77(a)(6) for consistency with § 1.77; (2) change ''may'' and ''should'' to ''must''; (3) delete the sentence ''[a]ll computer program listings submitted on paper will be printed as part of the patent''; (4) relocate the phrase ''except as modified or clarified below'' in subsection (c)(2); (5) change the phrase ''computer-generated information submitted as an appendix to an application for patent shall be in the form of microfiche in accordance with the standards'' to ''computer-generated information submitted as a 'microfiche appendix' to an application shall be in accordance with the standards'' for clarity; (6) change the references to the specific American National Standards Institute (ANSI) or National Micrographics Association (NMA) standards with 36 CFR Part 1230; (7) change ''serial number'' to ''application number''; and (8) provide metric dimensions with English equivalents in parentheticals, rather than *vice versa.*

Section 1.97(a) is amended to include the phrase ''for an applicant for patent or for reissue of a patent.'' Paragraphs (a)–(d) are amended to include the phrase ''by the applicant'' to clarify that § 1.97 is not available for any third party seeking to have information considered in a pending application. Any third party seeking to have information considered in a pending application must proceed under §§ 1.291 or 1.292. As discussed *supra,* §§ 1.97 (a), (c) and (d) are also being amended for clarity. Section 1.97(c) is further amended to correct the phrase ''certification as specified in paragraph (3) of this section'' to read ''certification as specified in paragraph (e) of this section.''

Section 1.107 is amended to delete the phrase ''and the classes of inventions.''

Section 1.110 is amended to change the reference to § 1.78(d) to a reference to § 1.130 for consistency with the removal of § 1.78(d), and the location of the provisions of former § 1.78(d) in § 1.130(b).

A new paragraph (a)(3) in § 1.131 was proposed in the Notice of Proposed Rulemaking to permit a showing of prior invention in a pending application or patent under reexamination to avoid a rejection under 35 U.S.C. 103 based upon a patent which qualifies as prior art only under 35 U.S.C. 102 (a) or (e), where the application or patent under reexamination and the patent upon which the rejection is based are both owned by a single party, so long as the invention claimed in the pending application or patent under reexamination and in the other patent are not identical as set forth in 35 U.S.C. 102. Upon further study, it is considered

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appropriate to disqualify such patents, and provide for the obviation of judicially created double patenting rejections in an application or a patent under reexamination by the filing of a terminal disclaimer in accordance with § 1.321(c), in a separate § 1.130.

New § 1.130(a) provides that when any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 103 on a U.S. patent to another or others which is not prior art under 35 U.S.C. 102(b), and the inventions defined by the claims in the application or patent under reexamination and by the claims in the patent are patentably indistinct but not identical as set forth in 35 U.S.C. 101, and the inventions are owned by the same party, the applicant or owner of the patent under reexamination may disqualify the patent as prior art. Section 1.130(a) specifically provides that the patent can be disqualified as prior art by submission of: (1) A terminal disclaimer in accordance with § 1.321(c), and (2) an oath or declaration stating that the application or patent under reexamination and the patent are currently owned by the same party, and that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104.

Where inventions defined by the rejected claims in the application or a patent under reexamination and by the claims in the patent upon which the rejection is based are patentably distinct, the rejection may be overcome pursuant to § 1.131. Since § 1.130 applies only when inventions defined by the claims in an application or a patent under reexamination and by the claims in the patent are patentably indistinct, § 1.130 expressly provides that an oath or declaration submitted pursuant to § 1.130 to disqualify a patent must be accompanied by a terminal disclaimer in accordance with § 1.321(c).

As the conflict between two pending applications can be avoided by filing a continuation-in-part application merging the conflicting inventions into a single application, § 1.130 is limited to rejections based upon a patent.

New § 1.130(b) includes the provisions of former § 1.78(d), as proposed in the Notice of Proposed Rulemaking. Former § 1.78(d) was proposed to be amended to change ''obviousness-type double patenting rejection'' to ''non-statutory double patenting rejections'' as current examining procedures authorize non-obviousness-type double patenting rejections, as well as obviousness-type double patenting rejections (See section 804(II) of the Manual of Patent Examining Procedure (MPEP)), and either may be obviated by filing a terminal disclaimer in accordance with § 1.321(c). The phrase ''non-statutory double patenting rejection,'' however, is being replaced with ''judicially created double patenting rejection'' to better set forth the legal basis for the rejection.

Section 1.78(d) was also proposed to be amended to change each instance of ''application'' to ''application or a patent under reexamination'' for consistency with § 1.321 and to clarify that double patenting is a proper consideration in reexamination (*Ex parte Obiaya*, 227 USPQ 58, 60–61 (Bd. Pat. App. & Inter. 1985)), and that a judicially created double patenting rejection in a patent under reexamination may be obviated by filing a terminal disclaimer in accordance with § 1.321(c).

New § 1.130(b) specifically provides that where an application or a patent under reexamination claims an invention which is not patentably distinct from an invention claimed in a commonly owned patent with the same or a different inventive entity, a double patenting rejection will be made in the application or a patent under reexamination, and that a judicially created double patenting rejection may be obviated by filing a terminal disclaimer in accordance with § 1.321(c).

Section 1.131 is amended to change ''U.S. patent to another'' to ''U.S. patent to another or others'' to parallel the language in 35 U.S.C. 102(a), as well as 35 U.S.C. 102(e).

Section 1.132 is amended to change ''domestic patent'' to ''U.S. patent,'' and ''does not claim the invention'' to ''does not claim the same patentable invention, as defined in § 1.601(n)'' for consistency with § 1.131.

Section 1.154 is amended to provide that the elements of a design application, if applicable, should appear in the following order: (1) Design Application Transmittal Form; (2) Fee Transmittal Form; (3) preamble, stating name of the applicant and title of the design; (4) cross-reference to related applications; (5) statement regarding federally sponsored research or development; (6) description of the figure or figures of the drawing; (7) feature description; (8) a single claim; (9) drawings or photographs; and (10) executed oath or declaration. The phrase ''[t]he following order of arrangement should be observed in framing design specifications'' is changed to ''[t]he elements of the design application, if applicable, should appear in the following order'' to clarify that § 1.154 does not *per se* require that an application include all of the listed elements, but merely provides that any listed element included in the application should appear in the order set forth in § 1.154. This amendment to § 1.154, however, does not modify the current requirement that an application for a design patent have but a single claim.

A new § 1.163(c) is added to provide that the elements of a plant application, if applicable, should appear in the following order: (1) Plant Application Transmittal Form; (2) Fee Transmittal Form; (3) title of the invention; (4) cross-reference to related applications; (5) statement regarding federally sponsored research or development; (6) background of the invention; (7) brief summary of the invention; (8) brief description of the drawing; (9) detailed botanical description; (10) a single claim; (11) abstract of the disclosure; (12) drawings (in duplicate); (13) executed oath or declaration; and (14) Plant Color Coding Sheet. The phrase ''if applicable'' is included in the heading, rather than associated with any particular listed element, to clarify that § 1.163 does not *per se* require that an application include all of the listed elements, but merely provides that any listed element included in the application should appear in the order set forth in § 1.163. This amendment to § 1.163, however, does not modify the current requirement that an application for a plant patent have but a single claim.

A new § 1.163(d) is added to define a plant color coding sheet. A plant color coding sheet is a sheet that specifies a color coding system as designated in a color dictionary, and lists every plant structure to which color is a distinguishing feature and the corresponding color code which best represents that plant structure. The plant color coding sheet will provide a means for applicants to uniformly convey detailed color characteristics of the plant. Providing this information in a systematic manner will facilitate the examination of the application.

Section 1.291 is amended to provide that a protest must be filed prior to the mailing of a Notice of Allowance to be considered timely. As a protest cannot be considered subsequent to issuance of the application as a patent, § 1.291(b) is amended to provide that the protest will be considered if the application is still pending when the protest and application file are provided to the examiner (*i.e.*, that the application was pending at the time the protest was filed would be immaterial to its ultimate consideration). Finally, the sentences

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''[p]rotests raising fraud or other inequitable conduct issues will be entered in the application file, generally without comment on those issues'' and ''[p]rotests which do not adequately identify a pending patent application will be disposed of and will not be considered by the Office'' in § 1.291 are changed to ''[p]rotests raising fraud or other inequitable conduct issues will be entered in the application file, generally without comment on those issues'' and ''[p]rotests which do not adequately identify a pending patent application will be returned to the protestor and will not be further considered by the Office,'' respectively, and are located in paragraph (b). The Office will acknowledge protests prior to their entry into the application file or return to the protestor, as appropriate.

Section 1.292 is amended to delete the phrase ''is filed by one having information of the pendency of an application'' as unnecessary, and would move the requirement for the fee set forth in § 1.17(j) from paragraph (a) to paragraph (b) where the conditions for entry of a petition for the institution of public use proceedings are set forth. Section 1.292 is amended to further require that any petition be served on the applicant in accordance with § 1.248, or be filed with the Office in duplicate in the event that service on the applicant is not possible. Finally, § 1.292 is amended to provide that a petition to institute public use proceedings to be considered timely must be filed prior to the mailing of a Notice of Allowance.

Section 1.315 is amended to change ''the attorney or agent of record, if there be one; or if the attorney or agent so request, to the patentee or assignee of an interest therein; or, if there be no attorney or agent, to the patentee or to the assignee of the entire interest, if he so request'' to ''the correspondence address of record. See § 1.33(a).'' This change is to simplify § 1.315, and because patents are currently mailed to the patentee at the correspondence address of record.

Section 1.321(c) is amended to change ''double patenting rejection'' to ''judicially created double patenting rejection'' for consistency with § 1.78(c) and to clarify that the filing of a terminal disclaimer is ineffective to overcome a statutory double patenting rejection.

Section 1.497(a) is amended to provide that an applicant in an international application must file an oath or declaration that: (1) Is executed in accordance with either §§ 1.66 or 1.68, (2) identifies the specification to which it is directed, (3) identifies each inventor and the country of citizenship of each inventor, and (4) states that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought, rather than an oath or declaration in accordance with § 1.63, to enter the national stage pursuant to §§ 1.494 or 1.495. Currently, the failure to file an oath or declaration in strict compliance with § 1.63 results in non-compliance with § 1.497, and thus 35 U.S.C. 371, which in turn delays the entry of the international application into the national stage. To expedite the entry of international applications into the national stage, § 1.497(a) is amended to require only an oath or declaration that is properly executed, identifies the specification to which it is directed, and, as required by 35 U.S.C. 115, identifies each inventor and the country of citizenship of each inventor and states that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

Section 1.497(b) is subdivided into paragraphs (b)(1) and (b)(2). Section 1.497(b)(1) is amended to provide that the oath or declaration must be made by all of the actual inventors except as provided for in §§ 1.42, 1.43 or 1.47. Section 1.497(b)(2) is amended to change ''[i]f the international application was made as provided in §§ 1.422, 1.423 or 1.425, the applicant shall state his or her relationship to the inventor and, upon information and belief, the facts which the inventor is required by § 1.63 to state'' to ''[i]f the person making the oath or declaration is not the inventor, the oath or declaration shall state the relationship of the person to the inventor, the facts required by §§ 1.42, 1.43 or 1.47, and, upon information and belief, the facts which the inventor would have been required to state.''

Section 1.497(c) is added to provide that the oath or declaration must comply with the requirements of § 1.63. Section 1.497(c) further provides that in instances where the oath or declaration does not comply with § 1.63, but meets the requirements of § 1.497 (a) and (b), the oath or declaration will be accepted as complying with 35 U.S.C. 371(c)(4) and §§ 1.494(c) or 1.495(c), thus permitting the application to enter the national stage and the assignment of dates under 35 U.S.C. 102(e) and 371(c). A supplemental oath or declaration in compliance with § 1.63, however, will be required in accordance with § 1.67.

Response to Comments

Two hundred and forty-two written comments were received in response to the Notice of Proposed Rulemaking. A public hearing was held on September 19, 1995. Eight persons testified at the public hearing.

The written comments, and the testimony at the public hearing, have been analyzed. In the event that H.R. 1733 is enacted, the comments directed to the proposed changes to the rules of practice to implement the 18-month publication of patent applications will be considered and addressed in the final rule package to implement 18-month publication. Responses to the comments germane to the changes in this final rule package follow.

Comment (1): One comment suggested that, in the absence of an 18-month publication system, the proposed rules relating to application format and standardization of applications be republished to give the public an opportunity to comment on the desirability of these changes in the absence of an 18-month publication system.

Response: The Notice of Proposed Rulemaking specifically stated that the proposed rules relating to application format and standardization of applications may be adopted as final rules even in the absence of an 18-month publication system, and specifically advised interested members of the public to comment on the advisability of the proposed rules relating to application format and standardization of applications, regardless of the legislative action on H.R. 1733. Thus, the public was given an opportunity to comment on the desirability of these changes in the absence of an 18-month publication system. Because the standardization of applications is generally favored and will substantially improve the Office's ability to efficiently and effectively process applications, delaying their adoption as final rules is not justified.

Comment (2): One comment stated that the Office has the authority to require that applications be submitted in computer-readable form, and in fact requires sequence listings to be submitted in such form. The comment suggested that the cost of electronically scanning application papers, as well as errors in scanning the application papers, can be avoided by requiring applicants to provide the specification in computer-readable form. Another comment stated that the Office has the authority to permit electronic filing, and electronic filing should be permitted. Several other comments indicated that

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scanning an application into a data base, rather than permitting applicants to provide a copy of the application on an electronic medium, is more costly, and is further more likely to introduce errors that could render text searching unreliable. And, several comments suggested that the scanning and typesetting costs associated with the current publication process for issued patents could be reduced by the acceptance of electronic media in place of or in addition to the paper medium currently provided for in the rules of practice. These comments further suggested that the Office should establish fees that reflect the reduced cost to the Office when a copy of an application is provided on an electronic medium (*i.e.*, should establish reduced fees for those who submit a copy of their application on an electronic medium), which fee structure would provide an incentive to supply a copy of an application on an electronic medium.

Response: As discussed in the Notice of Proposed Rulemaking, while the Office is considering the legislative and regulatory changes that would be necessary to permit purely electronic filing of application papers, it does not currently have in place an automated system for the acceptance and processing of application papers in electronic form, other than for sequence listings. Moreover, the Office does not currently have the statutory authority to rebate statutory patent filing fees to reflect any reduced cost to the Office due to the submission of a copy of an application on an electronic medium. The Office will give the comments further consideration as it designs and develops the Patent Application Management (PAM) system.

Comment (3): Several comments noted that §§ 1.52 (a) and (b) impose a standard on applicants not currently observed by the Office, and questioned whether papers in the application file prepared by the Office will comply with §§ 1.52 (a) and (b).

Response: Sections 1.52 (a) and (b) apply to the application papers, and amendments or corrections thereto. As such, §§ 1.52 (a) and (b) do not apply to those papers in the application file prepared by the Office, since they do not become part of the printed patent.

Comment (4): One comment noted that proposed § 1.52 appears to be neutral with regard to numbering the lines (*e.g.*, a line number every five lines) of the specification, and suggested that line numbering is a beneficial practice which should be permitted, and even encouraged.

Response: Section 1.52 neither requires nor prohibits line numbering. Applicants are encouraged, but not required, to number the lines of the specification. The Office will give the suggestion further study and consideration in future rulemaking.

Comment (5): One comment noted that when paragraphs are separated by a blank line only (*i.e.*, no indentation) and end between pages, it is not possible to tell that a paragraph break occurred. The comment suggested that the application format requirements should additionally require an indentation at the beginning of each new paragraph.

Response: It is desirable that a specification include an indentation at the beginning of a new paragraph. This requirement, however, was not proposed for comment in the Notice of Proposed Rulemaking. In addition, PCT Rule 11 does not require that the beginning of each new paragraph in the specification be indented.

Comment (6): One comment noted that § 1.52(a) would prohibit handwriting or hand-printing on papers which are to become permanent Office records. The comment questioned whether this requirement would also apply to papers issued in the Office. The comment suggested revising Office practice to prohibit an examiner from handwriting comments on official papers (*e.g.*, advisory actions or interview summary records) because: (1) The handwriting is not always decipherable, and (2) the handwriting as it comes through on the carbon copies furnished to applicants is frequently too light at least in part to be decipherable.

Response: The Office's goal is to create a readable administrative record of the prosecution of every application. The Office is currently designing, testing and implementing electronic forms and Office action writing software to avoid or minimize the need for handwriting/printing in Office communications. Any applicant receiving an Office communication in which the handwriting is not decipherable, or does not adequately appear on the carbon copies to be decipherable, should request a legible copy of such communication from the Office.

Comment (7): Several comments noted that the limitations in § 1.52 (a) and (b) regarding ''typed'' and ''ink'' appear to exclude computer and laser printers, as well as commercially or mechanically printed papers such as declaration forms. Another comment noted that the limitations in §§ 1.52 (a) and (b) regarding ''typed'' and ''ink'' are more restrictive than PCT Rule 11.9 (a) and (d).

Response: The phrase ''printed'' was proposed to be deleted since it could be read to mean that hand-printing is acceptable. Section 1.52(a) will require, in part, that ''[a]ll papers which are to become a part of the permanent records of the Patent and Trademark Office must be legibly written either by a typewriter or mechanical printer in permanent dark ink or its equivalent in portrait orientation on flexible, strong, smooth, non-shiny, durable, and white paper.'' This will clarify that papers printed by a computer-operated laser, or any mechanical printer are acceptable, but that hand-printed papers are not. This change will also avoid inconsistencies with the requirements of PCT Rule 11.9.

Comment (8): One comment noted that the proposed changes to § 1.52(a) did not include any limitations regarding permissible type fonts. The comment questioned, since the purpose of the proposed rule change was to permit optical character recognition (OCR) scanning of the application papers, whether script fonts would be permissible.

Response: Section 1.52(a) does not include any express prohibition against the use of script fonts. Nevertheless, § 1.52(a) requires that ''the application papers must be presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit * * * electronic reproduction by use of digital imaging and optical character recognition.'' Any application papers, including application papers containing a script font, that are not in a form having sufficient clarity and contrast between the paper and the writing thereon to permit electronic reproduction by use of digital imaging and optical character recognition will be objected to as not in compliance with § 1.52(a). Therefore, the Office cautions applicants not to submit application papers having script fonts.

Comment (9): One comment noted that § 1.52(b) would require that all papers (including drawings per proposed § 1.84) be limited to either DIN size A4 or 8½ by 11 inches, which would eliminate the currently allowed paper sizes of 8½ by 13 or 14 inches. The comment questioned whether this would also apply to the official papers issued by the Office, noting that the Office currently issues papers having a paper size mix of 8½ by 11, 13, and 14 inches, which presents problems for applicants. The comment suggested that the Office should not issue papers of a size not permitted in § 1.52.

Response: The Office is currently in the process of standardizing to either

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21.0 cm. by 29.7 cm. (DIN size A4) or 21.6 cm. by 27.9 cm. (8½ by 11 inches).

Comment (10): One comment suggested that the Office should not issue papers with writing on the back side in accordance with § 1.52(b).

Response: The Office currently includes informational language on the back side of certain forms. The alternatives to issuing such forms with writing on the back side are: (1) Not providing this information to applicants, (2) reducing the print size to permit all of the information to be located on the front of the form, or (3) routinely providing multiple page forms. Since none of the alternatives are preferable to simply including informational language on the back side of certain forms, the Office will continue to include information language on the back of papers issued by the Office, until it fully transforms all of its forms to electronically generated forms.

Comment (11): One comment questioned whether the phrase ''claims on a separate sheet'' in § 1.52(b) means that: (1) All of the claims must appear on a single separate sheet, (2) each claim must appear on a separate sheet, or (3) the claims (claim 1) must begin or commence on a separate sheet. The comment suggested the PCT wording that the claims shall commence on a separate sheet if the rule is intended to require that the claims (claim 1) must begin or commence on a separate sheet.

Response: The phrase has been changed to ''the claim or claims commencing on a separate sheet'' to clarify that the claims must begin or commence on a separate sheet to parallel PCT requirements. Thus, §§ 1.52(b) and 1.75(h) require that the claims (claim 1) must begin or commence on a separate sheet. Sections 1.52(b) and 1.75(h) do not require that all of the claims be set forth on a single sheet, or that each claim be set forth on a separate sheet.

Comment (12): One comment questioned whether the phrase ''abstract and claims on a separate sheet'' in § 1.52(b) means that the abstract is to be on one separate sheet, and the claims are to be (or commence) on another separate sheet.

Response: The phrase has been changed to ''the claim or claims commencing on a separate sheet and abstract commencing on a separate sheet'' to clarify that the claims must commence on one separate sheet and the abstract must commence on another separate sheet.

Comment (13): One comment noted that the requirement in § 1.52(b), as proposed, will require that the lines in the oath or declaration, as well as quotations from the rules, the MPEP, and court decisions in subsequently filed amendments, be 1½ or double spaced, and is inconsistent with the forms included for comment with the Notice of Proposed Rulemaking.

Response: Section 1.52(b) has been changed to require, *inter alia*, that ''[t]he lines of the specification, and any amendments to the specification, must be 1½ or double spaced.'' The requirement for 1½ or double spacing will not apply to oaths or declarations, pre-printed forms, or all of the statements in the ''Remarks'' section of an amendment. Applicants are nevertheless requested to submit papers with lines 1½ or double spaced, except in standardized forms or where single-spacing may be stylistically necessary (*e.g.*, block quotations).

Comment (14): One comment questioned whether the requirement in § 1.52(b), as proposed, that papers have lines 1½ or double spaced will apply to Office actions. The comment suggested that not placing block quotations from the statutes and regulations in single spacing will decrease the readability of Office actions.

Response: As discussed *supra*, §§ 1.52 (a) and (b) are designed to facilitate patent printing and do not apply to Office actions. Section 1.52(b) has been changed to require, *inter alia*, that ''[t]he lines of the specification, and any amendments to the specification, must be 1½ or double spaced.'' Therefore, the requirement for 1½ or double spaced lines will not apply to Office actions.

Comment (15): Several comments objected to the requirement that tables be in portrait orientation as inconsistent with PCT rules, and as causing tables to be split over multiple pages.

Response: The suggestions are adopted. Section 1.58 will state that ''[c]hemical and mathematical formulae and tables must be presented in compliance with §§ 1.52 (a) and (b), except that chemical and mathematical formulae or tables may be placed in a landscape orientation if they cannot be presented satisfactorily in a portrait orientation,'' rather than ''[t]o facilitate camera copying when printing, the width of formulae and tables as presented should be limited normally to 12.7 cm. (5 inches) so that it may appear as a single column in the printed patent.''

Comment (16): One comment stated that § 1.72 is contrary to PCT Rule 11.4(a), and will require renumbering of the application pages for later filing of that application in the European Patent Office (EPO) or under the PCT.

Response: Section 1.72, as proposed in the Notice of Proposed Rulemaking, provided that the abstract be ''preferably prior to the first page of the specification,'' and, as such, merely expressed the Office's preference for the location of the abstract as prior to the first page of the specification. Nevertheless, to avoid the undesirable result of requiring an applicant who submitted an application in the format set forth in § 1.77 to renumber the specification pages for filing that application in the EPO or under the PCT, § 1.72 is changed to state that the preferable location of the abstract is following the claims.

Comment (17): One comment stated that requiring that the rarely used section headings (*e.g.*, statement regarding federally sponsored research and development) be followed by the phrase ''not-applicable'' is confusing.

Response: Section 1.77 is permissive rather than mandatory. As such, any applicant finding the format suggested therein to be confusing is at liberty to simply include those section headings applicable to the particular application. The use of each section heading, even when the section is ''not-applicable,'' is desirable in that it apprises the Office that the section at issue has been considered and deemed inapplicable. Simply not providing a section heading is ambiguous as to whether the applicant considers the section inapplicable or has not considered whether the section is applicable to the application. In addition, the use of such section headings will be of greater benefit when the Office implements procedures to permit the electronic filing of patent applications.

Comment (18): One comment stated that the requirements set forth in § 1.77 are in addition to those required by the PCT. The comment argued that the Office cannot require international applications entering the national stage under 35 U.S.C. 371 to comply with these requirements.

Response: As discussed *supra*, § 1.77 merely expresses the Office's preference for the arrangement of the application elements. The Office may advise an applicant that the application does not comply with the format set forth in § 1.77, and suggest this format for the applicant's consideration; however, the Office will not require any application to comply with the format set forth in § 1.77. Therefore, there is no conflict between § 1.77 and the PCT.

Comment (19): One comment noted that §§ 1.154 and 1.163 apply to design and plant applications, and, as such, they are not in conflict with PCT Rules. The comment suggested that it would,

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however, be preferable that all types of U.S. applications maintain the same order of application elements, and that this order be the order set forth by the PCT Rules.

Response: As discussed *supra*, the arrangement of the elements of an application set forth in § 1.77 is not mandatory, and, as such, § 1.77 is not in conflict with the PCT or PCT Rules. Section 1.77 merely expresses the Office's preference for the arrangement of the elements of an application. The Office's preference for the format of design applications (§ 1.154) and plant applications (§ 1.163) is the same as the Office's preference for utility applications (§ 1.77).

Comment (20): One comment stated that in the absence of statutory requirements for the application elements proposed in §§ 1.77, 1.154, and 1.163, the rule should clearly state that these application elements or arrangements are preferred but not mandatory.

Response: Sections 1.77, 1.154, and 1.163 employ the phrase ''should'' rather than ''must,'' which is the language of a precatory statement. Therefore, §§ 1.77, 1.154, and 1.163 currently state that these application elements or arrangements are preferred, but are not mandatory.

Comment (21): One comment questioned whether the Application Transmittal Form, and Fee Transmittal Form set forth in § 1.77 should be numbered pages 1 and 2 pursuant to § 1.52, and further questioned where the drawings and oath or declaration are to be numbered.

Response: Section 1.52 has been changed to provide that the pages of the specification, not the application, should be consecutively numbered beginning with page 1. The Application Transmittal Form, and Fee Transmittal Form set forth in § 1.77 are not part of the specification. As such, they should not be numbered as pages 1 and 2, respectively. Likewise, the drawings and oath or declaration are not part of the specification, and need not be numbered.

Comment (22): One comment stated that the failure to include the phrase ''not applicable'' by all of the application elements not required by statute or regulation rendered it unclear as to whether the Office would object to the lack of an application element for which the phrase ''not applicable'' is not included.

Response: The Office anticipates that an applicant choosing to use the Transmittal forms provided by the Office will arrange his or her application in the format suggested by the Office. The patent statutes and regulations set forth the requirements for a complete application, as well as the requirements for obtaining a filing date in an application. Applications are examined for compliance with the patent statutes and regulations, not for consistency with any particular transmittal form.

Comment (23): One comment noted, in regard to § 1.84(c), that the drawings of an international application, which are often used for processing in the Office, will have the World Organization (WO) publication number and International Bureau (IB) publication date on the top of the drawing.

Response: The WO publication number and IB publication date placed on the top of the drawing of an international application is not objectionable under § 1.84(c).

Comment (24): One comment stated that the scan target points conflict with PCT Rule 11.6(e). As such, the scan target points would have to be removed from applications to be filed as an international application. The comment further stated that these target points are unnecessary in view of the paper size and margin requirements.

Response: Section 1.84(g) states that drawings ''should,'' and not ''must,'' have scan target points printed on two catercorner margin corners. Thus, § 1.84(g) merely expresses the Office's preference for scan target points on the drawings for filming and printing purposes, which are considered desirable due to the different sights on 21.0 cm. by 29.7 cm. (DIN size A4) and 21.6 cm. by 27.9 cm. (8½ by 11 inch) drawing sheets. An applicant wishing to provide scan target points on drawings that will later be filed in the EPO may simply copy the drawings to be filed in the EPO, place the scan target points only on the Office copy of the drawings, and submit the copy of the drawings containing the scan target points to the Office. Likewise, applicants filing drawings that were previously filed in the EPO should simply add scan target points only to the copy of the drawings to be filed in the Office. Nevertheless, as § 1.84(g) merely expresses a preference for scan target points for Office filming and printing purposes, an applicant intending to later file the application in the EPO, or any applicant, is at liberty to not include such scan target points on the drawings. The Office will not object to the absence of scan target points on any drawings filed in the Office. Therefore, § 1.84(g) does not include a requirement in excess of, or inconsistent, with PCT Rules.

Comment (25): One comment stated that the term ''catercorner'' is slang, and suggested that it be replaced in § 1.84(g) with a phrase such as ''diagonally opposite.''

Response: The term ''catercorner'' is not slang. While there are a number of acceptable English phrases to denote diagonally opposite, the term ''catercorner'' was selected to avoid using a multiple word phrase where a single word will suffice.

Comment (26): One comment stated that the language proposed to be added to § 1.97 regarding a reexamination or patent owner is inconsistent with § 1.533 and suggested that it be deleted.

Response: The suggestion is adopted.

Comment (27): One comment stated that § 1.131 does not specify whether the phrase ''application'' includes provisional applications. The comment suggested that § 1.131 be amended to state ''unless the date of such patent or publication is more than one year prior to the earliest date on which the inventor's or patent owner's application or provisional application from which that application claims priority therefrom was filed in this country.''

Response: The proposed change to § 1.131 is not adopted. It is well established that the filing date of any abandoned application co-pending with and referred to in a patent is the effective date of the patent with respect to the common subject matter disclosed in the patent and abandoned application. See *In re Switzer*, 166 F.2d 827, 77 USPQ 156 (CCPA 1948). Section 1.131 does not make a specific reference to nonprovisional applications for which a benefit is claimed under 35 U.S.C. 120; however, it is understood that the effective date of any patent sought to be antedated pursuant to § 1.131 is the earliest filing date of any application to which the patent is entitled to under 35 U.S.C. 120 with respect to the common subject matter disclosed in the patent and the application. The provisions of title 35, except for 35 U.S.C. 115, 131, 135 and 157, apply to provisional applications. 35 U.S.C. 111(b)(8). It is therefore likewise unnecessary to specifically reference provisional applications in § 1.131.

Comment (28): Several comments objected to §§ 1.291 and 1.292 as pre-grant opposition, especially in view of the pre-grant publication of pending applications that would be provided for in H.R. 1733, if enacted, and the expanded reexamination that would be provided for in H.R. 1732, if enacted. The comments either suggested that the protest and public use proceeding

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provisions of §§ 1.291 and 1.292 be severely limited or abolished.

Response: The changes to §§ 1.291 and 1.292 place greater obligations on third parties seeking to use these sections. As such, this rule change does not add to any third party's ability to participate in the prosecution of a pending application. Nevertheless, as neither H.R. 1732 nor H.R. 1733 has presently been enacted, analysis of whether modification of §§ 1.291 and 1.292 in addition to that proposed in the Notice of Proposed Rulemaking is desirable in a pre-grant publication or expanded reexamination system is held in abeyance pending enactment of H.R. 1733 or 1732.

Comment (29): One comment noted that any standardization of patent applications should not include pre-printed forms taking eleven hours to complete. The comment further suggested that word-processor versions of any collection of information, rather than pre-printed forms, would be of greater assistance to members of the public.

Response: Initially, the Notice of Proposed Rulemaking indicated that the initial patent application (*e.g.*, the specification, drawings, as well as the standard forms), not merely the proposed standardized forms, is a collection of information estimated to average eleven hours to complete. The Notice of Proposed Rulemaking stated that the public reporting burden for these collections of information is estimated to average: (1) Twelve minutes per response for the Fee Transmittal form, (2) twelve minutes per response for the Utility Patent Application Transmittal form, (3) twelve minutes per response for the Design Patent Application Transmittal form, (4) twelve minutes per response for the Plant Patent Application Transmittal form, (5) twelve minutes per response for the Plant Color Coding Sheet, (6) twenty-four minutes per response for the Declaration form, and (7) twenty-four minutes per response for the Plant Patent Application Declaration. Nevertheless, the final rules do not require the use of any standardized form. The Office publishes standardized forms only as an aid to practitioners and applicants.

Comment (30): One comment questioned whether use of the standardized versions of the various forms would be required. Another comment stated that the Office has no authority to require the use of the published forms in the absence of statutory authority.t

Response: Use of the forms included for comment with the Notice of Proposed Rulemaking is not mandatory. That is, an applicant need not use the standardized versions of the Fee Transmittal form, Utility Patent Application Transmittal form, Design Patent Application Transmittal form, Plant Patent Application Transmittal form, Plant Color Coding Sheet, Declaration form and Plant Patent Application Declaration form, and need not use any fee transmittal form, application transmittal form, or plant color coding sheet. These forms were created to assist applicants in filing a patent application and to help ensure the filing of a complete application accompanied by the appropriate fees, thereby avoiding unnecessary delays in the examination of the application.

Comment (31): One comment stated that the Office should not require the use of mandated forms, and if the Office requires the use of mandated forms, the Office should revise the forms to render them readily reproducible by conventional software, and should arrange for versions of these forms in various formats to be distributed by the Internet, bulletin board, or floppy disk. Another comment suggested that the Office should make its form or templates available for electronic copying.

Response: Copies of the standard forms provided by the Office may be obtained by contacting the Customer Service Center of the Office of Initial Patent Examination at (703) 308–1214. Also, many standardized forms have been loaded on the Office's Internet Website and may be electronically copied via the Internet through anonymous file transfer protocol (ftp) (address: ftp.uspto.gov). Nevertheless, use of the forms included for comment with the Notice of Proposed Rulemaking is not mandatory.

Comment (32): One comment questioned why there is a box with an instruction to type a plus sign in the box at the very top of the standardized forms.

Response: As discussed *supra*, the Office plans to replace or augment the current microfilming process with an electronic data base which captures at least the technical content of the application-as-filed for internal Office use. Typing a plus sign (+) into this box will facilitate the image scanner in aligning the remaining typing on the form during the scanning process.

Comment (33): One comment questioned: (1) Why the application transmittal forms do not have a place for applicant to indicate the type of new utility application being transmitted (*e.g.*, a provisional, original, continuation, division, continuation-in-part, reissue), and (2) how the Office official will obtain this information for entry in the official use ''application type'' box.

Response: The Utility Patent Application Transmittal form sets forth instructions for filing utility applications under § 1.53 in the arrangement set forth in § 1.77. All non-reissue, nonprovisional utility applications (*i.e.*, original, continuation, divisional, and continuation-in-part applications) filed under § 1.53 should be submitted using the Utility Patent Application Transmittal form. The Design Patent Application Transmittal form sets forth instructions for filing design applications in the arrangement set forth in § 1.154. All non-reissue design applications should be submitted using the Design Patent Application Transmittal form. The Plant Patent Application Transmittal form sets forth instructions for filing plant applications in the arrangement set forth in § 1.163. All non-reissue, nonprovisional plant applications should be submitted using the Plant Patent Application Transmittal form.

A Reissue Patent Application Transmittal form is also available, and all applications for the reissue of a patent should be submitted using the Reissue Patent Application Transmittal form. The cover sheet provided for in § 1.53(b)(2)(i) for a provisional application functions as a transmittal sheet for a provisional application. As such, the standardized Provisional Application Cover Sheet is the transmittal form for a provisional application. The provisional application cover sheet was published in the rulemaking entitled ''Changes to Implement 20-Year Patent Term and Provisional Applications,'' in the Federal Register at 60 FR 20230–31 (April 25, 1995), and in the Patent and Trademark Office Official Gazette at 1174 Off. Gaz. Pat Office 45–46 (May 2, 1995).

To provide a place on the Application Transmittal form for claims under 35 U.S.C. 119, 120, or 121 would require the use of an unacceptably smaller font on the Application Transmittal form. The Declaration forms provide a place for stating claims under 35 U.S.C. 119, 120 or 121. The inclusion on filing of an executed or unexecuted Declaration form containing this information would assist the Office in ascertaining whether the application is an original, continuation, divisional, or continuation-in-part application. In addition, in the event that H.R. 1733 is enacted, and the proposed changes to §§ 1.55(a) and 1.78(a)(2) are adopted substantially as proposed, the routine

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inclusion of claims for priority under 35 U.S.C. 119, 120, or 121 in an executed or unexecuted declaration form accompanying the application papers would be an excellent mechanism for avoiding an inadvertent failure to timely submit a claim for priority under 35 U.S.C. 119, 120, or 121.

Comment (34): One comment noted that the heading ''DECLARATION'' does not state the types of applications with which the declaration form could be used. The comment questioned whether it is intended to be used with any type of nonprovisional application except plant applications for which a separate form is proposed.

Response: The declaration form containing the heading ''DECLARATION'' is intended to be used with any type of nonprovisional application except plant applications, for which a separate Plant Declaration form is provided.

Comment (35): One comment suggested that in the foreign priority claim section of the Declaration form, the last line, the phrase ''having a filing date before that of the application on which priority is claimed'' should be changed to ''for which priority is not claimed,'' to cover those foreign applications which have a filing date after that of the application on which priority is claimed and the benefit of which applicant does not want to claim. The comment also indicated that, frequently, an application is filed after the Convention Year.

Response: The suggestion is not adopted. Section 1.63(c) requires that an oath or declaration in any application in which a claim for priority is made pursuant to § 1.55 identify * * * ''any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing.'' Thus, the language in the Declaration form aids applicants in submitting a declaration in compliance with § 1.63(c). Any foreign application having a filing date before that of the application on which priority is claimed is, by definition, a foreign application for which priority is not claimed.

Comment (36): One comment suggested that in the foreign priority claim section, the right hand columns, the heading should be corrected to ''Certified Copy Attached'' since the Office does not routinely want uncertified copies.

Response: The suggestion is adopted. The Declaration form has been modified accordingly.

Comment (37): One comment noted that the Fee Calculation and Application Transmittal are currently on a single sheet/form, where the proposed forms provide a separate sheet/form for each. The comment also noted that the current Declaration form is a single sheet, where the proposed Declaration form contains multiple sheets.

Response: The Office currently receives application transmittals, fee calculations/transmittals and declarations in a variety of forms and in a multitude of formats. The proposed forms were developed as a result of an analysis of the current practices and requirements of applicants, as well as the Office's plans to scan application data from these forms into an electronic data base. The Fee Transmittal form was created to aid applicants in submitting the fees due on filing a new patent application, as well as the fees that may be due throughout the prosecution of the application. The Application Transmittal serves to both aid applicants in filing a complete application, and simplify the pre-examination processing of the application. To permit the inclusion of additional fee calculation and application transmittal information on the standardized forms, and to provide a Fee Transmittal form for use throughout the prosecution of the application, a separate Fee Transmittal form and Application Transmittal form were developed. A multi-page Declaration form is necessary to accommodate the Office's plans to scan application data from this Declaration form into an electronic data base.

Comment (38): One comment indicated that the meaning or purpose of ''suffix'' in the inventor signature block is unclear, and requested an explanation as to whether it refers to ''Jr.'' or ''II,'' or whether it is a place to put the mother's name for those inventors whose family name is followed by their mother's name.

Response: The field on the Declaration form labeled (inventor) ''suffix'' is intended to provide the applicant with an option to indicate family position relative to age. Examples of an inventor's suffix are: Jr., Sr., and III. This information is tracked by the Office and is necessary to print patents which accurately reflect bibliographic information about the inventor. The use of this field and the data expected will be clarified and specified in the form instructions.

Comment (39): One comment questioned the meaning or purpose of ''Applicant Authority'' in the last line of the inventor data block.

Response: The phrase ''Applicant Authority'' indicates the authority that the applicant has in executing the application (e.g., inventor, executor (§ 1.42), assignee (§ 1.47(b)). This field is an optional field for the applicant to complete. The electronic versions of the proposed standard declaration forms would provide the applicant with directions and a list of valid codes that correspond with a specific identification of the authority the applicant retains (*e.g.*, the Authority Code for an executor will be ''04'').

Comment (40): One comment stated that due to the spacing and small fonts on the fee transmittal form, this sheet cannot be used with a conventional word processor.

Response: To accommodate all the fee descriptions on a one-page fee transmittal it was necessary to use smaller fonts in the form's design. These fonts are available in Word and WordPerfect. An electronic version of the fee transmittal will be available from the Office soon.

Comment (41): One comment stated that the ''one form fits all'' mentality of the fee transmittal form should be reconsidered since certain fees are submitted only once during the prosecution of an application.

Response: The proposed standard one-page fee form is primarily to facilitate and simplify the fee payment process. The one-page fee transmittal is intended to aid applicants in providing complete fee information to the Office for each application and paper submission. This will enable the Office to more efficiently process and record fee payments, which will avoid delays in the prosecution of an application.

Other Considerations

This final rule change is in conformity with the requirements of the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*), Executive Order 12612, and the Paperwork Reduction Act of 1995, 44 U.S.C. 3501 *et seq*. It has been determined that this final rule is not significant for the purposes of Executive Order 12866.

The Assistant General Counsel for Legislation and Regulation of the Department of Commerce has certified to the Chief Counsel for Advocacy, Small Business Administration, that this rule change will not have a significant economic impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)). The principal effect of this rule change is to simplify and clarify the rules governing the form of patent application papers.

The Office has also determined that this notice has no Federalism implications affecting the relationship between the National Government and

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the States as outlined in Executive Order 12612.

Notwithstanding any other provision of law, no person is required to respond to nor shall any person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

This final rule package contains a collection of information subject to the Paperwork Reduction Act of 1995, 44 U.S.C. 3501 *et seq*. This collection of information is currently approved by the Office of Management and Budget under Control No. 0651–0032. This collection of information includes the initial patent application filing, the Fee Transmittal form, the Utility Patent Application Transmittal form, the Design Patent Application Transmittal form, the Plant Patent Application Transmittal form, the Plant Color Coding Sheet, the Declaration form, and the Plant Patent Application Declaration form. The above-mentioned forms will reduce the burden and uncertainty associated with the submission of an application and related information, and enhance the Office's ability to use standardized automation techniques (optical character recognition, etc.) to record and process information concerning applications. The public reporting burden for these collections of information is estimated to average: (1) Ten hours per response for the specification and drawings of an application, (2) twelve minutes per response for the Fee Transmittal form, (3) twelve minutes per response for the Utility Patent Application Transmittal form, (4) twelve minutes per response for the Design Patent Application Transmittal form, (5) twelve minutes per response for the Plant Patent Application Transmittal form, (6) twelve minutes per response for the Plant Color Coding Sheet, (7) twenty-four minutes per response for the Declaration form, and (8) twenty-four minutes per response for the Plant Patent Application Declaration. These estimates include the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed, and completing and reviewing the collections of information.

Send comments regarding this burden estimate or any other aspect of this collection of information, including suggestions for reducing this burden to the Office of System Quality and Enhancement, Data Administration Division, Patent and Trademark Office, Washington, DC 20231, and to the Office of Information and Regulatory Affairs, Office of Management and Budget, Washington, DC 20503 (ATTN: Paperwork Reduction Act Project 0651–0032).

List of Subjects in 37 CFR Part 1

Administrative practice and procedure, Courts, Freedom of Information, Inventions and patents, Reporting and recordkeeping requirements, Small businesses.

For the reasons set forth in the preamble, 37 CFR Part 1 is amended as follows:

PART 1—RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR Part 1 continues to read as follows:

Authority: 35 U.S.C. 6, unless otherwise noted.

2. Section 1.5 is amended by adding paragraph (f) to read as follows:

§ 1.5 Identification of application, patent or registration.

* * * * *

(f) When a paper concerns a provisional application, it should identify the application as such and include the application number.

3. Section 1.12 is amended by revising paragraph (c) to read as follows:

§ 1.12 Assignment records open to public inspection.

* * * * *

(c) Any request by a member of the public seeking copies of any assignment records of any pending or abandoned patent application preserved in confidence under § 1.14, or any information with respect thereto, must:

(1) Be in the form of a petition accompanied by the petition fee set forth in § 1.17(i); or

(2) Include written authority granting access to the member of the public to the particular assignment records from the applicant or applicant's assignee or attorney or agent of record.

* * * * *

4. Section 1.14 is amended by revising the section heading and paragraphs (a), (b), and (e) to read as follows:

§ 1.14 Patent applications preserved in confidence.

(a) (1) Patent applications are generally preserved in confidence pursuant to 35 U.S.C. 122. No information will be given concerning the filing, pendency, or subject matter of any application for patent, and no access will be given to, or copies furnished of, any application or papers relating thereto, except as set forth in this section.

(2) Status information, which includes information such as whether the application is pending, abandoned, or patented, as well as the application number and filing date, may be supplied:

(i) Concerning an application or any application claiming the benefit of the filing date of the application, if the application has been identified by application number or serial number and filing date in a published patent document,

(ii) Concerning the national stage application or any application claiming the benefit of the filing date of a published international application, if the United States of America has been indicated as a Designated State in the international application, or

(iii) When it has been determined by the Commissioner to be necessary for the proper conduct of business before the Office.

(3) Access to, or copies of, an application may be provided:

(i) When the application is open to the public as provided in § 1.11(b),

(ii) When written authority in that application from the applicant, the assignee of the application, or the attorney or agent of record has been granted,

(iii) When it has been determined by the Commissioner to be necessary for the proper conduct of business before the Office, or

(iv) To any person on written request, without notice to the applicant, when the application is abandoned and available and is:

(A) Referred to in a U.S. patent,

(B) Referred to in an application open to public inspection,

(C) An application which claims the benefit of the filing date of an application open to public inspection, or

(D) An application in which the applicant has filed an authorization to lay open the complete application to the public.

(b) Complete applications (§ 1.51(a)) which are abandoned may be destroyed and hence may not be available for access or copies as permitted by paragraph (a)(3)(iv) of this section after 20 years from their filing date, except those to which particular attention has been called and which have been marked for preservation.

* * * * *

(e) Any request by a member of the public seeking access to, or copies of, any pending or abandoned application preserved in confidence pursuant to paragraph (a) of this section, or any papers relating thereto, must:

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(1) Be in the form of a petition and be accompanied by the petition fee set forth in § 1.17(i); or

(2) Include written authority granting access to the member of the public in that particular application from the applicant or the applicant's assignee or attorney or agent of record.

5. Section 1.52 is amended by revising paragraphs (a) and (b) to read as follows:

§ 1.52 Language, paper, writing, margins.

(a) The application, any amendments or corrections thereto, and the oath or declaration must be in the English language except as provided for in § 1.69 and paragraph (d) of this section, or be accompanied by a verified translation of the application and a translation of any corrections or amendments into the English language. All papers which are to become a part of the permanent records of the Patent and Trademark Office must be legibly written either by a typewriter or mechanical printer in permanent dark ink or its equivalent in portrait orientation on flexible, strong, smooth, non-shiny, durable, and white paper. All of the application papers must be presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic reproduction by use of digital imaging and optical character recognition. If the papers are not of the required quality, substitute typewritten or mechanically printed papers of suitable quality will be required. See § 1.125 for filing substitute typewritten or mechanically printed papers constituting a substitute specification when required by the Office.

(b) Except for drawings, the application papers (specification, including claims, abstract, oath or declaration, and papers as provided for in this part and also papers subsequently filed, must have each page plainly written on only one side of a sheet of paper, with the claim or claims commencing on a separate sheet and the abstract commencing on a separate sheet. See §§ 1.72(b) and 1.75(h). The sheets of paper must be the same size and either 21.0 cm. by 29.7 cm. (DIN size A4) or 21.6 cm. by 27.9 cm. (8½ by 11 inches). Each sheet must include a top margin of at least 2.0 cm. (¾ inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 2.0 cm. (¾ inch), and a bottom margin of at least 2.0 cm. (¾ inch), and no holes should be made in the sheets as submitted. The lines of the specification, and any amendments to the specification, must be 1½ or double spaced. The pages of the specification including claims and abstract must be numbered consecutively, starting with 1, the numbers being centrally located above or preferably, below, the text. See § 1.84 for drawings.

* * * * *

6. Section 1.54 is amended by revising paragraph (b) to read as follows:

§ 1.54 Parts of application to be filed together; filing receipt.

* * * * *

(b) Applicant will be informed of the application number and filing date by a filing receipt.

7. Section 1.58 is amended by removing and reserving paragraph (b) and revising the section heading and paragraph (c) to read as follows:

§ 1.58 Chemical and mathematical formulae and tables.

* * * * *

(b) [Reserved]

(c) Chemical and mathematical formulae and tables must be presented in compliance with § 1.52 (a) and (b), except that chemical and mathematical formulae or tables may be placed in a landscape orientation if they cannot be presented satisfactorily in a portrait orientation. Typewritten characters used in such formulae and tables must be chosen from a block (nonscript) type font or lettering style having capital letters which are at least 0.21 cm. (0.08 inch) high (*e.g.*, elite type). A space at least 0.64 cm. (¼ inch) high should be provided between complex formulae and tables and the text. Tables should have the lines and columns of data closely spaced to conserve space, consistent with a high degree of legibility.

8. Section 1.62 is amended by revising paragraphs (e) and (f) to read as follows:

§ 1.62 File wrapper continuing procedure.

* * * * *

(e) An application filed under this section will utilize the file wrapper and contents of the prior application to constitute the new continuation, continuation-in-part, or divisional application but will be assigned a new application number. Changes to the prior application must be made in the form of an amendment to the prior application as it exists at the time of filing the application under this section. No copy of the prior application or new specification is required. The filing of such a copy or specification will be considered improper, and a filing date as of the date of deposit of the request for an application under this section will not be granted to the application unless a petition with the fee set forth in § 1.17(i) is filed with instructions to cancel the copy or specification.

(f) The filing of an application under this section will be construed to include a waiver of confidence by the applicant under 35 U.S.C. 122 to the extent that any member of the public who is entitled under the provisions of § 1.14 to access to, or information concerning either the prior application or any continuing application filed under the provisions of this section may be given similar access to, or similar information concerning, the other application(s) in the file wrapper.

* * * * *

9. Section 1.72 is amended by revising paragraph (b) to read as follows:

§ 1.72 Title and abstract.

* * * * *

(b) A brief abstract of the technical disclosure in the specification must commence on a separate sheet, preferably following the claims, under the heading ''Abstract of the Disclosure.'' The purpose of the abstract is to enable the Patent and Trademark Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure. The abstract shall not be used for interpreting the scope of the claims.

10. Section 1.75 is amended by revising paragraph (g) and adding paragraphs (h) and (i) to read as follows:

§ 1.75 Claim(s).

* * * * *

(g) The least restrictive claim should be presented as claim number 1, and all dependent claims should be grouped together with the claim or claims to which they refer to the extent practicable.

(h) The claim or claims must commence on a separate sheet.

(i) Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.

11. Section 1.77 is revised to read as follows:

§ 1.77 Arrangement of application elements.

(a) The elements of the application, if applicable, should appear in the following order:

(1) Utility Application Transmittal Form.

(2) Fee Transmittal Form.

(3) Title of the invention; or an introductory portion stating the name, citizenship, and residence of the applicant, and the title of the invention.

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(4) Cross-reference to related applications.

(5) Statement regarding federally sponsored research or development.

(6) Reference to a ''Microfiche appendix.'' (See § 1.96 (c)). The total number of microfiche and total number of frames should be specified.

(7) Background of the invention.

(8) Brief summary of the invention.

(9) Brief description of the several views of the drawing.

(10) Detailed description of the invention.

(11) Claim or claims.

(12) Abstract of the Disclosure.

(13) Drawings.

(14) Executed oath or declaration.

(15) Sequence Listing (See §§ 1.821 through 1.825).

(b) The elements set forth in paragraphs (a)(3) through (a)(5), (a)(7) through (a)(12) and (a)(15) of this section should appear in upper case, without underlining or bold type, as section headings. If no text follows the section heading, the phrase ''Not Applicable'' should follow the section heading.

12. Section 1.78 is amended by removing paragraph (d) and revising paragraphs (a)(2) and (c) to read as follows:

§ 1.78 Claiming benefit of earlier filing date and cross references to other applications.

(a) * * *

(2) Any nonprovisional application claiming the benefit of one or more prior filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain in the first sentence of the specification following the title a reference to each such prior application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross-references to other related applications may be made when appropriate. (See § 1.14(a)).

* * * * *

(c) Where an application or a patent under reexamination and at least one other application naming different inventors are owned by the same party and contain conflicting claims, and there is no statement of record indicating that the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, the assignee may be called upon to state whether the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, and if not, indicate which named inventor is the prior inventor.

13. Section 1.84 is amended by revising paragraphs (c), (f), (g), and (x) to read as follows:

§ 1.84 Standards for drawings.

* * * * *

(c) *Identification of drawings.* Identifying indicia, if provided, should include the application number or the title of the invention, inventor's name, docket number (if any), and the name and telephone number of a person to call if the Office is unable to match the drawings to the proper application. This information should be placed on the back of each sheet of drawings a minimum distance of 1.5 cm. (5/8 inch) down from the top of the page. In addition, a reference to the application number, or, if an application number has not been assigned, the inventor's name, may be included in the left-hand corner, provided that the reference appears within 1.5 cm. (9/16 inch) from the top of the sheet.

* * * * *

(f) *Size of paper.* All drawing sheets in an application must be the same size. One of the shorter sides of the sheet is regarded as its top. The size of the sheets on which drawings are made must be:

(1) 21.0 cm. by 29.7 cm. (DIN size A4), or

(2) 21.6 cm. by 27.9 cm. (8½ by 11 inches).

(g) *Margins.* The sheets must not contain frames around the sight; *i.e.*, the usable surface, but should have scan target points, *i.e.*, cross-hairs, printed on two catercorner margin corners. Each sheet must include a top margin of at least 2.5 cm. (1 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 1.5 cm. (9/16 inch), and a bottom margin of at least 1.0 cm. (3/8 inch), thereby leaving a sight no greater than 17.0 cm. by 26.2 cm. on 21.0 cm. by 29.7 cm. (DIN size A4) drawing sheets, and a sight no greater than 17.6 cm. by 24.4 cm. (6 15/16 by 9 5/8 inches) on 21.6 cm. by 27.9 cm. (8½ by 11 inch) drawing sheets.

* * * * *

(x) *Holes.* No holes should be made by applicant in the drawing sheets. (See § 1.152 for design drawings, § 1.165 for plant drawings, and § 1.174 for reissue drawings.)

14. Section 1.96 is revised to read as follows:

§ 1.96 Submission of computer program listings.

(a) *General.* Descriptions of the operation and general content of computer program listings should appear in the description portion of the specification. A computer program listing for the purpose of this section is defined as a printout that lists in appropriate sequence the instructions, routines, and other contents of a program for a computer. The program listing may be either in machine or machine-independent (object or source) language which will cause a computer to perform a desired procedure or task such as solve a problem, regulate the flow of work in a computer, or control or monitor events. Computer program listings may be submitted in patent applications as set forth in paragraphs (b) and (c) of this section.

(b) *Material which will be printed in the patent.* If the computer program listing is contained on ten printout pages or less, it must be submitted either as drawings or as part of the specification.

(1) *Drawings.* If the listing is submitted as drawings, it must be submitted in the manner and complying with the requirements for drawings as provided in § 1.84. At least one figure numeral is required on each sheet of drawing.

(2) *Specification.* (i) If the listing is submitted as part of the specification, it must be submitted in accordance with the provisions of § 1.52, at the end of the description but before the claims.

(ii) Any listing submitted as part of the specification must be direct printouts (*i.e.*, not copies) from the computer's printer with dark solid black letters not less than 0.21 cm. high, on white, unshaded and unlined paper, and the sheets should be submitted in a protective cover. Any amendments must be made by way of submission of substitute sheets.

(c) *As an appendix which will not be printed.* If a computer program listing printout is eleven or more pages long, applicants must submit such listing in the form of microfiche, referred to in the specification (see § 1.77(a)(6)). Such microfiche filed with a patent application is to be referred to as a ''microfiche appendix.'' The ''microfiche appendix'' will not be part of the printed patent. Reference in the application to the ''microfiche appendix'' must be made at the beginning of the specification at the location indicated in § 1.77(a)(6). Any amendments thereto must be made by way of revised microfiche.

(1) *Availability of appendix.* Such computer program listings on

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microfiche will be available to the public for inspection, and microfiche copies thereof will be available for purchase with the file wrapper and contents, after a patent based on such application is granted or the application is otherwise made publicly available.

(2) *Submission requirements.* Except as modified or clarified in this paragraph (c)(2), computer-generated information submitted as a ''microfiche appendix'' to an application shall be in accordance with the standards set forth in 36 CFR part 1230 (Micrographics).

(i) Film submitted shall be a first generation (camera film) negative appearing microfiche (with emulsion on the back side of the film when viewed with the images right-reading).

(ii) Reduction ratio of microfiche submitted should be 24:1 or a similar ratio where variation from said ratio is required in order to fit the documents into the image area of the microfiche format used.

(iii) At least the left-most third (50 mm.×12 mm.) of the header or title area of each microfiche submitted shall be clear or positive appearing so that the Patent and Trademark Office can apply an application number and filing date thereto in an eye-readable form. The middle portion of the header shall be used by applicant to apply an eye-readable application identification such as the title and/or the first inventor's name. The attorney's docket number may be included. The final right-hand portion of the microfiche shall contain sequence information for the microfiche, such as 1 of 4, 2 of 4, *etc.*

(iv) Additional requirements which apply specifically to microfiche of filmed paper copy:

(A) The first frame of each microfiche submitted shall contain a test target.

(B) The second frame of each microfiche submitted must contain a fully descriptive title and the inventor's name as filed.

(C) The pages or lines appearing on the microfiche frames should be consecutively numbered.

(D) Pagination of the microfiche frames shall be from left to right and from top to bottom.

(E) At a reduction of 24:1, resolution of the original microfilm shall be at least 120 lines per mm. (5.0 target).

(F) An index, when included, should appear in the last frame (lower right-hand corner when data is right-reading) of each microfiche.

(v) Microfiche generated by Computer Output Microfilm.

(A) The first frame of each microfiche submitted should contain a resolution test frame.

(B) The second frame of each microfiche submitted must contain a fully descriptive title and the inventor's name as filed.

(C) The pages or lines appearing on the microfiche frames should be consecutively numbered.

(D) It is preferred that pagination of the microfiche frames be from left to right and top to bottom but the alternative, *i.e.*, from top to bottom and from left to right, is also acceptable.

(E) An index, when included, should appear on the last frame (lower right-hand corner when data is right-reading) of each microfiche.

15. Section 1.97 is amended by revising paragraphs (a) through (d) to read as follows:

§ 1.97 Filing of information disclosure statement.

(a) In order for an applicant for a patent or for a reissue of a patent to have an information disclosure statement in compliance with § 1.98 considered by the Office during the pendency of the application, it must satisfy paragraph (b), (c), or (d) of this section.

(b) An information disclosure statement shall be considered by the Office if filed by the applicant:

(1) Within three months of the filing date of a national application;

(2) Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application; or

(3) Before the mailing date of a first Office action on the merits, whichever event occurs last.

(c) An information disclosure statement shall be considered by the Office if filed by the applicant after the period specified in paragraph (b) of this section, provided that the statement is accompanied by either a certification as specified in paragraph (e) of this section or the fee set forth in § 1.17(p), and is filed before the mailing date of either:

(1) A final action under § 1.113; or

(2) A notice of allowance under § 1.311, whichever occurs first.

(d) An information disclosure statement shall be considered by the Office if filed by the applicant after the period specified in paragraph (c) of this section, provided that the statement is filed on or before payment of the issue fee and is accompanied by:

(1) A certification as specified in paragraph (e) of this section;

(2) A petition requesting consideration of the information disclosure statement; and

(3) The petition fee set forth in § 1.17(i).

* * * * *

16. Section 1.107 is amended by revising paragraph (a) to read as follows:

§ 1.107 Citation of references.

(a) If domestic patents are cited by the examiner, their numbers and dates, and the names of the patentees must be stated. If foreign published applications or patents are cited, their nationality or country, numbers and dates, and the names of the patentees must be stated, and such other data must be furnished as may be necessary to enable the applicant, or in the case of a reexamination proceeding, the patent owner, to identify the published applications or patents cited. In citing foreign published applications or patents, in case only a part of the document is involved, the particular pages and sheets containing the parts relied upon must be identified. If printed publications are cited, the author (if any), title, date, pages or plates, and place of publication, or place where a copy can be found, shall be given.

* * * * *

17. Section 1.110 is revised to read as follows:

§ 1.110 Inventorship and date of invention of the subject matter of individual claims.

When more than one inventor is named in an application or patent, the Patent and Trademark Office, when necessary for purposes of an Office proceeding, may require an applicant, patentee, or owner to identify the inventive entity of the subject matter of each claim in the application or patent. Where appropriate, the invention dates of the subject matter of each claim and the ownership of the subject matter on the date of invention may be required of the applicant, patentee or owner. See also §§ 1.78(c) and 1.130.

18. A new § 1.130 is added after the undesignated center heading ''Affidavits Overcoming Rejections'' to read as follows:

§ 1.130 Affidavit or declaration to disqualify commonly owned patent as prior art.

(a) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 103 in view of a U.S. patent which is not prior art under 35 U.S.C. 102(b), and the inventions defined by the claims in the application or patent under reexamination and by the claims in the patent are not identical but are not patentably distinct, and the inventions are owned by the same party, the applicant or owner of the patent under reexamination may disqualify the patent as prior art. The patent can be disqualified as prior art by submission of:

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(1) A terminal disclaimer in accordance with § 1.321(c), and

(2) An oath or declaration stating that the application or patent under reexamination and the patent are currently owned by the same party, and that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104.

(b) When an application or a patent under reexamination claims an invention which is not patentably distinct from an invention claimed in a commonly owned patent with the same or a different inventive entity, a double patenting rejection will be made in the application or a patent under reexamination. A judicially created double patenting rejection may be obviated by filing a terminal disclaimer in accordance with § 1.321(c).

19. Section 1.131 is amended by revising paragraph (a) to read as follows:

§ 1.131 Affidavit or declaration of prior invention to overcome cited patent or publication.

(a) (1) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 102 (a) or (e), or 35 U.S.C. 103 based on a U.S. patent to another or others which is prior art under 35 U.S.C. 102 (a) or (e) and which substantially shows or describes but does not claim the same patentable invention, as defined in § 1.601(n), or on reference to a foreign patent or to a printed publication, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to overcome the patent or publication. The oath or declaration must include facts showing a completion of the invention in this country or in a NAFTA or WTO member country before the filing date of the application on which the U.S. patent issued, or before the date of the foreign patent, or before the date of the printed publication. When an appropriate oath or declaration is made, the patent or publication cited shall not bar the grant of a patent to the inventor or the confirmation of the patentability of the claims of the patent, unless the date of such patent or printed publication is more than one year prior to the date on which the inventor's or patent owner's application was filed in this country.

(2) A date of completion of the invention may not be established under this section before December 8, 1993, in a NAFTA country, or before January 1, 1996, in a WTO member country other than a NAFTA country.

* * * * *

20. Section 1.132 is revised to read as follows:

§ 1.132 Affidavits or declarations traversing grounds of rejection.

When any claim of an application or a patent under reexamination is rejected on reference to a U.S. patent which substantially shows or describes but does not claim the same patentable invention, as defined in § 1.601(n), on reference to a foreign patent, on reference to a printed publication, or on reference to facts within the personal knowledge of an employee of the Office, or when rejected upon a mode or capability of operation attributed to a reference, or because the alleged invention is held to be inoperative, lacking in utility, frivolous, or injurious to public health or morals, affidavits or declarations traversing these references or objections may be received.

21. Section 1.154 is revised to read as follows:

§ 1.154 Arrangement of specification.

(a) The elements of the design application, if applicable, should appear in the following order:

(1) Design Application Transmittal Form.

(2) Fee Transmittal Form.

(3) Preamble, stating name of the applicant and title of the design.

(4) Cross-reference to related applications.

(5) Statement regarding federally sponsored research or development.

(6) Description of the figure or figures of the drawing.

(7) Feature Description.

(8) A single claim.

(9) Drawings or photographs.

(10) Executed oath or declaration (See § 1.153(b)).

(b) [Reserved]

22. Section 1.163 is amended by adding new paragraphs (c) and (d) to read as follows:

§ 1.163 Specification.

* * * * *

(c) The elements of the plant application, if applicable, should appear in the following order:

(1) Plant Application Transmittal Form.

(2) Fee Transmittal Form.

(3) Title of the invention.

(4) Cross-reference to related applications.

(5) Statement regarding federally sponsored research or development.

(6) Background of the invention.

(7) Brief summary of the invention.

(8) Brief description of the drawing.

(9) Detailed Botanical Description.

(10) A single claim.

(11) Abstract of the Disclosure.

(12) Drawings (in duplicate).

(13) Executed oath or declaration.

(14) Plant color coding sheet.

(d) A plant color coding sheet as used in this section means a sheet that specifies a color coding system as designated in a color dictionary, and lists every plant structure to which color is a distinguishing feature and the corresponding color code which best represents that plant structure.

23. Section 1.291 is amended by revising paragraphs (a) and (b) to read as follows:

§ 1.291 Protests by the public against pending applications.

(a) Protests by a member of the public against pending applications will be referred to the examiner having charge of the subject matter involved. A protest specifically identifying the application to which the protest is directed will be entered in the application file if:

(1) The protest is submitted prior to the mailing of a notice of allowance under § 1.311; and

(2) The protest is either served upon the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible.

(b) Protests raising fraud or other inequitable conduct issues will be entered in the application file, generally without comment on those issues. Protests which do not adequately identify a pending patent application will be returned to the protestor and will not be further considered by the Office. A protest submitted in accordance with the second sentence of paragraph (a) of this section will be considered by the Office if the application is still pending when the protest and application file are brought before the examiner and it includes:

(1) A listing of the patents, publications, or other information relied upon;

(2) A concise explanation of the relevance of each listed item;

(3) A copy of each listed patent or publication or other item of information in written form or at least the pertinent portions thereof; and

(4) An English language translation of all the necessary and pertinent parts of any non-English language patent, publication, or other item of information in written form relied upon.

* * * * *

24. Section 1.292 is amended by revising paragraphs (a) and (b) to read as follows:

§ 1.292 Public use proceedings.

(a) When a petition for the institution of public use proceedings, supported by affidavits or declarations is found, on reference to the examiner, to make a *prima facie* showing that the invention claimed in an application believed to be on file had been in public use or on sale more than one year before the filing of the application, a hearing may be had before the Commissioner to determine whether a public use proceeding should be instituted. If instituted, the Commissioner may designate an appropriate official to conduct the public use proceeding, including the setting of times for taking testimony, which shall be taken as provided by §§ 1.671 through 1.685. The petitioner will be heard in the proceedings but after decision therein will not be heard further in the prosecution of the application for patent.

(b) The petition and accompanying papers, or a notice that such a petition has been filed, shall be entered in the application file if:

(1) The petition is accompanied by the fee set forth in § 1.17(j);

(2) The petition is served on the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible; and

(3) The petition is submitted prior to the mailing of a notice of allowance under § 1.311.

* * * * *

25. Section 1.315 is revised to read as follows:

§ 1.315 Delivery of patent.

The patent will be delivered or mailed upon issuance to the correspondence address of record. See § 1.33(a).

26. Section 1.321 is amended by revising paragraph (c) to read as follows:

§ 1.321 Statutory disclaimers, including terminal disclaimers.

* * * * *

(c) A terminal disclaimer, when filed to obviate a judicially created double patenting rejection in a patent application or in a reexamination proceeding, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and

(3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection.

27. Section 1.497 is revised to read as follows:

§ 1.497 Oath or declaration under 35 U.S.C. 371(c)(4).

(a) When an applicant of an international application desires to enter the national stage under 35 U.S.C. 371 pursuant to §§ 1.494 or 1.495, he or she must file an oath or declaration that:

(1) Is executed in accordance with either §§ 1.66 or 1.68;

(2) Identifies the specification to which it is directed;

(3) Identifies each inventor and the country of citizenship of each inventor; and

(4) States that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

(b)(1) The oath or declaration must be made by all of the actual inventors except as provided for in §§ 1.42, 1.43 or 1.47.

(2) If the person making the oath or declaration is not the inventor, the oath or declaration shall state the relationship of the person to the inventor, the facts required by §§ 1.42, 1.43 or 1.47, and, upon information and belief, the facts which the inventor would have been required to state.

(c) If the oath or declaration meets the requirements of paragraphs (a) and (b) of this section, the oath or declaration will be accepted as complying with 35 U.S.C. 371(c)(4) and §§ 1.494(c) or 1.495(c). However, if the oath or declaration does not also meet the requirements of § 1.63, a supplemental oath or declaration in compliance with § 1.63 will be required in accordance with § 1.67.

Dated: August 13, 1996.

Bruce A. Lehman,

Assistant Secretary of Commerce and Commissioner of Patents and Trademarks.

[FR Doc. 96–21073 Filed 8–16–96; 8:45 am]

BILLING CODE 3510–16–P

37 CFR Parts 15 and 15a

[Docket No. 960722200–6200–01]

RIN 0651–XX07

Service of Process; Testimony by Employees and the Production of Documents in Legal Proceedings

AGENCY: Patent and Trademark Office, Commerce.

ACTION: Final rule.

SUMMARY: This final rule removes parts dealing with service of process on Patent and Trademark Office (PTO) employees in their official capacity and with testimony by employees and production of documents in legal proceedings. The PTO will rely on analogous Commerce Department regulations found in title 15 of the Code of Federal Regulations.

EFFECTIVE DATE: August 19, 1996.

FOR FURTHER INFORMATION CONTACT: Kenneth Corsello by telephone at (703) 305–9041; by mail marked to his attention and addressed to the Office of the Solicitor, Box 8, Washington, D.C. 20231; by electronic mail to corsello@uspto.gov; or by fax marked to his attention at (703) 305–9373.

SUPPLEMENTARY INFORMATION: In March 1995, President Clinton issued a directive to Federal agencies regarding their responsibilities under his Regulatory Reform Initiative. This initiative is part of the National Performance Review and calls for immediate, comprehensive regulatory reform. The President directed all agencies to undertake, as part of this initiative, an exhaustive review of all of their regulations—with an emphasis on eliminating or modifying those that are obsolete or otherwise in need of reform. This final rule is part of the Regulatory Reform Initiative.

The Department of Commerce regulations dealing with service of process (15 CFR Part 15) and with employee testimony and the production of documents (15 CFR Part 15a) apply to the PTO. Therefore, the PTO is removing 37 CFR Parts 15 and 15a because they are unnecessary and duplicative.

This rule is not a significant rule for the purposes of Executive Order 12866. Notice and comment is not required for this rulemaking because it relates to agency management or personnel, 5 U.S.C. 553(a)(2), and thus no regulatory flexibility analysis is required, 5 U.S.C. 603(a). This rule does not change the paperwork burden imposed on the public. See 44 U.S.C. 3501 *et seq.*

List of Subjects

37 CFR Part 15

Administrative practice and procedure, Attorneys, Courts, Government employees.

37 CFR Part 15a

Administrative practice and procedure, Attorneys, Courts, Government employees.

For the reasons set forth in the preamble, and pursuant to the authority

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