

patent statute as to international applications to clarify that a translation of the international publication, as opposed to the international application, is required to be filed in order for a patent owner to obtain provisional rights pursuant to 35 U.S.C. 154(d). In view of this change to the statute, the corresponding reference to the translation in § 1.14 is proposed to be changed to add “a publication of an international patent application” after “English language translation of.” In addition, it is proposed that the parenthetical phrase at the end of paragraph (h)(1), referencing the fee for a copy of an international application file, or a copy of a document in a file, be changed from a reference to § 1.19(b) rather than § 1.19(b)(2) or § 1.19(b)(3), the fees for the contents of a file or a CD, and the parenthetical phrase at the end of paragraph (h)(2), referencing the fee for a copy of an English language translation in a file, be corrected to refer to § 1.19(b)(4), the fee for a document, rather than § 1.19(b)(2) or § 1.19(b)(3).

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

As proposed to be amended, § 1.14 will apply to all patent applications filed before, on, or after the date that the amendment to § 1.14 becomes final.

Section 1.17: Section 1.17 is proposed to be amended to eliminate the reference to returning information in paragraph (h) because expunged information will not be returned under § 1.59 as proposed to be amended.

Section 1.19: Section 1.19 is proposed to be amended by revising paragraph (b)(1) to eliminate the fee for providing an electronic copy of an application as filed to another IP Office if applicant consents in writing by filing an authorization under 35 U.S.C. 122(a) to permit the Office to exchange information related to the entire file record of the application with the other IP Office. The electronic transmission would serve as the certified copies of applications as filed that can be required by the other IP Offices under Article 4(D)(3) of the Paris Convention.

Section 1.52: Section 1.52 is proposed to be amended to clarify the requirement for proper paper sizes in paper communications submitted to the Office and to set forth the analogous requirements for electronic communications.

The Office plans to capture electronic images of all documents that form the record of patent examination. These images will form the Official file of the application. Applicants will have the option of submitting application documents and other communications

to the Office on paper, by facsimile transmission, or via the Office's electronic filing system (EFS). The existing requirements for paper and facsimile submissions (as well as the prohibition against filing patent applications by facsimile, see § 1.6(d)(3)) are retained, and the requirements for electronic submissions are added. One newly added requirement for paper submissions requires that the papers not be permanently bound because the papers must be readily separable for scanned entry into the image system. The use of binder clips or standard office staples will generally be acceptable. The detailed requirements for electronic submissions are provided in the Office's EFS documentation (available electronically at www.uspto.gov) and the proposed amendments direct the affected party's attention to those requirements.

Paragraph (a)(1) of § 1.52 is proposed to be amended to clarify that it pertains to paper and facsimile submissions, and that such submissions not be permanently bound together.

Paragraph (a)(2) of § 1.52 is proposed to be amended to clarify that it pertains to paper and facsimile submissions.

Paragraph (a)(3) of § 1.52 is proposed to be amended to clarify that it pertains to paper and facsimile submissions.

Paragraph (a)(5) of § 1.52 is proposed to be amended to clarify that it pertains to paper and facsimile submissions.

Paragraph (a) of § 1.52 is also proposed to be amended by adding paragraphs (a)(6) and (a)(7) to set forth that papers submitted electronically must comply with the Office's EFS requirements and that failure to comply will result in a requirement for correction.

Paragraphs (b)(3) and (b)(4) of § 1.52 are proposed to be amended to clarify that the requirements for the abstract and claims to begin on a separate sheet on physical paper are similarly required to begin on a separate electronic page in an electronic submission.

Paragraph (b)(7) of § 1.52 is proposed to be amended to explain the consequences of a failure to provide compliant papers within the set time period. That is, as proposed to be amended, the rule will provide that compliant papers must be provided within the set time period in order to avoid abandonment of the application in the case of an applicant for patent, termination of proceedings in the case of a patent owner in a reexamination proceeding, or refusal of consideration of the papers in the case of a third party requester in a reexamination proceeding.

Section 1.59: Section 1.59 is proposed to be amended to eliminate references to returning documents that have been expunged to recognize that, with electronic Official files, there will be nothing to return when a paper is expunged. The Office is capturing electronic images of all documents that form the Official file. Where the image is generated from a physical source document, the originating document may be disposed of once the electronic image accuracy is verified. Therefore, if a document is to be expunged from the record, the only operation that will be required will be removal of the image from the Official file. Paragraph (a)(1) of § 1.59 is proposed to be amended by deleting the phrase “and returned” from the first sentence, and deleting the second sentence. Paragraph (b) of § 1.59 is proposed to be amended by deleting the phrase “and return” from each of the first and second sentences.

Section 1.71: Section 1.71 is proposed to be amended by adding a new paragraph (f) to require that the first page of a specification commence on a new sheet and to require that no sheet including part of the text of the specification include any other material. Claims must also commence on a new sheet and in accordance with the proposed changes to § 1.75, must not include other parts of the application.

Section 1.72: Paragraph (b) of § 1.72 is proposed to be amended to prohibit the paper presenting the abstract to include any other portions of the application or other material. Presentation of material other than the abstract on the same page as the abstract makes the electronic indexing of the application more difficult. In addition, it is proposed to remove the last sentence of paragraph (b) to eliminate the prohibition on using the abstract to be used to interpret the claims to conform the rule to be consistent with Federal Circuit case law. *See Hill-Rom Co. v. Kinetic Concepts, Inc.*, 209 F.3d 1337, 1341 n.*, 54 USPQ2d 1437, 1440 n.1 (Fed. Cir. 2000).

Section 1.75: Paragraph (h) of § 1.75 is proposed to be amended to prohibit a paper presenting claims from including any other portions of the application or other material. Presentation of material other than the claims on the same page as one or more claims makes the electronic indexing of the application more difficult.

Section 1.97: Section 1.97 is proposed to be amended to move the last date on which an information disclosure statement (IDS) may be filed to the day prior to the mailing of the next Office action from the Office.

Sections 1.97(b) and (c) are proposed to be amended to move the last date on