Changes to Support Implementation of the USPTO 21st Century Strategic Plan, Final Rule
69 FR 56481 (September 21, 2004)

Office of Patent Legal Administration (OPLA)
(571) 272-7701
Deputy Commissioner for Patent Examination Policy (DCPEP)
PatentPractice@uspto.gov
Significant Changes

§1.4 Signatures (adding Electronic and S-signatures)
§1.6 Submission of Drawing by Facsimile
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Effective Dates

There are 3 effective dates based on the September 21, 2004 date of publication of the final rule in the Federal Register, as follows:

1. All changes are effective 30 days after publication, October 21, 2004, except for the changes identified in 2 and 3.

2. The changes to 37 CFR §§ 1.4, 1.6, 1.10, 1.27, 1.57(a), 1.78, 1.84, 1.115, 1.137, 1.178 and 1.311 are effective on the date of publication, September 21, 2004 and

3. The fee changes, § 1.17, are effective the Monday after 60 days from the date of publication, or November 22, 2004.
I. Handwritten (personally signed) signatures are now specifically provided for in § 1.4(d)(1).

The following additional types of signature are now acceptable:

II. S-signatures (§ 1.4(d)(2)):

- Example for signing applicant: /James Jones/
  James T. Jones

III. Electronic Filing System (EFS) character coded (electronic) signatures for correspondence transmitted via EFS (§1.4(d)(3))

- Note: electronic signatures in EFS must be completed by filling in the appropriate EFS menu
- EFS signatures have previously been acceptable under a waiver.

Note: Additional samples of acceptable signatures for applicants and registered practitioners will be posted on the internet
S-Signatures, 37 CFR 1.4(d)(2)
Definition and Uses

An **S-Signature** is any signature between forward slashes that is not a handwritten (§§ 1.4(d)(1) or (e)) or an EFS character coded signature (§ 1.4(d)(3)).

- It is inserted by electronic (e.g., a word processor) or mechanical means.

S-Signatures may be used to sign **all correspondence** unless otherwise explicitly required (e.g., when a written or “wet” signature is required or when the signature requirements for a document are not covered by 37 CFR 1.4).

S-Signatures may be used on documents that are either:

1. Mailed or hand (courier) delivered,
2. Transmitted by facsimile, or
3. Submitted via EFS directly as an EFS Tagged Image File Format (TIFF) attachment (e.g., scanned image), to the Office.
S-Signatures, 37 CFR 1.4(d)(2) Requirements

1. The S-signature must consist only of letters (including Kanji, etc.), Arabic numbers, and appropriate spaces, commas, periods, apostrophes, or hyphens for punctuation.

2. The person signing must insert his or her own signature

3. The signer’s name must be presented immediately below or adjacent to the S-signature, and be reasonably specific so that the identity of the signer can be readily recognized.

4. A registered practitioner may S-sign but his or her registration number is required, either as part of the S-signature or immediately below or adjacent to the signature.
   
   • For example:  /John Attorney Reg. #99999/  
   John Attorney
EFS Character Coded Signatures must consist only of English letters, numbers and punctuation typed into an EFS menu. (§ 1.4(d)(3)).

The person signing must personally insert his/her electronic signature as with S-signatures:

- but the location of the signer’s name in printed or typed form and the registration number of a practitioner are set by the EFS software,

The following correspondence filed via EFS as an EXtensible Markup Language (XML) document may include an EFS character coded signature: new applications, assignments, amended biotech listings, and e-IDS’s.
There is no requirement that the signer’s actual, full or legal name be used.

- It is strongly suggested that the full name be used;
- The typed or presented name below the signature must be reasonably specific enough so that the identity of the signer can be readily recognized (37 CFR 1.4(d)(2)(iii)(B)).

Titles may be included as part of the signature.
Certification Requirement (§ 1.4(d)(4)(ii)(A))

A. For another’s signature: A person submitting a document signed by another under § 1.4(d)(2) or (d)(3):
   a. is obligated to have a reasonable basis to believe that the person whose signature is present on the document actually inserted that signature, and
   b. should retain evidence of authenticity of the signature.

B. For your own signature: The person inserting a signature under § 1.4(d)(2) or (d)(3) in a document submitted to the Office certifies that the inserted signature appearing in the document is his or her own signature.

Violations of the signature certifications may result in the imposition of sanctions under §§ 10.18(c) and (d).
Questionable Signatures

ียว Ratification, confirmation or evidence of authenticity of a signature may be required where the Office has:

– Reasonable doubt as to its authenticity,
– Where the signature and typed or printed name do not clearly identify the person signing.

ียว The failure to follow the S-signature format and content requirements will usually be treated as a bona fide attempt, but will cause the paper to be treated as unsigned with differing results, e.g.:

– Amendments would receive a new 1-month time period
– § 1.63 declarations, would receive a two month time period and a surcharge may be imposed.
A practitioner creates a document and S-signature signs it on his/her PC. The practitioner can then:

- Facsimile transfer the document directly from the PC to the Office; or
- Print the document and then facsimile transmit, mail, or hand-carry the document to the Office

An affidavit under § 1.132 is S-signed by the party making the affidavit, the S-signed affidavit is then:

- Electronically sent to the practitioner, e.g., via an e-mail. The practitioner can then facsimile transfer, mail or hand-carry the S-signature signed document to the Office.
Black and white drawings will be permitted to be transmitted to the Office by facsimile in all applications other than original filings:

– Color photographs or color drawings must continue to be hand-carried or mailed to the Office instead of being sent by facsimile; and

– Black and white photographs or drawings with fine details should not be sent by facsimile:
  • Transmission via facsimile may degrade the quality of the drawings, but the Office will generally print what is filed.
Petition fees have been 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 are provided:

1. $130 petition fee retained in § 1.17(h);
   - *e.g.*, § 1.102(d) to make an application special,

2. $200 petition fee created in § 1.17(g);
   - *e.g.*, § 1.47 nonsigning inventor and § 1.59 expungement, and

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 a requirement of the rules.
Copies of files and/or documents may be provided in paper or electronic form.

Electronic form may be:
- Compact disc (CD);
- Transmitted over Internet; or
- Another electronic medium as designated by the Director.

For a copy of an application file wrapper and contents, the fee will be:
- $200 – if provided on paper (up to 400 pages); or
- $55 – if provided on one compact disc or other electronic form.

The seven-day requirement for processing copy requests is removed.
Impact of a Security Interest Held by a Large Entity: A security interest in an application or patent held by a large entity is not a sufficient interest to bar entitlement to small entity status so long as the security interest is not triggered. (§ 1.27(a)(5)).

Impact of SBA Requirements on Foreign Applicants: Certain Small Business Administration (SBA) requirements relating to location in the U.S. or making a significant contribution to the U.S. economy do not bar entitlement to small entity status for patent applicants. (§ 1.27(a)(2)(ii)).
Font Sizes 37 CFR 1.52(b)

🌟 Recommended Font Size: The rule is revised to recommend that the preferred font size of text is 12 points, which is identified in the preamble discussion as approximately 0.166 inches or 0.422 cm high (§ 1.52(b)(2)(ii)). See also § 1.58(c).
Compact Disc Specifications
37 CFR 1.52(e)

The requirements permitting tables on compact disc are changed:

– A table of any size may be placed on a compact disc if the total number of pages of all the tables in an application exceeds 100 pages in length (or any single table more than 50 pages in length, which practice is unchanged) (§ 1.52(e)(1)(iii));

– What constitutes a table page is clarified to be a page printed on paper pursuant to §§ 1.52(b) and 1.58(c) of this section (§ 1.52(e)(1)(iii));

– CD’s must be finalized to assure archival nature of discs. Finalized means that the compact discs are closed to adding further data (§ 1.52(e)(3)(i));

– Landscape orientation should be indicated on the transmittal letter: It is clarified that landscape orientation of a table is an example of special information needed to interpret that table and such information should be provided on the transmittal letter (§ 1.52(e)(3)(ii)).
Priority/benefit claims will act as a limited incorporation by reference of a prior application. 37 CFR 1.57(a).

All or a portion of the specification or drawing(s) from a prior-filed application may be added by corrective amendment to a later-filed application claiming the priority/benefit of the prior-filed application under § 1.55 or § 1.78, where:

– The claim was present on the filing date of the later-filed application;
– The material to be added was inadvertently omitted from the later-filed application; and
– The omitted portion is completely contained in the prior-filed application.

If the application is not entitled to a filing date, the corrective amendment must be by way of petition. 37 CFR 1.57(a)(3).

Timeliness Requirement

– The corrective amendment must be filed within any time period set by the Office, but in no case later than close of prosecution (as defined by § 1.114(b)) or the abandonment of the application, whichever occurs earlier.
Additional Requirements for Corrective Amendment: Along with the amendment to include inadvertently omitted material, applicant must submit:

- A copy of the prior application, except where the prior application is filed under 35 U.S.C. 111;
- An English language translation, if the prior application is in a foreign language; and
- Identification of where in the prior application the omitted portion to be added to the later application can be found.

Although a statement that the omission was inadvertent is not required, any amendment to add the omitted material would constitute a certification under § 10.18(b).

Any amendment to an international application is effective only as to the U.S., and shall not affect the international filing date of the application.
Sections 1.57(b)-(g) generally codified the practice set forth in MPEP 608.01(p)(8th Ed., August 2001) with definitions of essential and nonessential material set forth.

**Trigger Required:** The incorporation by reference must be expressly presented in the specification:

- Using the root words: “incorporate” and “reference” and
- Clearly identifying the referenced patent, application, or publication.

**Essential Material** may be incorporated by reference to:

- U.S. patents or U.S. patent application publications, but the patent or publication may not itself incorporate such essential material.

**Nonessential material** may be incorporated by reference:

- Patents, publications (including U.S., foreign, and nonpatent publications);
- Hyperlinks or other form of browser executable codes are not permitted.
Incorporation By Reference – Essential Material 37 CFR 1.57(b) (New Rule)

Essential material from an application that has not issued as a patent or been published is not permitted to be incorporated:

- It is not permitted even when the issue fee has been paid but the application has not yet issued as a patent.

Examiner may require submission of a copy of the material incorporated even if properly incorporated and a statement that the copy consists of the same material incorporated.

An amendment to include the incorporated material must be accompanied by a statement that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter.

An incorporation by reference that does not comply with §1.57(b), (c), or (d) is not effective unless corrected within any time period set by the Office, but in no case later than the close of prosecution or abandonment, whichever occurs earlier.
Tables and Sequence Listings included in the specification must not be duplicated in the drawings (§§ 1.58(a), 1.83):
- The prohibition does not apply to applications filed under 35 USC 371.

Tables filed in electronic form must be encoded to visually maintain the relational information they convey when the file is opened for viewing in the Office (e.g., rows and columns) (§ 1.58(b)).

**Recommended Font Size:** The rule is revised to recommend that the preferred font size is 12, which is approximately 0.166 inches or 0.422 cm high (§ 1.58(c)). See also § 1.52(b)(2)(ii).
ADS, and any supplemental ADS, must have:

- The appropriate title (i.e., “Application Data Sheet” or “Supplemental Application Data Sheet”);
- All seven section headings;
- The appropriate data for each section; and
- Additionally, for supplemental ADSs, identification of what is being corrected, added, or deleted.

A supplemental ADS must be a complete replacement ADS showing the changes using underlining and strike-through.

- Submitting only the changes or new information in a supplemental ADS is no longer permitted.
If an ADS is inconsistent with information provided in another document that was submitted at the same time or prior to the ADS submission, the ADS will control:

– e.g., the correspondence address designated in an ADS is used instead of the address in a transmittal letter that was submitted prior to or with the ADS,

– but not for inventorship or citizenship. (§ 1.76(d)(1) and (2))

The option of utilizing a § 1.63 oath or declaration to correct captured bibliographic data has been eliminated (§ 1.76(d)(4)).
Multiple Sentences Permitted: multiple sentences forming a continuous string starting with the first sentence of the specification, rather than a single sentence, is permitted to identify benefit claims to prior U.S. applications.

Double Patenting Rejections: the rule clarifies that the prior art exception under 35 U.S.C. 103(c) (common assignee) does not preclude a double patenting rejection. § 1.78(c).

– Applicants must disclose all related applications where a double patenting rejection can be made, and should disclose any related application(s) if there is any doubt.
Codification of a previous OG Notice to remove the requirement for black and white copies of color drawings and photos.

Adds recommendation that drawings include identification labels, but if labels are used they must be placed on (§ 1.84(c)):

- front of drawing, and
- within the top margin.

Identification Labels: To be consistent with § 1.121(d), drawings submitted after the filing date must be identified as either:

- “Replacement Sheet” (amended drawing),
- “New Sheet,” or
- “Annotated Sheet” (for a marked-up copy).
Photos Required: Any model or exhibit that is not in compliance with § 1.52, must be accompanied by photographs in compliance with § 1.84, showing multiple views.

Artifact File: Models, exhibits or specimens not in compliance with § 1.52, and those in compliance that cannot be scanned for IFW, will be stored in artifact folders until they can be disposed of.

Applicant can be required to arrange for their return at applicant’s expense when they are no longer necessary for the conduct of business before the Office and adequate photos have been submitted. Retention by applicant is required for the enforceable life of any patent.

The Office will dispose of perishables without notice to the applicant unless applicant notifies the Office upon submission that a return is desired and promptly makes arrangements for their return.
Copies of cited U.S. patents and U.S. patent application publications are no longer required to be filed with an IDS regardless of the filing date of the application.

Note:


(2) Copies of cited U.S. patent applications are also no longer required to be filed with an IDS. A copy does not have to be supplied if the application is in the Image File Wrapper (IFW) system. The waiver for copies is limited to the specification, including claims, and drawings. Applications in IFW includes all applications filed on or after June 30, 2003; check PAIR for earlier filed applications which are being continually added to the IFW. Waiver of the Copy Requirement in 37 CFR 1.98 for Cited Pending U.S. Patent Applications, __ Off. Gaz. Pat. Office __ (October 19, 2004).
A large number of citations of U.S. patents, U.S. patent application publications and U.S. patent applications may trigger an Office requirement for applicant to supply paper copies for all citations. See preamble discussion in Final Rule notice.

The effective date is October 21, 2004:

– Until the effective date, unless the references are submitted in an e-IDS, applicant must continue to submit copies of cited U.S. patents and U.S. patent application publications in:
  • Applications filed on or before June 30, 2003, and
  • International applications that have entered the national stage under 35 U.S.C. 371 filed on or before June 30, 2003.
Recommendation: Applicants are encouraged to file an e-IDS via EFS for U.S. patents and patent application publications rather than a paper IDS form (1449 or PTO/SB/08) listing the citations for the following reasons:

- An e-IDS is directly processed into the IFW system so it is available to the examiner much faster, and
- Cites on a paper IDS form have to be entered into the IFW system via a more complex processing arrangement (OCR scanning, checking and then manually keying to correct scanning errors), which not only takes longer, but may introduce errors.

Applicants are still required to submit copies of foreign patent documents and non-patent literature in accordance with §1.98(a)(2).
Additional format requirements for the listing of cited prior art documents:

- A column that provides a space next to each citation for the examiner’s initials when the examiner considers the cited document.
- A heading on the listing that clearly indicates that the list is an Information Disclosure Statement (e.g., not a citation of prior art under §§ 1.99 or 1.291).

**Note:** (1) Office forms PTO/SB/08a (8/03) and PTO/SB/08b (8/03) are fully compliant so it is recommended that use be made of these Office forms. (2) Any 1449 form (formerly a PTO form) that the public has may not be fully compliant. The PTO-1449 form has been discontinued by the Office and should no longer be used. (3) Applicants are reminded that the Office’s PTO/SB form number must be removed if the form is modified (at all) by applicant.
A petition without fee to make an application special based on an invention’s ability to counter terrorism has been established. § 1.102(c).

There must be a good faith effort to determine that the claimed invention is in fact materially directed to countering terrorism. §§ 1.56 and 10.18(b).

Note: Where the disclosure of the application is not clear on its face that the claimed invention is materially directed to countering terrorism, an explanatory statement to that effect is required. MPEP 708.02, XI.
Section 1.105 has been amended to additionally provide for requiring technical (factual) information (not opinions nor the level of ordinary skill in the art) via:

- Interrogatories in the form of specific questions seeking applicant’s factual knowledge; or
- Stipulations as to facts with which the applicant may agree or disagree.

The types of factual information concern:

- The related art;
- The disclosure;
- Claimed subject matter;
- Other factual information pertinent to patentability; or
- The accuracy of the examiner’s stated interpretation of such items.
More specific examples of applicant’s actual knowledge (as set forth in the preamble discussion of the final rule):

1. of common technical features shared among all claims or admission that certain groups of claims do not share any common technical features;
2. about the support found in the disclosure for means or step plus function claims (35 U.S.C. 112, 6th paragraph);
3. of which portion of the disclosure provides the written description and enablement support for a specific claim element;
4. of the meaning of claim limitations or terms used in the claims, such as what teachings in the prior art would be covered by particular limitations or terms in a claim and which dictionary definitions would define a particular claim term, particularly where those terms are not used per se in the specification.
More specific examples of applicant’s actual knowledge (continued):

5. of which portions of each claim correspond to any admitted prior art of the specification;
6. of the specific utility provided by the claimed subject matter on a claim by claim basis;
7. as to whether a dependent claim element is known in the prior art based on the examiner having a reasonable basis for believing so;
8. of support for added limitations in an amended claim; and
9. of facts related to public use or sale situations.
Requirements for Information
37 CFR 1.105

The Office may accept as a complete reply to a requirement for factual information that the information is unknown or is not readily available, without further specification as to which of the two is relied upon:

- Such reply may only be used after applicant has made a good faith attempt to obtain the information based on reasonable inquiry; and
- Such reply may affect the prosecution of the application, e.g.:
  - Where the inquiry is in regard to correlation of structure set forth in the specification with a claim under 35 U.S.C. 112, paragraph 6, a reply that the correlation in the specification is unknown may cause, e.g., rejections under 35 U.S.C. 112, paragraphs 1 and 2 to be made.

For a transition period, the Office will provide management review of requirements for information for interrogatories and stipulations.
Supplemental replies are no longer entered as a matter of right.

After a complete reply has been filed, the Office may enter a supplemental reply that is filed before final rejection or allowance and in sufficient time to be entered into the application file, if the subsequent reply is clearly limited upon cursory review to:

- Cancellation of claims;
- Adoption of an examiner suggestion(s);
- Placement of the application in condition for allowance;
- Reply to an Office requirement made after the first reply was filed;
- Correction of informalities (e.g., typographical errors); or
- Simplification of issues for appeal.
Supplemental replies filed during a suspension of action under § 1.103(a) or (c) will continue to be entered as a matter of right.

If the applicant wishes to have a (not-entered) supplemental reply considered by the examiner, applicant must include the contents of the supplemental reply in a subsequent proper reply.

IDSs are not considered replies and are not subject to the new limitations:

– except where a second IDS is submitted in reply to a § 1.105 requirement for information.
Preliminary amendments that are present on the filing date of an application are treated as part of the original disclosure:

- Applicants are responsible for reviewing all preliminary amendments present on the filing date and providing a reference thereto in a § 1.63 oath or declaration for each such preliminary amendment containing subject matter not otherwise present in the application as filed.

Preliminary amendments seeking cancellation of all the claims without presenting any new or substitute claims will be disapproved.
If a continuation of a reissue is filed and the parent reissue is not being abandoned, then the continuation needs to identify an error not being corrected in the parent reissue application. § 1.175.

The requirement for physical surrender of the original patent has been eliminated. § 1.178.

- Surrender is automatic upon grant of the reissue patent.

  Effective date: September 21, 2004, the date of publication of the final rule.

- Applies retroactively to all pending reissue applications.
Patent application publications may be based on amendments to (§ 1.215(a)):
- Abstract;
- Claims that are reflected in a complete claim listing;
- Drawings; and
- Specification (other than abstract or claims) if amended via a substitute specification.

The amendment must be submitted in sufficient time to be entered into the Office file wrapper of the application before technical preparations for publication have begun:
- Generally four months prior to the projected date of publication.
A statement must accompany a protest that it is the first protest submitted in the application by the real party in interest (who does not need to be identified), or there must be compliance with the requirements for second or subsequent protests (§ 1.291(b)(2)):

- This section does not apply where a protest is the first protest in the application.

For second or subsequent protests by the same real party in interest (§ 1.291(c)(5)):

- An explanation is required as to why additional prior art issues are significantly different, and why they were not earlier presented; and
- A processing fee under § 1.17(i) is required.

Eliminates cumulative prior art submissions by a single protester by requiring subsequent protest to identify:

- How issues are significantly different, and
- Why the different issues were not presented in the earlier protest.
List of Contacts

Generally: Robert Spar, Director (571) 272-7700
Hiram Bernstein (571) 272-7707
Office of Patent Legal Administration (571) 272-7701

- §§ 1.4, 1.52 (compact discs), 1.58(b) & (c) - Michael Lewis (571) 272-7755
- §§ 1.6, 1.19, 1.58(a) & (c), 1.83, 1.84 - Karin Ferriter (571) 272-7744
- §§ 1.17, 1.102, 1.291 - James Engel (571) 272-7725
- §§ 1.27, 1.57, 1.91, 1.94 - Eugenia Jones (571) 272-7727
- §§ 1.78, 1.98 - Jeanne Clark (571) 272-7714
- § 1.76 - Kery Fries (571) 272-7757
- § 1.105 - Anton Fetting (571) 272-7717
- § 1.111 - Joni Chang (571) 272-7720
- § 1.115 - Fred Silverberg (571) 272-7719
- § 1.215 - Mark Polutta (571) 272-7709
- §§ 1.175, 1.179 - Kenneth Schor (571) 272-7710
Questions and answers regarding this final rule package will be posted on the Office’s official website, http://www.uspto.gov.