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[3510-16-P]

## DEPARTMENT OF COMMERCE

### United States Patent and Trademark Office

### 37 CFR Parts 1 and 3

[Docket No.: PTO-P-2013-0007]

**RIN 0651-AC85**

### **Changes to Implement the Patent Law Treaty**

**AGENCY:** United States Patent and Trademark Office, Commerce.

**ACTION:** Notice of proposed rulemaking.

**SUMMARY:** The Patent Law Treaties Implementation Act of 2012 (PLTIA) amends the patent laws to implement the provisions of the Hague Agreement Concerning International Registration of Industrial Designs (Hague Agreement) in title I, and the Patent Law Treaty (PLT) in title II. The PLT harmonizes and streamlines formal procedures pertaining to the filing and processing of patent applications. This notice proposes changes to the rules of practice for consistency with the changes in the PLT and title II of the PLTIA. The United States Patent and Trademark Office (Office) is

implementing the Hague Agreement and title I of the PLTIA in a separate rulemaking. The notable changes in the PLT and title II of the PLTIA pertain to: (1) the filing date requirements for a patent application; (2) the restoration of patent rights via the revival of abandoned applications and acceptance of delayed maintenance fee payments; and (3) the restoration of the right of priority to a foreign application or the benefit of a provisional application via the permitting of a claim to priority to a foreign application or the benefit of a provisional application in a subsequent application filed within two months of the expiration of the twelve-month period (six-month period for design applications) for filing such a subsequent application.

**COMMENT DEADLINE DATE:** Written comments must be received on or before [Insert date 60 days after publication in the FEDERAL REGISTER].

**ADDRESSES:** Comments should be sent by electronic mail message over the Internet addressed to: AC85.comments@uspto.gov. Comments may also be submitted by postal mail addressed to: Mail Stop Comments-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, marked to the attention of Robert W. Bahr, Senior Patent Counsel, Office of Patent Examination Policy.

Comments may also be sent by electronic mail message over the Internet via the Federal eRulemaking Portal. See the Federal eRulemaking Portal Web site (<http://www.regulations.gov>) for additional instructions on providing comments via the Federal eRulemaking Portal.

Although comments may be submitted by postal mail, the Office prefers to receive comments by electronic mail message over the Internet because sharing comments with the public is more easily accomplished. Electronic comments are preferred to be submitted in plain text, but also may be submitted in ADOBE® portable document format or MICROSOFT WORD® format. Comments not submitted electronically should be submitted on paper in a format that facilitates convenient digital scanning into ADOBE® portable document format.

The comments will be available for public inspection at the Office of the Commissioner for Patents, currently located in Madison East, Tenth Floor, 600 Dulany Street, Alexandria, Virginia. Comments also will be available for viewing via the Office's Internet Web site (<http://www.uspto.gov>). Because comments will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included in the comments.

**FOR FURTHER INFORMATION CONTACT:** Robert W. Bahr, Senior Patent Counsel, Office of Patent Examination Policy, at (571) 272-8090.

**SUPPLEMENTARY INFORMATION:**

**Executive Summary:** Purpose: The PLT harmonizes and streamlines formal procedures pertaining to the filing and processing of patent applications. Title II of the PLTIA

amends the patent laws to implement the provisions of the PLT. This notice proposes changes to the rules of practice for consistency with the changes in the PLT and title II of the PLTIA.

Summary of Major Provisions: The major changes in the PLT and title II of the PLTIA pertain to: (1) the filing date requirements for a patent application; (2) the restoration of patent rights via the revival of abandoned applications and acceptance of delayed maintenance fee payments; and (3) the restoration of the right of priority to a foreign application or the benefit of a provisional application via the permitting of a claim to priority to a foreign application or the benefit of a provisional application in a subsequent application filed within two months of the expiration of the twelve-month period (six-month period for design applications) for filing such a subsequent application.

The Office is specifically proposing to revise the rules of practice pertaining to the filing date requirements for a patent application to provide that a claim is not required for a nonprovisional application (other than for a design patent) to be entitled to a filing date (a claim is currently not required for a provisional application to be entitled to a filing date). The Office is also providing for the filing of a nonprovisional application “by reference” to a previously filed application in lieu of filing the specification and drawings. An application filed either without at least one claim or “by reference” to a previously filed application in lieu of the specification and drawings will be treated in a manner analogous to the current provisions for treating an application that is missing application components not required for a filing date under 35 U.S.C. 111(a) (37 CFR 1.53(f)), in

that the applicant will be given a period of time within which to supply a claim and/or claims or a copy of the specification and drawings of the previously filed application.

The Office is also proposing to revise the rules of practice pertaining to the revival of abandoned applications (37 CFR 1.137) and acceptance of delayed maintenance fee payments (37 CFR 1.378) to provide for the revival of abandoned applications and acceptance of delayed maintenance fee payments solely on the basis of “unintentional” delay. The PLTIA eliminates the provisions of the patent statutes relating to revival of abandoned applications or acceptance of delayed maintenance fee payments on the basis of a showing of “unavoidable” delay.

The Office is also proposing to revise the rules of practice pertaining to priority and benefit claims to provide for the restoration of the right of priority to a prior-filed foreign application and restoration of the right to benefit of a prior-filed provisional application. The Office is providing with respect to the right of priority to a prior-filed foreign application that if the subsequent application is filed after the expiration of the twelve-month period (six-month period in the case of a design application) set forth in 35 U.S.C. 119(a), but within two months from the expiration of the twelve-month period (six-month period in the case of a design application), the right of priority in the subsequent application may be restored upon petition and payment of the applicable fee if the delay in filing the subsequent application within the twelve- or six-month period was unintentional. The Office is providing with respect to benefit of a prior-filed provisional application that if the subsequent application is filed after the expiration of the twelve-

month period set forth in 35 U.S.C. 119(e), but within two months from the expiration of the twelve-month period, the benefit of the provisional application may be restored upon petition and payment of the applicable fee if the delay in filing the subsequent application within the twelve-month period was unintentional.

The Office is also proposing to revise the patent term adjustment rules to provide for a reduction of any patent term adjustment if an application is not in condition for examination within eight months of its filing date (or date of commencement of national stage in an international application). The PLT and PLTIA provide applicants with additional opportunities to delay the examination process (e.g., the ability to file an application without any claims and to file an application merely by reference to a previously filed application). This proposed change to the patent term adjustment rules is to avoid the situation in which an applicant obtains patent term adjustment as a consequence of the applicant's taking advantage of the additional opportunities to delay the examination process provided by the PLT and PLTIA.

**Costs and Benefits:** This rulemaking is not economically significant under Executive Order 12866 (Sept. 30, 1993).

**Background:** The PLT was concluded on June 1, 2000, and entered into force on April 28, 2005. The PLT harmonizes and streamlines formal procedures pertaining to the filing and processing of patent applications. With the exception of the filing date requirements specified in PLT Article 5, the PLT specifies maximum form and content

requirements that an Office that is a party to the PLT (a Contracting Party) may apply, in that a Contracting Party is free to provide for requirements that are more permissive from the viewpoint of applicants and patent owners. The PLT does not apply to design, plant, provisional, or reissue applications. See PLT Art. 3 (the PLT applies to the types of applications that are permitted to be filed as international applications under the Patent Cooperation Treaty). The PLT Articles and Regulations under the PLT are available on the World Intellectual Property Organization (WIPO) Internet Web site ([www.wipo.int](http://www.wipo.int)).

The United States Senate ratified the PLT on December 7, 2007. The PLT did not enter into force in the United States upon ratification in 2007 as the PLT is not a self-executing treaty. See Patent Law Treaty and Regulations under Patent Law Treaty, Executive Report 110-6 at 3-4 (2007). Legislation (title II of the PLTIA) to amend the provisions of title 35, United States Code, to implement the PLT was enacted on December 18, 2012. See Pub. L. No. 112-211, sections 201 through 203, 126 Stat. 1527, 1533-37 (2012). The changes in title II (sections 201 through 203) of the PLTIA are divided into three groups: (1) the changes pertaining to a patent application filing date; (2) the changes pertaining to the revival of abandoned applications and acceptance of delayed maintenance fee payments; and (3) the changes pertaining to the restoration of the right of priority application to a foreign application or the benefit of a provisional application. See id. The major provisions of the PLT and title II of the PLTIA are as follows:

PLT Article 5 sets forth the requirements for obtaining a filing date. PLT Article 5(1) provides that a filing date will be accorded to an application upon compliance with three

formal requirements: (1) an indication that the elements received by the Office are intended to be an application for a patent for an invention; (2) indications that would allow the Office to identify and to contact the applicant; and (3) a part which appears to be a description of the invention. No additional elements (such as a claim or a drawing) can be required for a filing date to be accorded to an application. Pre-PLTIA 35 U.S.C. 111(a) provides that the filing date of an application shall be the date on which “the specification and any required drawing” are received in the Office, and thus requires that an application contain a drawing where necessary for an understanding of the invention (35 U.S.C. 113(first sentence)) and at least one claim to be entitled to a filing date. See Baxter Int'l, Inc. v. McGaw, Inc., 149 F.3d 1321, 1333 (Fed. Cir. 1998) (both statute and regulation make clear the requirement that an application for a patent must include, inter alia, a specification containing claims and a drawing, and the omission of any of these component parts makes a patent application incomplete and thus not entitled to a filing date). Section 201(a) of the PLTIA amends 35 U.S.C. 111(a) to provide that the filing date of an application (other than for a design patent) is the date on which a specification, “with or without claims,” is received in the Office. See 126 Stat. at 1533.

PLT Article 5(1)(b) permits a Contracting Party to accept a drawing as a description of the invention in appropriate circumstances. This is considered to be consistent with current jurisprudence in the United States and thus no change in that regard is necessary. See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1565 (Fed. Cir. 1991) (“under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by [35 U.S.C.] 112”).

PLT Article 5 and PLTIA 35 U.S.C. 111(a) specify the formal requirements necessary for an application to be entitled to a filing date, and compliance with these requirements ensures only that the disclosure present upon filing in the application will be entitled to a filing date. An application whose disclosure satisfies only the requirements of 35 U.S.C. 111(a) to be entitled to a filing date may nonetheless not meet the requirements of 35 U.S.C. 112 and 113 necessary for the applicant to be entitled to a patent for any claimed invention presented in the application, or even for the application to effectively serve as a priority or benefit application for an application subsequently filed in the United States or abroad. Therefore, the ability to file an application without a claim or drawing should be viewed as a safeguard against the loss of a filing date due to a technicality and not as a best practice.

PLT Article 5(2) permits the description of the invention to be filed in any language.

As discussed previously, the filing date requirements in PLT Article 5 are not simply the maximum requirements but constitute the absolute requirements for an application to be accorded a filing date. See PLT Art. 2(1).

Finally, as discussed previously, the PLT does not apply to design applications. Section 202(a) of the PLTIA amends 35 U.S.C. 171 to provide that the filing date of an application for design patent shall be the date on which the specification as prescribed by 35 U.S.C. 112 and any required drawings are filed. See 126 Stat. at 1535. Therefore, a

design application must contain a claim and any required drawings to be entitled to a filing date.

35 U.S.C. 111(a) currently provides that the fee and oath or declaration may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director, and that upon failure to submit the fee and oath or declaration within such prescribed period, the application shall be regarded as abandoned. See 35 U.S.C. 111(a)(3) and (a)(4). Section 201(a) of the PLTIA amends 35 U.S.C. 111(a)(3) and (a)(4) to provide that the fee, oath or declaration, and claim or claims may be submitted after the filing date of the application, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Office, and that upon failure to submit the fee, oath or declaration, and claim or claims within the period prescribed by the Office, the application shall be regarded as abandoned. See 126 Stat. at 1533.

Section 201(a) of the PLTIA further amends 35 U.S.C. 111 to: (1) more closely align the corresponding provisions for nonprovisional applications in 35 U.S.C. 111(a) and provisional applications in 35 U.S.C. 111(b); (2) more clearly distinguish the filing date requirements in those sections from the more substantive requirements of 35 U.S.C. 112 and 113; and (3) delete the reference to the “unavoidable or unintentional” standard in favor of an “unintentional” standard in new 35 U.S.C. 27. See id.

PLT Article 5(6) pertains to applications containing a missing part of the description or a missing drawing. PLT Article 5(6)(a) provides that if the missing part of the description or a missing drawing is timely filed, the filing date of the application shall be the date on which the Office has received that part of the description or that drawing. PLT Article 5(6)(c) provides that if the missing part of the description or the missing drawing is timely withdrawn by the applicant, the filing date of the application shall be the date on which the applicant complied with requirements provided for in PLT Article 5(1) and (2). PLT Article 5(6)(b) provides that where a prior-filed application contains the missing part of the description and/or missing drawing, the application as filed claims the priority to the prior-filed application, and the applicant timely files a copy of the prior-filed application (and translation if necessary), the filing date of the application (including the missing part of the description and/or missing drawing) shall be the date on which the applicant complied with requirements provided for in PLT Article 5(1) and (2). The Office's procedures concerning the handling of applications containing a missing part of the description or a missing drawing are set forth in MPEP 601.01(d) (applications filed without all pages of the specification) and 601.01(g) (applications filed without all figures of drawings).

PLT Article 5(7) provides that a reference to a previously filed application, made upon the filing of the application, shall replace the description and any drawings of the application for purposes of the filing date of the application. PLT Rule 2(5) requires that this reference to the previously filed application indicate that, for the purposes of the filing date, the description and any drawings of the application are replaced by the

reference to the previously filed application, and also indicate the application number and Office with which the previously filed application was filed. PLT Rule 2(5) further provides that a Contracting Party may require that: (1) a copy of the previously filed application and a translation of the previously filed application (if not in a language accepted by the Office) be filed with the Office within a time limit of not less than two months from the date on which the application containing the reference was received by the Office; and (2) a certified copy of the previously filed application be filed with the Office within a time limit of not less than four months from the date on which the application containing the reference was received by the Office.

Section 201(a) of the PLTIA amends 35 U.S.C. 111 to provide for this reference filing in a new 35 U.S.C. 111(c). New 35 U.S.C. 111(c) provides that a reference made upon the filing of an application to a previously filed application shall, as prescribed by the Office, constitute the specification and any drawings of the subsequent application for purposes of a filing date. See 126 Stat. at 1533-34. New 35 U.S.C. 111(c) specifically provides that the Director may prescribe the conditions, including the payment of a surcharge, under which a reference made upon the filing of an application under 35 U.S.C. 111(a) to a previously filed application, specifying the previously filed application by application number and the intellectual property authority or country in which the application was filed, shall constitute the specification and any drawings of the subsequent application for purposes of a filing date. See 126 Stat. at 1533. New 35 U.S.C. 111(c) further provides that a copy of the specification and any drawings of the previously filed application shall be submitted within such period and under such conditions as may be prescribed by the

Director, and that a failure to submit the copy of the specification and any drawings of the previously filed application within the prescribed period shall result in the application being regarded as abandoned. See 126 Stat. at 1533-34. New 35 U.S.C. 111(c) finally provides that such an abandoned application shall be treated as having never been filed, unless: (1) the application is revived under 35 U.S.C. 27; and (2) a copy of the specification and any drawings of the previously filed application are submitted to the Director. See 126 Stat. at 1534.

PLT Article 6 standardizes application format requirements by providing that a Contracting Party may not impose form or content requirements different from or in addition to the form and content requirements provided for in the Patent Cooperation Treaty (PCT), or permitted by the PCT for international applications during national processing or examination, or as prescribed in the PLT Regulations. The United States has taken a reservation with respect to PLT Article 6, in that PLT Article 6(1) shall not apply to any requirement relating to unity of invention applicable under the PCT to an international application. See Patent Law Treaty and Regulations under Patent Law Treaty, Executive Report 110-6 at 6 (2007). The Office appreciates that patent stakeholders prefer that the Office move from the “independent and distinct” restriction standard of 35 U.S.C. 121 to the “unity of invention” standard of PCT Rule 13. The Office is in the process of studying the changes to the patent statute, regulations, examination practices, and filings fees that would be necessary to move from the “independent and distinct” restriction standard of 35 U.S.C. 121 to the “unity of invention” standard of PCT Rule 13 in a practical manner.

The PLT further provides for the establishment of standardized Model International Forms, which will have to be accepted by all Contracting Parties. The following Model International Forms have been established under the PLT: (1) Model International Request Form; (2) Model International Power of Attorney Form; (3) Model International Request for Recordation of Change in Name or Address Form; (4) Model International Request for Correction of Mistakes Form; (5) Model International Request for Recordation of Change in Applicant or Owner Form; (6) Model International Certificate of Transfer Form; (7) Model International Request for Recordation of a License/Cancellation of the Recordation of a License Form; and (8) Model International Request for Recordation of a Security Interest/Cancellation of the Recordation of a Security Interest Form.

PLT Articles 6, 7, and 8 provide for simplified procedures, such as exceptions from mandatory representation for certain actions, restrictions on requiring evidence on a systematic basis, permitting a single communication for more than one application or patent from the same person in certain situations (e.g., powers of attorney), and restrictions on the requirement to submit a copy and any necessary translation of an earlier application.

PLT Rule 7(2)(b) specifically provides that a single power of attorney is sufficient even where it relates to more than one application or patent of the same person, and also that a power of attorney will be sufficient where it relates to future applications of such person.

PLT Rule 7(2)(b) permits the Office to require a separate copy of the power of attorney be filed in each application and patent to which it relates. The Office permits a single power of attorney for multiple applications or patents of the same person, but requires a separate copy of the power of attorney be filed in each application or patent to which it relates. See 37 CFR 1.4(b). A person may give a power of attorney that is not specific to an application or patent, similar to the General Power of Attorney used in PCT practice (general power of attorney), and a practitioner having authority from such person may submit a copy of the general power of attorney in any application or patent of that person.

PLT Articles 11, 12, and 13 provide procedures to avoid the loss of substantive rights as a result of an unintentional failure to comply with formality requirements or time periods.

PLT Article 11 requires a Contracting Party to provide for either extensions of time (or an alternative to reinstate the applicant or owner's rights) for time limits fixed by the Contracting Party. The PLT distinguishes between time limits fixed by applicable law and time limits fixed by the Contracting Party. A time limit is fixed by applicable law when the time limit is provided for in a statute (e.g., the three-month period in 35 U.S.C. 151) or regulation (e.g., the three-month period in 37 CFR 1.85(c)). A time limit is fixed by the Contracting Party when the applicable statute or regulation provides for a time period to be set, but does not specify the time limit itself (e.g., 35 U.S.C. 133, 37 CFR 1.53(f)(1), or 37 CFR 1.134). While many time limits fixed by regulation are extendable (e.g., 37 CFR 1.53(f)(1), and 1.137(e)), PLT Article 11 applies only to time limits that are not fixed by statute or regulation.

PLT Article 12 provides for reinstatement of rights on the basis of unintentional delay (or alternatively if the failure occurred in spite of due care). Section 201(b) of the PLTIA adds a new section 27 to title 35. New 35 U.S.C. 27 provides that the Director may establish procedures, including the payment of a surcharge, to revive an unintentionally abandoned application for patent, accept an unintentionally delayed payment of the fee for issuing each patent, or accept an unintentionally delayed response by the patent owner in a reexamination proceeding, upon petition by the applicant for patent or patent owner.

See 126 Stat. at 1534. As discussed previously, the PLTIA eliminates the provisions of the patent statutes relating to revival or acceptance of delayed maintenance fee payments on the basis of a showing of “unavoidable” delay. Thus, the PLTIA provides a single standard (unintentional delay) for reviving abandoned applications, accepting delayed issue fee and maintenance fee payments, and accepting delayed responses by the patent owner in a reexamination proceeding.

Section 202(b)(1)(A) of the PLTIA amends 35 U.S.C. 41(a)(7) to provide that the Office shall charge \$1,700.00 on filing each petition for the revival of an abandoned application for a patent, for the delayed payment of the fee for issuing each patent, for the delayed response by the patent owner in any reexamination proceeding, for the delayed payment of the fee for maintaining a patent in force, for the delayed submission of a priority or benefit claim, or for the extension of the twelve-month period for filing a subsequent application. See 126 Stat. at 1535. Section 202(b)(1)(A) of the PLTIA also amends

35 U.S.C. 41(a)(7) to provide that the Director may refund any part of this fee in exceptional circumstances as determined by the Director. See id.

Section 202(b)(1)(B) of the PLTIA also amends 35 U.S.C. 41(c)(1) to conform procedures for the late payment of maintenance fees to those provided in new 35 U.S.C. 27. Section 202(b)(1)(B) of the PLTIA specifically amends 35 U.S.C. 41(c)(1) to delete the twenty-four month time limit for unintentionally delayed maintenance fee payments and the reference to an unavoidable standard. PLTIA 35 U.S.C. 41(c)(1) provides that: (1) the Director may accept the payment of any maintenance fee required by 35 U.S.C. 41(b) after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unintentional; (2) the Director may require the payment of the fee specified in 35 U.S.C. 41(a)(7) as a condition of accepting payment of any maintenance fee after the six-month grace period; and (3) if the Director accepts payment of a maintenance fee after the six-month grace period, the patent shall be considered as not having expired at the end of the grace period (subject to the current intervening rights provision of 35 U.S.C. 41(c)(2)). See 126 Stat. at 1535-36.

Section 202(b) of the PLTIA also amends 35 U.S.C. 122(b)(2)(B)(iii), 133, 151, 364(b), and 371(d) to delete the reference to an unavoidable standard in light of new 35 U.S.C. 27. See 126 Stat. at 1536.

Section 202(b)(6) of the PLTIA also amends 35 U.S.C. 151 to delete the third and fourth paragraphs pertaining to the lapsed patent practice. See id.

PLT Article 13 provides for the restoration of the right of priority where there is a failure to timely claim priority to the prior application, and also where there is a failure to file the subsequent application within twelve months of the filing date of the priority application. Section 201(c) of the PLTIA amends 35 U.S.C. 119 to provide that the twelve-month periods set forth in 35 U.S.C. 119(a) and (e) may be extended by an additional two months if the delay in filing an application claiming priority to a foreign application or the benefit of a provisional application within the twelve-month period was unintentional. Section 201(c) of the PLTIA also amends 35 U.S.C. 119(a) and 365(b) to provide for unintentionally delayed claims for priority under the PCT and the Regulations under the PCT, and priority claims to an application not filed within the priority period specified in the PCT and the Regulations under the PCT but filed within the additional two-month period.

Section 201(c) of the PLTIA specifically amends 35 U.S.C. 119(a) by adding that the Director may prescribe regulations, including the requirement for payment of the fee specified in 35 U.S.C. 41(a)(7), pursuant to which the twelve-month period set forth in 35 U.S.C. 119(a) may be extended by an additional two months if the delay in filing the application in the United States within the twelve-month period was unintentional. See 126 Stat. at 1534.

Section 201(c) of the PLTIA specifically amends 35 U.S.C. 119(e)(1) by adding that the Director may prescribe regulations, including the requirement for payment of the fee

specified in 35 U.S.C. 41(a)(7), pursuant to which the twelve-month period set forth in 35 U.S.C. 119(e) may be extended by an additional two months if the delay in filing the application under 35 U.S.C. 111(a) or 363 within the twelve-month period was unintentional. See id.

Section 201(c) of the PLTIA amends 35 U.S.C. 119(e)(3) by adding that for an application for patent filed under 35 U.S.C. 363 in a Receiving Office other than the United States Patent and Trademark Office, the twelve-month and additional two-month period set forth in 35 U.S.C. 119(e) shall be extended as provided under the PCT and PCT Regulations. See 126 Stat. at 1534-35.

Section 201(c) of the PLTIA amends 35 U.S.C. 365(b) by adding that the Director may establish procedures, including the requirement for payment of the fee specified in 35 U.S.C. 41(a)(7), to accept an unintentionally delayed claim for priority under the PCT and PCT Regulations, and to accept a priority claim that pertains to an application that was not filed within the priority period specified in the PCT and PCT Regulations, but was filed within the additional two-month period specified under 35 U.S.C. 119(a) or the PCT or PCT Regulations. See 126 Stat. at 1535.

Sections 201(c) and 202(b)(2) and (b)(3) of the PLTIA amend 35 U.S.C. 119(b), 119(e), and 120 to change the phrase “including the payment of a surcharge” in the provision pertaining to the submission of delayed priority or benefit claims to “including the

requirement for payment of the fee specified in [35 U.S.C.] 41(a)(7).” See 126 Stat. at 1534 and 1536.

PLT Article 14 and PLT Rules 15, 16, and 17 pertain to requests for a change in the applicant’s or owner’s name or address, requests for a change in the applicant or owner (e.g., due to an assignment), requests for recordation of a license or a security interest, and requests for correction of a mistake.

35 U.S.C. 261 currently provides that: “Subject to the provisions of this title, patents shall have the attributes of personal property.” Section 201(d) of the PLTIA amends 35 U.S.C. 261, first paragraph, by adding: “The [United States] Patent and Trademark Office shall maintain a register of interests in applications for patents and patents and shall record any document related thereto upon request, and may require a fee therefor.” See 126 Stat. at 1535. Section 201(d) of the PLTIA also amends 35 U.S.C. 261, fourth paragraph, to read as follows: “An interest that constitutes an assignment, grant or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the [United States] Patent and Trademark Office within three months from its date or prior to the date of such subsequent purchase or mortgage.” See id.

PLT Rule 15(3)(b) provides that a single request for recordation of a change in the name and/or address of the applicant or owner is sufficient even where it relates to more than one application or patent of the same person, but also permits the Office to require a

separate copy of the request for each application and patent to which it relates. PLT Rules 16(5) and 17(5) provide that a single request for recordation of a change in the applicant or owner and a single request for recordation of a license or security interest is sufficient even where it relates to more than one application or patent of the same person, but also permits the Office to require a separate copy of the request for each application and patent to which it relates. The Office will permit a single request for recordation of a change in the name and/or address of the applicant or owner, single request for recordation of a change in the applicant or owner, and a single request for recordation of a license or security interest power of attorney for multiple applications or patents of the same person, but will require that a separate copy of such a request for each application and patent to which it relates. See 37 CFR 1.4(b).

PLT Rule 18(3) provides that a single request for correction of a mistake is sufficient even where it relates to more than one application or patent of the same person, provided that the mistake and correction are common to all applications or patents concerned, but also permits the Office to require a separate copy of the request for each application and patent to which it relates. The Office will permit a single request for correction of a mistake to more than one application or patent of the same person, provided that the mistake and correction are common to all applications or patents concerned, but will require a separate copy of such a request for each application and patent to which it relates. See 37 CFR 1.4(b).

Section 203(a) provides that the amendments made by title II of the PLTIA take effect on December 18, 2013 (the date that is one year after the date of the enactment of the PLTIA) and apply to: (1) any patent issued before, on, or after December 18, 2013; and (2) any application for patent that is pending on or filed after December 18, 2013. See 126 Stat. at 1536. Section 203(b) provides that the amendments to 35 U.S.C. 111 made by title II of the PLTIA apply only to applications that are filed on or after December 18, 2013. Section 203(b) also provides that the amendments made by title II of the PLTIA shall have no effect with respect to any patent that is the subject of litigation in an action commenced before December 18, 2013. See 126 Stat. at 1537.

### **Discussion of Specific Rules**

The following is a discussion of proposed amendments to Title 37 of the Code of Federal Regulations, Part 1.

Section 1.4: Section 1.4(c) is proposed to be amended to provide that subjects provided for on a single Office or WIPO form may be contained in a single paper. This provision is to clarify that subjects that are provided for on a single Office or WIPO form are not considered separate subjects for purposes of § 1.4(c) (which thus must be contained in separate papers).

Section 1.4(d) is proposed to be amended to implement the signature provisions of PLT Rule 9(4) concerning electronic communications. PLT Rule 9(4) provides that where an

Office permits the filing of communications in electronic form or by electronic means of transmittal, it shall consider such a communication signed if a graphic representation of a signature accepted by that Office appears on that communication as received by the Office. Section 1.4(d) is specifically proposed to be amended to provide that correspondence permitted via the Office electronic filing system may be signed by a graphic representation of a handwritten signature as provided for in § 1.4(d)(1) or a graphic representation of an S-signature as provided for in § 1.4(d)(2) when it is submitted via the Office electronic filing system.

Section 1.16: Section 1.16(f) is proposed to be amended to provide that it is also applicable to an application that does not contain at least one claim on the filing date of the application and to an application filed by reference to a previously filed application under § 1.57(a). See discussion of §§ 1.53 and 1.57.

Section 1.17: Section 1.17(f) is proposed to be amended for consistency with the proposed change to § 1.57. See discussion of § 1.57.

Section 1.17(m) is proposed to be amended to implement the change to 35 U.S.C. 41(a)(7), 41(c)(1), 119, 120 and 365 in section 202(b) of the PLTIA. Section 202(b)(1)(A) of the PLTIA amends 35 U.S.C. 41(a)(7) to provide that the Office shall charge \$1,700.00 (\$850.00 small entity) on filing each petition for the revival of an abandoned application for a patent, for the delayed payment of the fee for issuing each patent, for the delayed response by the patent owner in any reexamination proceeding, for

the delayed payment of the fee for maintaining a patent in force, for the delayed submission of a priority or benefit claim, or for the extension of the twelve-month period for filing a subsequent application. Sections 202(b)(1)(B), 202(b)(2) and 202(b)(3) of the PLTIA amend 35 U.S.C. 41(c)(1), 119, and 120 to replace “payment of a surcharge” with “payment of the fee specified in section 41(a)(7).” Section 1.17(m) does not include a micro entity fee amount as this fee is set under 35 U.S.C. 41(a)(7) as amended by 202(b)(1)(A) of the PLTIA and not section 10(a) of the Leahy-Smith America Invents Act (AIA). Section 10(b) of the AIA provides that the micro entity discount applies to fees set under section 10(a) of the AIA. See Pub. L. No. 112-29, 125 Stat. 284, 316-17 (2011). The fee specified in § 1.17(m) will have a micro entity amount when patent fees are again set under section 10(a) of the AIA.

Section 1.17(p) is proposed to be amended and § 1.17(o) is proposed to be added to provide for information disclosure statements under §§ 1.97(c) or (d) in § 1.17(p) and for third-party submissions under § 1.290 in § 1.17(o). Section 1.17(p) currently provides for both information disclosure statements under §§ 1.97(c) or (d) and third-party submissions under § 1.290, which may cause confusion as a third party is not eligible for the micro entity discount. Thus, § 1.17(p) as proposed provides for information disclosure statements under §§ 1.97(c) or (d) and includes both a small entity and micro entity discount, and § 1.17(o) as proposed provides for third-party submissions under § 1.290 and includes only a small entity discount.

Sections 1.17(l) and 1.17(t) are proposed to be removed in view of the change to 35 U.S.C. 41(a)(7), 119, and 120 in section 202(b) of the PLTIA.

Section 1.20: Section 1.20(i) is proposed to be removed in view of the change to 35 U.S.C. 41(a)(7) and 41(c)(1) in section 202(b)(1) of the PLTIA.

Section 1.23: Section 1.23(c) is proposed to be added to provide that a fee transmittal letter may be signed by a juristic applicant or patent owner. PLT Article 7(2) provides that an assignee of an application, an applicant, owner or other interested person may act pro se before the Office for the mere payment of a fee.

Section 1.29: Section 1.29(e) is proposed to be amended to provide that a micro entity certification in an international application filed in a Receiving Office other than the United States Receiving Office may be signed by a person authorized to represent the applicant under § 1.455.

Section 1.29(k)(4) is proposed to be amended to delete “but payment of a deficiency based upon the difference between the current fee amount for a small entity and the amount of the previous erroneous micro entity fee payment will not be treated as an assertion of small entity status under § 1.27(c)” and “[o]nce a deficiency payment is submitted under this paragraph, a written assertion of small entity status under § 1.27(c)(1) is required to obtain small entity status.” This proposed change is for

consistency with the provision of § 1.29(i) that a notification of loss of micro entity status is not automatically treated as a notification of loss of small entity status.

Section 1.51: Section 1.51(a) is proposed to be amended to provide that an application transmittal letter limited to the transmittal of the documents and fees comprising a patent application under this section may be signed by a juristic applicant or patent owner. PLT Article 7(2) provides that an assignee of an application, an applicant, owner or other interested person may act pro se before the Office for the filing of an application for the purposes of the filing date.

Section 1.53: Section 1.53 is proposed to be amended to implement the changes to 35 U.S.C. 111 in section 201 of the PLTIA and the change to 35 U.S.C. 172 in section 202(a) of the PLTIA.

Section 201(a) of the PLTIA amends 35 U.S.C. 111(a) to provide that the filing date of an application (other than for a design patent) is the date on which a specification, “with or without claims,” is received in the Office. Section 1.53(b) is thus proposed to be amended to provide that the filing date of an application for patent filed under § 1.53, except for an application for a design patent or a provisional application under § 1.53(c), is the date on which a specification, with or without claims is received in the Office.

Section 202(a) of the PLTIA amends 35 U.S.C. 171 to provide that the filing date of an application for design patent shall be the date on which the specification as prescribed by

35 U.S.C. 112 and any required drawings are filed. Therefore, a design application must contain a claim to be entitled to a filing date. Section 1.53(b) is thus proposed to be amended to provide that the filing date of an application for a design patent filed under this section, except for a continued prosecution application under § 1.53(d), is the date on which the specification as prescribed by 35 U.S.C. 112, including at least one claim, and any required drawings are received in the Office.

Section 201(a) of the PLTIA amends 35 U.S.C. 111(b) to more closely align the corresponding provisions for nonprovisional applications in 35 U.S.C. 111(a) and provisional applications in 35 U.S.C. 111(b). Section 1.53(c) is thus proposed to be amended to provide that the filing date of a provisional application is the date on which a specification, with or without claims, is received in the Office.

As discussed previously, PLT Article 5 and PLTIA 35 U.S.C. 111(a) provide minimal formal requirements necessary for an application to be entitled to a filing date to safeguard against the loss of a filing date due to a technicality. PLT Article 5 and PLTIA 35 U.S.C. 111 should not be viewed as prescribing a best practice for the preparation and filing of a patent application. The drafting of claims at the time an application (provisional or nonprovisional) is prepared to any claimed invention for which patent protection is desired and inclusion of such claims with the application will help ensure that the application will contain an adequate disclosure under 35 U.S.C. 112.

Section 201(a) of the PLTIA amends 35 U.S.C. 111(a) to provide that the claim or claims may be submitted after the filing date of the application, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Office, and that upon failure to submit one or more claims within the period prescribed by the Office, the application shall be regarded as abandoned. Section 1.53(f) is thus proposed to be amended to provide that an application filed without at least one claim would be treated in a manner analogous to how an application without the filing, search, or examination fee is treated under current § 1.53. Section 1.53(f) is specifically proposed to be amended to provide that if an application which has been accorded a filing date pursuant to § 1.53(b) does not include at least one claim: (1) the applicant will be notified and given a period of time within which to file a claim or claims and pay the surcharge if required by § 1.16(f) to avoid abandonment if the applicant has provided a correspondence address; and (2) the applicant has three months from the filing date of the application within which to file a claim or claims and pay the surcharge required by § 1.16(f) to avoid abandonment if the applicant has not provided a correspondence address.

In the rulemaking to implement the inventor's oath or declaration provisions of the AIA, the Office provided that applicants may postpone filing the inventor's oath or declaration until the application is otherwise in condition for allowance if the applicant provides an application data sheet before examination indicating the name, residence, and mailing address of each inventor. See Changes to Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act, 77 FR 48776, 48779-80 (Aug. 14,

2012) (final rule). AIA 35 U.S.C. 115(f) provided that a notice of allowance under 35 U.S.C. 151 may be provided to an applicant only if the applicant has filed each required oath or declaration under 35 U.S.C. 115(a), substitute statement under 35 U.S.C. 115(d), or recorded assignment meeting the requirements of 35 U.S.C. 115(e). The Office thus provided that if an application is in condition for allowance but does not include an oath or declaration in compliance with § 1.63, or a substitute statement in compliance with § 1.64, executed by or with respect to each actual inventor, the Office will issue a “Notice of Allowability” (PTOL-37) (but not a “Notice of Allowance and Fee(s) Due” (PTOL-85)) giving the applicant three months to file an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each actual inventor, to avoid abandonment, and that the “Notice of Allowance and Fee(s) Due” (PTOL-85) will not be issued until the application includes an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each actual inventor. See Changes to Implement the Inventor’s Oath or Declaration Provisions of the Leahy-Smith America Invents Act, 77 FR at 48787-88.

Section 1(f) of the Act to correct and improve certain provisions of the Leahy-Smith America Invents Act and title 35, United States Code (AIA Technical Corrections Act) amends 35 U.S.C. 115(f) to read as follows: “The applicant for patent shall provide each required oath or declaration under [35 U.S.C. 115](a), substitute statement under [35 U.S.C. 115](d), or recorded assignment meeting the requirements of [35 U.S.C. 115](e) no later than the date on which the issue fee for the patent is paid.” See Pub. L.

No. 112-274, section 1(f), 126 Stat. 2456-57 (2013). This change to 35 U.S.C. 115(f) permits the Office to issue a “Notice of Allowance and Fee(s) Due” (PTOL-85) before the application includes an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each actual inventor.

See Changes to Implement the Inventor’s Oath or Declaration Provisions of the Leahy-Smith America Invents Act, 77 FR at 48802 (noting that the only effect of AIA 35 U.S.C. 115(f) is to preclude the Office from issuing a notice of allowance until each required inventor’s oath or declaration has been filed). The Office is thus revising the provisions pertaining to the filing of an application without the inventor’s oath or declaration to provide that if an application is in condition for allowance but does not include an oath or declaration in compliance with § 1.63, or a substitute statement in compliance with § 1.64, executed by or with respect to each actual inventor, the Office will issue a “Notice of Allowability” (PTOL-37) requiring an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each actual inventor, together with the “Notice of Allowance and Fee(s) Due” (PTOL-85).

35 U.S.C. 115(f) does not specifically provide for the consequence that results if an applicant fails to provide an oath or declaration in compliance with § 1.63, or a substitute statement in compliance with § 1.64, executed by or with respect to each actual inventor. PLTIA 35 U.S.C. 111(a)(3), however, provides that the “fee, oath or declaration, and 1 or more claims may be submitted after the filing date of the application, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by

the Director,” and that “[u]pon failure to submit the fee, oath or declaration, and 1 or more claims within such prescribed period, the application shall be regarded as abandoned.” The Office is thus proposing to amend § 1.53(f)(3)(ii) to provide that if the applicant is notified in a notice of allowability that an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each named inventor has not been filed, the applicant must file each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, no later than the date on which the issue fee is paid to avoid abandonment (which time period is not extendable). The Office is also proposing to amend § 1.53(f)(3)(ii) to provide that: (1) the applicant must file each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, no later than the date on which the issue fee for the patent is paid (as required by 35 U.S.C. 115(f)); and (2) that the Office may dispense with the notice provided for in § 1.53(f)(1) if each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, has been filed before the application is in condition for allowance.

Section 1.54: Section 1.54(b) is amended to provide that a letter limited to a request for a filing receipt (which includes a corrected filing receipt) may be signed by a juristic applicant or patent owner. PLT Article 7(2) provides that an assignee of an application, an applicant, owner or other interested person may act pro se before the Office for the issue of a receipt or notification by the Office in respect of any procedure referred to in PLT Article 7(2)(a)(i) through 7(2)(a)(iii).

Section 1.55: Section 1.55(b) is proposed to be amended to implement the provisions in section 201(c) of the PLTIA and PLT Article 13 for the restoration of the right of priority. Section 201(c) of the PLTIA amends 35 U.S.C. 119(a) by adding that the Director may prescribe regulations, including the requirement for payment of the fee specified in 35 U.S.C. 41(a)(7), pursuant to which the twelve-month period set forth in 35 U.S.C. 119(a) may be extended by an additional two months if the delay in filing the application in the United States within the twelve-month period was unintentional. Section 1.55(b) is thus proposed to be amended to provide that if the subsequent application has a filing date which is after the expiration of the twelve-month period (six-month period in the case of a design application) set forth in § 1.55(b)(1) but within two months from the expiration of the period set forth in § 1.55(b)(1), the right of priority in the subsequent application may be restored upon petition if the delay in filing the subsequent application within the period set forth in § 1.55(b)(1) was unintentional. Section 1.55(b) is further proposed to be amended to provide that a petition to restore the right of priority under § 1.55(b) filed in the subsequent application must include: (1) the priority claim under 35 U.S.C. 119(a) through (d) or (f) or 365(a) in an application data sheet (§ 1.76(b)(6)), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, unless previously submitted; (2) the petition fee as set forth in § 1.17(m); and (3) a statement that the delay in filing the subsequent application within the twelve-month period (six-month period in the case of a design application) set forth in § 1.55(b)(1) was unintentional. Section 1.55(b) is further proposed to provide that the

Director may require additional information where there is a question whether the delay was unintentional.

Section 1.55(b) as proposed also provides that the right of priority in the subsequent application may be restored under PCT Rule 26bis.3. A decision by a Receiving Office to restore a right of priority under PCT Rule 26bis.3 in an international application designating the United States is effective as to the United States in the national stage of such application in accordance with PCT Rule 49ter.1.

Section 1.55(c) is proposed to provide for the situation in which a certified copy of the foreign application is not filed during the international stage of an international application. Section 1.55(c) is specifically proposed to provide that in such a situation: (1) a certified copy of the foreign application must be filed within four months from the date of entry into the national stage as set forth in § 1.491 or sixteen months from the filing date of the prior-filed foreign application (except as provided in §§ 1.55(h) and (i)); and (2) the certified copy of the foreign application must be accompanied by a petition including a showing of good and sufficient cause for the delay and the petition fee set forth in § 1.17(g), if a certified copy of the foreign application is not filed within the later of four months from the date of entry into the national stage as set forth in § 1.491 or sixteen months from the filing date of the prior-filed foreign application, and the exceptions in §§ 1.55(h) and (i) are not applicable.

Section 1.55(e) is proposed to be amended to provide for delayed priority claims under 35 U.S.C. 365(b) in a national stage application under 35 U.S.C. 371. Section 1.55(e) is also proposed to be amended for consistency with the change to 35 U.S.C. 119(b) in section 202(b)(2) of the PLTIA (replaces “payment of a surcharge” with “payment of the fee specified in section 41(a)(7)”). See discussion of § 1.17(m).

Section 1.55(i) is proposed to be amended to also refer to § 1.55(c) for consistency with the proposed change to § 1.55(c).

Section 1.57: Sections 1.57(a) through (g) are proposed to be redesignated as §§ 1.57(b) through (h), respectively. Section 1.57(a) is proposed to be added to implement the reference filing provisions of section 201(a) of the PLTIA (new 35 U.S.C. 111(c)) and PLT Article 5(7). Section 1.57 already implements the provisions of PLT Article 5(6) pertaining to applications containing a missing part of the description or a missing drawing. See Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan, 69 FR 56482, 56499 (Sept. 21, 2004).

35 U.S.C. 111(c) provides that a reference made upon the filing of an application to a previously filed application shall, as prescribed by the Office, constitute the specification and any drawings of the subsequent application for purposes of a filing date.

35 U.S.C. 111(c) specifically provides that the Director may prescribe the conditions, including the payment of a surcharge, under which a reference made upon the filing of an application under 35 U.S.C. 111(a) to a previously filed application, specifying the

previously filed application by application number and the intellectual property authority or country in which the application was filed, shall constitute the specification and any drawings of the subsequent application for purposes of a filing date. PLT Rule 2(5) requires that this reference to the previously filed application indicate that, for the purposes of the filing date, the description and any drawings of the application are replaced by the reference to the previously filed application, and also provides that a Contracting Party may require that the reference also indicate the filing date of the previously filed application. Proposed § 1.57(a) thus provides that, subject to the conditions and requirements of § 1.57(a), a reference made in the English language in an application data sheet in accordance with § 1.76 upon the filing of an application under 35 U.S.C. 111(a) to a previously filed application, indicating that the specification and any drawings of the application are replaced by the reference to the previously filed application, and specifying the previously filed application by application number, filing date, and the intellectual property authority or country in which the application was filed, shall constitute the specification and any drawings of the subsequent application for purposes of a filing date under § 1.53(b). The requirement for a reference to the previously filed application in an application data sheet will be satisfied by the presentation of such priority or benefit claim on the Patent Law Treaty Model International Request Form filed in the Office (see discussion of § 1.76).

For an application filed by reference to a previously filed application under proposed § 1.57(a), the specification and any drawings of the previously filed application will constitute the specification and any drawings of the application filed by reference under

proposed § 1.57(a). Thus, the specification and any drawings of the previously filed application will be considered in determining whether an application filed by reference under proposed § 1.57(a) is entitled to a filing date under § 1.53(b).

35 U.S.C. 111(c) further provides that a copy of the specification and any drawings of the previously filed application shall be submitted within such period and under such conditions as may be prescribed by the Director, and that a failure to submit the copy of the specification and any drawings of the previously filed application within the prescribed period shall result in the application's being regarded as abandoned. Proposed § 1.57(a) thus provides that: (1) the applicant will be notified and given a period of time within which to file a copy of the specification and drawings from the previously filed application, an English language translation of the previously filed application and the fee required by § 1.17(i) if the previously filed application is in a language other than English, and pay the surcharge required by § 1.16(f) to avoid abandonment if the applicant has provided a correspondence address (proposed § 1.57(a)(1)); and (2) the applicant has three months from the filing date of the application to file a copy of the specification and drawings from the previously filed application, an English language translation of the previously filed application and the fee required by § 1.17(i) if the previously filed application is in a language other than English, and pay the surcharge required by § 1.16(f) to avoid abandonment if the applicant has not provided a correspondence address (proposed § 1.57(a)(2)). Proposed § 1.57(a)(1) also provides that such a notice may be combined with a notice under § 1.53(f) (e.g., a notice requiring that the applicant provide at least one claim and pay the filing fees).

35 U.S.C. 111(c) finally provides that such an application shall be treated as having never been filed, unless: (1) the application is revived under 35 U.S.C. 27; and (2) a copy of the specification and any drawings of the previously filed application are submitted to the Director. Section 1.57(a)(3) is thus proposed to provide that an application abandoned under §§ 1.57(a)(1) or (a)(2) shall be treated as having never been filed, unless: (1) the application is revived under § 1.137; and (2) a copy of the specification and any drawings of the previously filed application are filed in the Office.

Section 1.57(a)(4) is proposed to provide that a certified copy of the previously filed application must be filed in the Office or received by the Office from a foreign intellectual property office participating in a priority document exchange agreement within the later of four months from the filing date of the application or sixteen months from the filing date of the previously filed application, unless the previously filed application is an application filed under 35 U.S.C. 111 or 363. Proposed § 1.57(a)(4) also provides that failure to comply with this requirement, absent a petition pursuant to § 1.57(a) accompanied by the fee set forth in § 1.17(f), will result in the application not being accorded a filing date earlier than the date a copy of the specification and drawings from the previously filed application is filed in or received by the Office.

Section 1.57(i) is proposed to be added to provide that an application transmittal letter limited to the transmittal of a copy of the specification and drawings from a previously filed application submitted under §§ 1.57(a) or (b) of this section may be signed by a

juristic applicant or patent owner. PLT Article 7(2) and PLT Rule 7(1) provide that an assignee of an application, an applicant, owner or other interested person may act pro se before the Office for the filing of a copy of a previously filed application for purposes of the reference filing provisions of PLT Article 5(7) and reliance upon a reference to a prior-filed application to provide the missing parts of the description or missing drawings under PLT Article 5(6).

Section 1.58: Section 1.58(a) is proposed to be amended to provide that the description portion of the specification may contain tables, but the same tables should (rather than “must”) not be included in both the drawings and description portion of the specification.

Section 1.72: Section 1.72(b) is proposed to be amended to provide that the abstract must be as concise as the disclosure permits, preferably not exceeding 150 words in length.

See PCT Rule 8.1(b) (“The abstract shall be as concise as the disclosure permits (preferably 50 to 150 words if it is in English or when translated into English”).

Section 1.76: Section 1.76(b)(3) is proposed to be amended to include the sentence: “[t]his information also includes the reference to the previously filed application, indicating that the specification and any drawings of the application are replaced by the reference to the previously filed application, and specifying the previously filed application by application number, filing date, and the intellectual property authority or country in which the application was filed, for an application filed by reference to a previously filed application under § 1.57(a).” See discussion of § 1.57(a).

Section 1.76 is also proposed to be amended to permit the use of PLT Model International Forms as appropriate in lieu of an application data sheet under § 1.76. Section 1.76(f) specifically provides that: (1) the requirement in § 1.55 or 1.78 for the presentation of a priority or benefit claim under 35 U.S.C. 119, 120, 121, or 365 in an application data sheet will be satisfied by the presentation of such priority or benefit claim in the Patent Law Treaty Model International Request Form; (2) the requirement in § 1.57(a) for a reference to the previously filed application in an application data sheet will be satisfied by the presentation of such priority or benefit claim in the Patent Law Treaty Model International Request Form; and (3) the requirement in § 1.46 for the presentation of the name of the applicant under 35 U.S.C. 118 in an application data sheet will be satisfied by the presentation of the name of the applicant in the Patent Law Treaty Model International Request Form, Patent Law Treaty Model International Request for Recordation of Change in Name or Address Form, or Patent Law Treaty Model International Request for Recordation of Change in Applicant or Owner Form, as applicable. Section 1.76 is also proposed to be amended to permit the use of a PCT Request Form in lieu of an application data sheet under § 1.76 if the PCT Request Form is accompanied by a clear indication that treatment of the application as an application under 35 U.S.C. 111 is desired.

Section 1.78: Section 1.78(a) is proposed to be amended to implement the provisions in section 201(c) of the PLTIA and PLT Article 13 for the restoration of the right to the benefit of a provisional application. Section 201(c) of the PLTIA specifically amends

35 U.S.C. 119(e)(1) by adding that the Director may prescribe regulations, including the requirement for payment of the fee specified in 35 U.S.C. 41(a)(7), pursuant to which the twelve-month period set forth in 35 U.S.C. 119(e) may be extended by an additional two months if the delay in filing the application under 35 U.S.C. 111(a) or 363 within the twelve-month period was unintentional. Section 1.78(a)(1) is thus proposed to be amended to provide that if the nonprovisional application or international application designating the United States of America has a filing date which is after the expiration of the twelve-month period set forth in § 1.78(a)(1)(i) but within two months from the expiration of the period set forth in § 1.78(a)(1)(i), the benefit of the provisional application may be restored upon petition if the delay in filing the nonprovisional application or international application designating the United States of America within the period set forth in § 1.78(a)(1)(i) section was unintentional. Section 1.78(a)(1) is further proposed to be amended to provide that a petition to restore the benefit of the provisional application under this paragraph filed in the nonprovisional application or international application designating the United States of America must include: (1) the reference required by 35 U.S.C. 119(e) and § 1.78(a)(3) to the prior-filed provisional application, unless previously submitted; (2) the petition fee as set forth in § 1.17(m); and (3) a statement that the delay in filing the nonprovisional application or international application designating the United States of America within the twelve-month period set forth in § 1.78(a)(1)(i) was unintentional. Section 1.78(a)(1) is further proposed to be amended to provide that the Director may require additional information where there is a question whether the delay was unintentional.

Section 1.78(a) as proposed also provides that the right of priority in the subsequent application may be restored under PCT Rule 26bis.3. A decision by a Receiving Office to restore a right of priority under PCT Rule 26bis.3 to a provisional application in an international application designating the United States is effective as to the United States in the national stage of such application in accordance with PCT Rule 49ter.1.

Section 1.78(a) as proposed provides that the restoration of the right of priority under PCT Rule 26bis.3 to a provisional application does not affect the requirement to include the reference required by § 1.78(a)(3) to the provisional application in a national stage application under 35 U.S.C. 371 within the time period provided by § 1.78(a)(4) to avoid waiver of the benefit claim.

Section 1.78(a) is also proposed to be amended to provide that the twelve-month period is subject to PCT Rule 80.5, as well as 35 U.S.C. 21(b) (and § 1.7(a)).

Section 1.78(a)(4) is proposed to be amended to provide that if the later-filed application is a national stage application under 35 U.S.C. 371, this reference must be submitted within the latest of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or sixteen months from the filing date of the prior-filed provisional application. This change is proposed in order to avoid the need for petitions under both § 1.137 and § 1.78(b) in the situation in which the applicant does not make the initial submission under 35 U.S.C. 371 to enter the national stage within four

months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application.

Section 1.78(b) is proposed to be amended to implement the changes to 35 U.S.C. 119(e) in section 201(c)(1)(B)(i)(II) of the PLTIA. Section 201(c)(1)(B)(i)(II) of the PLTIA replaces “payment of a surcharge” with “payment of the fee specified in section 41(a)(7)” (see discussion of § 1.17(m)) and deletes “during the pendency of the application.”

Section 1.78(b) is thus proposed to be amended to provide that if the reference required by 35 U.S.C. 119(e) and § 1.78(a)(3) is presented in an application (either a nonprovisional application or an international application designating the United States) after the time period provided by § 1.78(a)(4), the claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application may be accepted if the reference identifying the prior-filed application by provisional application number was unintentionally delayed. Section 1.78(b) is further proposed to be amended to provide that a petition to accept an unintentionally delayed claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application must be accompanied by: (1) the reference required by 35 U.S.C. 119(e) and § 1.78(a)(3) to the prior-filed provisional application, unless previously submitted; (2) the petition fee as set forth in § 1.17(m); and (3) a statement that the entire delay between the date the benefit claim was due under § 1.78(a)(4) and the date the benefit claim was filed was unintentional. Section 1.78(b) as proposed would continue to provide that the Director may require additional information where there is a question as to whether the delay was unintentional.

Section 1.78(c)(3) is proposed to be amended to provide that if the later-filed application is a nonprovisional application entering the national stage from an international application under 35 U.S.C. 371, this reference must also be submitted within the latest of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application, four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or sixteen months from the filing date of the prior-filed application. This change is proposed to avoid the need for petitions under both § 1.137 and § 1.78(d) in the situation in which the applicant does not make the initial submission under 35 U.S.C. 371 to enter the national stage within four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application.

Section 1.78(d)(2) is proposed to be amended for consistency with the change to 35 U.S.C. 120 in section 202(b)(3) of the PLTIA (replaces “payment of a surcharge” with “payment of the fee specified in section 41(a)(7)”). See discussion of § 1.17(m).

Section 1.81: Section 1.81(a) is proposed to be amended to delete the provision that a drawing (where necessary for the understanding of the subject matter sought to be patented), or a high quality copy thereof, must be filed with the application. As discussed previously, 35 U.S.C. 111 no longer requires that an application contain a drawing where necessary for the understanding of the subject matter sought to be patented to be entitled to a filing date. 35 U.S.C. 113 continues to provide that “[t]he applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be

patented” and that “[d]rawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or (ii) to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim.” See 35 U.S.C. 113. Thus, the absence of any drawing on the filing of an application where a drawing is necessary for the understanding of the subject matter sought to be patented may result in an applicant not being able to obtain a patent for any claimed invention presented in the application, but the absence of any drawing on the filing of an application no longer raises a question as to whether the application as deposited is entitled to a filing date.

As discussed previously, PLT Article 5 and PLTIA 35 U.S.C. 111 should not be viewed as prescribing a best practice for the preparation and filing of a patent application. The preparation of drawings at the time an application (provisional or nonprovisional) is prepared for any claimed invention for which patent protection is desired where a drawing is necessary for the understanding of the subject matter sought to be patented, and inclusion of such drawing(s) will help ensure that the application will contain a drawing where required by 35 U.S.C. 113 for any such claimed invention.

Section 1.83: Section 1.83(a) is proposed to be amended to provide that tables that are included in the specification and sequences that are included in sequence listings “should” (rather than must) not be duplicated in the drawings.

Section 1.85: Section 1.85(c) is proposed to be amended to provide that if a corrected drawing is required or if a drawing does not comply with § 1.84 at the time an application is allowed, the Office may notify the applicant in a notice of allowability and set a three-month (non-extendable) period of time from the mail date of the notice of allowability within which the applicant must file a corrected drawing in compliance with § 1.84 to avoid abandonment.

Section 1.137: Section 1.137 is revised to implement the change in the PLTIA to eliminate revival of abandoned applications under the “unavoidable” standard and to provide for the revival of abandoned applications (as well as the acceptance of delayed responses in reexamination by patent owners and delayed maintenance fee payments) on the basis of unintentional delay. As discussed previously, section 201(b) of the PLTIA specifically adds new 35 U.S.C. 27, providing that the Director may establish procedures, including the payment of a surcharge, to revive an unintentionally abandoned application for patent, accept an unintentionally delayed payment of the fee for issuing each patent, or accept an unintentionally delayed response by the patent owner in a reexamination proceeding, upon petition by the applicant for patent or patent owner. The patent law formerly provided for revival of an unintentionally abandoned application only in the patent fee provisions of 35 U.S.C. 41(a)(7). See Pub. L. No. 97-247, section 3(a), 96 Stat. 317-18 (1982). This raised questions concerning the Office’s authority to revive an unintentionally abandoned application (without a showing of unavoidable delay) in certain situations. See e.g., Aristocrat Techs. Australia Pty Ltd. v. Int’l Game Tech., 543 F.3d 657 (Fed. Cir. 2008).

Sections 1.137(a) is proposed to be amended to eliminate the provisions pertaining to petitions on the basis of unavoidable delay. Section 1.137(a) is proposed to be amended to instead provide that if the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to § 1.137 to revive an abandoned application or a reexamination prosecution terminated under § 1.550(d) or § 1.957(b) or limited under § 1.957(c).

Section 1.137(b) is proposed to be amended to set out the petition requirements. Section 1.137(b) is specifically proposed to be amended to provide that a grantable petition pursuant to § 1.137 must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this section was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to § 1.137(d). Section 1.137 as proposed would continue to provide that the Director may require additional information where there is a question whether the delay was unintentional.

Sections 1.137(c) and (e) are proposed to be amended to remove the language pertaining to “lapsed” patents. Section 202(b)(6) of the PLTIA amends 35 U.S.C. 151 to delete the third and fourth paragraphs pertaining to the lapsed patent practice.

Section 1.137(c) is also proposed to be amended to provide that in an application abandoned under § 1.57(a), the reply must include a copy of the specification and any drawings of the previously filed application, and to clarify that an application must be abandoned after the close of prosecution as defined in § 1.114(b), for the reply requirement to be met by the filing of a request for continued examination in compliance with § 1.114.

Section 1.137(f) is proposed to be amended to remove as unnecessary the language limiting petitions to the unintentional standard. The PLTIA eliminates revival of abandoned applications under the “unavoidable” standard.

Section 1.290: Section 1.290(f) is proposed to be amended to reference § 1.17(o), rather than § 1.17(p), for consistency with the proposed change to § 1.17. See discussion of § 1.17.

Section 1.317: Section 1.317 is proposed to be removed and reserved. Section 202(b)(6) of the PLTIA amends 35 U.S.C. 151 to delete the third and fourth paragraphs pertaining to the lapsed patent practice.

Section 1.366: Section 1.366(a) is proposed to be amended to provide that a maintenance fee transmittal letter may be signed by a juristic applicant or patent owner. PLT Article 7(2)(b) provides that a maintenance fee may be paid by any person.

Section 1.378: Section 1.378 is proposed to be amended to implement the changes to 35 U.S.C. 41(c)(1) in section 202(b)(1)(B) of the PLTIA. Section 202(b)(1)(B) of the PLTIA amends 35 U.S.C. 41(c)(1) to delete the twenty-four month time limit for unintentionally delayed maintenance fee payments and to delete the reference to an unavoidable standard. PLTIA 35 U.S.C. 41(c)(1) provides that: (1) the Director may accept the payment of any maintenance fee required by 35 U.S.C. 41(b) after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unintentional; (2) the Director may require the payment of the fee specified in 35 U.S.C. 41(a)(7) as a condition of accepting payment of any maintenance fee after the six-month grace period; and (3) if the Director accepts payment of a maintenance fee after the six-month grace period, the patent shall be considered as not having expired at the end of the grace period.

Sections 1.378(a) is proposed to be amended to eliminate the provisions pertaining to petitions on the basis of unavoidable delay.

Section 1.378(b) is also proposed to be amended to eliminate the provisions pertaining to petitions asserting unavoidable delay. Section 1.378(b) is proposed to be amended to set out the requirements for petitions asserting unintentional delay (these requirements are currently set out in § 1.378(c)). Section 1.378(b) is also proposed to be amended to refer to the petition fee set forth in § 1.17(m) rather than the surcharge set forth in § 1.20(i) as PLTIA 35 U.S.C. 41(c)(1) refers to the fee specified in 35 U.S.C. 41(a)(7) rather than a surcharge.

Section 1.378(c) is proposed to be amended to provide that any petition under this section must be signed in compliance with § 1.33(b) (§ 1.378(d) sets out the current signature requirement for a petition to accept a delayed maintenance fee payment).

Section 1.378(d) is proposed to be amended to include the current provisions pertaining to a request for reconsideration of a maintenance fee decision, except that § 1.378(d) is proposed to be amended to eliminate the provision that after the decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

Section 1.378(e) is proposed to be amended to include the current provisions of § 1.378(e) pertaining to the situation in which the maintenance fee or any petition fee will be refunded.

Section 1.452: Section 201(c) of the PLTIA amends 35 U.S.C. 365(b) by adding that the Director may establish procedures, including the requirement for payment of the fee specified in 35 U.S.C. 41(a)(7), to accept an unintentionally delayed claim for priority under the treaty and the Regulations, and to accept a priority claim that pertains to an application that was not filed within the priority period specified in the treaty and Regulations, but was filed within the additional two-month period specified under 35 U.S.C. 119(a) or the PCT or PCT Regulations. Section 1.452(b)(2) is thus proposed to

be amended to refer to the petition fee as set forth in § 1.17(m) for consistency with section 201(c) of the PLTIA.

Section 1.452(d) currently contains a caveat that restoration of a right of priority to a prior application by the United States Receiving Office under § 1.452, or by any other Receiving Office under the provisions of PCT Rule 26bis.3, will not entitle applicants to a right of priority in any application which has entered the national stage under 35 U.S.C. 371, or in any application filed under 35 U.S.C. 111(a) which claims benefit under 35 U.S.C. 120 and 365(c) to an international application in which the right to priority has been restored. Section 1.452(d) is proposed to be removed in view of PLTIA 35 U.S.C. 119 and 365(b).

Section 1.495: As discussed previously, the Office is revising the provisions pertaining to the filing of an application without the inventor's oath or declaration to provide that if an application is in condition for allowance but does not include an oath or declaration in compliance with § 1.63, or a substitute statement in compliance with § 1.64, executed by or with respect to each actual inventor, the Office will issue a "Notice of Allowability" (PTOL-37) requiring an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each actual inventor, together with the "Notice of Allowance and Fee(s) Due" (PTOL-85), since the AIA Technical Corrections Act amends 35 U.S.C. 115(f) to permit the Office to issue a "Notice of Allowance and Fee(s) Due" (PTOL-85) before the application includes an oath or declaration in compliance with § 1.63, or substitute statement in compliance with

§ 1.64, executed by or with respect to each actual inventor. As also discussed previously, 35 U.S.C. 115(f) does not specifically provide for the consequence that results if an applicant fails to provide an oath or declaration in compliance with § 1.63, or a substitute statement in compliance with § 1.64, executed by or with respect to each actual inventor. PLTIA 35 U.S.C. 371(d), however, provides that “[t]he requirement with respect to . . . the oath or declaration referred to in [35 U.S.C. 371(c)(4)] shall be complied with by the date of the commencement of the national stage or by such later time as may be fixed by the Director,” and that the “[f]ailure to comply with these requirements shall be regarded as abandonment of the application by the parties thereof.” The Office is thus proposing to amend § 1.495(c)(3)(ii) to provide that if the applicant is notified in a notice of allowability that an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each named inventor has not been filed, the applicant must file each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, no later than the date on which the issue fee is paid to avoid abandonment (which time period is not extendable). The Office is also proposing to amend § 1.495(c)(3)(ii) to provide that: (1) the applicant must file each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, no later than the date on which the issue fee for the patent is paid (as required by 35 U.S.C. 115(f)); and (2) that the Office may dispense with the notice provided for in § 1.495(c)(1) if each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, has been filed before the application is in condition for allowance.

Section 1.704: Section 1.704 is proposed to be amended to provide for the situation in which an application is not in condition for examination within eight months from the date on which the application was filed under 35 U.S.C. 111(a) or the date of commencement of the national stage under 35 U.S.C. 371(b) or (f) in an international application. In implementing the patent term adjustment provisions of the American Inventors Protection Act of 1999 (Pub. L. No. 106-113, 113 Stat. 1501, 1501A-557 through 1501A-560 (1999)), the Office proposed a reduction of any patent term adjustment if an application was not complete on filing. See Changes to Implement Patent term Adjustment Under Twenty-Year Patent Term, 65 FR 17215, 17219-20, 17228 (Mar. 31, 2000) (proposed rule). The Office received a number of comments in response to this proposal suggesting that an application being in condition for examination on filing is not necessary for the Office to meet the fourteen-month timeframe in 35 U.S.C. 154(b)(1)(A)(i) and that an applicant should be permitted to complete the application and correct application informalities after the filing date of the application. See Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term, 65 FR 56366, 56381 (Sept. 18, 2000) (final rule). The Office did not adopt this proposed reduction in 2000 because an applicant could not delay placing an application in condition for examination to the point that it would contribute to the Office's missing the fourteen-month timeframe in 35 U.S.C. 154(b)(1)(A)(i) under the provisions for completing an application (§ 1.53(f)) in effect in 2000 without the applicant's incurring a reduction of patent term adjustment under 35 U.S.C. 154(b)(2)(C)(ii). See id. Specifically, the fourteen-month timeframe in 35 U.S.C. 154(b)(1)(A)(i) did not begin (under the patent laws in effect between 2000

and 2012) until the specification and drawings of an application were filed in the Office, which permitted the Office to conduct a formalities review and issue a notice (if necessary) requiring the applicant to complete the application and correct any application informalities no later than one to two months from the filing of an application. Thus, the Office could review the specification and drawings and issue a notice (if necessary) requiring the applicant to complete the application and correct the application papers no later than two months from the filing of an application. As such, applications would either be in condition for examination within five months from the filing of an application, or the applicant would incur a reduction of any patent term adjustment under 35 U.S.C. 154(b)(2)(C)(ii) (providing a reduction of any patent term adjustment for the cumulative total of any periods of time in excess of three months that are taken to respond to a notice from the Office making any rejection, objection, argument, or other request, and measuring such three-month period from the date the notice was given or mailed to the applicant). The Office, however, also noted that it would revisit this decision if the provisions for completing an application and correcting application formalities contributed to the Office's missing the fourteen-month timeframe under 35 U.S.C. 154(b)(1)(A)(i). See id.

The PLT and PLTIA 35 U.S.C. 111 provide applicants with additional opportunities to delay the examination process (e.g., the ability to file an application without any claims and to file an application merely by reference to a prior-filed application). Specifically, the fourteen-month timeframe specified in 35 U.S.C. 154(b)(1)(A)(i) may now begin before the specification and drawings of an application are filed in the Office in an

application filed under 35 U.S.C. 111(a), due to the change to 35 U.S.C. 111 in the PLTIA. In addition, the fourteen-month timeframe specified in 35 U.S.C. 154(b)(1)(A)(i) may now begin before the specification and drawings of an application are filed in the Office in an international application, due to the change to 35 U.S.C. 154(b)(1)(A)(i)(II) in section 1(h)(1)(A) of the AIA Technical Corrections Act, Pub. L. No. 112-274, 126 Stat. 2456, 2457 (2013), (changing “the date on which an international application fulfilled the requirements of section 371” to “the date of commencement of the national stage under section 371 in an international application”)).

The Office is not proposing to require that applications be in condition for examination on filing (or commencement of national stage in an international application) in order for an applicant to avoid a reduction of patent term adjustment. It is, however, reasonable to expect that an application should be placed in condition for examination within eight months of its filing date (or date of commencement of national stage in an international application). Therefore, the Office is proposing to provide that the circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the failure to provide an application in condition for examination within eight months from the date on which the application was filed under 35 U.S.C. 111(a) or the date of commencement of the national stage under 35 U.S.C. 371(b) or (f) in an international application. Section 1.704(c) is also proposed to be amended to provide that in such a case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is eight months from the date on which the application was filed under

35 U.S.C. 111(a) or the date of commencement of the national stage under  
35 U.S.C. 371(b) or (f) in an international application and ending on the date the  
application is in condition for examination.

Section 1.704(f) is proposed to be added to define when an application is “in condition for examination” for purposes of § 1.704(c). Proposed § 1.704(f) provides that an application filed under 35 U.S.C. 111(a) is in condition for examination when the application includes a specification, including at least one claim and an abstract (§ 1.72(b)), and has papers in compliance with § 1.52, drawings in compliance with § 1.84, any English translation required by § 1.52(d) or § 1.57(a), a sequence listing in compliance with §§ 1.821 through 1.825 (if applicable), the inventor’s oath or declaration or application data sheet containing the information specified in § 1.63(b), the basic filing fee (§ 1.16(a) or § 1.16(c)), any certified copy of the previously filed application required by § 1.57(a), and any application size fee required by the Office under § 1.16(s).

Section 1.704(f) as proposed provides that an international application is in condition for examination when the application has entered the national stage as defined in § 1.491(b), and includes a specification, including at least one claim and an abstract (§ 1.72(b)), and has papers in compliance with § 1.52, drawings in compliance with § 1.84, a sequence listing in compliance with §§ 1.821 through 1.825 (if applicable), the inventor’s oath or declaration or application data sheet containing the information specified in § 1.63(b), and any application size fee required by the Office under § 1.492(j).

Section 1.809: Section 1.809(c) is proposed to be amended to provide that if an application for patent is otherwise in condition for allowance except for a needed deposit and the Office has received a written assurance that an acceptable deposit will be made, the Office may notify the applicant in a notice of allowability and set a three-month (non-extendable) period of time from the mail date of the notice of allowability within which the deposit must be made in order to avoid abandonment.

Section 3.11: Section 3.11(a) is proposed to be amended to implement section 201(d) of the PLTIA. Section 201(d) of the PLTIA amends 35 U.S.C. 261, first paragraph, by adding: “The Patent and Trademark Office shall maintain a register of interests in applications for patents and patents and shall record any document related thereto upon request, and may require a fee therefor.” Section 3.11(a) is thus proposed to be amended to provide that other documents relating to interests in patent applications and patents, accompanied by completed cover sheets as specified in § 3.28 and § 3.31, will be recorded in the Office.

Section 3.31: Section 3.31(h) is proposed to be amended to permit the use of PLT International Model forms as appropriate in lieu of an assignment cover sheet under § 3.31. Section 3.31(h) specifically provides that the assignment cover sheet required by § 3.28 for a patent application or patent will be satisfied by the Patent Law Treaty Model International Request for Recordation of Change in Applicant or Owner Form, Patent Law Treaty Model International Request for Recordation of a License/Cancellation of the Recordation of a License Form, Patent Law Treaty Model International Certificate of

Transfer Form, or Patent Law Treaty Model International Request for Recordation of a Security Interest/Cancellation of the Recordation of a Security Interest Form, as applicable, except where the assignment is also an oath or declaration under § 1.63.

### **Rulemaking Considerations:**

**A. Administrative Procedure Act:** This rulemaking implements the PLT and title II of the PLTIA. The changes proposed in this rulemaking are to revise application filing and prosecution procedures to conform them to the changes to the patent laws in title II of the PLTIA and to eliminate procedural requirements to ensure that the rules of practice are consistent with the PLT (except for the proposed change to the patent term adjustment provisions of 37 CFR 1.704). Therefore, the changes proposed in this rulemaking (except for the proposed change to the patent term adjustment provisions of 37 CFR 1.704) involve rules of agency practice and procedure, and/or interpretive rules. See Bachow Commc'ns Inc. v. F.C.C., 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are procedural under the Administrative Procedure Act); Inova Alexandria Hosp. v. Shalala, 244 F.3d 342, 350 (4th Cir. 2001) (rules for handling appeals were procedural where they did not change the substantive standard for reviewing claims); Nat'l Org. of Veterans' Advocates, Inc. v. Sec'y of Veterans Affairs, 260 F.3d 1365, 1375 (Fed. Cir. 2001) (rule that clarifies interpretation of a statute is interpretive).

Accordingly, prior notice and opportunity for public comment are not required pursuant to 5 U.S.C. 553(b) or (c) (or any other law), except for the proposed change to the patent term adjustment provisions of 37 CFR 1.704. See Cooper Techs. Co. v. Dudas, 536 F.3d 1330, 1336-37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), does not require notice and comment rulemaking for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice”) (quoting 5 U.S.C. 553(b)(A)). The Office, however, is publishing all of these proposed changes (rather than only the proposed change to the patent term adjustment provisions of 37 CFR 1.704) for comment as it seeks the benefit of the public’s views on the Office’s proposed implementation of the PLT and title II of the PLTIA.

**B. Regulatory Flexibility Act:** For the reasons set forth herein, the Deputy General Counsel for General Law of the United States Patent and Trademark Office has certified to the Chief Counsel for Advocacy of the Small Business Administration that changes proposed in this notice will not have a significant economic impact on a substantial number of small entities. See 5 U.S.C. 605(b).

The changes proposed in this notice are to revise application filing and prosecution procedures to conform them to the changes to the patent laws in title II of the PLTIA and to eliminate procedural requirements to ensure that the rules of practice are consistent with the PLT.

The notable changes in the PLT and title II of the PLTIA pertain to: (1) the filing date requirements for a patent application; (2) the restoration of patent rights via the revival of abandoned applications and acceptance of delayed maintenance fee payments; and (3) the restoration of the right of priority to a foreign application or the benefit of a provisional application via the permitting of a claims to priority to a foreign application or the benefit of a provisional application in a subsequent application filed within two months of the expiration of the twelve-month period (six-month period for design applications) for filing such a subsequent application.

The requirements and fees for filing of an application without a claim track the existing provisions in 37 CFR 1.53(f) for an application that is missing application components not required for a filing date. The requirements and fees for filing of an application “by reference” to a previously filed application in lieu of filing the specification and drawings (reference filing) are simpler than the existing requirements in 37 CFR 1.57(a) that apply when relying upon the specification and drawings of a prior-filed application as the specification and drawings of an application.

The requirements for a petition to revive an abandoned application (37 CFR 1.137) or accept a delayed maintenance fee payment (37 CFR 1.378) on the basis of “unintentional” delay are the current requirements for a petition to revive an abandoned application or accept a delayed maintenance fee payment. PLTIA 35 U.S.C. 41(a)(7) and (c)(1) set the petition fee amount for a petition to accept a delayed maintenance fee payment at an amount equal to the fee for a petition to revive an unintentionally

abandoned application, which is lower than the current surcharge for accepting an unintentionally delayed maintenance fee payment.

The requirements and fees for a petition to restore the right of priority to a prior-filed foreign application or a petition to restore the right to benefit of a prior-filed provisional application correspond to the current requirements for petitions based upon unintentional delay (i.e., a petition to revive an abandoned application (37 CFR 1.137) or accept a delayed maintenance fee payment (37 CFR 1.378)). PLTIA 35 U.S.C. 41(a)(7) and 119 set the petition fee amount for a petition to restore the right of priority to a prior-filed foreign application or a petition to restore the right to benefit of a prior-filed provisional application at an amount equal to the fee for a petition to revive an unintentionally abandoned application. Current 35 U.S.C. 119 does not permit an applicant who missed the filing period requirement in 35 U.S.C. 119(a) or (e) to restore the right of priority to the prior-filed foreign application or restore the right to benefit of the prior-filed provisional application.

The proposed changes to the patent term adjustment reduction provisions do not impose any additional burden on applicants. The proposed change to 37 CFR 1.704(c) simply specifies that the failure to place an application in condition for examination within eight months from the date on which the application was filed under 35 U.S.C. 111(a) (or the date of commencement of the national stage under 35 U.S.C. 371(b) or (f) in an international application) constitutes failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. This proposed change

will not have a significant economic impact on a substantial number of small entities because: (1) applicants already have to place an application in a condition for examination; (2) applicants are not entitled to patent term adjustment for examination delays that result from an applicant's delay in prosecuting the application (35 U.S.C. 154(b)(2)(C)(i) and 37 CFR 1.704(a)); and (3) applicants may avoid any consequences from this provision simply by placing the application in condition for examination within eight months from the date on which the application was filed under 35 U.S.C. 111(a) (or the date of commencement of the national stage under 35 U.S.C. 371(b) or (f) in an international application).

For the foregoing reasons, the changes proposed in this notice will not have a significant economic impact on a substantial number of small entities.

**C. Executive Order 12866 (Regulatory Planning and Review):** This rulemaking has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

**D. Executive Order 13563 (Improving Regulation and Regulatory Review):** The Office has complied with Executive Order 13563. Specifically, the Office has, to the extent feasible and applicable: (1) made a reasoned determination that the benefits justify the costs of the rule; (2) tailored the rule to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed

available alternatives; (6) involved the public in an open exchange of information and perspectives among experts in relevant disciplines, affected stakeholders in the private sector and the public as a whole, and provided on-line access to the rulemaking docket; (7) attempted to promote coordination, simplification, and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes.

**E. Executive Order 13132 (Federalism):** This rulemaking does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

**F. Executive Order 13175 (Tribal Consultation):** This rulemaking will not: (1) have substantial direct effects on one or more Indian tribes; (2) impose substantial direct compliance costs on Indian tribal governments; or (3) preempt tribal law. Therefore, a tribal summary impact statement is not required under Executive Order 13175 (Nov. 6, 2000).

**G. Executive Order 13211 (Energy Effects):** This rulemaking is not a significant energy action under Executive Order 13211 because this rulemaking is not likely to have a significant adverse effect on the supply, distribution, or use of energy. Therefore, a

Statement of Energy Effects is not required under Executive Order 13211  
(May 18, 2001).

**H. Executive Order 12988 (Civil Justice Reform):** This rulemaking meets applicable standards to minimize litigation, eliminate ambiguity, and reduce burden as set forth in sections 3(a) and 3(b)(2) of Executive Order 12988 (Feb. 5, 1996).

**I. Executive Order 13045 (Protection of Children):** This rulemaking does not concern an environmental risk to health or safety that may disproportionately affect children under Executive Order 13045 (Apr. 21, 1997).

**J. Executive Order 12630 (Taking of Private Property):** This rulemaking will not affect a taking of private property or otherwise have taking implications under Executive Order 12630 (Mar. 15, 1988).

**K. Congressional Review Act:** Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 et seq.), prior to issuing any final rule, the United States Patent and Trademark Office will submit a report containing the final rule and other required information to the United States Senate, the United States House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this notice are not expected to result in an annual effect on the economy of 100 million dollars or more, a major increase in costs or prices, or significant adverse effects on competition, employment, investment,

productivity, innovation, or the ability of United States-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this notice is not expected to result in a “major rule” as defined in 5 U.S.C. 804(2).

**L. Unfunded Mandates Reform Act of 1995:** The changes set forth in this notice do not involve a Federal intergovernmental mandate that will result in the expenditure by State, local, and tribal governments, in the aggregate, of 100 million dollars (as adjusted) or more in any one year, or a Federal private sector mandate that will result in the expenditure by the private sector of 100 million dollars (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no actions are necessary under the provisions of the Unfunded Mandates Reform Act of 1995. See 2 U.S.C. 1501 et seq.

**M. National Environmental Policy Act:** This rulemaking will not have any effect on the quality of the environment and is thus categorically excluded from review under the National Environmental Policy Act of 1969. See 42 U.S.C. 4321 et seq.

**N. National Technology Transfer and Advancement Act:** The requirements of section 12(d) of the National Technology Transfer and Advancement Act of 1995 (15 U.S.C. 272 note) are not applicable because this rulemaking does not contain provisions which involve the use of technical standards.

**O. Paperwork Reduction Act:** The Paperwork Reduction Act of 1995 (44 U.S.C. 3501 et seq.) requires that the Office consider the impact of paperwork and other information collection burdens imposed on the public. This rulemaking involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501-3549).

The notable changes in the PLT and title II of the PLTIA pertain to: (1) the filing date requirements for a patent application; (2) the restoration of patent rights via the revival of abandoned applications and acceptance of delayed maintenance fee payments; and (3) the restoration of the right of priority to a foreign application or the benefit of a provisional application via the permitting of a claims to priority to a foreign application or the benefit of a provisional application in a subsequent application filed within two months of the expiration of the twelve-month period (six-month period for design applications) for filing such a subsequent application.

The information collection requirements pertaining to petitions to accept a delayed maintenance fee payment have been reviewed and approved by the OMB under OMB control number 0651-0016. The information collection requirements pertaining to patent term adjustment have been reviewed and approved by the OMB under OMB control number 0651-0020. The information collection requirements pertaining to recording assignments (and other interests) in patents and patent applications have been reviewed and approved by the OMB under OMB control number 0651-0027. The information collection requirements pertaining to petitions to revive an abandoned application have

been reviewed and approved by the OMB under OMB control number 0651-0031. The information collection requirements pertaining to the specification (including claims) and drawings required for a patent application have been reviewed and approved by the OMB under OMB control number 0651-0032. The information collection requirements pertaining to representative and correspondence address have been reviewed and approved by the OMB under OMB control number 0651-0035. The changes in this rulemaking pertaining to petitions to accept a delayed maintenance fee payment, patent term adjustment, petitions to revive an abandoned application, the specification (including claims) and drawings required for a patent application, and representative and correspondence address, do not propose to add any additional requirements (including information collection requirements) or fees for patent applicants or patentees.

Therefore, the Office is not resubmitting information collection packages to OMB for its review and approval because the changes in this rulemaking do not affect the information collection requirements associated with the information collections approved under OMB control numbers 0651-0016, 0651-0020, 0651-0027, 0651-0031, 0651-0032, and 0651-0035.

This rulemaking also provides for the optional use by applicants of the following Patent Law Treaty Model International Forms: (1) Model International Request Form; (2) Model International Power of Attorney Form; (3) Model International Request for Recordation of Change in Name or Address Form; (4) Model International Request for Correction of Mistakes Form; (5) Model International Request for Recordation of Change in Applicant or Owner Form; (6) Model International Certificate of Transfer Form;

(7) Model International Request for Recordation of a License/Cancellation of the Recordation of a License Form; and (8) Model International Request for Recordation of a Security Interest/Cancellation of the Recordation of a Security Interest Form. This rulemaking also requires revisions to the pre-printed information on the forms for petitions to accept a delayed maintenance fee payment and petitions to revive an abandoned application (PTO/SB/64, PTO/SB/64a, PTO/SB/66) and elimination of the forms for petitions based upon unavoidable delay (PTO/SB/61 and PTO/SB/65) in the information collections approved under OMB control numbers 0651-0016 and 0651-0031. The Office will submit a change worksheet to OMB to add these Patent Law Treaty Model International Forms and form revisions to the information collections approved under OMB control numbers 0651-0016, 0651-0020, 0651-0027, 0651-0031, 0651-0032, and 0651-0035.

This rulemaking proposes to add petitions to restore the right of priority to a prior-filed foreign application or a petition to restore the right to benefit of a prior-filed provisional application. The collection of information involved in this notice has been submitted to OMB under OMB control number 0651-00xx. The proposed collection will be available at OMB's Information Collection Review Web site:  
[www.reginfo.gov/public/do/PRAMain](http://www.reginfo.gov/public/do/PRAMain).

Title of Collection: Patent Law Treaty.

OMB Control Number: 0651-00xx.

Needs and Uses: This information collection is necessary so that patent applicants and/or patentees may seek restoration of the right of priority to a prior-filed foreign application or of the right to benefit of a prior-filed provisional application. The Office will use the petition to restore the right of priority to a prior-filed foreign application or the right to benefit of a prior-filed provisional application to determine whether the applicant has satisfied the conditions of the applicable statute (35 U.S.C. 119) and regulations (proposed 37 CFR 1.55(b) and 1.78(a)(1)).

Method of Collection: By mail, facsimile, hand delivery, or electronically to the Office.

Affected Public: Individuals or households; businesses or other for-profits; and not-for-profit institutions.

Estimated Number of Respondents: 500 responses per year.

Estimated Time Per Response: The Office estimates that the responses in this collection will take the public approximately 1.0 hours.

Estimated Total Annual Respondent Burden Hours: 500 hours per year.

Estimated Total Annual (Hour) Respondent Cost Burden: \$185,500 per year (500 hours per year at \$371 per hour).

The Office is soliciting comments to: (1) evaluate whether the proposed information requirement is necessary for the proper performance of the functions of the Office, including whether the information will have practical utility; (2) evaluate the accuracy of the Office's estimate of the burden; (3) enhance the quality, utility, and clarity of the information to be collected; and (4) minimize the burden of collecting the information on those who are to respond, including by using appropriate automated, electronic, mechanical, or other technological collection techniques or other forms of information technology.

Please send comments on or before [Insert date 60 days after publication in the FEDERAL REGISTER] to Mail Stop Comments--Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, marked to the attention of Raul Tamayo, Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy. Comments should also be submitted to the Office of Information and Regulatory Affairs, Office of Management and Budget, New Executive Office Building, Room 10202, 725 17th Street, N.W., Washington, DC 20503, Attention: Desk Officer for the United States Patent and Trademark Office.

Notwithstanding any other provision of law, no person is required to respond to, nor shall a 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.

## **List of Subjects**

### **37 CFR Part 1**

Administrative practice and procedure, Courts, Freedom of Information, Inventions and patents, Reporting and record keeping requirements, Small Businesses.

### **37 CFR Part 3**

Administrative practice and procedure, Inventions and patents, Trademarks.

For the reasons set forth in the preamble, 37 CFR parts 1 and 3 are proposed to be 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. 2(b)(2).

2. Section 1.4 is amended by revising paragraph (c), redesignating paragraphs (d)(3) and (d)(4) as paragraphs (d)(4) and (d)(5), respectively, and adding a new paragraph (d)(3) to read as follows:

**§ 1.4 Nature of correspondence and signature requirements.**

\* \* \* \* \*

(c) Since different matters may be considered by different branches or sections of the Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects. Subjects provided for on a single Office or World Intellectual Property Organization form may be contained in a single paper.

(d) \* \* \*

(3) Electronically submitted correspondence. Correspondence permitted via the Office electronic filing system may be signed by a graphic representation of a handwritten signature as provided for in paragraph (d)(1) of this section or a graphic representation of an S-signature as provided for in paragraph (d)(2) of this section when it is submitted via the Office electronic filing system.

\* \* \* \* \*

3. Section 1.16 is amended by revising paragraph (f) to read as follows:

**§ 1.16 National application filing, search, and examination fees.**

\* \* \* \* \*

(f) Surcharge for filing any of the basic filing fee, the search fee, the examination fee, or the inventor's oath or declaration on a date later than the filing date of the application, for an application that does not contain at least one claim on the filing date of

the application, and for an application filed by reference to a previously filed application under § 1.57(a), except provisional applications:

By a micro entity (§ 1.29).....	\$35.00
By a small entity (§ 1.27(a)).....	\$70.00
By other than a small or micro entity.....	\$140.00
* * * * *	

4. Section 1.17 is amended by revising paragraphs (f), (m), and (p), adding new paragraph (o), and removing and reserving paragraphs (l) and (t) to read as follows:

**§ 1.17 Patent application and reexamination processing fees.**

\* \* \* \* \*

(f) For filing a petition under one of the following sections which refers to this paragraph:

By a micro entity (§ 1.29).....	\$100.00
By a small entity (§ 1.27(a)).....	\$200.00
By other than a small or micro entity.....	\$400.00

§ 1.36(a)—for revocation of a power of attorney by fewer than all of the applicants.

§ 1.53(e)—to accord a filing date.

§ 1.57(a)—to accord a filing date.

§ 1.57(b)—to accord a filing date.

§ 1.182—for decision on a question not specifically provided for.

§ 1.183—to suspend the rules.

§ 1.741(b)—to accord a filing date to an application under § 1.740 for extension of a patent term.

\* \* \* \* \*

(l) [Reserved]

(m) For filing a petition for the revival of an abandoned application for a patent, for the delayed payment of the fee for issuing each patent, for the delayed response by the patent owner in any reexamination proceeding, for the delayed payment of the fee for maintaining a patent in force, for the delayed submission of a priority or benefit claim, or for the extension of the twelve-month (six-month for designs) period for filing a subsequent application (§§ 1.55(b), 1.55(d), 1.78(a)(1), 1.78(b), 1.78(d), 1.137, and 1.378):

By a small entity (§ 1.27(a)).....	\$850.00
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By other than a small or micro entity.....	\$1,700.00
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\* \* \* \* \*

(o) For every ten items or fraction thereof in a third-party submission under § 1.290:

By a small entity (§ 1.27(a)).....	\$90.00
------------------------------------	---------

By other than a small entity.....	\$180.00
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(p) For an information disclosure statement under § 1.97(c) or (d):

By a micro entity (§ 1.29).....	\$45.00
---------------------------------	---------

By a small entity (§ 1.27(a)).....	\$90.00
------------------------------------	---------

By other than a small or micro entity.....	\$180.00
--	----------

\* \* \* \* \*

(t) [Reserved]

5. Section 1.20 is amended by removing and reserving paragraph (i).

**§ 1.20 Post issuance fees.**

\* \* \* \* \*

(i) [Reserved]

\* \* \* \* \*

6. Section 1.23 is amended by adding a new paragraph (c) to read as follows:

**§ 1.23 Methods of payment.**

\* \* \* \* \*

(c) A fee transmittal letter may be signed by a juristic applicant or patent owner.

7. Section 1.29 is amended by revising the first sentence of paragraph (e) and paragraph (k)(4) to read as follows:

**§ 1.29 Micro entity status.**

\* \* \* \* \*

(e) Micro entity status is established in an application by filing a micro entity certification in writing complying with the requirements of either paragraph (a) or

paragraph (d) of this section and signed either in compliance with § 1.33(b) or in an international application filed in a Receiving Office other than the United States Receiving Office by a person authorized to represent the applicant under § 1.455. \* \* \*

\* \* \* \* \*

(k) \* \* \*

(4) Any deficiency payment (based on a previous erroneous payment of a micro entity fee) submitted under this paragraph will be treated as a notification of a loss of entitlement to micro entity status under paragraph (i) of this section.

8. Section 1.51 is amended by revising paragraph (a) to read as follows:

**§ 1.51 General requisites of an application.**

(a) Applications for patents must be made to the Director of the United States Patent and Trademark Office. An application transmittal letter limited to the transmittal of the documents and fees comprising a patent application under this section may be signed by a juristic applicant or patent owner.

\* \* \* \* \*

9. Section 1.53 is amended by revising the introductory text of paragraphs (b) and (c), and revising paragraphs (f)(1), (f)(2) and (f)(3)(ii) to read as follows:

**§ 1.53 Application number, filing date, and completion of application.**

\* \* \* \* \*

(b) Application filing requirements—Nonprovisional application. The filing date of an application for patent filed under this section, other than an application for a design patent or a provisional application under paragraph (c) of this section, is the date on which a specification, with or without claims is received in the Office. The filing date of an application for a design patent filed under this section, except for a continued prosecution application under paragraph (d) of this section, is the date on which the specification as prescribed by 35 U.S.C. 112, including at least one claim, and any required drawings are received in the Office. No new matter may be introduced into an application after its filing date. A continuing application, which may be a continuation, divisional, or continuation-in-part application, may be filed under the conditions specified in 35 U.S.C. 120, 121, or 365(c) and §§ 1.78(c) and (d).

\* \* \* \* \*

(c) Application filing requirements—Provisional application. The filing date of a provisional application is the date on which a specification, with or without claims is received in the Office. No amendment, other than to make the provisional application comply with the patent statute and all applicable regulations, may be made to the provisional application after the filing date of the provisional application.

\* \* \* \* \*

(f) Completion of application subsequent to filing—Nonprovisional (including continued prosecution or reissue) application. (1) If an application which has been accorded a filing date pursuant to paragraph (b) or (d) of this section does not include the basic filing fee, the search fee, or the examination fee, or if an application which has been accorded a

filings date pursuant to paragraph (b) of this section does not include at least one claim or the inventor's oath or declaration (§§ 1.63, 1.64, 1.162 or 1.175), and the applicant has provided a correspondence address (§ 1.33(a)), the applicant will be notified and given a period of time within which to file a claim or claims, pay the basic filing fee, search fee, and examination fee, and pay the surcharge if required by § 1.16(f) to avoid abandonment.

(2) If an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include the basic filing fee, the search fee, the examination fee, at least one claim, or the inventor's oath or declaration, and the applicant has not provided a correspondence address (§ 1.33(a)), the applicant has three months from the filing date of the application within which to file a claim or claims, pay the basic filing fee, search fee, and examination fee, and pay the surcharge required by § 1.16(f) to avoid abandonment.

(3) \* \* \*

(ii) The applicant must file each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, no later than the date on which the issue fee for the patent is paid. If the applicant is notified in a notice of allowability that an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each named inventor has not been filed, the applicant must file each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, no later than the date on which the issue fee is paid to avoid abandonment. This time period is not extendable under § 1.136 (see § 1.136(c)). The Office may dispense with the notice provided for in paragraph

(f)(1) of this section if each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, has been filed before the application is in condition for allowance.

\* \* \* \* \*

10. 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, unless the application is an application filed under § 1.53(d). A letter limited to a request for a filing receipt may be signed by a juristic applicant or patent owner.

11. Section 1.55 is amended by revising paragraphs (b), (c), and (e), and the introductory text of paragraph (i) to read as follows:

**§ 1.55 Claim for foreign priority.**

\* \* \* \* \*

(b) Time for filing subsequent application. (1) Except as provided in paragraph (b)(2) of this section, the nonprovisional application must be filed not later than twelve months (six months in the case of a design application) after the date on which the foreign application was filed, or be entitled to claim the benefit under 35 U.S.C. 120, 121,

or 365(c) of an application that was filed not later than twelve months (six months in the case of a design application) after the date on which the foreign application was filed.

The twelve-month period is subject to 35 U.S.C. 21(b) (and § 1.7(a)) and PCT Rule 80.5, and the six-month period is subject to 35 U.S.C. 21(b) (and § 1.7(a)).

(2) If the subsequent application has a filing date which is after the expiration of the twelve-month period (six-month period in the case of a design application) set forth in paragraph (b)(1) of this section but within two months from the expiration of the period set forth in paragraph (b)(1) of this section, the right of priority in the subsequent application may be restored under PCT Rule 26bis.3 for an international application or upon petition if the delay in the subsequent application within the period set forth in paragraph (b)(1) of this section was unintentional. A petition to restore the right of priority under this paragraph filed in the subsequent application must include:

(i) The priority claim under 35 U.S.C. 119(a) through (d) or (f), or 365(a) or (b) in an application data sheet (§ 1.76(b)(6)), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, unless previously submitted;

(ii) The petition fee as set forth in § 1.17(m); and

(iii) A statement that the delay in filing the subsequent application within the twelve-month period (six-month period in the case of a design application) as set forth in paragraph (b)(1) of this section was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(c) Time for filing priority claim and certified copy of foreign application in an application entering the national stage under 35 U.S.C. 371. In an international

application entering the national stage under 35 U.S.C. 371, the claim for priority must be made and a certified copy of the foreign application must be filed within the time limit set forth in the PCT and the Regulations under the PCT. If a certified copy of the foreign application is not filed during the international stage, a certified copy of the foreign application must be filed within four months from the date of entry into the national stage as set forth in § 1.491 or sixteen months from the filing date of the prior-filed foreign application, except as provided in paragraphs (h) and (i) of this section. If a certified copy of the foreign application is not filed within four months from the date of entry into the national stage as set forth in § 1.491 or sixteen months from the filing date of the prior-filed foreign application, and the exceptions in paragraphs (h) and (i) of this section are not applicable, the certified copy of the foreign application must be accompanied by a petition including a showing of good and sufficient cause for the delay and the petition fee set forth in § 1.17(g).

\* \* \* \* \*

(e) Delayed priority claim in an application filed under 35 U.S.C. 111(a) or in a national stage application under 35 U.S.C. 371. Unless such claim is accepted in accordance with the provisions of this paragraph, any claim for priority under 35 U.S.C. 119(a) through (d) or (f), or 365(a) or (b) in an original application filed under 35 U.S.C. 111(a) not presented in an application data sheet (§ 1.76(b)(6)), or in a national stage application under 35 U.S.C. 371 not presented in accordance with the PCT and the Regulations under the PCT, within the time period provided by paragraph (c) or (d) of this section is considered to have been waived. If a claim for priority is presented after the time period provided by paragraph (c) or (d) of this section, the claim may be

accepted if the priority claim was unintentionally delayed. A petition to accept a delayed claim for priority under 35 U.S.C. 119(a) through (d) or (f), or 365(a) or (b) must be accompanied by:

- (1) The priority claim under 35 U.S.C. 119(a) through (d) or (f), or 365(a) or (b) in an application data sheet (§ 1.76(b)(6)), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, unless previously submitted;
- (2) A certified copy of the foreign application if required by paragraph (c) or (f) of this section, unless previously submitted;
- (3) The petition fee as set forth in § 1.17(m); and
- (4) A statement that the entire delay between the date the priority claim was due under paragraph (c) or (d) of this section and the date the priority claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

\* \* \* \* \*

(i) Interim copy. The requirement in paragraph (c) or (f) for a certified copy of the foreign application to be filed within the time limit set forth therein will be considered satisfied if:

\* \* \* \* \*

12. Section 1.57 is amended by redesignating paragraphs (a) through (g) as paragraphs (b) through (h), respectively, and adding paragraphs (a) and (i) to read as follows:

**§ 1.57 Incorporation by reference.**

(a) Subject to the conditions and requirements of this paragraph, a reference made in the English language in an application data sheet in accordance with § 1.76 upon the filing of an application under 35 U.S.C. 111(a) to a previously filed application, indicating that the specification and any drawings of the application are replaced by the reference to the previously filed application, and specifying the previously filed application by application number, filing date, and the intellectual property authority or country in which the application was filed, shall constitute the specification and any drawings of the subsequent application for purposes of a filing date under § 1.53(b).

(1) If the applicant has provided a correspondence address (§ 1.33(a)), the applicant will be notified and given a period of time within which to file a copy of the specification and drawings from the previously filed application, an English language translation of the previously filed application and the fee required by § 1.17(i) if it is in a language other than English, and pay the surcharge required by § 1.16(f) to avoid abandonment. Such a notice may be combined with a notice under § 1.53(f).

(2) If the applicant has not provided a correspondence address (§ 1.33(a)), the applicant has three months from the filing date of the application to file a copy of the specification and drawings from the previously filed application, an English language translation of the previously filed application and the fee required by § 1.17(i) if it is in a language other than English, and pay the surcharge required by § 1.16(f) to avoid abandonment.

(3) An application abandoned under paragraph (a)(1) or (a)(2) of this section shall be treated as having never been filed, unless:

- (i) The application is revived under § 1.137; and
- (ii) A copy of the specification and any drawings of the previously filed application are filed in the Office.

(4) A certified copy of the previously filed application must be filed in the Office or received by the Office from a foreign intellectual property office participating in a priority document exchange agreement within the later of four months from the filing date of the application or sixteen months from the filing date of the previously filed application, unless the previously filed application is an application filed under 35 U.S.C. 111 or 363. Failure to comply with this requirement will result in the application not being accorded a filing date earlier than the date a copy of the specification and drawings from the previously filed application is filed in or received by the Office in the absence of a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(f).

\* \* \* \* \*

(i) An application transmittal letter limited to the transmittal of a copy of the specification and drawings from a previously filed application submitted under paragraph (a) or (b) of this section may be signed by a juristic applicant or patent owner.

13. Section 1.58 is amended by revising paragraph (a) to read as follows:

**§ 1.58 Chemical and mathematical formulae and tables.**

(a) The specification, including the claims, may contain chemical and mathematical formulae, but shall not contain drawings or flow diagrams. The description portion of the specification may contain tables, but the same tables should not be included in both the drawings and description portion of the specification. Claims may contain tables either if necessary to conform to 35 U.S.C. 112 or if otherwise found to be desirable.

\* \* \* \* \*

14. 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” or “Abstract of the Disclosure.” The sheet or sheets presenting the abstract may not include other parts of the application or other material. The abstract must be as concise as the disclosure permits, preferably not exceeding 150 words in length. The purpose of the abstract is to enable the Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure.

15. Section 1.76 is amended by revising paragraph (b)(3) and adding a new paragraph (f) to read as follows:

**§ 1.76 Application data sheet.**

\* \* \* \* \*

(b) \* \* \*

(3) Application information. This information includes the title of the invention, the total number of drawing sheets, a suggested drawing figure for publication (in a nonprovisional application), any docket number assigned to the application, the type of application (e.g., utility, plant, design, reissue, provisional), whether the application discloses any significant part of the subject matter of an application under a secrecy order pursuant to § 5.2 of this chapter (see § 5.2(c)), and, for plant applications, the Latin name of the genus and species of the plant claimed, as well as the variety denomination. This information also includes the reference to the previously filed application, indicating that the specification and any drawings of the application are replaced by the reference to the previously filed application, and specifying the previously filed application by application number, filing date, and the intellectual property authority or country in which the application was filed, for an application filed by reference to a previously filed application under § 1.57(a).

\* \* \* \* \*

(f) Patent Law Treaty Model International Forms. The requirement in § 1.55 or § 1.78 for the presentation of a priority or benefit claim under 35 U.S.C. 119, 120, 121, or 365 in an application data sheet will be satisfied by the presentation of such priority or benefit claim in the Patent Law Treaty Model International Request Form, and the requirement in § 1.57(a) for a reference to the previously filed application in an application data sheet will be satisfied by the presentation of such reference to the

previously filed application in the Patent Law Treaty Model International Request Form. The requirement in § 1.46 for the presentation of the name of the applicant under 35 U.S.C. 118 in an application data sheet will be satisfied by the presentation of the name of the applicant in the Patent Law Treaty Model International Request Form, Patent Law Treaty Model International Request for Recordation of Change in Name or Address Form, or Patent Law Treaty Model International Request for Recordation of Change in Applicant or Owner Form, as applicable. The requirement in § 1.55 or § 1.78 for the presentation of a priority or benefit claim under 35 U.S.C. 119, 120, 121, or 365 in an application data sheet and the requirement in § 1.46 for the presentation of the name of the applicant under 35 U.S.C. 118 in an application data sheet will also be satisfied by the presentation of such priority or benefit claim and presentation of the name of the applicant in a Patent Cooperation Treaty Request Form if the Patent Cooperation Treaty Request Form is accompanied by a clear indication that treatment of the application as an application under 35 U.S.C. 111 is desired.

16. Section 1.78 is amended by revising paragraphs (a)(1), (a)(4), (b), (c)(3), and (d)(2) to read as follows:

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

(a) \* \* \*

(1)(i) Except as provided in paragraph (a)(1)(ii) of this section, the nonprovisional application or international application designating the United States of America must be

filed not later than twelve months after the date on which the provisional application was filed, or be entitled to claim the benefit under 35 U.S.C. 120, 121, or 365(c) of an application that was filed not later than twelve months after the date on which the provisional application was filed. This twelve-month period is subject to 35 U.S.C. 21(b) (and § 1.7(a)) and PCT Rule 80.5.

(ii) If the nonprovisional application or international application designating the United States of America has a filing date which is after the expiration of the twelve-month period set forth in paragraph (a)(1)(i) of this section but within two months from the expiration of the period set forth in paragraph (a)(1)(i) of this section, the benefit of the provisional application may be restored under PCT Rule 26bis.3 for an international application or upon petition if the delay in filing the nonprovisional application or international application designating the United States of America within the period set forth in paragraph (a)(1)(i) of this section was unintentional. A petition to restore the benefit of the provisional application under this paragraph filed in the nonprovisional application or international application designating the United States of America must include:

- (A) The reference required by 35 U.S.C. 119(e) and paragraph (a)(3) of this section to the prior-filed provisional application, unless previously submitted;
- (B) The petition fee as set forth in § 1.17(m); and
- (C) A statement that the delay in filing the nonprovisional application or international application designating the United States of America within the twelve-month period set forth in paragraph (a)(1)(i) of this section was unintentional. The

Director may require additional information where there is a question whether the delay was unintentional.

(iii) The restoration of the right of priority under PCT Rule 26bis.3 to a provisional application does not affect the requirement to include the reference required by paragraph (a)(3) of this section to the provisional application in a national stage application under 35 U.S.C. 371 within the time period provided by paragraph (a)(4) of this section to avoid the benefit claim being considered waived.

\* \* \* \* \*

(4) The reference required by paragraph (a)(3) of this section must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed provisional application. If the later-filed application is a national stage application under 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or sixteen months from the filing date of the prior-filed provisional application. Except as provided in paragraph (b) of this section, failure to timely submit the reference is considered a waiver of any benefit under 35 U.S.C. 119(e) of the prior-filed provisional application.

\* \* \* \* \*

(b) Delayed claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application. If the reference required by 35 U.S.C. 119(e) and paragraph

(a)(3) of this section is presented in an application after the time period provided by paragraph (a)(4) of this section, the claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application may be accepted if the reference identifying the prior-filed application by provisional application number was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application must be accompanied by:

- (1) The reference required by 35 U.S.C. 119(e) and paragraph (a)(3) of this section to the prior-filed provisional application, unless previously submitted;
- (2) The petition fee as set forth in § 1.17(m); and
- (3) A statement that the entire delay between the date the benefit claim was due under paragraph (a)(4) of this section and the date the benefit claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

\* \* \* \* \*

(c) \* \* \*

- (3) The reference required by 35 U.S.C. 120 and paragraph (c)(2) of this section must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the later-filed application is a nonprovisional application entering the national stage from an international application under 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced

under 35 U.S.C. 371(b) or (f) in the later-filed international application, four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or sixteen months from the filing date of the prior-filed application. Except as provided in paragraph (d) of this section, failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (c)(2) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to the prior-filed application. The time periods in this paragraph do not apply in a design application.

\* \* \* \* \*

(d) \* \* \*

(2) The petition fee as set forth in § 1.17(m); and

\* \* \* \* \*

17. Section 1.81 is amended by revising paragraph (a) to read as follows:

**§ 1.81 Drawings required in patent application.**

(a) The applicant for a patent is required to furnish a drawing of his or her invention where necessary for the understanding of the subject matter sought to be patented. Since corrections are the responsibility of the applicant, the original drawing(s) should be retained by the applicant for any necessary future correction.

\* \* \* \* \*

18. Section 1.83 is amended by revising paragraph (a) to read as follows:

**§ 1.83 Content of drawing.**

(a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box). In addition, tables that are included in the specification and sequences that are included in sequence listings should not be duplicated in the drawings.

\* \* \* \* \*

19. Section 1.85 is amended by revising paragraph (c) to read as follows:

**§ 1.85 Corrections to drawings.**

\* \* \* \* \*

(c) If a corrected drawing is required or if a drawing does not comply with § 1.84 at the time an application is allowed, the Office may notify the applicant in a notice of allowability and set a three-month period of time from the mail date of the notice of allowability within which the applicant must file a corrected drawing in compliance with § 1.84 to avoid abandonment. This time period is not extendable under § 1.136 (see § 1.136(c)).

20. Section 1.137 is amended by revising its section heading and paragraphs (a), (b), (c), (e) and (f) to read as follows:

**§ 1.137 Revival of abandoned application, or terminated or limited reexamination prosecution.**

(a) Revival on the basis of unintentional delay. If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this section to revive an abandoned application or a reexamination prosecution terminated under § 1.550(d) or § 1.957(b) or limited under § 1.957(c).

(b) Petition requirements. A grantable petition pursuant to this section must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this section was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

(c) Reply. In an application abandoned under § 1.57(a), the reply must include a copy of the specification and any drawings of the previously filed application. In an application or patent abandoned for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application abandoned for failure to pay the publication fee, the required reply must

include payment of the publication fee. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, abandoned after the close of prosecution as defined in § 1.114(b), the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114.

\* \* \* \* \*

(e) Request for reconsideration. Any request for reconsideration or review of a decision refusing to revive an abandoned application, or a terminated or limited reexamination prosecution, upon petition filed pursuant to this section, to be considered timely, must be filed within two months of the decision refusing to revive or within such time as set in the decision. Unless a decision indicates otherwise, this time period may be extended under:

- (1) The provisions of § 1.136 for an abandoned application;
- (2) The provisions of § 1.550(c) for a terminated ex parte reexamination prosecution, where the ex parte reexamination was filed under § 1.510; or
- (3) The provisions of § 1.956 for a terminated inter partes reexamination prosecution or an inter partes reexamination limited as to further prosecution, where the inter partes reexamination was filed under § 1.913.

(f) Abandonment for failure to notify the Office of a foreign filing. A nonprovisional application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to timely notify the Office of the filing of an application in a foreign country or under a multinational treaty that requires publication of applications eighteen months after filing,

may be revived pursuant to this section. The reply requirement of paragraph (c) of this section is met by the notification of such filing in a foreign country or under a multinational treaty, but the filing of a petition under this section will not operate to stay any period for reply that may be running against the application.

\* \* \* \* \*

21. Section 1.290 is amended by revising paragraph (f) to read as follows:

**§ 1.290 Submissions by third parties in applications.**

\* \* \* \* \*

(f) Any third-party submission under this section must be accompanied by the fee set forth in § 1.17(o) for every ten items or fraction thereof identified in the document list.

\* \* \* \* \*

**§ 1.317 [Reserved]**

22. Section 1.317 is removed and reserved.

23. Section 1.366 is amended by revising paragraph (a) to read as follows:

**§ 1.366 Submission of maintenance fees.**

(a) The patentee may pay maintenance fees and any necessary surcharges, or any person or organization may pay maintenance fees and any necessary surcharges on behalf of a patentee. A maintenance fee transmittal letter may be signed by a juristic applicant or patent owner. A patentee need not file authorization to enable any person or organization to pay maintenance fees and any necessary surcharges on behalf of the patentee.

\* \* \* \* \*

24. Section 1.378 is revised to read as follows:

**§ 1.378 Acceptance of delayed payment of maintenance fee in expired patent to reinstate patent.**

(a) The Director may accept the payment of any maintenance fee due on a patent after expiration of the patent if, upon petition, the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been unintentional. If the Director accepts payment of the maintenance fee upon petition, the patent shall be considered as not having expired, but will be subject to the conditions set forth in 35 U.S.C. 41(c)(2).

(b) Any petition to accept an unintentionally delayed payment of a maintenance fee must include:

- (1) The required maintenance fee set forth in § 1.20(e) through (g);
- (2) The petition fee as set forth in § 1.17(m); and

(3) A statement that the delay in payment of the maintenance fee was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(c) Any petition under this section must be signed in compliance with § 1.33(b).

(d) Reconsideration of a decision refusing to accept a maintenance fee may be obtained by filing a petition for reconsideration within two months of the decision, or such other time as set in the decision refusing to accept the delayed payment of the maintenance fee. Any such petition for reconsideration must be accompanied by the petition fee set forth in § 1.17(f).

(e) If the delayed payment of the maintenance fee is not accepted, the maintenance fee will be refunded following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed. Any petition fee under this section will not be refunded unless the refusal to accept and record the maintenance fee is determined to result from an error by the Office.

25. Section 1.452 is amended by removing paragraph (d) and revising paragraph (b)(2) to read as follows:

**§ 1.452 Restoration of right of priority.**

\* \* \* \* \*

(b) \* \* \* \* \*

(2) The petition fee as set forth in § 1.17(m); and

\* \* \* \* \*

26. Section 1.495 is amended by revising paragraph (c)(3)(ii) to read as follows:

**§ 1.495 Entering the national stage in the United States of America.**

\* \* \* \* \*

(c) \* \* \*

(3) \* \* \*

(ii) The applicant must file each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, no later than the date on which the issue fee for the patent is paid. If the applicant is notified in a notice of allowability that an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each named inventor has not been filed, the applicant must file each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, no later than the date on which the issue fee is paid to avoid abandonment. This time period is not extendable under § 1.136 (see § 1.136(c)). The Office may dispense with the notice provided for in paragraph (c)(1) of this section if each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, has been filed before the application is in condition for allowance.

\* \* \* \* \*

27. Section 1.704 is amended by redesignating paragraphs (c)(11) and (c)(12) as paragraphs (c)(12) and (c)(13), respectively, and adding new paragraphs (c)(11) and (f) to read as follows:

**§ 1.704 Reduction of period of adjustment of patent term.**

\* \* \* \* \*

(c) \* \* \*

(11) Failure to provide an application in condition for examination as defined in paragraph (f) of this section within eight months from either the date on which the application was filed under 35 U.S.C. 111(a) or the date of commencement of the national stage under 35 U.S.C. 371(b) or (f) in an international application, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is eight months from either the date on which the application was filed under 35 U.S.C. 111(a) or the date of commencement of the national stage under 35 U.S.C. 371(b) or (f) in an international application and ending on the date the application is in condition for examination as defined in paragraph (f) of this section.

\* \* \* \* \*

(f) An application filed under 35 U.S.C. 111(a) is in condition for examination when the application includes a specification, including at least one claim and an abstract (§ 1.72(b)), and has papers in compliance with § 1.52, drawings (if any) in compliance with § 1.84, any English translation required by § 1.52(d) or § 1.57(a), a sequence listing in compliance with § 1.821 through § 1.825 (if applicable), the inventor's oath or

declaration or application data sheet containing the information specified in § 1.63(b), the basic filing fee (§ 1.16(a) or § 1.16(c)), any certified copy of the previously filed application required by § 1.57(a), and any application size fee required by the Office under § 1.16(s). An international application is in condition for examination when the application has entered the national stage as defined in § 1.491(b), and includes a specification, including at least one claim and an abstract (§ 1.72(b)), and has papers in compliance with § 1.52, drawings (if any) in compliance with § 1.84, a sequence listing in compliance with § 1.821 through § 1.825 (if applicable), the inventor's oath or declaration or application data sheet containing the information specified in § 1.63(b), and any application size fee required by the Office under § 1.492(j).

28. Section 1.809 is amended by revising paragraph (c) to read as follows:

**§ 1.809 Examination procedures.**

\* \* \* \* \*

(c) If an application for patent is otherwise in condition for allowance except for a needed deposit and the Office has received a written assurance that an acceptable deposit will be made, the Office may notify the applicant in a notice of allowability and set a three-month period of time from the mail date of the notice of allowability within which the deposit must be made in order to avoid abandonment. This time period is not extendable under § 1.136 (see § 1.136(c)).

\* \* \* \* \*

## **PART 3--ASSIGNMENT, RECORDING AND RIGHTS OF ASSIGNEE**

29. The authority citation for part 3 continues to read as follows:

**Authority:** 15 U.S.C. 1123; 35 U.S.C. 2(b)(2).

30. Section 3.11 is amended by revising paragraph (a) to read as follows:

### **§ 3.11 Documents which will be recorded.**

(a) Assignments of applications, patents, and registrations, and other documents relating to interests in patent applications and patents, accompanied by completed cover sheets as specified in § 3.28 and § 3.31, will be recorded in the Office. Other documents, accompanied by completed cover sheets as specified in § 3.28 and § 3.31, affecting title to applications, patents, or registrations, will be recorded as provided in this part or at the discretion of the Director.

\* \* \* \* \*

31. Section 3.31 is amended by revising paragraph (h) to read as follows:

### **§ 3.31 Cover sheet content.**

\* \* \* \* \*

(h) The assignment cover sheet required by § 3.28 for a patent application or patent will be satisfied by the Patent Law Treaty Model International Request for

Recordation of Change in Applicant or Owner Form, Patent Law Treaty Model International Request for Recordation of a License/Cancellation of the Recordation of a License Form, Patent Law Treaty Model Certificate of Transfer Form or Patent Law Treaty Model International Request for Recordation of a Security Interest/Cancellation of the Recordation of a Security Interest Form, as applicable, except where the assignment is also an oath or declaration under § 1.63 of this chapter. An assignment cover sheet required by § 3.28 must contain a conspicuous indication of an intent to utilize the assignment as an oath or declaration under § 1.63 of this chapter.

Date: April 1, 2013

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Teresa Stanek Rea  
Acting Under Secretary of Commerce for Intellectual Property and  
Acting Director of the United States Patent and Trademark Office

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