

Dated: December 29, 1983.

Charles N. Canestro,

Management Analyst, Federal Register
Liaison.

[FR Doc. 84-70 Filed 1-3-84; 8:45 am]

BILLING CODE 8230-01-M

**President's International Youth
Exchange Initiative; Selective
Assistance Through Limited Grant
Support to Not-for-Profit Organizations**

The United States Information Agency (USIA) announces a program of selective assistance through limited grant support to private not-for-profit organizations for programs in support of the President's International Youth Exchange Initiative with the United Kingdom, the Federal Republic of Germany and France.

The primary goal of the program will be to develop collaborative, continuing exchange relationships between eligible U.S. exchange organizations and clearly identified youth groups in the three countries. Such groups in the U.K. may, but need not, be sponsored and assisted by the British Council or the Central Bureau for Educational Visits and Exchanges. In Germany, they must be sponsored by the Ministry for Youth, Family and Health. In France such groups may, but need not, be sponsored and assisted by the French Ministry of Cultural Relations or the French Ministry of Youth and Sports.

Amounts of \$400,000 for US-German exchanges, \$150,000 for US-UK exchanges, and \$150,000 for US-French exchanges have been allocated for all programs within this announcement.

Organizations meeting eligibility requirements and interested in working cooperatively with USIA are invited to submit concept papers for the following program areas to the International Youth Exchange Staff.

Program Proposal Content

The following categories for the program have been established for this competition:

A. U.K. Programs

1. Participant type—Students aged 15 to 19 years; youth leaders, young workers and farm youth aged 15-25.

2. Program Length—Generally, four to six weeks or longer.

3. Accommodations—Homestays for the full period of residency are preferred.

Preference will be given to:

1. Organizations which have established ongoing partnerships with appropriate British youth organizations.
2. Exchanges that involve work,

service and other similar projects, which lend themselves to continuing exchanges in future years, not requiring Federal funding.

3. Reciprocal exchanges in which a group of members of a youth organization in the U.S. and a group of members of a similar organization in the United Kingdom exchange visits for the purpose of better understanding of each other's way of life. In each country there should be a program in which both groups take part.

For the U.K., a two-step process of concept paper and full proposal will be employed (See Grant Guidelines section). Organizations whose intended partners in the Kingdom are applying separately to either the British Council or the Central Bureau should include reference to that application for funding (and the amount requested) in their concept papers. The Governments of the U.S. and Great Britain will coordinate on the award of grants. A consultative mechanism consisting of representatives of appropriate US/UK governmental entities will meet to review all applications for grant funding prior to final awards.

B. Federal Republic of Germany (FRG)

1. Participant type—16 to 25 year-olds.

2. Program length—Generally three-six weeks or longer.

3. Homestay—Homestays are preferred.

Preference will be given to:

1. Organizations which have established ongoing partner relationships with appropriate German youth organizations;
2. Exchanges that involve work, service and other similar projects, which lend themselves to continuing exchanges in future years, not requiring Federal funding.

Proposals are invited in fulfillment of the following types of exchanges:

1. A program to enable youth active in social welfare projects to gain practical experience through an exchange with the FRG. Preference will be given to concepts which include work/observation periods in areas of mutual German-American concern. For example, community action, minorities, drug addiction, probation system, the disabled, juvenile delinquency.

2. A program to enable youth active in environmental protection to gain experience through an exchange with the FRG. Preference will be given to concepts which provide broad exposure to the measures which both societies are taking to respond positively to environmental problems.

3. A program to enable youth to observe the political process in the U.S. and the FRG. Preference will be given to

concepts which provide maximum exposure to grass-roots political activity and the positive role of youth in political action.

4. A program to enable young trade union leaders and potential leaders to participate in youth-related activities of unions in the U.S. and the FRG. Preference will be given to concepts which will provide well-rounded activities allowing for the participation in all aspects of youth-related union work.

5. A program for young farm youth to intensify organizational contacts between farm youth organizations in the U.S. and the FRG, leading to continued exchange programs.

6. A program to bring together young Germans and Americans who share an appreciation for the arts in fora such as workshops, camps, and other educational activities (excluded are professionals and performing tours of national groups).

For the FRG, organizations whose German partners intend to apply separately to the Ministry of Youth, Family and Health for funding should so indicate in their concept papers. Proposals will be reviewed by a joint US-FRG committee prior to the award of grants.

C. France

1. Participant type—15-22 year-olds.

2. Program length—Generally four weeks or longer.

3. Homestay—Homestays for the full period of residency are preferred.

4. Preference will be given to intercultural learning programs designed specifically for non-academic participants, such as young workers, business interns, and farm youth.

Organizations interested in establishing new partnerships with French organizations should contact the Youth Exchange Staff of USIA at the address below for the list.

For France, a joint US-French panel will be convened in Paris to review all proposals recommended by USIA prior to final approval.

Eligibility

Academic, cultural and not-for-profit exchange-of-persons organizations are eligible to apply. Organizations should be able to demonstrate a proven record (four years) of work in their field.

Not-for-profit organizations which are the offspring of for-profit firms engaged in similar activities will not be eligible for consideration under this program.

Priority will be given to organizations with national or regional volunteers. Organizations must be capable of meeting the "Criteria for Teen-ager

Exchange Visitors Programs" or "Criteria for Practical Trainees", which may be obtained by writing to the USIA address listed at the end of this announcement.

Grant Guidelines

USIA grant assistance should constitute only a portion of total project funding. Continuing projects for which USIA assistance is requested should include an acceptable plan for leading to a self-sustaining status. Under normal circumstances, USIA support is limited to one year.

Concept papers will be judged on the basis of the following criteria:

- The proposed activity should contribute to the sustained, long-term development of youth exchanges.
- The project should show promise of generating additional private exchange activity.
- The project should enhance the quality of the exchange visitors' experience.
- The organization should demonstrate the ability to manage the exchange (adequate field personnel, administrative support mechanisms, etc.).
- Reciprocity of exchange—i.e., two-way flow—is an integral part of this program.
- Reasonable per capita costs, as viewed in comparison with other proposals and with standards for the field.
- Consistency with the thematic emphases described in this announcement.

Under this program USIA will not finance: preparation of research studies; the underwriting of exchange activities already being carried out or of operating costs; any project which is designed to lobby elected officials or promote politically partisan views; projects whose aim is to promote religious activities.

Interested organizations are invited to forward (to the address given below) 10 copies of a brief two to three page concept paper, in the case of the United Kingdom, outlining the objective of their proposed activity and the nature of the project. Please also include: a copy of the organization's charter; a list of the board of directors; a budget which notes the probable contributions of the organization or other sources to the total

cost of the proposed project; and curricula vitae on the principal project staff.

In the case of Germany and France, interested organizations are invited to submit 10 copies of a full proposal, which should include the following: (1) A standard USIA cover sheet; (2) project summary; (3) narrative description of the project; (4) work plan/time frame for achieving the project's objectives; (5) a line-item budget; and the other attachments listed above. Organizations may call or write USIA for a copy of the proposal guidelines and cover sheet.

Timetable

United Kingdom—In order to be considered for funding in this competition, concept papers must be received by USIA not later than February 15, 1984. USIA review of the concept papers, on the basis of the criteria listed above, will be completed by March 15 and full proposals invited. Proposals will be due April 15. Final review and approval decisions will be made by May 31. It should be understood that USIA's recommendation to prepare a detailed grant proposal does not necessarily guarantee the approval of the proposal.

Germany—The concept paper stage will not be included in the competition for US-German exchanges. As noted above, interested organizations should request a copy of the Guidelines for Youth Exchange Proposals from the address listed below. Proposals are due in USIA by February 15, 1984. They will be reviewed by March 15 and decisions made by April 1.

France—As in the case of Germany, full proposals are herein solicited. Interested organizations may write or call for the Guidelines and proposals must be received in USIA by February 15. The Youth Exchange Staff will complete initial review of the proposals by March 1.

As stated above, all project ideas will be subjected to review by the joint committees in the U.K., the FRG and France.

Address for all inquiries: The International Youth Exchange Staff, Bureau of Educational and Cultural Affairs (E/YX), U.S. Information Agency, Washington, D.C. 20547 or call (202) 485-7299.

Dated: December 29, 1983.

Charles Canestro,
Federal Register Liaison, United States Information Agency.

[FR Doc. 84-79 Filed 1-3-84; 8:45 am]

BILLING CODE 8230-01-M

OFFICE OF THE UNITED STATES TRADE REPRESENTATIVE

Renewal of the Advisory Committee for Trade Negotiations

The United States Trade Representative, pursuant to Section 135(b) of the Trade Act of 1979 (19 U.S.C. 2155(b)), (the Act), the Federal Advisory Committee Act (5 U.S.C. App. I) and Section 4(d) of Executive Order No. 11846 of March 27, 1975, hereby renews the Advisory Committee for trade Negotiations to provide overall policy advice referred to in Title I of the Act.

The Committee shall consist of not more than 45 members including representatives of government, labor, industry, agriculture, small business, service industries, retailers, consumer interest, and the general public. Members of the Committee shall be appointed by the President for a period of two years, and may be reappointed.

The Committee shall provide overall policy advice with respect to negotiating objectives and bargaining positions directed toward trade agreements under Section 102 of the Act, to the operation of trade agreements entered into, and to other matters arising in connection with the administration of the trade policy of the United States. The Committee also shall provide to the President, the Congress and the United States Trade Representative advice on whether and to what extent any agreement entered into under Section 102 of the Act promotes the economic interests of the United States.

Representatives from the private sector wishing further information should contact: the Office of the U.S. Trade Representative, Office of Private Sector Liaison, 600 17th Street, NW., Washington, D.C. 20506, (202) 395-6120.

Phyllis O. Bonanno,
Director, Office of Private Sector Liaison.

[FR Doc. 84-26 Filed 1-3-84; 8:45 am]

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Sunshine Act Meetings

Federal Register

Vol. 49, No. 2

Wednesday, January 4, 1984

This section of the FEDERAL REGISTER contains notices of meetings published under the "Government in the Sunshine Act" (Pub. L. 94-409) 5 U.S.C. 552b(e)(3).

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1

FEDERAL RESERVE SYSTEM

TIME AND DATE: 10:00 a.m., Monday, January 9, 1984.

PLACE: 20th Street and Constitution Avenue, NW., Washington, D.C. 20551.

STATUS: Closed.

MATTERS TO BE CONSIDERED:

1. Personnel actions (appointments, promotions, assignments, reassignments, and salary actions) involving individual Federal Reserve System employees.

2. Any items carried forward from a previously announced meeting.

CONTACT PERSON FOR MORE INFORMATION:

Mr. Joseph R. Coyne, Assistant to the Board; (202) 452-3204.

Dated: December 30, 1983.

James McAfee,

Associate Secretary of the Board.

[S-1811-83 Filed 12-30-83; 4:18 pm]

BILLING CODE 6210-01-M

2

PACIFIC NORTHWEST ELECTRIC POWER AND CONSERVATION PLANNING COUNCIL

AGENCY HOLDING THE MEETING: Pacific Northwest Electric Power and Conservation Planning Council (Northwest Power Planning Council).

ACTION: Notice of meeting to be held pursuant to the Government in the Sunshine Act (5 U.S.C. 552b).

STATUS: Open. A portion of this meeting will be closed to the public to discuss pending litigation and other legal matters.

TIME AND DATE: January 11-12, 1984, 9:00 a.m.

PLACE: Federal Building, South Auditorium, Seattle, Washington.

MATTERS TO BE CONSIDERED:

Status Reports on Yakima Basin Workplan
Status Report on Goals Study
Decision on Pend Oreille Hatchery
Status Report on Columbia River Basin Fish and Wildlife Program Amendment Schedule
Staff Presentation on EPA Billing Credits
Public Comment on Proposed Amendments to the Council's Study on Large Thermal Plant Planning and Construction Schedules (Action 23.1)
Status Report on Regional Energy Demand
Review of Model Conservation Standards
Material
Council Business
Public Comment

FOR FURTHER INFORMATION CONTACT:

Ms. Bess Wong (503) 222-5161.

Edward Sheets,

Executive Director.

[S-1812-83 Filed 12-3-83; 4:26 pm]

BILLING CODE 0000-00-M

Registered Trademark

Wednesday
January 4, 1984

Part II

Department of Commerce

Patent and Trademark Office

37 CFR Part 1

Revision of Patent Practice; Final Rule

DEPARTMENT OF COMMERCE**Patent and Trademark Office****37 CFR Part 1****[Docket No. 31-201-229]****Revision of Patent Practice****AGENCY:** Patent and Trademark Office, Commerce.**ACTION:** Final rule.

SUMMARY: The Patent and Trademark Office is amending the rules of practice in patent cases, Part 1 of 37 CFR, to clarify the practice under certain sections of Pub. L. 97-247 of 1982 and to make certain other changes and clarifications in practice which have been found desirable after some experience. The rulemaking changes the practice under §§ 1.27 and 1.28 with regard to subsequently establishing small entity status and qualifying for a refund of fees paid in full. The changes in other rules clarify and improve the practice in certain areas.

EFFECTIVE DATE: April 1, 1984.

FOR FURTHER INFORMATION CONTACT: R. Franklin Burnett by telephone at (703) 557-3054 or by mail marked to his attention and addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231.

SUPPLEMENTARY INFORMATION: This rule change is designed primarily to (1) clarify the small entity status of independent inventors, small business concerns and nonprofit organizations having funding agreements with a federal governmental agency as defined in 35 U.S.C. 202(c)(4); (2) rewrite § 1.28 to provide a system for obtaining a refund of a portion of a fee paid in full when small entity status is established within two months of the date of such payment; (3) provide that a separate statement establishing small entity status is not required in an application filed under § 1.62 when such status has been established in the parent application; and (4) modify certain other rules to clarify practice.

New § 1.21(l) establishes a fee for processing and retaining any application which is abandoned for failing to complete the application pursuant to § 1.53(d). This new paragraph, as well as the changes to §§ 1.53 and 1.78, indicate that in order to obtain benefit of a prior U.S. application, either the basic filing fee or the processing and retention fee of § 1.21(l) must be paid. Section 1.53(d) further establishes that the application will be disposed of if the required fee is not paid within a set period. Section 1.56(b) requires submission of copies of

foreign patent documents, non-patent publications, or other non-patent items of information disclosed pursuant to the duty to disclose. New § 1.191(d) clarifies that § 1.136 applies in patent applications and that § 1.550(c) applies in reexamination proceedings to all time periods set forth in §§ 1.191-1.194, 1.196 and 1.197.

Discussion of Specific Rules and Significant Differences Between Proposed and Final Rules

Section 1.5, paragraph (a) is amended to remove a reference to § 1.55, which is no longer appropriate and to clarify how letters to the Office are to be identified.

Section 1.6 is amended as proposed to clarify the manner in which letters and papers, including fees, filed in accordance with § 1.10 by "Express Mail" are date stamped when received in the Patent and Trademark Office. Such letters and papers, which comply with § 1.10, will be stamped with the date of deposit as "Express Mail" with the United States Postal Service unless the date of deposit is a Saturday, Sunday or federal holiday within the District of Columbia, in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or a federal holiday within the District of Columbia. No papers are received in the Patent and Trademark Office on Saturdays, Sundays, or federal holidays within the District of Columbia.

Section 1.10, paragraphs (a) and (c), are amended to clarify that papers deposited as "Express Mail" on a Saturday, Sunday, or a federal holiday within the District of Columbia will be stamped with the date of the next succeeding day which is not a Saturday, Sunday, or a federal holiday within the District of Columbia. A cross reference to § 1.6(a) has also been added to the rule. This change was not contained in the notice of proposed rulemaking but is being made to avoid confusion and to ensure that the Office's practice in date-stamping of papers is clearly understood. The change was suggested by a comment received on the proposed rules.

Section 1.14 is amended as proposed to revise paragraph (b) to clarify that only complete patent applications as defined in § 1.51(a) which become abandoned will be retained for a period of twenty years from the filing date. Incomplete applications will be retained as provided in §§ 1.21 and 1.53.

Section 1.19, paragraph (b)(3), is amended as proposed to clarify that only copies made from Office records, but not prepared by the Office, will be compared with the original prior to certification of the copies. The Office

will not compare copies made from some other copy or record with Office records for purposes of certification. The stated charge of ten cents per page would not be sufficient to make a word-by-word comparison. The requirements of the public appear to still be served by limiting the use of the comparison fee to Office records.

Section 1.21 is amended as proposed to revise paragraph (b)(2) and establish a new paragraph (1). The change in paragraph (b)(2) is in accord with the change in § 1.25(a). New paragraph (1) provides a fee for processing and retaining any application which is abandoned pursuant to § 1.53(d). Such applications have received a filing date pursuant to 35 U.S.C. 111 but have been abandoned for failure to complete the application by filing the oath or declaration, filing fee or surcharge (§ 1.16(e)). The fee covers the handling, filing, processing, data input and storage required to retain an application. The fee is not due in any application in which the basic filing fee was paid.

Section 1.25 is amended as proposed to revise paragraph (a) to set the minimum deposit for a deposit account at \$1000 and to clarify that an amount sufficient to cover all fees as well as services, copies, etc., requested must always be on deposit. This minimum amount is considered necessary and proper in view of the substantial increase in the amounts of fees being charged to deposit accounts and the processing costs of handling overdrawn accounts. Paragraph (b) clarifies that fees may be charged against a deposit account only where sufficient funds are on deposit to cover the entire amount of the fees. Paragraph (b) also clarifies that an authorization to charge a fee to a deposit account will not be considered payment on the date the authorization to charge is effective as to that fee unless sufficient funds are present in the account to cover the fee.

Section 1.27 is amended as proposed to revise paragraphs (b), (c) and (d) to provide clearly that an independent inventor, small business concern, or nonprofit organization, which is otherwise qualified as a small entity for purposes of paying reduced patent fees under 37 CFR 1.9 and 1.27, is not disqualified therefrom because of a license to a federal agency pursuant to 35 U.S.C. 202(c)(4). Section 1.27 is amended to state that such a license does not constitute a license or a conveyance of rights which would preclude qualifying for small entity status. The amendment is necessary for clarification and to avoid frustrating the

intent of Pub. L. 97-247 and Pub. L. 96-517 when taken together.

The text of Title 35, United States Code, section 202(c)(4) reads as follows:

Section 202. Disposition of rights

(c) Each funding agreement with a small business firm or nonprofit organization shall contain appropriate provisions to effectuate the following:

* * * * *

(4) With respect to any invention in which the contractor elects rights, the Federal agency shall have a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States any subject invention throughout the world, and may, if provided in the funding agreement, have additional rights to sublicense any foreign government or international organization pursuant to any existing or future treaty or agreement.

Section 1.28 is amended as proposed to revise paragraph (a) to clarify that a separate verified statement is not required to be filed in a file wrapper continuing application filed pursuant to § 1.62, if status as a small entity has been established in the parent application and is still proper. Section 1.28(a) also permits a refund of a fee timely paid in the full amount if within two months of the date of the full timely payment: (1) Small entity status is properly established, and (2) a refund is requested. Under § 1.28(a), no request for a refund filed later than two months after the date on which a full fee has been paid will be entertained even if additional time is sought to file the request. The two-month period referred to in § 1.28(a) is not a period for response under § 1.136 and cannot be extended. Section 1.28(a) provides for, in somewhat modified form, the practice presently in effect pursuant to a waiver of § 1.28 published at 1023 O.G. 77 on October 26, 1982 and extended at 1027 O.G. 115 on February 15, 1983. The revised refund procedures in § 1.28(a) will apply to any fees timely paid in full on or after the effective date of the final rule. The refund procedures set forth in the Patent and Trademark Office *Official Gazette* Notice entitled "Filing of Verified Statements Claiming Small Entity Status" published at 1023 O.G. 77 on October 26, 1982, and the *Official Gazette* Notice entitled "Requirement for Filing Verified Statements Claiming Small Entity Status" published at 1027 O.G. 115 on February 15, 1983, continue in effect until the effective date of the final rule.

Section 1.52(d) is amended as proposed to clarify that the verified English translation of a non-English language application and the fee set forth in § 1.17(k) can be filed with the

application or within such time as may be set by the Office.

Section 1.53, paragraphs (b) and (d), are amended to clarify in paragraph (b) that the application for patent must be filed in the name of the actual inventor or inventors by giving all their names as required by § 1.41. Paragraph 1.53(d) states that if a correspondence address is provided, notice will be provided to that address where the appropriate filing fee or oath or declaration does not accompany the application. Paragraph 1.53(d) also provides that if the required filing fee is not paid, or the processing and retention fee is not paid, within one year of the date of mailing of notification pursuant to § 1.53(d) or within one year from the filing date if no correspondence address is included in the application, the application will be disposed of. The paragraph further indicates that no copies will be provided or certified by the Office of an application which has been disposed of or in which neither the basic filing fee nor the processing fee has been paid. Finally, § 1.53(d) specifies that if no correspondence address is included in the application, applicant will have two months from the filing date to file the fee, oath or declaration and to pay the surcharge set forth in § 1.16(e) in order to prevent abandonment of the application.

Section 1.55, paragraph (b), is amended as proposed to correct an error in referring to paragraph (a) of this section.

Section 1.56 is amended as proposed to revise paragraph (b) and add a new paragraph (j). Paragraph 1.56(b) requires that a copy of each foreign patent document, non-patent publication, or other non-patent item of information in written form being disclosed pursuant to § 1.56 accompany such disclosures unless the copy is not in the possession of the person making the disclosure. In such a situation, a statement to that effect is required. Paragraph 1.56(b) also adds "or her" to refer to both genders. New § 1.56(j) states that applicant will be notified if a copy or statement required pursuant to § 1.56(b) is not submitted and that applicant will be given a time period within which to file the copy or a statement that the copy is not in the possession of the person making the disclosure. Such a time period would be extendable under § 1.136. Failure to respond in a proper and timely manner would result in abandonment of the application.

Section 1.59 is amended as proposed to clarify that the Office will furnish copies of papers received in the Office at the usual cost only if the basic filing

fee or the processing and retention fee has been paid.

Section 1.60 is amended to break the section into paragraph (a) and new paragraph (b). Paragraph (a) adds a reference to amended § 1.78(a) to clarify the conditions under which continuation or divisional applications may be filed. New § 1.60(b) provides that the signing of the oath or declaration can be omitted if the prior application was complete as set forth in § 1.51(a). New § 1.60(b) also requires that a true copy of the prior complete application be filed. The final rule also clarifies that the copy of the oath or declaration filed must show the applicant's signature or contain an indication it was signed. Paragraph 1.60(b) also provides that only amendments reducing the number of claims or adding a reference to the prior application will be entered before calculating the filing fee and granting the filing date.

Section 1.62 is amended as proposed to revise paragraphs (a) and (d). Paragraph 1.62(a) provides that the file wrapper continuing procedure is applicable only to prior complete applications under § 1.51(a). Paragraph 1.62(d) clarifies that the filing fee referred to is the basic filing fee.

Section 1.78 is amended as proposed to change the title to more explicitly define the contents of the section. Paragraph 1.78(a) specifies that in order for an application to claim the benefit of a prior filed copending national application, the prior application must be complete as set forth in § 1.51(a) or be entitled to a filing date as set forth in § 1.53(b) and include the basic filing fee set forth in § 1.16, or be entitled to a filing date as set forth in § 1.53(b) and have paid the processing and retention fee set forth in § 1.21(1) within the time period set forth in § 1.53(d).

Section 1.121 is amended as proposed to revise paragraph (e) to specify how amendments to the description and claims are to be made in reissue applications.

Section 1.123 is amended as proposed to clarify that the sketch showing proposed amendments to the drawing with its cover letter should be a separate paper.

Section 1.135 is amended as proposed to remove paragraph (d) since it is not necessary in view of the ability to obtain extensions of time under § 1.136(a) by petition and payment of fee.

Section 1.136 is amended as proposed to clarify in paragraphs (a) and (b) that the extension of time practice under this section does not apply in interference proceedings or in reexamination

proceedings. Extension of time practice in interference proceedings, including extension of time for appeal or civil action (§ 1.304), is subject to § 1.245. Extension of time practice in reexamination proceedings, including extension of time for appeal or civil action (§ 1.304), is subject to § 1.550(c).

Section 1.191 is amended as proposed to add a new paragraph (d) to provide that the time periods for appeal and review set forth in §§ 1.191-1.194, 1.196 and 1.197 are subject to the provisions of § 1.136 for patent applications or § 1.550(c) for reexamination proceedings.

Section 1.192 is amended as proposed to revise paragraph (a) to delete the reference to § 1.136 since it is provided for in new § 1.191(d).

Section 1.197 is amended as proposed to revise paragraph (b) to delete the reference to § 1.136 since it is provided for in new § 1.191(d).

Section 1.304 is amended as proposed to clarify that extensions of time periods set forth therein are subject to the provisions of § 1.245 for interferences or § 1.550(c) where reexamination proceedings are involved rather than to § 1.136 which applies in all other cases.

Section 1.550 is amended as proposed to revise paragraph (c) to clarify that the time for taking any action, including appeal, by a patent owner in a reexamination proceeding is governed solely by this section.

Section 1.555 is amended to revise paragraphs (a) and (b). In § 1.555(a) "prior art" statement has been changed to "information disclosure" statement to conform to the language of § 1.98. Paragraph 1.555(b) requires that disclosures pursuant to this paragraph be accompanied by a copy of each foreign patent document or non-patent printed publication which is being disclosed and which is in the possession of the person making the disclosure.

Responses To Comments on the Rules

Specific comments were received on a number of the sections. Thirty-five letters presenting written comments were received. No oral testimony was presented at the public hearing conducted on October 18, 1983. All of the comments were considered in adopting the changes set forth herein. Comments appear below with responses thereto.

Comments From Associations

Comment: The American Patent Law Association commented that they were in full accord with most of the proposed changes. They submitted comments and suggestions from some members. The Patent, Trademark and Copyright

Section of the American Bar Association did not render an official section position on the proposed rule changes but polled its members and found the majority of the members responding either to favor the proposed rule changes or to view them as acceptable. They also submitted comments and suggestions from some members. The United States Trademark Association commented on the proposed rules concerning deposit accounts.

Reply: The efforts and input of these organizations are appreciated. Specific comments and suggestions from individual members of the organizations are covered below.

Comments From Individuals

Comment: One comment was received that the proposed amendment to § 1.6 was unnecessary and possibly improper.

Reply: The amendment to § 1.6 has been adopted as proposed. The amended rule sets out the Patent and Trademark Office practice which has been in effect. No papers are stamped as having arrived in the Office on Saturday, Sunday, or a federal holiday within the District of Columbia no matter how the papers are filed. Article 4, C(3) of the Paris Convention says that the period of priority shall be extended until the first following working day "when the Office is not open for the filing of applications in the country where protection is claimed". To accept papers through use of "Express Mail" or some other way on Saturdays, Sundays or federal holidays within the District of Columbia would raise the possibility that the Office would be viewed as open for the filing of papers on such days and thereby remove the current ability to file a priority claiming application on the first working day if the priority year ended on a non-working day. The final rule avoids this implication.

Comment: One comment indicated that the change to § 1.6 should not be applied retroactively to papers filed before the clarifying language was placed in the rule.

Reply: Any such fact situation will be reviewed through the normal petition procedure.

Comment: One comment suggested that § 1.10 be amended rather than § 1.6 with regard to papers deposited as "Express Mail" on a Saturday, Sunday, or federal holiday within the District of Columbia.

Reply: This comment has been adopted in that both §§ 1.6 and 1.10 have been amended to avoid any possible confusion.

Comment: One comment suggested that § 1.19(b)(3) be changed to permit the Office to certify material not copied

from the records of the Office when reproduction of Office records is not feasible or possible.

Reply: This comment has not been adopted. The Office will only certify that material is a copy of an Office record if, in fact, the material was reproduced from the Office record.

Comment: One person commented that the \$100 processing and retention fee under § 1.21 was excessive and unnecessary.

Reply: The fee is considered proper and necessary in view of the cost to the Office in handling, filming, processing and storage required to retain an application which has a filing date but in which no basic filing fee has been paid. If this expense is not covered by the applicant, it must be recovered from other sources.

Comment: Twenty-seven comments were received on the proposal to amend § 1.25 to raise to \$1000 the minimum balance required in a deposit account. The amount is also referred to in § 1.21(b)(2). These comments generally suggested that the \$1000 amount was too high for account holders who did not use their accounts for charges other than small fees such as for patent copies. Several comments received acknowledged that the minimum balance for deposit accounts should be raised and suggested various amounts less than the proposed \$1000. Several comments suggested a separate account category for persons who do not use their accounts for other than small fees. Two comments suggested that the Office accept credit cards for payment of fees.

Reply: These comments and suggestions have not been adopted. The fees for filing, processing and issuing of patent and trademark applications have increased so as to make the present \$40 minimum balance for deposit accounts totally inadequate. A number of persons objecting to the \$1000 minimum balance acknowledged that they used their deposit accounts as a safeguard against failure to calculate or to submit proper fees by a check. An account with a very low balance obviously cannot be effective as a safeguard when a patent filing fee is \$300 and a patent issue fee is \$500. Dealing with overdrawn accounts causes administrative problems for the Patent and Trademark Office. An authorization to charge an account without sufficient funds to cover a charge will not be effective as payment and may result in loss of rights to an applicant. Also, unnecessary expense will be incurred by an applicant if an insufficient balance in an account results in abandonment of an application and the necessity of filing a

petition to revive under 37 CFR 1.137(b) with the requisite \$500 fee. Experience has shown that many single practitioners and small firms have failed to have sufficient funds in their accounts when needed. The increase of the minimum balance in deposit accounts to \$1000 is seen to be necessary and proper. A failure to raise the minimum balance in deposit accounts to \$1000 would serve as an incorrect indication that the Patent and Trademark Office views a minimum balance of less than \$1000 as acceptable. If it is not possible for a small firm or individual to maintain a minimum balance of \$1000, the deposit account could still be retained and used by paying the service charge set forth in § 1.21(b)(2) for any month in which the balance at the end of the month is below \$1000. The use of credit cards is not considered viable since legislation would be required to do so.

Comment: Two comments were received suggesting that a license to a federal agency in an invention made by a federal employee should not preclude the employee from qualifying as a small entity and that § 1.27 should be amended to cover this situation.

Reply: These comments have not been adopted. Such an amendment was not proposed and the public has not had an opportunity to comment on it.

Comment: One comment suggested that the time for filing a verified statement claiming small entity status to obtain a refund of a filing fee pursuant to § 1.28 should run from the date of mailing of the filing receipt due to difficulty in identifying the new application before the filing receipt is received. Three persons suggested that the period for establishing small entity status and requesting a refund should be three months rather than two months as proposed.

Reply: These comments have not been adopted. An application may be identified before the filing receipt is issued in a number of ways including title, inventor's name, filing date and attorney docket number. Also, a postcard may be included with filing of the application to learn the application serial number. The two month period for obtaining a refund is seen to be adequate since the small entity practice is no longer new and the public has had time to become familiar with it. It allows sufficient time to have a small entity statement executed and sent to the Patent and Trademark Office.

Comment: One comment suggested that it should be made clear that an application filed in a foreign language (§ 1.52(d)) without including a signed oath or declaration can receive a filing date under the provisions of § 1.53(b).

Reply: The regulations permit and this reply makes it clear that an application filed in a language other than English can receive a filing date by complying with § 1.53(b).

Comment: Three comments were received suggesting that the proposed language not be added to § 1.53(b). One comment alleged that the requirement to name the inventors upon filing a patent application is not required or even authorized by statute.

Reply: 35 U.S.C. 111 says that application for patent "shall be made, or authorized to be made, by the inventor". The rules of practice (§ 1.41(a)) contain the same requirement. The amendment to § 1.53(b) is only clarifying the rules by also placing the requirement in the section. Further, United States patent practice has long required that the inventors be named at the time of filing.

Comment: One person commented that the language of § 1.53(d) should be changed to reflect that only one of the filing fee or processing and retention fee must be paid to prevent the application being disposed of.

Reply: The language of the rule is seen to be unambiguous in this regard.

Comment: One person commented that the language of § 1.53(d) should be changed to establish a time within which the processing and retention fee may be paid to prevent the application being disposed of when no correspondence address has been provided.

Reply: The suggestion has been adopted.

Comment: One person suggested that § 1.56(b) which states that copies of disclosed documents must be filed is inconsistent with § 1.56(j) which provides that such copies must be filed unless they are not in the possession of the person making the disclosure.

Reply: The language of § 1.56(b) has been modified to clarify this point.

Comment: Three persons commented that the requirement of § 1.56(b) that copies of disclosed documents be supplied was an unnecessary burden. One person commented similarly on the requirement of § 1.555 that copies of disclosed documents be supplied. Another person suggested that the proposed amendment to § 1.56(b) would require submission of a complete document even if only a small portion were relevant.

Reply: The Office agrees with another person who commented that the "requirement that disclosers in application and reexamination proceedings provide copies of disclosed documents which they have is fair and reasonable and should aid the Examiner in making an informed as possible

decision in any given proceeding". The portion of a document required to be submitted under § 1.56(b) is the portion which is material to the examination of the application under § 1.56(a).

Comment: One person commented that the proposed amendment to § 1.78(a) would appear to require that a petition for correction of inventorship under § 1.48 be filed in a parent application as well as in the continuing application in which the inventorship was corrected.

Reply: The amendment to § 1.78 does not change the practice regarding the filing of petitions under § 1.48.

Comment: One person commented that § 1.123 is unclear as amended in not referring to the paper requesting that amendments to the drawing be made.

Reply: The Patent and Trademark Office no longer makes amendments to the drawings. Applicants must submit new drawings with the changes or use bonded draftmen to make the amendments. A paper requesting that the Office make the amendments is therefore inappropriate.

Comment: Four persons commented that § 1.135(d) should not be deleted since they thought it desirable to be able to ratify unsigned papers without paying any fee.

Reply: The statute and rules now provide for obtaining extensions of time through simple petition and payment of fee and for revival through a simple statement that the abandonment was unintentional and the payment of a fee. Further, a filing date can now be obtained on filing an application without the oath or declaration. The handling of unsigned papers by the Patent and Trademark Office causes administrative problems and expense to the Office and delays the processing of applications. The emergency-type situations involving loss of rights which the previous practice was intended to cover have been substantially eliminated by the changes in the law and rules.

Comment: One person commented that § 1.191(d) was undecipherable in that it refers to a number of other rules.

Reply: This section was intended to serve as a point of summarization for the applicable extension of time rules in appeals before the Board of Appeals. The section is seen to adequately serve that purpose.

Comment: One person commented that the final sentence of § 1.555(b) needs clarification.

Reply: This sentence was not changed by the proposed rules and is seen to be clear as written.

Comment: One person commented that proposed § 1.555(b) requires copies

and does not make any exceptions or qualifications on this requirement.

Reply: The language of § 1.555(b) has been clarified to require filing of a copy of each foreign patent document or non-patent printed publication which is being disclosed and which is in the possession of the person making the disclosure.

Environmental, energy, and other considerations: The rule change will not have a significant impact on the quality of the human environment or the conservation of energy resources.

The rule change is in conformity with the requirements of the Regulatory Flexibility Act (Pub. L. 96-354), Executive Order 12291, and the Paperwork Reduction Act of 1980, 44 U.S.C. 3501 *et seq.*

The General Counsel of the Department of Commerce certified to the Small Business Administration that the rule change will not have a significant adverse economic impact on a substantial number of small entities (Regulatory Flexibility Act, Pub. L. 96-354). Public Laws 96-517 and 97-247 have both taken into consideration the impact they may have on small entities.

The Patent and Trademark Office has determined that this rule change is not a major rule under Executive Order 12291. The annual effect on the economy will be less than \$100 million. There will be no major increase in costs or prices for consumers, individual industries, federal, state, or local government agencies, or geographic regions. There will be no significant adverse effects on competition, employment, investment, productivity, innovation, or on the ability of United States-based enterprises to compete with foreign-based enterprises in domestic or export markets.

This rule change will not impose a burden under the Paperwork Reduction Act of 1980, 44 U.S.C. 3501 *et seq.*, since no significant additional recordkeeping or reporting requirements are placed upon the public. In fact, some paperwork, especially that related to filing of small entity statements in applications filed under § 1.62 will be reduced.

List of Subjects in 37 CFR Part 1

Administrative practice and procedure, Authority delegations (government agencies), Conflict of interests, Courts, Inventions and patents, Lawyers.

Notice is hereby given that, pursuant to the authority granted to the Commissioner of Patents and Trademarks by 35 U.S.C. 6 and Pub. L. 97-247, the Patent and Trademark Office

is amending Title 37 of the Code of Federal Regulations as set forth below.

PART 1—[AMENDED]

37 CFR, Part 1, is amended as follows:

1. Section 1.5 is amended by revising paragraph (a) to read as follows:

§ 1.5 Identification of application, patent or registration.

(a) When a letter concerns an application for patent, it should state the name of the applicant, the title of the invention, the serial number or international application number of the application, the date of filing the same, and, if known, the group art unit or other unit within the Patent and Trademark Office responsible for considering the letter and the name of the examiner or other person to which it has been assigned.

2. Section 1.6 is amended by revising paragraph (a) to read as follows:

§ 1.6 Receipt of letters and papers.

(a) Letters and other papers received in the Patent and Trademark Office are stamped with the date of receipt except where such letters and papers are filed in accordance with § 1.10. Any such letters and papers filed in accordance with § 1.10 will be stamped with the date of deposit as "Express Mail" with the United States Postal Service unless the date of deposit is a Saturday, Sunday, or federal holiday within the District of Columbia in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or federal holiday within the District of Columbia. No papers are received in the Patent and Trademark Office on Saturdays, Sundays or federal holidays within the District of Columbia.

3. Section 1.10 is amended by revising paragraphs (a) and (c) to read as follows:

§ 1.10 Filing of papers and fees by "Express Mail" with certificate.

(a) Any paper or fee to be filed in the Patent and Trademark Office can be filed utilizing the "Express Mail Post Office to Addressee" service of the United States Postal Service and be considered as having been filed in the Office on the date the paper or fee is shown to have been deposited as "Express Mail" with the United States Postal Service unless the date of deposit is a Saturday, Sunday, or federal holiday within the District of Columbia. See § 1.6(a).

(c) The Patent and Trademark Office will accept the certificate of mailing by "Express Mail" and accord the paper or fee the certificate date under 35 U.S.C. 21(a) (unless the certificate date is a Saturday, Sunday, or federal holiday within the District of Columbia—see § 1.6(a)) without further proof of the date on which the mailing by "Express Mail" occurred unless a question is present regarding the date of mailing. If more than a reasonable time has elapsed between the certificate date and the Patent and Trademark Office receipt date or if other questions regarding the date of mailing are present, the person mailing the paper or fee may be required to file a copy of the "Express Mail" receipt showing the actual date of mailing and a statement from the person who mailed the paper or fee averring to the fact that the mailing occurred on the date certified. Such statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office.

4. Section 1.14 is amended by revising paragraph (b) to read as follows:

§ 1.14 Patent applications preserved in secrecy.

(b) Except as provided in § 1.11(b) abandoned applications are likewise not open to public inspection, except that if an application referred to in a U.S. patent, or in an application which is open to inspection pursuant to § 1.139, is abandoned and is available, it may be inspected or copies obtained by any person on written request, without notice to the applicant.

Complete applications (§ 1.51(a)) which are abandoned may be destroyed after 20 years from their filing date, except those to which particular attention has been called and which have been marked for preservation. Abandoned applications will not be returned.

5. Section 1.19 is amended by revising paragraph (b)(3) to read as follows:

§ 1.19 Document supply fees.

(b) * * *

(3) For comparing copies, made from Patent and Trademark Office records but not prepared by the Patent and Trademark Office, with the original, prior to certification of the copies, per page—\$0.10

6. Section 1.21 is amended by revising paragraph (b)(2) and by adding a new paragraph (l) to read as follows:

§ 1.21 Miscellaneous fees and charges.

(b) * * *

(2) Service charge for each month when the balance at the end of the month is below \$1,000—\$2.00

(l) For processing and retaining any application abandoned pursuant to § 1.53(d) unless the required basic filing fee has been paid—\$100.00.

7. Section 1.25 is revised to read as follows:

§ 1.25 Deposit accounts.

(a) For the convenience of attorneys, agents, and the general public in paying any fees due, in ordering services offered by the Office, copies of records, etc., deposit accounts may be established in the Patent and Trademark Office upon payment of the fee for establishing a deposit account (§ 1.21(b)(1)). A minimum deposit of \$1,000 or more, depending on the activity of the individual account, is required. At the close of each month's business, a statement will be rendered. A remittance must be made promptly upon receipt of the statement to cover the value of items or services charged to the account and thus restore the account to its established normal deposit value. An amount sufficient to cover all fees, services, copies, etc., requested must always be on deposit. A service charge (§ 1.21(b)(2)) will be assessed for each month that the balance at the end of the month is below \$1,000.

(b) Filing, issue, appeal, international-type search report, international application processing, petition, and post-issuance fees may be charged against these accounts if sufficient funds are on deposit to cover such fees. A general authorization to charge all fees, or only certain fees, set forth in §§ 1.16 to 1.18 to a deposit account containing sufficient funds may be filed in an individual application, either for the entire pendency of the application or with respect to a particular paper filed. An authorization to charge to a deposit account the fee for a request for reexamination pursuant to § 1.510 and any other fees required in a reexamination proceeding in a patent may also be filed with the request for reexamination. An authorization to charge a fee to a deposit account will not be considered payment of the fee on the date the authorization to charge the fee is effective as to the particular fee to be charged unless sufficient funds are present in the account to cover the fee.

8. Section 1.27 is amended by revising paragraphs (b), (c) and (d) to read as follows:

§ 1.27 Statement of status as small entity.

(b) Any verified statement filed pursuant to paragraph (a) of this section on behalf of an independent inventor must be signed by the independent inventor except as provided in §§ 1.42, 1.43, or 1.47 of this part, and must aver that the inventor qualifies as an independent inventor in accordance with § 1.9(c) of this part. Where there are joint inventors in an application, each inventor must file a verified statement establishing status as an independent inventor in order to qualify as a small entity. Where any rights have been assigned, granted, conveyed, or licensed, or there is an obligation to assign, grant, convey, or license, any rights to a small business concern, a nonprofit organization, or any other individual, a verified statement must be filed by the individual, the owner of the small business concern, or an official of the small business concern or nonprofit organization empowered to act on behalf of the small business concern or nonprofit organization averring to their status. For purposes of a verified statement under this paragraph, a license to a federal agency resulting from a funding agreement with that agency pursuant to 35 U.S.C. 202(c)(4) does not constitute a license as set forth in § 1.9 of this part.

(c) Any verified statement filed pursuant to paragraph (a) of this section on behalf of a small business concern must (1) be signed by the owner or an official of the small business concern empowered to act on behalf of the concern; (2) aver that the concern qualifies as a small business concern as defined in § 1.9(d); and (3) aver that exclusive rights to the invention have been conveyed to and remain with the small business concern, or if the rights are not exclusive, that all other rights belong to small entities as defined in § 1.9. Where the rights of the small business concern as a small entity are not exclusive, a verified statement must also be filed by the other small entities having rights averring to their status as such. For purposes of a verified statement under this paragraph, a license to a federal agency resulting from a funding agreement with that agency pursuant to 35 U.S.C. 202(c)(4) does not constitute a license as set forth in § 1.9 of this part.

(d) Any verified statement filed pursuant to paragraph (a) of this section on behalf of a nonprofit organization must (1) be signed by an official of the nonprofit organization empowered to act on behalf of the organization; (2) aver that the organization qualifies as a nonprofit organization as defined in

§ 1.9(e) of this part specifying under which one of § 1.9 (e)(1), (e)(2), (e)(3), or (e)(4) of this part the organization qualifies; and (3) aver that exclusive rights to the invention have been conveyed to and remain with the organization or if the rights are not exclusive, that all other rights belong to small entities as defined in § 1.9 of this part. Where the rights of the nonprofit organization as a small entity are not exclusive, a verified statement must also be filed by the other small entities having rights averring to their status as such. For purposes of a verified statement under this paragraph, a license to a federal agency resulting from a funding agreement with that agency pursuant to 35 U.S.C. 202(c)(4) does not constitute a conveyance of rights as set forth in this paragraph.

9. Section 1.28 is amended by revising paragraph (a) to read as follows:

§ 1.28 Effect on fees of failure to establish status, or change status, as a small entity.

(a) The failure to establish status as a small entity (§§ 1.9(f) and 1.27 of this part) in any application or patent prior to paying, or at the time of paying any fee precludes payment of the fee in the amount established for small entities. A refund pursuant to § 1.26 of this part, based on establishment of small entity status, of a portion of fees timely paid in full prior to establishing status as a small entity may only be obtained if a verified statement under § 1.27 and a request for a refund of the excess amount are filed within two months of the date of the timely payment of the full fee. The two-month time period is not extendable under § 1.136. Status as a small entity is waived for any fee by the failure to establish the status prior to paying, at the time of paying, or within two months of the date of payment of, the fee. Status as a small entity must be specifically established by a verified statement filed in each application or patent in which the status is available and desired, except those applications filed under § 1.60 or § 1.62 of this part where the status as a small entity has been established in a parent application and is still proper. Once status as a small entity has been established in an application or patent, the status remains in that application or patent without the filing of a further verified statement pursuant to § 1.27 of this part unless the Office is notified of a change in status. Status as a small entity in one application or patent does not affect any other application or patent, including applications or patents which are directly or indirectly dependent upon the application or patent in which the

status has been established, except those filed under § 1.60 or § 1.62 of this part. Applications filed under § 1.60 or § 1.62 of this part must include a reference to a verified statement in a parent application if status as a small entity is still proper and desired.

10. Section 1.52 is amended by revising paragraph (d) to read as follows:

§ 1.52 Language, paper, writing, margins.

(d) An application may be filed in a language other than English. A verified English translation of the non-English-language application and the fee set forth in § 1.17(k) are required to be filed with the application or within such time as may be set by the Office.

11. Section 1.53 is amended by revising paragraphs (b) and (d) to read as follows:

§ 1.53 Serial number, filing date, and completion of application.

(b) The filing date of an application for patent is the date on which (1) a specification containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and (2) any drawing required by § 1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by § 1.41. No new matter may be introduced into an application after its filing date (§ 1.118).

(d) If an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include the appropriate filing fee or an oath or declaration by the applicant, applicant will be so notified, if a correspondence address has been provided, and given a period of time within which to file the fee, oath, or declaration and to pay the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application. If the required filing fee is not timely paid, or if the processing and retention fee set forth in § 1.21(l) is not paid within one year of the date of mailing of the notification required by this paragraph, the application will be disposed of. No copies will be provided or certified by the Office of an application which has been disposed of or in which neither the required basic filing fee nor the processing and retention fee has been paid. The notification pursuant to this paragraph may be made simultaneously with any notification pursuant to paragraph (c) of this section. If no

correspondence address is included in the application, applicant has two months from the filing date to file the fee, oath or declaration and to pay the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application or one year from the filing date to pay the processing and retention fee set forth in § 1.21(l) to prevent disposal of the application.

12. Section 1.55 is amended by revising paragraph (b) to read as follows:

§ 1.55 Claim for foreign priority.

(b) An applicant may under certain circumstances claim priority on the basis of an application for an inventor's certificate in a country granting both inventor's certificates and patents. When an applicant wishes to claim the right of priority as to a claim or claims of the application on the basis of an application for an inventor's certificate in such a country under 35 U.S.C. 119, last paragraph (as amended July 28, 1972), the applicant or his or her attorney or agent, when submitting a claim for such right as specified in paragraph (a) of this section, shall include an affidavit or declaration including a specific statement that, upon an investigation, he or she has satisfied himself or herself that to the best of his or her knowledge the applicant, when filing his or her application for the inventor's certificate, had the option to file an application either for a patent or an inventor's certificate as to the subject matter of the identified claim or claims forming the basis for the claim of priority.

13. Section 1.56 is amended by revising paragraph (b) and by adding a new paragraph (j) to read as follows:

§ 1.56 Duty of disclosure; fraud; striking or rejection of applications.

(b) Disclosures pursuant to this section must be accompanied by a copy of each foreign patent document, non-patent publication, or other non-patent item of information in written form which is being disclosed or by a statement that the copy is not in the possession of the person making the disclosure and may be made to the Office through an attorney or agent having responsibility for the preparation or prosecution of the application or through an inventor who is acting in his or her own behalf. Disclosure to such an attorney, agent or inventor shall satisfy the duty, with respect to the information disclosed, of any other individual. Such an attorney, agent or inventor has no

duty to transmit information which is not material to the examination of the application.

(j) If any disclosure pursuant to this section does not include a copy of each foreign patent document, non-patent publication, or other non-patent item of information in written form which is being disclosed or a statement that a copy thereof is not in the possession of the person making the disclosure, applicant will be so notified and given a period of time within which to file the copy or a statement that a copy is not in the possession of the person making the disclosure. The time period set may be extended under § 1.136.

14. Section 1.59 is revised to read as follows:

§ 1.59 Papers of application with filing date not to be returned.

Papers in an application which has received a filing date pursuant to § 1.53 will not be returned for any purpose whatever. If applicants have not preserved copies of the papers, the Office will furnish copies at the usual cost of any application in which either the required basic filing fee (§ 1.16) or the processing and retention fee (§ 1.21(l)) has been paid.

15. Section 1.60 is revised to read as follows:

§ 1.60 Continuation or divisional application for invention disclosed in a prior application.

(a) A continuation or divisional application (filed under the conditions specified in 35 U.S.C. 120 or 121 and § 1.78(a)), which discloses and claims only subject matter disclosed in a prior application may be filed as a separate application before the patenting or abandonment of or termination of proceedings on the prior application.

(b) An applicant may omit signing of the oath or declaration in a continuation or divisional application if (1) the prior application was a complete application as set forth in § 1.51(a) and (2) applicant files a true copy of the prior complete application as filed including the specification (including claims), drawings, oath or declaration showing the applicant's signature or an indication it was signed, and any amendments referred to in the oath or declaration filed to complete the prior application. The copy of the prior application must be accompanied by a statement that the application papers filed are a true copy of the prior application and that no amendments referred to in the oath or declaration

filed to complete the prior application introduced new matter therein. Such statement must be by the applicant or applicant's attorney or agent and must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office. Only amendments reducing the number of claims or adding a reference to the prior application (§ 1.78(a)) will be entered before calculating the filing fee and granting the filing date.

16. Section 1.62 is amended by revising paragraphs (a) and (d) to read as follows:

§ 1.62 File wrapper continuing procedure.

(a) A continuation, continuation-in-part, or divisional application, which uses the specification, drawings and oath or declaration from a prior complete application (§ 1.51(a)) to be abandoned, may be filed before the payment of the issue fee, abandonment of, or termination of proceedings on the prior application. The filing date of an application filed under this section is the date on which a request is filed for an application under this section including identification of the Serial Number, filing date, and applicant's name of the prior complete application.

(d) If an application which has been accorded a filing date pursuant to paragraph (a) of this section does not include the appropriate basic filing fee pursuant to paragraph (b) of this section, or an oath or declaration by the applicant in the case of a continuation-in-part application pursuant to paragraph (c) of this section, applicant will be so notified and given a period of time within which to file the fee, oath, or declaration and to pay the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application. The notification pursuant to this paragraph may be made simultaneously with any notification of a defect pursuant to paragraph (a) of this section.

17. Section 1.78 is amended by revising the heading and paragraph (a) to read as follows:

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

(a) An application may claim an invention disclosed in the same applicant's prior filed copending national application or international application designating the United States of America. In order for an application to claim the benefit of a prior filed copending national application, the prior application must

be (1) complete as set forth in § 1.51, or (2) entitled to a filing date as set forth in § 1.53(b) and include the basic filing fee set forth in § 1.16; or (3) entitled to filing date as set forth in § 1.53(b) and have paid therein the processing and retention fee set forth in § 1.21(l) within the time period set forth in § 1.53(d). Any application claiming the benefit of a prior filed copending national or international application must contain or be amended to contain in the first sentence of the specification following the title a reference to such prior application, identifying it by serial number and filing date or international application number and international filing date and indicating the relationship of the applications. Cross-references to other related applications may be made when appropriate. (See § 1.14(b)).

18. Section 1.121 is amended by revising paragraph (e) to read as follows:

§ 1.121 Manner of making amendments.

(e) In reissue applications, both the descriptive portion and the claims are to be amended by either (1) submitting a copy of a portion of the description or an entire claim with all matter to be deleted from the patent being placed between brackets and all matter to be added to the patent being underlined, or (2) indicating the exact word or words to be stricken out or inserted and the precise point where the deletion or insertion is to be made. Any word or words to be inserted must be underlined. See § 1.173.

19. Section 1.123 is revised to read as follows:

§ 1.123 Amendments to the drawing.

No change in the drawing may be made except by permission of the Office. Permissible changes in the construction shown in any drawing may be made only by bonded draftsmen, at applicant's expense, or by the submission of substitute drawings by applicant. A sketch in permanent ink showing proposed changes, to become part of the record, must be filed for approval by the examiner and should be a separate paper.

§ 1.135 [Amended]

20. Section 1.135 is amended by removing paragraph (d).

21. Section 1.136 is revised to read as follows:

§ 1.136 Filing of timely responses with petition and fee for extension of time and extensions of time for cause.

(a) If an applicant is required to respond within a non-statutory or shortened statutory time period, applicant may respond up to four months after the time period set if a petition for an extension of time and the fee set in § 1.17 are filed prior to or with the response, unless (1) applicant is notified otherwise in an Office action or (2) the application is involved in an interference declared pursuant to § 1.207. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for purposes of determining the period of extension and the corresponding amount of the fee. The expiration of the time period is determined by the amount of the fee paid. In no case may an applicant respond later than the maximum time period set by statute, or be granted an extension of time under paragraph (b) of this section when the provisions of this paragraph are available. See § 1.245 for extension of time in interference proceedings and § 1.550(c) for extension of time in reexamination proceedings.

(b) When a response with petition and fee for extension of time cannot be filed pursuant to paragraph (a) of this section, the time for response will be extended only for sufficient cause, and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the applicant is due, but in no case will the mere filing of the request effect any extension. In no case can any extension carry the date on which response to an Office action is due beyond the maximum time period set by statute or be granted when the provisions of paragraph (a) of this section are available. See § 1.245 for extension of time in interference proceedings and § 1.550(c) for extension of time in reexamination proceedings.

22. Section 1.191 is amended by adding a new paragraph (d) to read as follows:

§ 1.191 Appeal to Board of Appeals.

(d) The time periods set forth in §§ 1.191 through 1.194, 1.196 and 1.197 are subject to the provisions of § 1.136 for patent applications or § 1.550(c) for reexamination proceedings.

23. Section 1.192 is amended by revising paragraph (a) to read as follows:

§ 1.192 Appellant's brief.

(a) The appellant shall, within 2 months from the date of the notice of appeal under § 1.191 in an application, reissue application, or patent under reexamination, or within the time allowed for response to the action appealed from, if such time is later, file a brief in triplicate. The brief must be accompanied by the requisite fee set forth in § 1.17(f) and must set forth the authorities and arguments on which the appellant will rely to maintain the appeal. The brief must include a concise explanation of the invention which should refer to the drawing by reference characters, and a copy of the claims involved.

24. Section 1.197 is amended by revising paragraph (b) to read as follows:

§ 1.197 Action following decision.

(b) A single request for rehearing or reconsideration, or modification of the decision, may be made if filed within thirty days from the date of the original decision, unless that decision is so modified as to become, in effect, a new decision, and the Board of Appeals so states.

25. Section 1.304 is amended by revising paragraph (a) to read as follows:

§ 1.304 Time for appeal or civil action.

(a) The time for filing the notice and reasons of appeal to the U.S. Court of Appeals for the Federal Circuit (§ 1.302) or for commencing a civil action (§ 1.303) is sixty days from the date of

the decision of the Board of Appeals or the Board of Patent Interferences. If a request for rehearing or reconsideration, or modification of the decision, is filed within the time provided pursuant to § 1.197(b) or § 1.256(b), the time for filing an appeal or commencing a civil action shall expire at the end of the sixty-day period or thirty days after action on the request, whichever is later. The time periods set forth herein are subject to the provisions of § 1.136 or § 1.550(c) as to decisions of the Board of Appeals, or § 1.245 as to decisions of the Board of Patent Interferences.

26. Section 1.550 is amended by revising paragraph (c) to read as follows:

§ 1.550 Conduct of reexamination proceedings.

(c) The time for taking any action by a patent owner in a reexamination proceeding will be extended only for sufficient cause, and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of the request effect any extension.

27. Section 1.555 is amended by revising paragraphs (a) and (b) to read as follows:

§ 1.555 Duty of disclosure in reexamination proceedings.

(a) A duty of candor and good faith toward the Patent and Trademark Office rests on the patent owner, on each attorney or agent who represents the

patent owner, and on every other individual who is substantively involved on behalf of the patent owner in a reexamination proceeding. All such individuals who are aware, or become aware, of patents or printed publications material to the reexamination which have not been previously made of record in the patent file must bring such patents or printed publications to the attention of the Office. An information disclosure statement, preferably in accordance with § 1.98, should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible in order to bring such patents or printed publications to the attention of the Office.

(b) Disclosures pursuant to this section must be accompanied by a copy of each foreign patent document or non-patent printed publication which is being disclosed or by a statement that the copy is not in the possession of the person making the disclosure and may be made to the Office through an attorney or agent having responsibility on behalf of the patent owner for the reexamination proceeding or through a patent owner acting in his or her own behalf. Disclosure to such an attorney, agent or patent owner shall satisfy the duty of any other individual. Such an attorney, agent or patent owner has no duty to transmit information which is not material to the reexamination.

Dated: November 30, 1983.

Gerald J. Mossinghoff,
Commissioner of Patents and Trademarks.

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