Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan,
Notice of Proposed Rule Making,
68 FR 53815 (September 12, 2003);


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October 30, 2003
Electronic Signatures
37 CFR § 1.4

- An electronic signature (e-signature), personally typed by the signer on a computer, will be accepted when FINAL Rule making is implemented.

- As proposed, an e-signature would be permitted on certain correspondence filed in a patent application, patent, or reexamination proceeding when:
  A. The signer e-signs the correspondence on a computer; and
  B. The e-signed correspondence is:
     ■ Transmitted directly via facsimile from a computer to the Office; or
     ■ Printed on a paper and then transmitted via facsimile, mailed or hand-carried to the Office.
Electronic Signatures
37 CFR § 1.4

For example:

- Practitioner may create a document and e-sign it on a computer, and then transmit it via facsimile directly from the computer to the Office.

- An affidavit or a declaration may be e-signed by an applicant, and then electronically sent to the practitioner, e.g., via the Internet. The practitioner can transmit the e-signed document via facsimile directly from a computer to the Office or mail a paper copy of the e-signed document to the Office.
Electronic Signatures
37 CFR § 1.4

E-Signature advantages:

A. Permits applicants and third parties without access to scanners and facsimile machines to e-sign electronic documents (e.g., affidavits or declarations) and return them to a practitioner by e-mail.

B. Saves time by allowing facsimile transmission to the Office directly from a computer without first printing on paper and then faxing the paper version.

C. Permits practitioners to automate their records and electronically maintain signed documents.
Electronic Signatures

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Additional authentication burdens for E-Signature:

A. Software and hardware are constantly evolving, so that it may be difficult to access old electronic records (e.g., magnetic cards, 8.5 inch floppy discs). Similarly, replicating how the document appeared to the signer may be difficult because of track changes/notes embedded in the document, screen size, screen resolution, print driver and differences in software versions.

B. Chain of custody, non-alteration of document and (in case of repudiation) authentication of signature more difficult to document as many practitioners don’t log the electronic movement of messages and their modification.
Electronic Signatures
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Requirements:
A. Correspondence containing an e-signature must be sent to the Office by approved means for that type of correspondence:
   - Transmission via facsimile or the Office’s Electronic Filing System (EFS) directly from a computer to the Office;
   - Transmission via facsimile of a paper copy of the e-signed correspondence to the Office; or
   - Mail or hand-carry a paper copy of the e-signed correspondence to the Office.

Note:
   - E-mailing the correspondence directly to the Office still will not be permitted; and
   - New applications still will not be accepted via facsimile.
**Electronic Signatures**

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**Requirements (continued):**

B. The *e-signature* must be composed only of **letters** and/or **numbers between two forward slashes** (/…/), including **punctuation marks, spaces and titles**.

- A registration number that is part of the e-signature may contain the number character (#).
- For example: /Julie B. SMITH, Reg. #99999/

C. The *family name* must be entirely in **capital letters** when it is included in the actual name or registered name.

- Only the family name can be entirely in capital letters.
- For example: /Able Quincy INVENTOR/
Requirements (continued):

D. Practitioners signing pursuant to

§ 1.33(b)(1) (of record) and

§ 1.33(b)(2) (not of record but acting in representative capacity)

must:

1. Use their complete registered name as the e-signature; and

2. Place their registration number either in the e-signature or adjacent to the e-signature. For example:

   /Julie B. SMITH, Reg. #99999/
   /Julie B. SMITH/ Reg. #99999

*This would be a new requirement for 37 CFR 1.33(b)(1).
Electroninc Signatures
37 CFR § 1.4

Requirements (continued):

E. For non-practitioner signers
   (signatures other than under 37 CFR 1.33(b)(1) and (b)(2)),

1. The e-signature must be the signer’s actual name
   (including given name, middle name and family name); or
   • For example: /Able Quincy INVENTOR/

2. If the actual name is not used as part of the e-signature,
   • The actual name must also be
     • provided immediately below the e-signature and
     • indicated to be the signer’s actual name. For example:
       /Able Q. Inventor/
       Able Quincy INVENTOR – Signer’s Actual Name
Ratification of an e-signature may be required where there is reasonable doubt as to the authenticity of the e-signature; for example:

A. Where there are variations in the e-signature from one document to another; or

B. Where a document contains the name of the signer in its text without some indication of the family name, such as by all capital letters.
13 Examples

- **Registered practitioners** signing pursuant to 37 CFR 1.33(b)(1) or 1.33(b)(2)
  
  See Examples 1 – 6 **ONLY**

- **Any other signature** (e.g., on: declarations, affidavits, assignment statements, or any paper by a *pro se* applicant)
  
  See Examples 7-13 **ONLY**
Electronic Signatures, 37 CFR § 1.4

Example 1

Option 1:  /John T. PRACTITIONER, Reg. #123456/
Option 2:  /John T. PRACTITIONER/ Reg. #123456

These are the required e-signature options for a registered practitioner who is signing pursuant to § 1.33(b)(1) or (b)(2).

Either option is a proper e-signature because:

1. It is between two forward slashes (/…/);
2. It is the registered name of the practitioner (note: this would be a new requirement for registered practitioners);
3. Only the family name is entirely in capital letters;
4. The e-signature is composed of letters, numbers, spaces, and punctuation marks; and
5. The registration number with a number character is part of the e-signature (Option 1) or adjacent to the e-signature (Option 2).
The word (number), the abbreviation (No.) or the number character (#) for the registration number is acceptable. See Ex. 2.

If the practitioner’s registered name is “John Thomas Practitioner,” then the e-signature must be either:

- **Option 3:**
  
  /John Thomas PRACTITIONER, Reg. #123456/; or

- **Option 4:**
  
  /John Thomas PRACTITIONER/ Reg. #123456.
Example 1 (continued)

Correspondence with an e-signature of a registered practitioner as set forth in options 1, 2, 3 or 4, depending on the person’s name, as registered, of Ex. 1 will be accepted.

Conversely, correspondence with an e-signature of a registered practitioner that does not follow the format of Ex. 1, or one of the acceptable variations in Ex. 2, 3, 4, and 6 will be treated as unsigned.
Situation: The practitioner’s registered name including a hyphenated family name and a title (e.g., Ph.D.) is presented.

The e-signature on the correspondence is:

/Julie B. SMITH-JONES, Ph.D./
Reg. No. 99999

Question: Is this a proper e-signature?
Electronic Signatures, 37 CFR § 1.4
Example 2 (continued)

Answer: Yes

This is a **proper** e-signature because:

1. The signature is between two forward slashes (/…/);
2. The signature is composed only of letters, numbers, and punctuation marks (**the hyphen in the name is acceptable**);
3. **The signature may include a title** (e.g., Ph.D.) in addition to the registered name;
4. Only the family name is entirely in capital letters (both parts of the hyphenated family name must be capitalized); and
5. The practitioner’s registration number is presented, but it does not have to be within the slash marks.

Correspondence with an e-signature as set forth in Ex. 2 will be accepted.
Electronic Signatures, 37 CFR § 1.4

Example 3A

**Situation:** Ex. 3A and 3B address the situation of a practitioner who has changed her name since she registered with the Office.

The practitioner’s names are as follows:

Registered Name: Julie Smith
Current Actual Name: Julie Smith-Jones

The e-signature on the correspondence is:

/Julie SMITH, Reg. No. 99999/
Julie SMITH-JONES – signer’s actual name

**Question:** Is this a proper e-signature?
Answer: Yes

This is a proper e-signature because:

1. The practitioner signed her name, as registered.
   Note: This would be a mandatory requirement.

2. Below the e-signature:
   i. The person’s actual name is presented; and
   ii. It is specifically identified by the words: “signer’s actual name”

   Note: Either these exact words, or some equivalent, must be present!

See Ex. 2 for additional reasons why this is a proper e-signature.

Correspondence with an e-signature as set forth in Ex. 3A will be accepted.

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Electronic Signatures, 37 CFR § 1.4
Example 3B

Situation: This is the same as in Ex. 3A except the attorney signs her current actual name instead of her registered name.

The e-signature on the correspondence is:

/Julie SMITH-JONES/ - Signer’s Legal Name
Julie SMITH, Reg. No. 99999

Question: Is this a proper e-signature?
Answer: No

This is an improper e-signature because:

1. The e-signature is not the practitioner’s name, as registered.
   - A practitioner is required to sign her name, as registered.
   - The e-signature would have been accepted for a non-practitioner.

2. Supplying the registered name (i.e., Julie Smith) below the e-signature does not correct the defective e-signature.

Correspondence with an e-signature as set forth in Ex. 3B will be treated as unsigned; see Ex. 3A for a correct e-signature.
Situation: Ex. 4A, 4B and 4C address the situation of a registered practitioner attempting to sign for another registered practitioner.

The e-signature on the correspondence is:

/John T. PRACTITIONER/
for Julie B. Smith, Reg. No. 99999

Question: Is this a proper e-signature?
Electronic Signatures, 37 CFR § 1.4
Example 4A (continued)

Answer: No

This is an improper e-signature because:

1. It is not personally signed by Julie B. Smith; and
   - 37 CFR 10.18(a) requires that each piece of correspondence filed by a registered practitioner must bear a signature, personally signed by that practitioner.

2. No registration number was provided for John T. Practitioner, the practitioner who e-signed the correspondence.
   See Ex. 4B for an acceptable e-signature.

Correspondence with an e-signature as set forth in Ex. 4A will be treated as unsigned.
See Ex. 6 for a practitioner signing for an inventor.
Ex. 4B is the same as Ex. 4A but the e-signer provided his registration number.

The e-signature on the correspondence is:

/John T. PRACTITIONER, Reg. #123456/
for Julie B. Smith, Reg. No. 99999

Question 1: Can the e-signature be accepted under § 1.33(b)(1) or (b)(2) despite the indication that it is being signed “for” another?

Question 2: If the answer to question 1 is yes, is this a proper e-signature?
Answer for Question 1: Yes

- The e-signature can be accepted if it separately qualifies on the basis of John T. Practitioner signing for himself as a registered practitioner with a proper e-signature.
- The line below the e-signature does not cause the proper e-signature to become ineffective.

- John T. Practitioner’s signature for Julie B. Smith is acceptable.
- See the preamble to the rule change adopting 37 CFR 10.18 (50 FR 5161 (February 6, 1985)).
Answer for Question 2: Yes

The e-signature is *proper* because:

1. John T. Practitioner e-signed with his registered name and registration number;
2. Only the e-signer’s family name is entirely in capital letters;
3. The e-signature is between two forward slashes (/…/);
4. The e-signature is composed entirely of letters, numbers, spaces, punctuation marks and the number character (#) with a registration number.

Correspondence with an e-signature as set forth in Ex. 4B will be accepted.
Example 4C

Ex. 4C is the same as Ex. 4B but the e-signer signs “by” instead of “for”.

The e-signature on the correspondence is:

Julie B. Smith, Reg. #99999
by /John T. Practitioner, Reg. No. 123456/

Question 1: Can the e-signature be accepted under §1.33(b)(1) or (b)(2) despite the indication that it is being signed “by” another?

Question 2: If the answer to question 1 is yes, is this a proper e-signature?
Electronic Signatures, 37 CFR § 1.4
Example 4C (continued)

Answer for Question 1: Yes

- The e-signature can be accepted if it separately qualifies on the basis of John T. Practitioner signing for himself as a registered practitioner with a proper e-signature.
- The line on top of the e-signature does not cause the proper e-signature to become ineffective.

- John T. Practitioner’s signature is acceptable as a signature for Julie B. Smith.
- See the preamble to the rule change adopting 37 CFR 10.18 (50 FR 5161 (February 6, 1985)).
- The X “by” Y format is equivalent to the Y “for” X format in Ex. 4B.
Answer for Question 2: Yes

The e-signature is proper because:

1. John T. Practitioner e-signed with his registered name and registration number;
2. Only the signer’s family name is entirely in capital letters;
3. The e-signature is between two forward slashes (/…/); and
4. The e-signature is composed entirely of letters, numbers, spaces, punctuation marks, and the number character (#) with a registration number.

Correspondence with an e-signature as set forth in Ex. 4C will be accepted.
Situation: A customer number (CN) is used as the e-signature and the practitioners associated with the CN are of record in the application.

The e-signature on the correspondence is:

/Customer no. 15123/

Law Offices of PETER B. BLACK & ARNOLD N. GRAY

Question: Is this a proper e-signature?
Answer: No

This is an **improper** e-signature because:

- Practitioners must use their names, as registered, as their signatures.
- Other defects:
  1. The e-signature is not an actual name;
  2. The signer’s actual name are not identified; and
  3. Names other than the family name of the signer are in all capital letters.

Correspondence with an e-signature as set forth in Ex. 5 will be treated as unsigned.
Example 6A

Situation: The correspondence is expressly signed by an attorney of record on behalf of an inventor.

- Note that these provisions do not expand a patent practitioner’s ability to sign on behalf of an inventor.

The e-signature on the correspondence is:

/Able INVENTOR by John T. PRACTITIONER/

Question: Is this a proper e-signature?
Answer: No

This is an **improper** e-signature because:

- Two persons’ names in a single e-signature will **not** be acceptable;
- An e-signature, like a regular signature, must be by a single person; and
- It is not personally signed by Able Inventor.
Evaluation of Ex. 6 on the basis of just the practitioner’s name:

- Practitioners signing pursuant to § 1.33(b)(1) must use their registered names for their e-signatures;
- The inventor’s name is clearly not a part of the practitioner’s registered name; and
- The registration number was not provided within or adjacent to the e-signature as required.

Correspondence with an e-signature as set forth in Ex. 6 will be treated as unsigned.

See Ex. 4A, 4B and 4C for signing “by” or “for” another attorney.
Ex. 6B is the same as Ex. 6A, except that the signing practitioner separates his signature from the name of the inventor.

The e-signature on the correspondence is:

Respectfully submitted, Able Inventor
by /John T. Practitioner, Reg. No. 123456/

Question: Is this a proper e-signature?
Answer: Yes

This is a proper e-signature because:

1. John T. Practitioner e-signed with his registered name and registration number;
2. Only the signer’s family name is entirely in capital letters;
3. The e-signature is between two forward slashes (/…/); and
4. The e-signature is composed entirely of letters, numbers, spaces, punctuation marks, and the number character (#) with a registration number.

Correspondence with an e-signature as set forth in Ex. 6B will be accepted.

See Ex. 4A, 4B and 4C for signing “by” or “for” another attorney.
Ex. 6C is the same as Ex. 6B, except that the signing attorney signs for another patent attorney.

This is a combination of Ex. 6B and 4B.

The e-signature on the correspondence is:

Respectfully submitted, Able Inventor
by /John T. PRACTITIONER, Reg. No. 123456/
for Jane B. Smith, Reg. No. 99999

Question: Is this a proper e-signature?
Answer: Yes
This is a proper e-signature because:
1. John T. Practitioner e-signed with his registered name and registration number;
2. Only the signer’s family name is entirely in capital letters;
3. The e-signature is between two forward slashes (/…/); and
4. The e-signature is composed entirely of letters, numbers, spaces, punctuation marks, and the number character (#) with a registration number.

Correspondence with an e-signature as set forth in Ex. 6C will be accepted.

See Ex. 4A, 4B and 4C for signing “by” or “for” another attorney.
Electronic Signatures, 37 CFR § 1.4
Example 7A (recommended)

/Able Quincy INVENTOR/

This is a preferred e-signature for someone who is not a registered practitioner.
It is a proper e-signature because:
1. It is between two forward slashes (/…/);
2. Where only the e-signature is provided and it includes a first, middle, and last name, it is assumed to be the signer’s actual name;
3. The family name is entirely in capital letters; and
4. The e-signature is composed entirely of letters and spaces.

Below the signature: Nothing should be provided because anything that is provided is likely to cause confusion.

Correspondence with an e-signature as set forth in Ex. 7A will be accepted.

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Electronic Signatures, 37 CFR § 1.4
Example 7B

Situation: The inventor signed with an abbreviated middle name.

The e-signature on the correspondence is:

/Able Q. Inventor/
Able Quincy INVENTOR – Signer’s Actual Name

Question: Is this a proper e-signature?
Answer for Example 7B: Yes

It is a proper e-signature because:

1. It is between two forward slashes (/…/);
2. The e-signature is composed entirely of letters, punctuation marks and spaces; and
3. The actual name including the full middle name and only the family name in all capital letters is provided below the e-signature.

As the e-signature is not the signer’s actual name, the presence or absence of capitalization of letters in the e-signature is irrelevant. All of the following variations of the e-signature of Ex. 7B would be acceptable e-signatures:

/ABLE Q. INVENTOR/ or /ABLE inventor/ or /able inventor/
Electronic Signatures, 37 CFR § 1.4
Example 7B (continued)

Requirements for the actual name below the e-signature:

1. The signer’s actual name must be presented immediately below the e-signature and specifically identified by the words: “signer’s actual name”.

Note: Either these exact words “signer’s actual name,” or some equivalent, must be present!

2. The family name (in the “signer’s actual name”) must be the only name entirely in capital letters.

Correspondence with an e-signature as set forth in Ex. 7B will be accepted.
Note 1: If a person has a single letter (which is an actual name and not an abbreviation) as part of their actual complete name, then an e-signature with the single letter (initial) as part of their name is acceptable and nothing has to be typed immediately below the e-signature.

Note 2: If the single letter is an abbreviation, then an e-signature with the initial (e.g., Q.) is not acceptable (as a complete name) unless a complete name, without abbreviation, is also supplied (as in Ex. 7B).
Electronic Signatures, 37 CFR § 1.4
Example 8

Situation: The e-signature includes script or italics.

The e-signature on the correspondence is:

Able Quincy Inventor
Able Quincy INVENTOR

Question: Is this a proper e-signature?
Electronic Signatures, 37 CFR § 1.4
Example 8 (continued)

Answer: No

This is an improper e-signature because:
1. The e-signature is not placed between two forward slashes; and
2. Using a script font for the e-signature to imitate a pen and ink signature does not make this a proper e-signature.

If the script font e-signature were placed between 2 forward slashes, it might be acceptable.

A script font is not recommended because it could be construed as a wet ink signature or it may not be legible.

Correspondence with an e-signature as set forth in Ex. 8 will be treated as unsigned.
Electronic Signatures, 37 CFR § 1.4
Example 9

Situation: The family name is presented first.

The e-signature on the correspondence is:

A: /INVENTOR Quincy Able/
   or
B: /INVENTOR, Quincy Able/

Question: Is any of the e-signatures in A or B above a proper inventor’s e-signature?
Electronic Signatures, 37 CFR § 1.4
Example 9 (continued)

Answer: Yes

They are both *proper* inventor’s e-signatures because:

1. The e-signatures are between two forward slashes (/…/);
2. The e-signatures are the signer’s actual name, even though the family name is presented first in each signature; and
3. The e-signature is composed entirely of letters, punctuation marks and spaces.

- The comma after the family name is acceptable (punctuation is permitted).
- The usage of the comma is optional – it depends upon the signer’s preference.
Electronic Signatures, 37 CFR § 1.4
Example 9 (continued)

- This e-signature is **not** acceptable for a registered practitioner because no registration number is given.

- Where only the e-signature is provided and it includes a first, middle, and last name, it is assumed to be the signer’s actual name.

Correspondence with an e-signature as set forth in Ex. 9 will be accepted.
Situation: The e-signature includes symbols.

The e-signature on the correspondence is:

\[ \text{Able Quincy INVENTOR} \]

Question: Is this a proper e-signature?
Electronic Signatures, 37 CFR § 1.4

Example 10 (continued)

Answer: No

This is an improper e-signature because:

1. Graphic symbols (e.g., an airplane and a smiley face symbol) are not permitted; and

2. Providing the signer’s actual name cannot overcome the failure to use letters and numbers in the e-signature itself.

* Correspondence with an e-signature as set forth in Ex. 10 will be treated as unsigned.
Electronic Signatures, 37 CFR § 1.4
Example 11

Situation: A title (e.g., Professor) is presented after the e-signature.

The e-signature on the correspondence is:

/Able B INVENTOR/  Professor

Question: Is this a proper e-signature?
Answer: Yes

This is a **proper** (but not recommended) e-signature because:

1. The e-signature is between two forward slashes (/…/);
2. The e-signature includes the actual name of the signer (B is assumed to be the signer’s middle name and not an abbreviation);
3. The title appears after the e-signature does not contradict the name of the signer;
4. Only the signer’s family name is entirely in capital letters; and
5. The e-signature is composed entirely of letters and spaces.
Example 11 (continued)

While adding a title after the e-signature is acceptable, it is not recommended as it could cause confusion if the title is inaccurate, inconsistent or misleading.

Correspondence with an e-signature as set forth in Ex. 11 will be accepted.

Note: Including a title (e.g., /Able B INVENTOR, Professor/), within the 2 forward slashes would also be acceptable, but is not recommended.)
Situation: The e-signature is presented within multiple pairs of slashes.

The e-signature on the correspondence is:

//Allen INVENTOR//

Question: Is this a proper e-signature?
Answer: No

This e-signature is improper because:

1. It has more than a single slash mark before, and after, the e-signature resulting in four forward slash marks.

   - Only two forward slash marks would be required by §1.4(d)(1)(iv)(A); and
   - Extra forward slashes are expressly prohibited as signature characters by PCT Annex F, section 3.3.2 and the proposed rule is intended to be consistent with the PCT.

Note: if Allen Inventor has a middle name, it must be provided.

Correspondence with an e-signature as set forth in Ex. 12 will be treated as unsigned.
Situation: Inventor obtains a customer number (CN) for his correspondence address in a pro se application.

The e-signature on the correspondence is:

/Customer no. 15123/
Able Quincy INVENTOR – signer’s actual name

Question: Is this a proper e-signature?
Answer: Yes

This is a proper (but not recommended) e-signature for an inventor who is a pro se applicant because:

1. The e-signature is composed entirely of letters, spaces, numbers, and punctuation marks between two forward slashes (/…/);

2. Although the e-signature is not an actual name, the actual name is presented below the signature and clearly identified as such; and

3. The actual name is presented with the family name as the only name in all capital letters.
While an **inventor** can adopt an electronic signature that is something other than their name, such a signature is **not** recommended because it requires accurately identifying their complete actual name in the correspondence.

Note that **patent practitioners** must use their registered name as their e-signatures. See Examples 1 – 6.

Correspondence with an e-signature as set forth in Ex. 13 will be accepted.
Drawings May Be Submitted by Facsimile

37 CFR § 1.6

- Black and white drawings would be permitted to be transmitted to the Office by facsimile under § 1.6(d)(4); Exception: new applications including drawings cannot be faxed to the Office.
  1. Photographs or drawings with details should not be sent by facsimile;
  2. Color drawings must continue to be hand-carried or mailed to the Office instead of being sent by facsimile; and
  3. Transmission via facsimile may degrade the quality of the drawings, but the Office would generally print what is filed.

- The Office has been permitting drawings to be transmitted via facsimile when they are accompanying the issue fee.
  - See Payment of the Issue Fee and Filing Related Correspondence by Facsimile, 1254 Off. Gaz. Pat. Office 91 (Jan. 15, 2002).
  - These faxed drawings have been found to be of acceptable quality.
Petition Fees
37 CFR § 1.17

- Petition fees would be adjusted to more accurately reflect the Office’s current cost of treating petitions pursuant to 35 U.S.C. § 41(d).

- Three levels of petitions fees would be provided:
  1. $130 current fee retained for petition fees in § 1.17(h);
     - e.g., § 1.102 to make an application special
  2. $200 petition fee created in § 1.17(g); and
     - e.g., § 1.47 nonsigning inventor and § 1.59 expungement
  3. $400 petition fee created in § 1.17(f).
     - e.g., § 1.53(e) to accord a filing date, § 1.182 for questions not specifically provided for, and §1.183 for waiver of requirement of the rules
Copy Fees
37 CFR § 1.19

Would set a fee for supplying copies of applications from the Office’s Image File Wrapper system (IFW)


Would provide option for the Office to create copies of patent application (paper or compact disc) from IFW rather than from the original source document supplied to the Office by applicant, §1.19(b).

Would eliminate the current seven day requirement on the Office for processing copy requests, § 1.19(b).

Would provide for copying material that is not imaged scanned, such as large blueprints, microfiche and video cassette, § 1.19(g).

Would provide means for requesting copies of documents in a form other than that normally provided, § 1.19(h).
Small Entity
37 CFR § 1.27

- **Security Interests:** would clarify that untriggered security interests in an application or patent (e.g., held by a large entity bank in return for financing) would **not** be a sufficient interest to bar entitlement to small entity status, §§ 1.27(a)(1), (a)(2)(i), and (a)(3)(i).

- **SBA requirements:** would clarify that certain Small Business Administration requirements relating to a location in the U.S. or making a significant contribution to the U.S. economy would not apply to patent applicants, §1.27(a)(2)(ii).
For translations, the statement that the translation is accurate would now be required to be signed by the individual who made the translation.

See the proposed changes to §§1.52(b)(1)(ii) and (d)(1), § 1.55(a)(4), §1.69(b) and §1.78(a)(5)(iv).
Font Size
37 CFR §§ 1.52, 1.58

- A font size of 12, which is approximately 0.166 inches or 0.422 cm high, would be recommended for text in a patent application.

- See the proposed changes to §1.52(b)(2)(ii) and § 1.58(c).
If a table is more than 50 pages in length, or if the total number of pages of all of the tables in an application exceeds 100 pages in length, they would be able to be submitted on compact discs (CD-R or CD-ROM), § 1.52(e).
Claim for Foreign Priority
37 CFR § 1.55

- If the latest application in a chain of applications claims a foreign priority but it is filed more than 12 months after the foreign application, then
  - Each intermediate application* would be required to contain a claim for foreign priority in compliance with §1.55 to the prior foreign application; (see proposed §1.55(a)(1)(iii)); and
  - The priority claim would be required to be timely presented in each intermediate application (see proposed §1.55(c)).

- Example: Foreign application filed 1/8/04. Nonprovisional application 1 filed 1/5/05 and Nonprovisional application 2 filed 10/3/06. Nonprovisional application 1 as well as Nonprovisional application 2 would need to have a claim for foreign priority.

*any nonprovisional application, or international application designating the U.S., for which a benefit is claimed under 35 U.S.C. 120, 121, or 365(c) and §1.78(a) in the later-filed application.
Incorporation By Reference
37 CFR § 1.57 (A New Rule)
Priority & Benefit Claims

Priority/benefit claims would act as a limited incorporation by reference of a prior application. Omitted portion of the specification or drawing(s) could be added to the application (§ 1.57(a)) where:

- a claim for priority under § 1.55 or a claim for benefit under § 1.78 was present on the date of receipt of the application,
- the omitted portion was inadvertently omitted,
- the omitted portion is completely contained in the prior-filed application, and
- amendment to include the omitted portion is requested within a time period set by the Office, but in no case later than close of prosecution, § 1.114.

The examiner would be able to require an English language translation of the prior-filed application and identification of where the omitted portion can be found in such application, § 1.57(a)(1).
Incorporation By Reference

37 CFR § 1.57 (A New Rule)

Essential Material

- Essential material to be incorporated would require specific trigger language:
  - “incorporated by reference,” § 1.57(b).
- Would be able to incorporate essential material in a U.S. patent application publication (as well as U.S. patent), which does not itself incorporate such material, § 1.57(c):
  - would no longer be able to incorporate to applications for which the issue fee has been paid but the application has not yet issued as a patent.
- Would provides a definition for essential material based on 35 U.S.C. 112, ¶¶ 1, 2 and 6, and §§ 1.57(c)(1)-(3).
- Examiner would be able to require a copy of incorporated material along with a statement that the copy consists of the same material incorporated, § 1.57(e).
Would prohibit a table from being included in both the drawings and in the body of the specification, §1.58(a).

Would require that correct visual alignment of rows and columns of chemical and mathematical formulae and tables be retained when the electronic file is rendered by opening and displaying the electronic file at the Office using a text viewer program, § 1.58(b).

Would recommend a font size of at least 0.166 inches or 0.422 cm., § 1.58(c).
Application Data Sheet
37 CFR § 1.76

All application data sheets would be required:
- to have a title of either “Application Data Sheet” or “Supplemental Application Data Sheet,” and
- to contain all the section headings with any appropriate data for each heading.

Consequently, supplemental application data sheets would be required to include all information including information that is not being changed.
- Note: the current practice is to supply only the changed information, and identification of the information being changed.
Domestic Priority
37 CFR § 1.78

Would clarify that the prior art exception in 35 U.S.C. 103(c) (common assignee) does not apply to double patenting rejections, § 1.78(c):

- to emphasize the need for applicants to provide information about related applications so as to better permit the examiner to determine if conflict exists.

Multiple sentences (rather than a single sentence) would be permitted when reciting benefit claims to make it easier and clearer to set forth relationships, for example:

- where there is a provisional and multiple intermediate nonprovisional applications, it would be clearer to use multiple sentences in setting forth the required identification in the latest nonprovisional application as to which intermediate nonprovisional application(s) claims benefit to the provisional application.
Tables and sequence listings that are in the specification would not be permitted to also be included in the drawings, § 1.83(a).

Would remove requirement for submission of a black and white copy of any color drawings or photographs, §§ 1.84(a) and 1.165(b).

Identification (labeling) of the drawings would be recommended, but not required, and, if provided should be on the front of each sheet, to the left of the center on the top margin, § 1.84(c).
Models, Exhibits, and Specimens
37 CFR §§ 1.91 and 1.94

- Models, exhibits, or specimens that cannot be stored in the application file as they are not in compliance with § 1.52:
  - would be required to be accompanied by photographs showing multiple views pursuant to § 1.84, § 1.91(c)
  - when the Office no longer needs to retain the model, exhibit, or specimen, § 1.94:
    - applicant would be notified to arrange for their return at applicant’s expense, and
    - would be required to retain it for the life of any patent that issues,
  - for perishables:
    - it would be presumed that the Office has permission to dispose of unless applicant notifies the Office when submitted
Information Disclosure Statement
37 CFR § 1.98

Where applicant is not using an Office IDS form (PTO-1449 or PTO/SB/08A or B) applicant would be required to include, § 1.98(a):

- a column providing a space next to each citation for the examiner to initial,
- a heading clearly identifying the list as an IDS for a particular application number, and
- a separate listing of U.S patents and U.S. patent application publications from other citations.
Would permit an application to be made special, by rule, based on an invention’s ability to counter terrorism, without the current fee to make such application special, § 1.102(c).
Would add a (nonlimiting) example as to what applicant could be questioned about relating to technical information known to applicant concerning (§ 1.105(a)(1)(viii)):

- interpretation of the related art,
- the disclosure,
- the claimed subject matter,
- other information pertinent to patentability, or
- the accuracy of the examiner’s stated interpretation of such items.
Form for the presentation of a requirement for information would be identified as any appropriate form and three examples given (§ 1.105(a)(3)):

- a requirement for documents,
- interrogatories in the form of specific questions seeking applicant’s knowledge, or
- stipulations in the form of statements with which the applicant may agree or disagree.

Where applicant is asked for an opinion, a response that an opinion is not held by the party from which it was requested would be accepted as a complete reply (§1.105(a)(4)).
Supplemental replies, § 1.111(a), would no longer be entered as a matter of right. Supplemental replies would be entered if:

- filed before end of a statutory period for reply when limited to:
  - cancellation of claims,
  - adoption of an examiner suggestion(s), or
  - placement of the application in condition for allowance, or
- filed within the period when action by the Office is suspended under §§1.103(a)-(c).

The status of supplemental replies would be similar to the way after final amendments are treated.

This should eliminate a significant burden on the Office caused by a small percentage of applicants who do not file an appropriate reply as required by § 1.111.
Preliminary Amendments

37 CFR § 1.115

Preliminary amendments filed on (or prior to) the filing date of the application would automatically be part of the application, § 1.115(b):

- Current practice requires a petition under § 1.182 where a preliminary amendment is not referred to in an executed declaration.

If a preliminary amendment filed on (or prior to) the filing date of the application, § 1.115(b):

- is determined to contain matter not otherwise included in the specification, and
- the preliminary amendment is not referred to in a § 1.63 oath or declaration,
- then a new § 1.63 oath or declaration would be required to refer to the preliminary amendment.

The change would provide a consistent way of treating preliminary amendments, eliminate the need for filing a petition and save processing time.
A preliminary amendment seeking cancellation of all claims without presenting any new claims would be disapproved.

- For filing and fee calculation purposes only, the application would be treated as containing a single claim, which would be the first independent claim.
- This is a codification of current Office practice and consistent with Exxon v. Phillips, 265 F.3d 1249, 60 USPQ2d 1368 (Fed. Cir. 2001).
Extensions of Time
37 CFR §§ 1.136, 1.550, 1.956

Extensions of time for sufficient cause would require a § 1.17(g) petition fee of $200:

- § 1.136(b) in applications,
- § 1.550(c) in ex parte reexamination proceedings, and
- § 1.956 in inter partes reexamination proceedings.
Clarification that a terminal disclaimer would not be required when reviving an abandoned reissue application (regardless when the application was filed), § 1.137(d)(3).

Clarification that, where the parent reissue has not been abandoned, a new oath or declaration would be required for any continuation thereof identifying at least one error being corrected that is different from the error(s) being corrected in the parent reissue, § 1.175(e).

Would eliminate requirement for physical surrender of the original patent, § 1.178.

Would eliminate notification in the patent file that a reissue application has been filed and that reissue examination has been terminated. Public PAIR now provides this information. §1.179 would be removed and reserved.
Would clarify: To support a nonpublication request, the certification, that “the invention disclosed in the application has not and will not be the subject of an application filed in another country…,“:

- must be based on applicant’s intent at the time the nonpublication request is filed that the application will not be disclosed in a counterpart application subject to 18 month publication, § 1.213(a)(4):
- must be supported by actual inquiry consistent with §10.18(b):
  - not just the absence of any intent or plan concerning the filing of a counterpart application subject to 18 month publication’ and
  - not on past practices or tendencies of applicant.
Notice of Foreign Filing
37 CFR § 1.213

Notice of foreign filing is independent of rescission:

Would clarify that the mere filing of a request to rescind a previously filed nonpublication request (where a counterpart application was subsequently foreign filed subject to an 18 month publication):

- does not comply with the foreign filing notice requirement of 35 U.S.C 122(b)(2)(B)(iii) to provide notice to the Office within 45 days of the filing of a counterpart application subject to an 18 month publication, § 1.213(b) and (c).

Rescission
37 CFR § 1.213

Would clarify that a request to rescind a nonpublication request is not appropriate unless:

- the person signing the request has made inquiry consistent with § 10.18(b), and
- determined that a nonpublication request was in fact previously filed in the application in which the request to rescind is directed.

Would notify practitioners who file a request to rescind a nonpublication request in applications for which a nonpublication request was never filed that they:

- may be subject to sanctions, disciplinary action, or both, discussion of § 1.213(b).
Would recite a new alternative time frame of one month after the mailing of the first Office communication that includes a confirmation number, § 1.215(c), to submit:

- replacement paper drawings (with a processing fee replacing the petition requirement), § 1.215(a) or
- an amended version of an application through the Office’s electronic filing system, § 1.215(c).
Protests
37 CFR § 1.291

Would provide that protests may be filed at any time if accompanied by the written consent of the applicant, as provided by 35 U.S.C. 122(c), § 1.291(b)(1)(ii).

Would require that the real party in interest must be identified when filing a protest, except if anonymity is desired:
- a statement may be provided that the protest is, to the best knowledge of the submitting party, the first protest being submitted by the real party in interest, § 1.291(b)(3).

For second or subsequent protests by the same party, to ensure consideration, an explanation would be required to state why:
- the additional art issues are significantly different, and
- the art issues were not earlier presented, § 1.291(c)(5).
Exception that permits charging of issue fee to earlier supplied deposit account authorization would be expanded to include:

- any publication fee due, and
- use of applicant’s rather than the Office’s fee transmittal form, § 1.311(b).

Would clarify that the exception would only apply where the preauthorization was to the appropriate fee due.
Patent Term Adjustment Determination
37 CFR § 1.705

- Patentee would be able to request reconsideration of a patent term adjustment indicated in an issue notification letter, for events occurring after the mailing of a notice of allowance, within 30 days of the date that the patent issued where a patent indicates a revised patent term adjustment:
  - without the current limitation that the patent must issue on a date other than the projected date of issue, §1.705(d).

- Requests for reconsideration would continue to be dismissed as untimely for issues previously raised or issues that could have been raised in the determination provided with the mailing of the notice of allowance.
Changes in Support of 21st Century Strategic Plan Initiatives

The following concepts are the drivers behind the Strategic Plan and examples are given of the rules that embody them:

- Quality: §§ 1.52, 1.55, 1.78, 1.105, 1.291, 1.705.
- E-government: §§ 1.4, 1.19, 1.52, 1.58, 1.84(c), 1.91(c), 1.94, 1.98.
- Pendency/Timeliness: §§ 1.6, 1.111, 1.115, 1.213
- Resource alignment: § 1.17, § 1.94, §§ 1.136, 1.550, 1.956
- Unnecessary formalities removal: §§ 1.6, new 1.57(a), 1.27, 1.137, 1.178, 1.179, 1.215, 1.311.

When submitting comments, the above concepts should be kept in mind.
Time Schedule for Final Rule

- November 12, 2003 – Comment period closes.

Note: The Office has specifically requested comments on the following rule proposals:

- § 1.57(a) limited incorporation of a prior application based on a priority or benefit claim
- § 1.91 requirement for photographs for models or exhibits that do not confirm §§ 1.52 and 1.84.
- § 1.115 all preliminary amendments filed with the application treated as part of the original disclosure.
Time Schedule for Final Rule
(continued)

January 16, 2004 – Projected completion of consideration of comments and drafting of Final Rule:
- For those submitting comments, particularly towards the end of the comment period:
  - check Office web site Comments from the Public at http://www.uspto.gov/web/offices/pac/dapp/opla/comments/index.html
  - see if the comments have been posted and therefore received by the Office, and if not,
  - please notify Mr. Bernstein by phone (703) 305-8713 that comments were submitted.


May 28, 2004 – Projected Effective Date of Changes.
October 30, 2003

Contacts

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- §§ 1.83, 1.84, 1.165, Karin Ferriter (703) 306-3159
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- §§ 1.213, 1.215, Mark Polutta (703) 308-6710
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Thank You