

Paragraph (a)(1) has been rewritten to list the records that are available. The term "file wrapper and contents" has been replaced with the term "file contents" to avoid confusion with the paper (non-electronic) file jacket and its contents. Paragraph (a)(1) rephrases the provisions of current §§ 1.14(c) and (e) to assist the public in understanding what applications are available to the public. Accordingly, paragraph (a)(1), as rewritten, is divided into paragraphs (a)(1)(i) through (a)(1)(vi) listing different types of application files and explaining whether any part of the file content is available to the public. For example, paragraph (a)(1)(iii) explains that published pending applications are available to the public, upon written request, and payment of the appropriate fee, and that the original paper file of the pending application that was published as a patent application publication is not available to the public. In addition, it is proposed in the new paragraphs (a)(1)(iv) and (a)(1)(v) that where the benefit of an application is relied upon pursuant to 35 U.S.C. 119(e), 120, 121 or 365 in certain applications, the application will be available in the same manner that the application would have been had the application been referenced in a U.S. patent or U.S. patent application publication. As a result of this proposed rule change if an application is filed as a continuation of an earlier application, and the USPTO publishes the continuation as a patent application publication without a reference to the earlier application, the earlier-filed application will still be available to the public (either the originally filed application or the entire application file, depending upon whether the earlier-filed application is abandoned).

Paragraph (a)(2) is proposed to be revised to combine and restate current §§ 1.14(a)(1) and (b). The application number of any application that claims the benefit of the filing date of a patent or an application that has been published may be obtained from the Patent Application Information Retrieval (PAIR) system on the Office's web site at: <http://pair.uspto.gov>.

Section 1.14 is also proposed to be amended to have a new paragraph (b), to explain that electronic access may be provided to all or part of certain applications. Following migration to an electronic image file as the Official file of patent applications, access will be provided solely to the electronic Official file and not to the original paper document sheets used to create electronic images within the Official file.

Proposed § 1.14(c) is the same as current § 1.14(d). Paragraph (d) of current § 1.14 is proposed to be redesignated as § 1.14(c).

Proposed § 1.14(d) is the same as current § 1.14(f). Paragraph (f) of current § 1.14 is proposed to be redesignated as § 1.14(d).

Section 1.14 is also proposed to be amended to have a new paragraph (e), to provide that the Office may share its electronic application files that have not been published or otherwise made available to the public with another Intellectual Property (IP) Office pursuant to an agreement between the Office and another IP Office and if the applicant expressly consents. The written consent must be filed in the Office for the Office to transmit, or allow access by the other IP Office, to the application or other records associated with the application. The migration to an electronic environment will allow the Office to participate with other IP Offices in more rapid exchange of information, such as priority documents, between IP Offices. It should be noted that following publication, or where the application is otherwise available to the public, the written consent of applicant is not required before access to the application file is provided.

Paragraph (f) of § 1.14 corresponds to paragraph (g) of current § 1.14, which is proposed to be amended to move the text from (g) and of paragraph (g)(1) to paragraph (2), and to provide in the new paragraph (1) that any action of the Board of Patent Appeals and Interferences (BPAI), or any decision on petition, may be published or made available for public inspection without applicant's or patent owner's permission if rendered in a file open to the public pursuant to § 1.11 or available pursuant to § 1.14(e)(2), an application that has been published in accordance with §§ 1.211 through 1.221, or in an application claiming priority to, or the benefit of, an earlier filing date under 35 U.S.C. 119(a)–(d), 120, 121 or 365 of an application that has been published or patented. In paragraph (2), the rule would provide that an action of the BPAI, or any decision on petition, not publishable under paragraph (1) of this section, may be published or made available for public inspection if the Director believes the action or decision involves an interpretation of patent laws or regulations that would be of important precedential value; and the applicant, or any party involved in the interference, does not within two months after being notified of the intention to make the action or decision public, object in writing on the ground

that the decision discloses a trade secret or other confidential information and states that such information is not otherwise publicly available. If an action or decision discloses such information, the applicant or party shall identify the deletions in the text of the action or decision considered necessary to protect the information. If the applicant or the party considers that the entire action or decision must be withheld from the public to protect such information, the applicant or party must explain why. Applicants or parties will be given time, not less than twenty days, to request reconsideration and seek court review before any portions of actions or decisions are made public over their objection. This procedure is the same as that of current paragraph (g)(2), but has been reworded for clarity and also to use the terminology "any action" of the BPAI or "decision on petition" would be publishable, whereas the current rule uses the terminology "decision by the Director or the BPAI".

Generally, patent applications are maintained in confidence unless the Director finds "special circumstances" due to which information about an application or the application itself may be released. See 35 U.S.C. 122(a). Section 1.14 sets forth when some such "special circumstances" have been found, and specifies when release of information about an application or access to all or part of an application may be provided without a petition. Accordingly, as one example of a "special circumstance," as proposed to be amended with new paragraph (f)(1), a BPAI decision would be published, even if the decision does not involve an interpretation of patent laws or regulations that would be precedential so long as the application claims priority to or the benefit of an earlier application that has been published or patented (e.g., a Japanese patent application). The BPAI decision would be published even if the application in which the decision was made requests nonpublication of the application, and the application is not itself patented.

Proposed § 1.14(g) is the same as current § 1.14(h), which is proposed to be redesignated as § 1.14(g).

Proposed paragraph (h) of § 1.14 corresponds to current § 1.14(i), and is further proposed to be amended to explain the meaning of the terms "Home Copy," "Search Copy," and "Examination Copy," and by inserting "of the publication" after "English language translation" in paragraph (b)(2). Section 13204 of Public Law 107–273 made a technical change to the provisional rights provisions of the