

## Overview of Changes to Support Implementation of United States Patent and Trademark Office 21<sup>st</sup> Strategic Plan

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On September 21, 2004, the United States Patent and Trademark Office (USPTO) published a final rule involving numerous regulatory changes, the majority of which go into effect October 21, 2004. This article identifies some highlights of the rule changes, including changes to signature requirements, express mail practice, petition fees, small entity provisions, incorporation by reference practice, application data sheets, drawing amendments, information disclosure statements, Examiner requests for information, supplemental amendments, preliminary amendment practice, and reissue practice. References herein to rule numbers refer to Title 37, Code of Federal Regulations, Part 1.

### Signature Requirements

Rule 4(d)(2) permits an “S-signature” instead of a handwritten signature (Rule 4(d)(1)) or EFS signature (Rule (4)(d)(3)) on any paper filed in the USPTO, including papers signed by registered practitioners as well as declarations and other papers signed by inventors. An S-signature is defined as a signature inserted between forward slash marks, but not a handwritten signature, which is made by electronic or mechanical means or other modes which are not handwritten or EFS signatures. The S-signature must consist only of letters, Arabic numerals, or both, with appropriate spaces and commas, periods, apostrophes, or hyphens (e.g., /Dr. James T. Jones, Jr./). The number (#) character may only be used as part of an S-signature when appearing before a USPTO registration number. An S-signature must be physically typed by the person making the signature. Thus, an attorney may not direct his or her secretary to type the attorney’s S-signature. Although a person may adopt any desired combination of characters for an S-signature, the USPTO strongly encourages the use of the person’s full name so that no ambiguity is created as to the identify of the person signing. The printed name of the person signing should appear below the S-signature, as is the practice for handwritten signatures.

### Express Mail

Rule 10 has been amended to codify existing practices for U.S. Postal Service (USPS) emergencies that result in a discontinuance of Express Mail service. When the Director designates an interruption or emergency affecting Express Mail service, the USPTO will afford a date of Express Mail

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deposit provided that the submission is filed with the USPS promptly after the interruption of Express Mail service and is accompanied by a statement that the submission would have been filed on the particular date but for the interruption.

### Petition Fees

Petition fees have been categorized into three fee structures based on the amount of USPTO resources needed for their resolution as determined by an activity based accounting cost analysis. If a petition seeks relief under more than one rule with different petition fees, the petition fee will be that of the rule which has the highest petition fee. The highest petition fee (currently \$ 400) is assessed for petitions under Rule 53(e) or 57(a) to accord a filing date; petitions under Rule 182 for questions not specifically provided for; petitions under Rule 183 for suspension of the rules; petitions under Rule 378(e) for reconsideration of a decision refusing to accept late payment of a maintenance fee; petitions under former Rule 644(e) or (f) in interferences; petitions under former Rule 666(b) or (c) for access to or late filing of an interference settlement agreement; and petitions under Rule 741(b) to accord a filing date to an application under Rule 740 for extension of a patent term. An intermediate petition fee (currently \$ 200) will be charged for petitions under Rule 12 for access to an assignment record; petitions under Rule 14 for access to an application; petitions under Rule 47 for filing by persons other than all the inventors or a person not the inventor; petitions under Rule 59 for expungement of information; petitions under Rule 103(a) to suspend action in an application; petitions under Rule 136(b) to review requests for extensions of time when the provisions of Rule 136(a) are not available; petitions under Rule 296 for review of refusal to publish a statutory invention registration or to withdraw a request to publish a statutory invention registration; petitions under Rule 377 for review of a decision refusing to accept a maintenance fee; petitions under Rule 550(c) or Rule 956 for patent owner requests for extension of time in *ex parte* or *inter partes* reexamination proceedings; petitions under § 5.12 for expedited handling of foreign filing licenses; petitions under § 5.15 for changing the scope of a license; and petitions under § 5.25 for a retroactive license. Remaining petitions are covered by Rule 17(h), for which the petition fee currently remains at \$ 130.

### Small Entity Regulations

Rule 27(a) is amended to add a new paragraph (a)(5) which makes explicit that a security interest does not involve an obligation to transfer rights in the invention unless the security interest is defaulted upon. The paragraph clarifies that a security interest in a patent or application held by a large entity does not bar entitlement to small entity status unless the security interest is defaulted upon.

The USPTO also clarified that a transfer of “rights in the invention” (which if made to a large entity bars small entity status) involves only a transfer of the exclusionary rights granted by the patent.

Thus, the transfer to a large entity of merely the right to use embodiments of the invention, i.e., a non-exclusive license, does not preclude a claim to small entity status.

#### Incorporation by Reference Practice

Rule 57 is amended to provide that all or a portion of the specification or drawings that is inadvertently omitted from an application containing a priority claim to a prior-filed foreign, provisional, non-provisional, or international application, can be added to the application by way of a later-filed amendment provided that the inadvertently omitted portion is completely contained in the prior-filed application. This can be done even if there is no explicit incorporation by reference of the prior-filed application. The claim to priority to the earlier-filed application must be made on the application's filing date in order to take advantage of this automatic incorporation by reference. Any applications referred to in the specification but to which priority is not claimed are not incorporated by reference unless done so explicitly.

#### Application Data Sheets

Rule 76 is amended to set forth formal requirements for application data sheets (ADS). An ADS submitted to correct, modify, or augment original application data, must be titled "Supplemental Application Data Sheet" even if it is the first ADS submitted in the application. Changes to application data relative to an earlier filed ADS need to be indicated by appropriate markings, e.g., brackets or strikethrough. The use of an ADS is strongly encouraged when there is a change in the spelling of an inventor's name, a change in the inventor's name, or a correction of inventorship under Rule 48.

#### Drawing Requirements

Under amended Rule 84, any drawings submitted after the filing of an application need to be labeled "Replacement Sheet," "New Sheet," or "Annotated Sheet." Replacement sheets replace original drawing sheets. A drawing sheet must be labeled "annotated" whenever changes are indicated, such as a marked-up copy. Rule 85(c) is amended to delete reference to "formal" drawings. The concept of "formal" drawings is no longer applicable in that the focus is on whether a drawing can be scanned by the USPTO.

#### Information Disclosure Statements

Rule 98(a) is amended to require a specific column format for citing U.S. patents and published applications and other documents. U.S. patents and applications must be listed separately from other documents. Practitioners will comply with the new rule through the use of forms PTO/SB/08A and 08B or the more commonly used PTO-1449.

### Examiner's Requests for Information

Amended Rule 105 provides that a request for information may be used to ask for specific factual information known to the applicant. Interrogatories may be used to ask specific questions seeking applicant's factual knowledge. An interrogatory may inquire into the existence of a particular document or other piece of evidence and require that such information be supplied if it is known to exist and is readily available. An applicant need not derive or independently discover a fact in response to a request for information. An applicant may respond by stating that the requested information is "either unknown or is not readily available" (providing both alternatives) to the party or parties from which it was requested.

### Supplemental Amendments

Rule 111(a)(2) now states that an amendment that is supplemental to a Rule 111(b) compliant amendment will not be entered as a matter of right, unless it is filed within the period when action is suspended by the Office or at the request of the applicant under Rule 103(a) or (c). The USPTO may enter a supplemental amendment if it is filed in sufficient time to be considered by the Examiner before treatment of the prior amendment and if it is limited to cancellation of claim(s), adoption of Examiner's suggestions, placing the application in condition for allowance, responding to an Office requirement made after the first reply was filed, correction of informalities, or simplification of issues for appeal.

### Preliminary Amendments

Rule 115(a)(1) is amended to provide that any amendment filed on the filing date of an application is considered part of the original disclosure, even if it is not referred to in the oath or declaration. However, it is an applicant's obligation to determine whether the preliminary amendment contains any subject matter not otherwise included in the specification or drawings. If the preliminary amendment contains subject matter not contained in the specification or drawings, it is necessary to submit a supplemental oath or declaration under Rule 67 to refer to the preliminary amendment.

### Reissue Practice

Rule 178 is amended to eliminate the requirement for physical surrender of the original ("ribbon copy") letters patent. The rule applies retroactively for all pending applications.