Recent Significant Rule Makings and Changes in USPTO Practice

National Association of Patent Practitioners

Stephen G. Kunin
Deputy Commissioner for Patent Examination Policy

July 13, 2004

1. Patent Term Ext. and Adjustment (35 USC 154) – (4/04)
2. Implementing Public Law 107-273 (2002) and Ancillary Matters – (Inter Partes Reexam) – (12/03)
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**TOPICS**

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TOPICS

OG Notices (http://www.uspto.gov/web/offices/pac/dapp/ogsheet.html):
8. Application Data Sheets Encouraged- (4/13/04)
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12. Revised Procedures for Express Abandonments - (5/25/04)
13. Lengthy Tables – (5/18/04)
14. Request for Alert Concerning Submitted Petitions – (5/04)
15. New Street Address for the Customer Window (6/04)
Final Rule: Patent Term Extension and Patent Term Adjustment (35 USC 154)

A remand by the BPAI shall be considered a decision reversing an adverse determination of patentability for patent term adjustment and patent term extension purposes, if:

- The remand is by a panel of the BPAI
- The remand is the last action by a BPAI panel in the application; and
- No request for continued examination under 35 U.S.C. 132(b) (RCE per § 1.114) is filed after the remand and before the examiner’s next action under 35 U.S.C. 132 or notice of allowance under 35 U.S.C. 151.

Retroactivity: A request for reconsideration to obtain the benefit of this change will be timely filed in previously-issued patents if filed by July 21, 2004.
Rule 1.705(d) is amended:

- The period of time in which a patentee may request reconsideration of the patent term adjustment is changed from within thirty days of the date the patent issued to within two months, which is non-extendible.

- Reconsideration may now be requested if the patent indicates a revised patent term adjustment relative to the patent term adjustment indicated on the notice of allowance, instead of only when the patent issues on a date other than that projected.

- Provides that any request for reconsideration under § 1.705(d) that raises issues that were raised, or could have been raised, in an application for patent term adjustment under § 1.704(b) shall be dismissed as untimely as to those issues.
Final Rule: Implementing Public Law 107-273 (2002) and Ancillary Matters

Pursuant to Public Law 107-273, §13106, the requester of an *inter partes* reexamination may now:

- (1) Appeal adverse decision of Board of Patent Appeals and Interferences to Court of Appeals for Federal Circuit, and
- (2) Participate in Patent Owner’s Appeal to the Court.

- Rules 1.983 and 1.304 are amended to implement §13106 of Public Law 107-273.
- Patent owner/ requester cross appeals are permitted.
- Patent owner and requester may participate in each other’s Appeals to the Court.
- Provides level playing field for appeal in *inter partes* reexam.
- Does not apply to any *inter partes* reexam commenced prior to November 2, 2002.
Final Rule: Patent Cooperation Treaty

Effective Date: January 1, 2004

When establishing the International Search Report, the ISA will also establish a Written Opinion

ISA Written Opinion to be adopted by the IPEA as the first Examination Written Opinion

If no Demand is filed, the ISA Written Opinion will be issued at 30 months by the International Bureau as an IPRP* with equal status to the IPER**


** IPER = international preliminary examination report
The filing of an International Application will constitute:

- A designation of all contracting States
- An indication of all types of protection
- An indication of both national and regional filing

Similarly, filing of a Demand will constitute the election of all designated States

Relaxation of signature and other requirements for filing
All applications will now require naming of applicant/inventors

- Additional possible RO workload issues related to missing applicant/inventor information and signatures addressed by other reform initiatives

RO workload reductions due to elimination of precautionary designations

IPEA workload reductions due to elimination of later elections
With the elimination of separate designations there is no longer a need for the current multiple filing fee system \((i.e., \text{Basic Fee} + \text{Designation Fees})\).

Fee system therefore simplified via a single “flat” international filing fee.
Identifying information (i.e., address, residence, and nationality) for only one applicant required to avoid the Article 14 sanction of withdrawal

- Applicant must be entitled to file in that RO

Only the signature of one applicant required to avoid withdrawal

Offices and Authorities may waive the requirement for a Power of Attorney

- Power of Attorney requirement may not be waived in the case of applicant initiated withdrawals

National Offices may still require identifying information and signatures
In accordance with the PLT, PCT Regulations will provide for reinstatement of National Stage rights in applications where the 30-month deadline has been missed.

Offices will be able to apply either a due care or an unintentional standard.

If contrary to their national law, Offices will be able to take a reservation to this provision.
Initial impact expected to be minimal as reservation clause will maintain the status quo

Offices which already have reinstatement (e.g., U.S. revival practice) will continue

Offices without will take reservation until such time as their national laws can be amended
New U.S. PCT Fees:

- Transmittal Fee: $300.00
- Search Fee:
  - Corresponding § 111(a): $300.00
  - No corresponding § 111(a): $1,000.00
  - Per additional invention: $1,000.00
- Preliminary examination fee:
  - USPTO was ISA: $600.00
  - USPTO not ISA: $750.00
  - Per additional invention: $600.00
Final Rule: Power of Attorney Practice

and Assignment Rules


Effective: June 26, 2004
Significant Changes Made to Certain Rules

§ 1.32 (New Rule) Power of attorney.
§ 1.33 Correspondence Address; Signature Requirements.
§ 1.34 Acting in a Representative Capacity.
§ 3.24 Requirements for documents and cover sheets relating to patents and patent applications.
§ 3.25 Recording requirements for trademark applications and registrations.
§ 3.73 Establishing right of assignee to take action
§ 3.81 Issue of patent to assignee.
Main Changes

Power of Attorney related changes:
- Limit of ten patent practitioners will be made of record if Customer Number practice is not used. § 1.32 (new)
- Elimination of Associate Power of Attorney practice. § 1.34

Assignment changes:
- Original assignment document must not be submitted for recordation because the document submitted for recordation will no longer be returned. §§ 3.24 & 3.25
37 CFR 1.32(a) sets forth the following definitions:

- Power of attorney,
- Principal,
- Revocation, and
- Customer Number (CN)

37 CFR 1.32(b) sets forth power of attorney requirements:

- Must be in writing,
- Name one or more representatives in compliance with § 1.32(c),
- Give the representative power to act on behalf of the principal, and
- Be signed by the applicant for patent (§ 1.41(b)) or the assignee of the entire interest of the applicant.
Power of Attorney; New 37 CFR 1.32(c)

A power of attorney must name as representative either:

(1) one or more joint inventor;

(2) up to ten registered patent attorneys or registered patent agents; or

(3) those registered patent practitioners associated with a Customer Number.

If a power of attorney names more than ten patent practitioners

- power of attorney must be accompanied by a separate paper indicating which ten patent practitioners named in the power of attorney are to be recognized by the Office as being of record in application or patent to which the power of attorney is directed.

- If no separate paper, no power of attorney will be entered.
The Office will use the address associated with a Customer Number if given, over a typed correspondence address, when more than one correspondence address is given.

The Correspondence address given in an Application Data Sheet (§ 1.76) is given priority over any other correspondence address given.
Signature Requirements for Amendments and Other Papers §1.33(b)

Correspondence to the Office must be signed by:

- A registered patent attorney or patent agent of record appointed in compliance with § 1.32(b)
- A registered patent attorney or patent agent not of record who acts in a representative capacity under the provisions of § 1.34
- An assignee as provided for under § 3.71(b) (unchanged)
- All of the applicants for patent (unchanged)
Acting in a Representative Capacity § 1.34

Paragraph (b) of § 1.34 has been deleted.

§ 1.34 is now a single paragraph (revising prior § 1.34(a)) limited to acting in a representative capacity.

A registered patent attorney or patent agent not of record but acting in a representative capacity must specify his/her:

- Registration number
- Name (new requirement)
- Signature
Acting in a Representative Capacity § 1.34

Associate Power of Attorney practice has been eliminated (Prior § 1.34(b))

- Customer Number practice allows the list of patent practitioners associated with an application to be changed easily
- Use **sample form** “Authorization to Act in a Representative Capacity” to expressly authorize another practitioner to conduct an interview (available at [www.uspto.gov](http://www.uspto.gov), on the forms page; [http://www.uspto.gov/web/forms/sb0084.pdf](http://www.uspto.gov/web/forms/sb0084.pdf))

Associate Powers of Attorney filed before the effective date of the rule change will continue to have effect.
Assignment: Only Copies Should be Submitted for Recordation

37 CFR 3.24 (patents) and 3.25 (trademarks) are amended to provide:

- Only a copy of an original assignment document may be submitted for recording
- Electronic filing of assignment documents permitted

The Notice of Recordation returned to the applicant has been revised to reflect the title of the invention and docket number stored in the Office’s electronic records, if the notice of recordation is for a single property (application or patent)

Assignment documents must be submitted on 8.5 x 11 inch paper or DIN size A4
Section 3.81 is amended to modify the practice relating to issuance of a patent to an assignee

- after payment of an issue fee, a request for a certificate of correction must be filed in order to obtain issuance of the patent to an assignee.
- if assignment information is submitted after payment of the issue fee, the patent document will not include the assignment information
  - assignment information will be included in a certificate of correction.

The practice of allowing a patent to issue to an assignee when an assignment has not been recorded but a statement under § 3.73(b) has been filed is discontinued.
What is a Customer Number?

A Customer Number is a number that may be used to:

1. Designate the correspondence address of a patent application (the address associated with the Customer Number will be used for the correspondence address);

2. Designate the fee address (§ 1.363) of a patent (the fee associated with the Customer Number will be used for the fee address); and

3. Designate the power of attorney (a list of registered patent practitioners associated with the Customer Number will be recognized as having the power of attorney).
Why Use A Customer Number?

Using a Customer Number for the Correspondence Address will allow pro se applicants, or an applicant’s representatives, access to private PAIR.

The Office highly recommends that all patent practitioners and applicants have access to private PAIR.

To learn how to obtain a customer number and access private PAIR contact the Electronic Business Center (EBC)

- **Website:** www.uspto.gov/ebc
- **Toll Free:** (800)786-9199 or (703) 305-3028
- **Fax:** (703) 308-2840
- **E-mail:** ebc@uspto.gov
Why Use Private PAIR?

Private PAIR includes:
- **IFW Access** (added in June 2003) (Coming to public PAIR in Summer 2004)
- **View Outgoing Correspondence Notifications** (added in August 2003)
  - Display a list of patent application correspondence, by date, with links to IFW images
- **Pre-Grant Publication Review**
  - Submit request for bibliographic data changes online for Pre-Grant Publication purposes
- **Download Cited US References**
  - E-Patent Reference (added in December 2003)
- **Search applications by Customer Number or Attorney Docket Number**
- **Customer Number for Correspondence Address**
  - Submit request for CN Address or Practitioner change online (added in Nov. 2003)
- **Examiner Name Link**
  - Examiner’s name in application display links to Employee Locator contact information
Why Use PAIR?

In addition private PAIR includes (as does public PAIR):

- View bibliographic data and file history
- View continuity, foreign priority, Pre-Grant Publication numbers and dates, PTA/PTE history
- Link to Full-Text and Images on the web for patents and published applications
- Link to Office of Finance website for maintenance fee statements and payment information
- Search by Class/Subclass/GAU to display associated Class/Subclass and Group Art Unit.
- Search Employee Locator to display name, phone number and organization
Questions?
Contact Electronic Business Center (EBC)

1. Customer Number
- How to obtain a customer number?
- Which form do I use?
- How will I receive my customer number?

2. PKI Certificate
- How do I get access to private PAIR?
- How long does it take to get my codes?
- How to create or recover a profile?

3. Electronic Filing System (EFS)
- I can't download this software from the website, how do I get this software?
- How do I resolve the errors that I get when I validate in Epave?
- I have XP, how do I do my specification if PASAT is not compatible?

- Why do I get an invalid error when I enter in my case number?
- I forgot my password, how can I gain access to PAIR?
- My company uses proxys on our server, how can I connect to PAIR?

See also PAIR Frequently Asked Questions:
http://pair-direct.uspto.gov/final/images/pair_faq.html
Final Rule: Image File Wrapper (IFW)

Effective date: July 30, 2003

The Office continues to implement the Image File Wrapper (IFW) system which is an image technology system for storage and maintenance of records associated with patent applications.

All new applications filed since June 30, 2003 are scanned into the IFW system.

Paper components of pending application file contents (including the specification, oath or declaration, drawings, information disclosure statements, amendments, Office actions, and file jacket notations) will be image scanned into the IFW system.
The backfile of existing applications will be scanned, and indexed, into the IFW system.

A schedule for capturing the backfile of existing applications linked to the movement of art units to the Office’s new location at Carlyle has been established.

When a paper for an existing application in a designated art unit is recognized, the paper and the application will be scanned into the IFW system.

All processing and examination will be performed with the electronic image files, instead of paper source documents, by all Office personnel.
The electronic image files in the IFW system will be the official records of the applications (the transition started on 6/30/03).


The image technology system will replace the standard paper processing of applications.
Electronic Maintenance of Application Records

- Increases the integrity of the Office records;
- Reduces the potential for loss of records and misfiling;
- Allows parallel processing of the application by various parts of the Office; and
- Facilitate intra-Office access to an application file and to other authorized parties.
IFW Statistics (7/04)

- Number of Examiners using IFW
  - 3200 Examiners
- Number of Art Units Examining in IFW
  - 238 GAUs - 85% of Total
- Number of Applications Scanned
  - 459,020 New Applications (filed since June 2003)
  - 274,720 Backfile Applications (filed before June 30th 2003)
- Number of Pages Scanned
  - 110,844,664 Pages
Applicants may continue to file applications and correspondence in paper form.

Alternatively, applicants may use the Office electronic filing system (EFS) for new application filings and certain information disclosure statement (IDS) submissions.

– Copies of U.S. patents and U.S. patent application publications are not required under §1.98 if the references are being submitted in an e-IDS.
Applicants may electronically access their applications in the IFW system via the private side of PAIR.

The contents of published applications that are in the IFW system will generally be viewable by the public through the public side of PAIR in FY04.

The system is consistent with the data processing system used by the European Patent Office (EPO). The Office plans to increase information exchange by leveraging common storage architecture.
The rules have been revised to eliminate Office’s return of certain papers.
  – As part of the implementation of IFW, the original paper will be disposed in accordance with a record retention schedule after scanning.
Papers must **not** be permanently bound

- Papers must be readily separable for scanned entry into the image system.
- The use of binder clips or standard office staples will generally be acceptable.
Each section of a patent application is required to start on a separate sheet and include no other portions of the application or other material.

- The application will be electronically scanned and each section of the application (e.g., text of the specification, abstract, claims) will be indexed separately in IFW.
- Presentation of other material on same page makes the electronic indexing of the application more difficult.
Effective date: All amendments filed on or after **July 30, 2003** must comply with the revised 37 CFR 1.121, except amendments to the specification and claims filed in reissue applications and reexamination proceedings.

- A sample amendment document and Q’s and A’s are posted on the USPTO’s website at http://www.uspto.gov/web/offices/pac/dapp/opla/preognotic/e/moreinfoamdtprac.htm
Final Rule: Elimination of CPA Practice as to Utility and Plant Applications

Effective date: July 14, 2003

Effective July 14, 2003, CPA practice has been eliminated as to utility and plant applications.

Any CPA filed in a utility or plant application that was filed on/after June 8, 1995 will be treated as a request for continued examination (RCE) under §1.114.

– Note: If the request for a CPA does not satisfy all of the RCE requirements under §1.114, the request will be treated as an improper RCE.

Any CPA filed in a utility or plant application that was filed before June 8, 1995 will be treated under 37 CFR 1.53(e) as an improper application.

CPA practice remains in effect for design applications.
When a Notice of Foreign Filing is Required


Terminology Used:
- Non Pub Request
- Rescind Request
- Notice of Filing of Counterpart Application
The Office clarifies that:

(1) If an applicant makes a nonpublication request and then rescinds the nonpublication request before/on the date a counterpart application is filed in an eighteen-month publication country, the application will be treated as if the nonpublication request was never made.

(2) If an applicant makes a nonpublication request, subsequently files a counterpart application in an eighteen-month publication country and also files a notice of this foreign filing within forty-five days of the date such counterpart application was filed, the applicant is not required to rescind the nonpublication request.
The Office clarifies that (continued):

(3) If an applicant makes a nonpublication request and subsequently files a counterpart application in an eighteen-month publication country before the nonpublication request is rescinded, the applicant is required to notify the USPTO of the foreign filing no later than forty-five days after the date such counterpart application was filed to avoid abandonment of the application (even if no one recognizes that the application is abandoned).

(4) When an application is abandoned due to the failure to timely notify the USPTO of the filing of a counterpart application in an eighteen-month publication country, applicant’s sole remedy to restore the application to pending status is by filing a petition under 37 CFR § 1.137(b) to revive the abandoned application.
The Office clarifies that (continued):

(5) Applicants should also provide a notice of foreign filing when rescinding a nonpublication request in anticipation of filing a counterpart application in an eighteen-month publication country because no benefit is given to a certificate of mailing or transmission under 37 CFR 1.8 on a rescission of a nonpublication request in determining whether applicant has rescinded the nonpublication request before or on the date a counterpart application is filed in an eighteen-month publication country.

(6) Applicants may use USPTO form PTO/SB/36 (revision April 2001 or later) to both rescind a nonpublication request and provide notice of foreign filing.
Summary – When a Notice of Foreign Filing is Required

Summary

1) NonPub Request – Rescind Request – Foreign File – OK
2) NonPub Request – Foreign file – Notice within 45 days - OK
3) NonPub Request – Foreign file – No Notice within 45 days – application abandoned

In 2 and 3 a Rescind Request is insufficient alone and not needed.

4) If case abandoned, sole remedy is revival per 1.137(b)
5) No C of M benefit given to Rescind Request
6) Use PTO/SB/36 (revision April 2001 or later)
Reexamination Guidelines (Portola)

Effective Date: November 2, 2002

This notice sets forth reexamination policy and practice now in effect as a result of the revision of the reexamination statute made by the Public Law 107-273 (2002), which, in effect, overruled *In re Portola*, 100 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997). See *In re Robert T. Bass*, 65 USPQ2d 1156, 1157 (Fed. Cir. 1997).

Permits reexamination on the basis of prior art that was previously cited by or to, or considered by, the USPTO.

In any reexamination ordered on or after November 2, 2002 (the effective date of the statutory revision), reliance on old art does not necessarily preclude the existence of a substantial new question of patentability that is based exclusively on that old art.
Information Disclosure Statements (IDSs) May Be Filed Without Copies of U.S. References

Effective Date: For patent applications filed after June 30, 2003

IDSs May Be Filed Without Copies of U.S. References (6/30/03)

Electronic Information Disclosure Statement (eIDS)

- Section 1.98 has been amended to provide that the requirement for a copy of U.S. patents and U.S. application publications does not apply to any IDS submitted electronically in compliance with the Office’s EFS. Also see 1262 OG 94 (9/17/02).
- Only U.S. patents and application publications may be submitted with eIDS.
- eIDS may be submitted with original application or later.
- eIDS may be submitted even where application was not submitted by EFS.
- eIDS automatically loads patent citations for Examiner with EAST & WEST search tools.
Copies of cited U.S. patents and U.S. application publications are **not** required for IDS submissions filed in:

- U.S. applications filed after June 30, 2003; and
- International applications that have entered the national stage under 35 U.S.C. 371 after June 30, 2003.


IDSs May Be Filed Without Copies of U.S. References (Continued)

For applications filed on or before June 30, 2003, copies of cited U.S. patents and patent application publications are still required unless the references are submitted in an eIDS.

Applicants are still required to submit copies of foreign patent documents and non-patent literature in accordance with §1.98(a)(2).
USPTO to Cease Supplying Copies U.S. Patent References Cited by the Office (E-Patent Reference)


July 2, 2004
USPTO to Cease Supplying Copies U.S. Patent References Cited by the Office (5/04)

U.S. patent references cited in Office actions can be downloaded in one downloading step using E-Patent Reference feature of private PAIR.

The Office will begin to cease mailing paper copies of U.S. patent references with Office actions in accordance with the schedule:

- June 2004 – TCs 1600, 1700, 2800 and 2900
- July 2004 – TCs 3600 and 3700
- August 2004 – TCs 2100 and 2600

Paper copies of foreign patents and non-patent literature will continue to be included with Office actions, as well as U.S. patent references cited during the international stage of an international application.

U.S. patent references will continue to be available on the USPTO website, from the Office of Public Records and from commercial sources.
E-Patent Reference is a feature on private PAIR.

To access to private PAIR, a practitioner of record or pro se applicant must:

1. Get a free Public Key Infrastructure (PKI) digital certificate from the Office.
2. Get a customer number from the Office:
   i. Download and complete the Customer Number Request form, PTO-SB125, at: http://www.uspto.gov/web/forms/sb0125.pdf.
   ii. Associate your registration number with a customer number by adding your registration number to the Customer Number Request form.
   iii. The completed form can then be transmitted by facsimile to the Electronic Business Center at (703) 308-2840, or mailed to the address on the form.
3. Associate the application’s correspondence address with the customer number.
   – A description of associating a customer number with an application is described at the EBC web page at:

4. Obtain the software for electronic filing,
   – By downloading from www.uspto.gov/ebs, or
   – By contacting EFS Help Desk at (703) 305-3028.
   – Adobe Acrobat Reader is also required and available through a link from the USPTO web site.

5. Arrange for appropriate Internet access.
A practitioner of record or pro se applicant will be able to access application information using their PKI certificate to view the private PAIR Screen for applications which have the correspondence address associated with your customer number.

– When references are available for downloading, a reference button is displayed as shown on the next page.
USPTO to Cease Supplying Copies U.S. Patent References Cited by the Office (continued) (5/04)

New Button In private PAIR To Display References

<table>
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<th>Search results for application number: 10/387,861</th>
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<td><strong>Filing or 371(c) Date:</strong> 03-14-2003</td>
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<tr>
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The Office of Patent Publication may waive the requirements of 37 CFR 1.312 to accept amendments after the payment of issue fee that are required by the Office to correct errors in the application discovered during the preparation of the issuance of the patent.

European Patent Office (EPO) Resumes Competence to Act as a PCT Authority

The EPO will resume acting as a competent International Searching Authority (ISA) for international applications filed by U.S. residents or nationals on or after January 1, 2004 in the USPTO or IB as receiving Office, and where the application contains claims directed to the field of biotechnology.

The EPO will resume acting as a competent International Preliminary Examining Authority (IPEA) for international applications filed by U.S. residents or nationals on or after January 1, 2004 in the USPTO or IB as receiving Office, where the application contains one or more claims directed to the field of biotechnology and where the EPO acted as the ISA.

Patent Application Publications May Now Include Amendments

The patent application publication may be based upon:

- A substitute specification,
- An amendment to the abstract,
- A complete claim listing, and
- Replacement drawing sheets.

The amendments must be submitted in sufficient time to be entered into the application file wrapper before technical preparations for publication of the application have begun.

- Generally, technical preparations begin between 14 and 9 weeks prior to the projected publication date (PPD).

Usage of Application Data Sheets Encouraged

Use of an application data sheet (37 CFR 1.76) is strongly encouraged when submitting:

– A request to correct or change the name of an inventor,
– A request to correct the inventorship, or
– A petition to change the order of the inventors’ names.

See Advance Notice of Change to MPEP 605.04(b), (c) and (f) - Application Data Sheets Are Strongly Recommended When Inventor Information is Changed, 1281 Off. Gaz. Pat. Office 54 (April 13, 2004).
To maintain information in confidence, any material submitted pursuant to MPEP 724.02 must be placed in a clearly labeled envelope that indicates that the material is not to be scanned.

Information not submitted in compliance with MPEP 724.02 will be scanned and placed in the Image File Wrapper.

Centralized Delivery of Hand-Carried Papers and Facsimile Transmissions

Effective Date: December 1, 2003


Centralized Delivery of Hand-Carried Papers and Facsimile Transmissions

Effective December 1, 2003, for all official patent application related correspondence for organizations reporting to the Commissioner of Patents:

- Correspondence that is hand-carried (or delivered by other delivery services, e.g., FedEx, UPS, etc.) must be delivered to the Customer Window (with a few exceptions):
  2011 South Clark Place
  Crystal Plaza Two, Lobby, Room 1B03
  Arlington, VA 22202

- Effective June 5, 2004, although the building will remain the same, the address will change to: **220 South 20th Street**.

- Correspondence that is transmitted by facsimile must be directed to the central facsimile number, **(703) 872-9306** (with a few exceptions).
Some Exceptions:

Direct delivery or facsimile is appropriate for:

- Petitions for express abandonment to avoid publication under §1.138(c)
- Petitions to withdraw an application from issue under §1.313(c)
- Request for expedited examination of a design application
- Papers required by the Office of Patent Publication
Mail Stops


New Mail Stop L&R

When submitting applications subject to secrecy order or that are national security classified, or correspondence to be filed in such an application, the papers should either be:

1. Hand carried to Licensing and Review; or
2. Mailed to a new Mail Stop, **Mail Stop L&R**.

- Requests for Expedited Foreign Filing Licenses may be faxed to (703) 305-7658.

New Mail Stops

Mail Stop **Post Issue** – for correspondence in applications that have issued as a patent, such as:

- revocations of powers of attorney, withdrawal of attorney, submissions under 37 CFR 1.501, and requests for changes of address (other than a fee address, which should be addressed to Mail Stop M Correspondence).

Mail Stop **Amendment** – e.g., replies to non-final Office actions

- Mail Stop Non-Fee Amendment has been changed to Mail Stop Amendment

Mail Stop **Express Abandonment** – for petitions and letters of express abandonment under 37 CFR 1.138

- Mail Stop PGPub-ABD has been changed to Mail Stop Express Abandonment.

Deletions of Mail Stops

The mail stops that should **no longer** be used are:

- Mail Stop *Application Number*
- Mail Stop *CPA*
- Mail Stop *Design*
- Mail Stop *Non-Fee Amendment* (has been changed to Mail Stop Amendment);
- Mail Stop *Patent Application*;
- Mail Stop *PGPub-ABD* (has been changed to Mail Stop Express Abandonment); and
- Mail Stop *Provisional Patent Application*.

If no mail stop is included on the list in the OG notice, then no mail stop should be used for the correspondence.

Any petition for express abandonment to avoid publication and any other letter of express abandonment under 37 CFR 1.138, should be:

1. Mailed to: Mail Stop Express Abandonment
2. Transmitted by facsimile directly to (703) 305-8568; or
3. Hand delivered to the Pre-Grant Publication Division.

Since even a petition under § 1.138(c) will not stop publication unless it is recognized and acted on by the Pre-Grant Publication Division in sufficient time to avoid publication, a petition under § 1.138(c) should be filed by facsimile or hand-delivery if the projected publication date is within **three months** of the date when the petition will be filed.

Lengthy Tables

Lengthy tables (e.g., tables on more than 200 pages) cause significant scanning and publication problems.

Applicants are encouraged to submit lengthy tables on compact disc (CD) in ASCII text as provided in 37 CFR 1.52(e) or via Electronic Filing System (EFS) with the application, as an appendix (and not embedded in the specification).

Lengthy tables submitted in such electronic form will be published by posting on the sequence homepage of the USPTO web site.

See Notice that Lengthy Tables will be Published Differently in Patents, Statutory Invention Registration and patent Application Publication And Notice of Pilot Program With Respect to Lengthy Tables, 1282 Off. Gaz. Pat. Office 108 (May 18, 2004).
If a petition filed after **June 30, 2003** has **not** been acted upon by the Office; and

The petition is a type that is decided by the Office of Deputy Commissioner for Patent Examination Policy listed in MPEP § 1002.02(b),

Applicants are encouraged to send an e-mail alert to petitions@uspto.gov.

Applicants should check either their records or PAIR to determine whether the Office has responded to a petition listed in the MPEP § 1002.02(b), including the Office of Patent Legal Administration and the Office of Petitions (e.g., petitions to revive, petitions to withdraw an application from issue, and petitions for patent term adjustment).

Request for Alert
Concerning Submitted Petitions (continued)

The e-mail alert should include:

- The application number of the application in which the petition was filed;
- The filing date of the petition; and
- The regulation under which the petition was filed, if known.

Example [e-mail addressed to petitions@uspto.gov]

The following petitions have not been answered to date:

<table>
<thead>
<tr>
<th>Application No.</th>
<th>Petition Filed</th>
<th>Regulation</th>
</tr>
</thead>
<tbody>
<tr>
<td>10/111,111</td>
<td>October 3, 2003</td>
<td>37 CFR 1.137(b)</td>
</tr>
<tr>
<td>10/222,222</td>
<td>December 5, 2003</td>
<td>37 CFR 1.183</td>
</tr>
</tbody>
</table>
The e-mail alert

Should **not** include other information and attachments;

Will not be considered a communication in the file under 37 CFR 1.4(a)(2);

Will not be considered a status inquiry;

Will not be entered into the file contents; and

Will not be acknowledged.
Effective June 5, 2004, patent correspondence delivered by hand or delivery services, **other than the USPS**, to the Customer Window must be addressed as follows:

U.S. Patent and Trademark Office

220 20th Street S.

Customer Window, Mail Stop ______

Crystal Plaza Two, Lobby, Room 1B03

Arlington, VA  22202

Although the physical location of the Customer Window (the building and room number) will remain the same, on June 5, 2004 the street address of the Crystal Plaza 2 building will change from 2011 South Clark Place to **220 20th Street S.**

See **New Address for Customer Window which is Used for Patent Mail NOT Delivered by USPS, 1283 Off. Gaz. Pat. Office 23** (June 1, 2004) for other street address changes.
<table>
<thead>
<tr>
<th>TITLE*</th>
<th>OG CITE</th>
<th>OG DATE</th>
<th>FR CITE</th>
<th>FR DATE</th>
</tr>
</thead>
<tbody>
<tr>
<td>Maintenance Fee Statements are No Longer being Mailed for Maintenance Fees Paid over the Internet (posted 16 June 2004)</td>
<td>1283 OG 108</td>
<td>15 JUN 2004</td>
<td></td>
<td></td>
</tr>
</tbody>
</table>
Thank You