

# REPORT

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

October 7, 2004

The United States Patent and Trademark Office (PTO) has established a "21<sup>st</sup> Century Strategic Plan." The plan is purported to be intended to transform the PTO into a "quality-focused, highly productive, responsive organization supporting a market-driven intellectual property system." The PTO is revising the rules of practice over the next two months to support the implementation of the 21<sup>st</sup> Century Strategic Plan. The changes include:

- Eliminating the requirement for submission of copies of U.S. patents and U.S. patent application publications and of many unpublished U.S. patent applications in Information Disclosure Statements,
- Treating preliminary amendments submitted on the filing date of applications as part of the original disclosure,
- Providing automatic incorporation by reference of certain prior-filed U.S. and foreign applications, and codifying incorporation by reference practice,
- Expanding the number of submissions that can be filed on a compact disc,
- Prohibiting supplemental replies from being entered as a matter of right,
- Allowing Examiner requests for information to contain interrogatories or requests for stipulations seeking technical factual information actually known by the applicant,
- Adjusting fees for a number of patent-related petitions, and
- Providing for alternative signature formats on a number of submissions to accommodate its electronic filing program.

Other rules revised by the PTO's "Strategic Plan" relate to claiming benefit of an earlier filing date; patent application font recommendations; standards and contents for drawings; small entity status; extensions of time; document supply fees; protests by the public against pending applications; double patenting; correction of inventorship of a patent; revival of abandoned reissue applications; and petitions to make special.

### 1. Information Disclosure Statements

Effective October 21, 2004, the requirement in Rule 98 for submission of copies of U.S. patents or U.S. patent application publications in an Information Disclosure Statement (IDS) has been eliminated for all patent applications, not just those filed after June 30, 2003.

In addition, in a separately issued Notice, the PTO has waived the requirement for submission of a copy of unpublished cited U.S. patent applications that are stored in the PTO's Image File Wrapper (IFW) system. This waiver is effective immediately. However, this waiver is limited to the specification, including the claims, and drawings in the U.S. application (or portion of the application). If other material in the file of a U.S. patent application is being cited in an IDS, the IDS must contain a legible copy of such material.

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All provisional and non-provisional U.S. patent applications filed on or after June 30, 2003, and international applications that have entered the U.S. national stage on or after June 30, 2003, have been or are being scanned into the IFW system. The PTO is also in the process of scanning the files of many prior applications into the IFW system.

Accordingly, when citing to a pending unpublished application filed before June 30, 2003, or that entered the U.S. national stage before June 30, 2003, we will check the private Patent Application Information Retrieval (PAIR) System when possible to see whether the application is stored in the IFW system in order to determine whether a copy of the application (or portion of the application) must be provided with an IDS.

## 2. Preliminary Amendments

Effective immediately, Rule 115(a)(1) has been added to provide that a preliminary amendment that is present on the filing date of an application is part of the original disclosure of the application.

Before the rule change, a Preliminary Amendment that was present on the filing date of an application could be considered a part of the original disclosure only if it was referred to in a first filed oath or declaration in compliance with Rule 63. If the preliminary amendment was not referred to in the oath or declaration, any request to treat the preliminary amendment as part of the original disclosure was by way of petition under Rule 182 requesting that the original oath or declaration be disregarded and that the application be treated as an application filed without an executed oath or declaration under Rule 53.

After the rule change, if a Preliminary Amendment is present on the filing date of the application, whether or not the oath or declaration refers to the Preliminary Amendment, the Preliminary Amendment will be considered part of the original disclosure.

If the Preliminary Amendment contains subject matter not otherwise included in the specification or drawings of the application as filed, and the original oath or declaration does not refer to the Preliminary Amendment, a supplemental oath or declaration under Rule 67 referring to the Preliminary Amendment must thereafter be filed in the application.

If an examiner determines that a Preliminary Amendment that is present on the filing date of the application includes subject matter not otherwise supported by the originally filed specification and drawings, and there is no oath or declaration that refers to the Preliminary Amendment, the examiner should require the applicant to file a supplemental oath or declaration under Rule 67 referring to the Preliminary Amendment. However, because examiners can miss such issues, the applicant should ensure that any necessary supplemental oath or declaration is filed even if not required the examiner.

If an inventor who executed the original declaration is refusing, or cannot be found, to execute a required supplemental declaration, the requirement for that inventor to sign the supplemental declaration may be suspended or waived in accordance with Rule 183. All available joint inventors must sign the supplemental declaration on behalf of themselves, if appropriate, and on behalf of any nonsigning inventor.

## 3. Automatic Incorporation by Reference

Effective immediately, Rule 57 is amended to establish that foreign and domestic priority benefit applications and parent applications are incorporated by reference for certain purposes when a claim to benefit of them is present at the time an application is filed. This automatic incorporation by reference is intended to allow all or a portion of the specification or drawings that is inadvertently omitted from a patent application to be added to the application by way of an amendment if it was present in a prior benefit application. This rule change does not apply to any applications filed before the September 21, 2004 effective date of the rule change.

The rule change provides for the situation when:

(1) all or a portion of the specification or drawings is inadvertently omitted from an application;

(2) the application papers contain, on the filing date of the application, a claim for priority to a prior-filed foreign, international or provisional application, or for the benefit of a prior-filed nonprovisional or international application; and

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(3) the omitted portion of the specification or drawings is "completely contained" in the prior-filed application -- i.e., expressly (not merely implicitly) disclosed in the prior application.

In this situation, the claim for priority or benefit would be considered an incorporation by reference of the prior-filed application as to the inadvertently omitted portion of the specification or drawings.

According to the PTO, the rule change is to provide a safeguard for when pages of the specification, or a portion thereof, or a sheet of the drawings, or a portion thereof, is inadvertently omitted from an application.

For example, pages or lines lost in photocopying or facsimile transmissions could be replaced without raising new matter issues. Under Rule 57(a), it may also be possible to correct translational and/or typographical errors. For example, if a particular word is explicitly disclosed in the prior foreign application for which priority is claimed, but the translation of the foreign application resulted in the U.S. application being filed with a different word in its place, it would be permissible to correct this error under Rule 57(a). However, it must be clear on its face that the error was a translational or typographical error in order for such an error to be corrected by this rule. It would not be permissible to argue over the interpretation of a particular word or expression used in the foreign application or to argue, for example, that language in the foreign application that is directed to a species provides support for adding language directed to a genus.

There is no requirement for an applicant to submit a declaration stating that the omission was inadvertent or to submit proof that a particular omission was inadvertent at the time of filing of the application. However, an amendment to add the omitted material pursuant to Rule 57(a) would constitute a certification under Rule 10.18(b) that the omission was inadvertent. The PTO may inquire as to inadvertence where the record raises such an issue.

The incorporation by reference provided by the rule requires a timely amendment to the application to include the omitted material in order for this material to be considered part of the disclosure. The application must be amended no later than the close of prosecution as defined by Rule 114(b), or abandonment of the application (e.g.,

where the application is being abandoned in favor of a continuing application), whichever occurs earlier. An applicant may reopen prosecution by filing a Request for Continued Examination (RCE) and amending the specification to include the omitted material.

When amending to add omitted material under Rule 57(a), the applicant must provide:

(1) a copy of the prior-filed application, except where the prior-filed application is a provisional or nonprovisional U.S. patent application filed in the PTO;

(2) an English-language version of the prior-filed application; and

(3) identification of where the inadvertently omitted portion of the specification or drawings can be found in the prior-filed application.

Applicants can still intentionally omit material contained in a prior-filed application from the application containing the priority or benefit claim without the material coming back in by virtue of the incorporation by reference of Rule 57(a).

The PTO and our firm still encourage explicit incorporation by reference of a prior application or applications by including, in the body of the specification as filed, a statement that the prior application or applications is "hereby incorporated by reference." In any event, we strongly suggest that all priority claims be identified at the time of filing the application so that they can be included in the Application Transmittal letter and/or Application Data Sheet, to take advantage of the automatic incorporation by reference.

#### 4. Express Incorporation by Reference

Effective immediately, Rule 57(b)(1) has been changed to limit a proper incorporation by reference (other than an automatic incorporation by reference under Rule 57(a)) to instances where the perfecting words "incorporated by reference" or the root of the words "incorporate" (e.g., incorporating, incorporated) and "reference" (e.g., referencing) appear. The PTO is trying to provide a bright line test as to where something being referred to is an incorporation by reference. If a reference to a document does not clearly indicate an intended incorporation by

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reference, examination will proceed as if no incorporation by reference has been made and the PTO will not expend resources trying to determine whether an incorporation by reference was intended.

Rule 57(g) authorizes the correction of noncompliant incorporation by reference statements that do not use the root of the words "incorporate" and "reference" in the incorporation by reference statement. This correction cannot be made when the material was merely referred to and there was no clear specific intent to incorporate it by reference. Incorporating by reference material that was not incorporated by reference on the filing date of an application may be new matter.

Rule 57(c) now permits incorporation by reference of essential material found in a U.S. patent application publication.

Rule 57(d) defines the scope of incorporation by reference practice for nonessential subject matter. An incorporation by reference by hyperlink or other form of browser executable code is still not permitted.

Rule 57(e) allows the PTO to require a copy of the incorporated by reference material to be submitted to the PTO. We recommend that this be routinely done by way of an IDS.

Rule 57(f) requires that if an applicant decides to insert material incorporated by reference into the specification or drawings of an application, the applicant can do so by way of an amendment. The amendment must be accompanied by a statement that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter.

For the purpose of correcting the incorporation by reference, after prosecution of the application has been closed (e.g., a Final Rejection, an *ex parte* Quayle action, or a Notice of Allowance has been mailed to the applicant), an applicant may reopen prosecution by filing a Request for Continued Examination (RCE) under Rule 114. After the application has been abandoned, an applicant must file a petition to revive under Rule 137 for the purpose of correcting the incorporation by reference (e.g., to support continuity of disclosure in a continuing application). After the application has issued as a patent, an applicant may correct the patent by filing a reissue application. Correcting an improper incorporation by reference with a certificate of

correction is generally not an appropriate means of correction because it may alter the scope of the claims.

#### 5. Claiming Benefit of Earlier Filing Date

Effective immediately, Rules 78(a)(2)(iii) and (a)(5)(iii) are amended to permit the required reference to prior benefit application(s) to be in multiple sentences, forming a continuous string, at the beginning of the specification, rather than being limited to a single first sentence of the specification.

#### 6. Font Requirements

Effective October 21, 2004, Rule 52(b)(2)(ii) is revised to recommend that the font size of the text in patent applications be at least a 12 point font size.

#### 7. Compact Disc Submissions

Effective October 21, 2004, Rule 52(e)(1)(iii) is amended to allow greater flexibility in filing tables on compact disc, so that compact disc files may be used instead of paper where the total number of pages collectively occupied by all the tables in an application exceeds one hundred. Rule 52(e)(1)(iii) is also clarified to be consistent with tables submitted on paper as to what constitutes a page.

Rule 52(e)(3)(i) is amended to recite that CD-R discs should be finalized so that they are closed to further writing before they are filed in the PTO.

Rule 52(e)(3)(ii) is clarified to indicate that landscape orientation of a table is special information needed to interpret a table that must be provided on a transmittal letter when filing a compact disc containing such a table.

#### 8. Supplemental Responses to Office Actions

Effective October 21, 2004, Rule 111(a)(2) is amended to provide that a supplemental response that is supplemental to a Rule 111(b) compliant response will not be entered as a matter of right. An exception applies for supplemental responses filed within a period when action by the PTO is suspended at the applicant's request under Rule 103(a) or (c). In effect, the PTO has announced that only a single response to any given Office Action is likely to be considered by an examiner.

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Under Rule 111 (a)(2)(ii), the PTO may enter a supplemental response that is clearly limited to:

- (1) canceling of claims;
- (2) adopting examiner suggestions;
- (3) placing the application in condition for allowance;
- (4) replying to a PTO requirement made after the first response was filed;
- (5) correcting informalities (e.g. typographical errors); or
- (6) simplifying issues for appeal.

According to the PTO, items (1)-(6) listed above provide six exemplary circumstances where an examiner can exercise discretion to enter a supplemental response. That is, even if the supplemental response does not fall into one of the circumstances listed in Rule 111(a)(2)(ii), the examiner still has an option of entering the supplemental response. For example, if a supplemental response is filed after a Rule 111(b) compliant response is filed and after an interview with an examiner, the examiner may enter and consider the supplemental amendment.

Accordingly, we continue to recommend, whenever possible, to conduct an interview with the examiner prior to filing a response to an outstanding office action, and then to file a single, complete response. In this way, (1) any claim amendments filed in a response under Rule 111 will be ensured entry; and (2) unnecessary estoppels will be avoided in the response presented.

A supplemental response that has not been approved for entry, and therefore, not entered, will not be entered when a response to a subsequent PTO action is filed. Applicants cannot simply request the entry of a supplemental response in a subsequent response. If applicants wish to have the not-entered supplemental response considered by the examiner, applicants must include the contents of the not-entered supplemental response in a proper response under Rule 111, Rule 116, or Rule 312 in response to the next PTO action. Where the next PTO action is a Final Rejection, an RCE may have

to be filed to obtain entry of the not-entered supplemental response.

The changes to Rule 111(a)(2) will not change the impact of the submission of a supplemental response on patent term adjustment. As such, even if the PTO does not enter a supplemental response, the supplemental response will continue to cause a reduction of any accumulated patent term adjustment under Rule 704(c)(8).

Information Disclosure Statements under Rule 97 and 98 are not considered supplemental responses under Rule 111.

#### **9. Standards for Drawings**

Effective immediately, Rule 84(c) is amended to require that each drawing sheet submitted after the filing date of an application be identified as either "Replacement Sheet" or "New Sheet" in the top margin so that the PTO will recognize how to treat such a drawing sheet for entry into the application. Similarly, marked up copies of the drawings for examiner consideration should be labeled "Annotated Sheet" in the top margin.

Effective immediately, it is no longer necessary to submit a black and white copy of any color drawing or photograph.

#### **10. Content of Drawings**

Effective October 21, 2004, tables and sequence listings that are included in the specification are not permitted to be reprinted in the drawings. Applicants are not obliged to include tables or the sequence listing in the drawings by the requirement that all claimed features must be shown in the drawings. Therefore, if a sequence listing as shown in the drawings has more information than is contained in the specification, the sequence listing could be included in the specification and drawings, but a sequence listing in the specification would not be permitted to be duplicated in the drawings.

This rule change does not apply in the U.S. national stages of PCT applications.

#### **11. Requirements for Information**

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Requirements for information have so far been quite rare. The PTO estimates that requirements for information will continue to be issued in less than 100 patent applications per year.

Under existing Rule 105, an examiner or other PTO employee may require submission of information that may be "reasonably necessary for examination," for example, information such as:

- (1) the existence of any relevant commercial database that could be searched for aspects of the invention;
- (2) if a search for prior art was made, what was searched;
- (3) a copy of any non-patent literature, published application, or patent by any of the inventors that relates to the claimed invention;
- (4) a copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application;
- (5) a copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result;
- (6) if the claimed invention is an improvement, identification of what is being improved; and
- (7) identification of any use of the claimed invention known to any of the inventors.

Effective October 21, 2004, the rules set forth additional procedures for Examiners to solicit applicants' knowledge to resolve outstanding issues. Rule 105(a)(1)(viii) was added to allow an Examiner to ask for pertinent, factual, technical information (i.e., not opinions) that is known to applicant concerning:

- (1) the related art;
- (2) the disclosure;
- (3) the claimed subject matter; and

(4) other factual information pertinent to patentability or concerning the accuracy of the examiner's stated interpretation of such items.

The terms "factual" or "facts" are included in the rule to make it clear that it is facts, and factual information, that are known to an applicant, or readily obtained after reasonable inquiry by an applicant, that are being sought, and that requirements under Rule 105(a)(3) may not request opinions that may be held or that would need to be formulated by an applicant. An applicant does not need to derive or independently discover a fact, such as by experimentation, in response to a requirement for information. However, there is a duty of "reasonable inquiry" on the applicants.

Rule 105(a)(3) allows an Examiner to require information "in any appropriate manner," including:

- (1) requirements for factual information;
- (2) interrogatories in the form of specific questions seeking applicant's factual knowledge; or
- (3) proposed stipulations as to facts with which the applicant may agree or disagree.

Rule 105(a)(4) states that any reply to a requirement for information that asserts either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may (changing "will") be accepted as a complete reply.

An applicant may file a petition under Rule 181 to have a request for information modified or withdrawn if the applicant considers it improper. Interviews may also be used to clarify such requests. Where an applicant is being asked to submit what is believed to be trade secrets, proprietary, and/or protective order materials, an applicant can make use of, at the time the material is submitted, the provisions of Rule 59 for expungement of information where applicable.

According to the PTO, examples of requests for stipulations and interrogatories that may be used to elicit technical factual information reasonably necessary for examination include requests directed to applicants' actual knowledge of:

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- (1) common technical features shared among all claims, or admission that certain groups of claims do not share any common technical features;
- (2) the support found in the disclosure for means-plus-function or step-plus-function claims under 35 U.S.C. § 112, 6<sup>th</sup> paragraph;
- (3) precisely which portion(s) of the disclosure provide the written description and enablement support for specific claim element(s);
- (4) the meaning of claim limitations or terms used in the claims, such as what teachings in the prior art would be covered by particular limitations or terms in a claim and which dictionary definitions would define a particular claim term, particularly where those terms do not appear in the specification;
- (5) which portions of each claim correspond to any admitted prior art in the specification;
- (6) the specific utility provided by the claimed subject matter on a claim-by-claim basis;
- (7) whether a dependent claim element is known in the prior art;
- (8) support for added limitations in an amended claim; and
- (9) facts related to public use or sale situations.

## 12. Small Entity Status

The small entity status rules were amended for clarity. The amendments do not make any substantive changes in existing small entity practice.

Effective immediately, Rule 27(a)(5) was added to clarify that a security interest does not involve an obligation to transfer rights in an invention unless there is a default under the security interest agreement.

For example, if an applicant or patentee takes out a loan from a large entity banking institution, the loan may be secured with rights in a patent application or patent. The granting of such a security interest to the banking institution is not a currently enforceable obligation to

assign, grant, convey, or license any rights in the invention to the banking institution. Only upon default will the security interest permit a transfer of rights in the application or patent to the banking institution.

Thus, an applicant or patentee would not be prohibited from claiming small entity status merely because a large entity banking institution has been granted a security interest, but if the loan is defaulted upon, there would be a loss of entitlement to small entity status.

The last line of Rule 27(a)(2)(i) was also amended to replace the "." with "; and" to clarify that the requirements for small business concerns regarding non-transfer of rights under paragraph (a)(2)(i) and the size standards of the Small Business Administration under (a)(2)(ii) are additive requirements. That is, a party seeking to qualify as a small business must meet the requirements as to transfer of rights as well as the Small Business Administration size standards.

Rule 27(a)(2)(ii) is amended to clarify that the size standards for small entity are "set forth in 13 CFR 121.801 through 121.805" instead of "13 CFR part 121." As long as a business concern meets the small business size standards and complies with applicable PTO procedures, it continues to be eligible to pay reduced patent fees under 35 U.S.C. 41(h) even if the business concern is located in or operates primarily in a foreign country.

## 13. Petition Fees

Effective November 22, 2004, petitions enumerated under Rule 17(h) will be divided into three groups, with separate petition fees for each of these three groups.

The first group of petitions will be covered by new Rule 17(f), which will specify a petition fee of \$400. The petitions in this group are:

- (1) petitions under Rule 53(e) to accord a filing date in an application that initially failed to meet filing date requirements;
- (2) petitions under Rule 57(a) to accord a filing date to an application not otherwise entitled to a filing date under Rule 53(b);

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(3) petitions under Rule 182 for decision on a question not specifically provided for;

(4) petitions under Rule 183 to suspend the rules;

(5) petitions under Rule 378(e) for reconsideration of a decision on petition refusing to accept delayed payment of a maintenance fee in an expired patent;

(6) petitions under Rule 644(e) in an interference;

(7) petitions under Rule 644(f) for requesting reconsideration of a decision on petition in an interference;

(8) petitions under Rule 666(b) for access to an interference settlement agreement;

(9) petitions under Rule 666(c) for late filing of an interference settlement agreement; and

(10) petitions under Rule 741(b) to accord a filing date to an application under Rule 740 for extension of a patent term.

A petition fee under Rule 17(f) will be refunded where a petition to accord an application filing date was required solely to correct a PTO error.

The second group of petitions will be covered by new Rule 17(g), which will specify a petition fee of \$200. The petitions in this group are:

(1) petitions under Rule 12 for access to an assignment record;

(2) petitions under Rule 14 for access to an application;

(3) petitions under Rule 47 for filing by persons other than all the inventors or a person not the inventor;

(4) petitions under Rule 59 for expungement of information;

(5) petitions under Rule 103(a) to suspend action in an application;

(6) petitions under Rule 136(b) to review requests for extension of time when the provisions of Rule 136(a) are not available;

(7) petitions under Rule 295 for review of refusal to publish a statutory invention registration;

(8) petitions under Rule 296 to withdraw a request for publication of a statutory invention registration filed on or after the issue date of the notice of intent to publish;

(9) petitions under Rule 377 for review of a decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent;

(10) petitions under Rule 550(c) for patent owner requests for extension of time in *ex parte* reexamination proceedings;

(11) petitions under Rule 956 for patent owner requests for extension of time in *inter partes* reexamination proceedings;

(12) petitions under Rule 5.12 for expedited handling of a request for a foreign filing license;

(13) petitions under Rule 5.15 for changing the scope of a foreign filing license; and

(14) petitions under Rule 5.25 for a retroactive foreign filing license.

The third group of petitions will be covered by Rule 17(h), which will continue to specify a petition fee of \$130. The petitions in this group are:

(1) petitions under Rule 19(g) to request documents in a form other than that provided in the rules;

(2) petitions under Rule 84 for accepting color drawings or photographs;

(3) petitions under Rule 91 for entry of a model or exhibit;

(4) petitions under Rule 102(d) to make an application special;

(5) petitions under Rule 138(c) to expressly abandon an application to avoid publication;

(6) petitions under Rule 313 to withdraw an application from issue; and

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(7) petitions under Rule 314 to defer issuance of a patent.

In the situation in which a petition seeks action under more than one rule, the petition fee will be that of the rule with the highest fee under which the petition seeks action.

#### **14. Petition Fees for Non-Fee-Based Extensions of Time**

Effective November 22, 2004, Rule 136(b) is amended to add a \$200 petition fee requirement for extensions of time where a simple Rule 136(a) extension fee is not available. Rule 550(c) is similarly amended to add a \$200 petition fee requirement for extensions of time in *ex parte* reexamination proceedings. Detailed petitions justifying the need for extensions will continue to be required along with the new petition fee.

#### **15. Document Supply Fees**

Effective November 22, 2004, copies of documents may be provided in whole, or in part, in electronic image form at the PTO's option.

Rule 19(b)(1) sets forth the fees for a copy of a patent application as filed, or a patent-related file wrapper and contents that are stored in paper in a paper file wrapper, or in an image format in an image file wrapper.

If provided on paper, Rule 19(b)(1)(i)(D) is added to set a fee of \$25 for individual application documents, other than the application as filed.

If provided on compact disc or other physical electronic medium in a single order, Rule 19(b)(1)(ii)(A) is added to set a fee of \$20 for an application as filed.

If provided electronically (e.g. by electronic transmission), Rule 19(b)(1)(iii) is added to set a fee of \$25 for the application as filed and \$55 for the file wrapper and contents.

Rule 19(b)(2) sets forth the fees for patent-related file wrapper contents that were submitted on compact disc, or in electronic form, and not stored in paper in a paper file wrapper, or in an image format in an IFW. The fees are the same as those set forth in Rule 19(b)(1)(ii) and 19(b)(1)(iii).

#### **16. Electronic or Mechanical Signatures**

Effective immediately, Rule 4 is amended to provide for filing correspondence with the PTO with a signature made by electronic or mechanical means. The PTO has termed this type of signature an "S-signature". In addition to allowing attorney submissions to be signed in this manner, the PTO is allowing S-signatures for oaths or declarations and Powers of Attorney. However, for at least the following reasons, we do not recommend using an S-signature for such documents.

Rule 4(d)(4)(ii)(A) adds the requirement that a person submitting a document signed by another is obligated to have a reasonable basis to believe that the person whose S-signature is present on the document actually inserted that S-signature. For example, where an assignee or foreign associate was involved in the transmission of the declaration form and/or the executed declaration, an additional showing of chain of custody (e.g., e-mail chain with attached documents from the inventor to the assignee or foreign associate to the practitioner filing the declaration) of the document bearing the S-signature would be required.

Additionally, evidence of authenticity would need to be retained. This may involve retaining the e-mails sent to the inventor and any cover letter or e-mail (with the signed document as an attachment) back to the practitioner.

Furthermore, the detailed requirements and pitfalls associated with S-signatures span 18 columns of single spaced explanations in the PTO rulemaking. The PTO will consider an inadvertent failure to follow the format and content of an S-signature to be a bona fide attempt at a signature, but the paper will still be considered unsigned. Violations of the certification as to the signature may result in the imposition of sanctions under Rule 10.18 (c) and (d). Thus we recommend that S-signatures only be used by U.S. patent attorneys in connection with electronic filings, and even then only as required by the PTO.

#### **17. Protests by the Public Against Pending Applications**

Effective November 22, 2004, Rule 291(b)(1) has been changed to provide for the submission of a protest after publication or after the mailing of a notice of allowance when the protest is accompanied by the written consent of the applicant.

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Rule 291(b)(2) requires a protest to include a statement that it is the first protest submitted in the application by the real party in interest that is submitting the protest; or the protest must comply with the requirements relating to subsequent protests by the same real party in interest.

Rule 291(c)(5) has been added to eliminate the ability of a single protestor to submit cumulative prior art in a subsequent protest by requiring a subsequent protest to be directed at significantly different issue(s), and also requiring an explanation as to how the issue(s) raised are significantly different and why the different issues were not presented in the earlier protest. A processing fee under Rule 17(i) is also required.

**18. Double Patenting**

Effective immediately, Rule 78(c) is amended to clarify the existing law that the §102(e), (f) and (g) prior art exceptions under 35 U.S.C. §103(c) do not apply to double patenting rejections. Therefore, examiners may still make double patenting rejections, when appropriate, even if a reference is disqualified from being used in a rejection under 35 U.S.C. §103(a) via the prior art exclusion under 35 U.S.C. §103(c).

**19. Correction of Inventorship of a Patent**

Effective October 21, 2004, the inventorship of a patent may be changed only by way of request from *all* of the inventors together with any assignee(s) of the entire interest in the patent, or on order of a court. The PTO will then issue a certificate naming the correct inventors.

**20. Surrender of Original Patent for Issuance of Reissue Patent**

Effective immediately, physical surrender of the original Letters Patent (i.e., the ribbon copy of the original patent) is no longer required in a reissue application. Surrender of the original patent is automatic upon the grant of the reissue patent as a matter of law, without reference to the physical Letters Patent.

**21. Revival of Abandoned Reissue Applications**

Effective immediately, Rule 137 is amended to clarify that when reviving a reissue patent application, a terminal disclaimer is not required since reissue applications do not affect patent term.

**22. Petition to Make Special**

Effective October 21, 2004, a petition to make an application special may be filed without a fee when the application relates to an invention that materially contributes to countering terrorism, and includes a statement explaining how the invention contributes to countering terrorism.

**23. Additional Rule Changes**

Other rules not specifically addressed in this Special Report relate to various matters that our firm handles internally.

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*Oloff & Berridge, PLC is a full-service Intellectual Property law firm based in historic Alexandria, Virginia. The firm specializes in patent, copyright, trademark, and antitrust law and litigation, and represents a large and diverse group of domestic and international clients, including businesses ranging from large multinational corporations to small privately owned companies, major universities, and individual entrepreneurs.*

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