

parenthetical phrase at the end of paragraph (i)(2), referencing the fee for a copy of a document in a file, be corrected to refer to § 1.19(b)(4) rather than § 1.19(b)(2) or (3).

Section 1.78: It is proposed that § 1.78, paragraph (a)(3), be amended by deleting the phrase “in a nonprovisional application” in the first sentence of the paragraph.

Section 4508 of the AIPA as originally enacted did not make the 18-month publication amendments to 35 U.S.C. 119 and 120 applicable to an international application unless and until it enters the national stage under 35 U.S.C. 371. *See* Public Law 106–113, 113 Stat. at 1501A–566 through 1501A–567. Section 13205 of Public Law 107–273 amended section 4508 of the AIPA to make the 18-month publication amendments to 35 U.S.C. 119 and 120 also applicable during the international stage of an international application. With regard to international applications, § 1.78(a)(2)(ii) requires that the reference required by § 1.78(a)(2)(i) be submitted: (1) During the pendency of the later-filed application; and (2) within the later of (A) four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application or (B) 16 months from the filing date of the prior-filed application. An abandoned international application is not a nonprovisional application; thus, as § 1.78(a)(3) currently reads, the petition procedure set forth in § 1.78(a)(3) would not be applicable to a delayed priority claim in an abandoned international application. If the presently proposed amendment to § 1.78(a)(3) is adopted, then the petition procedure set forth in § 1.78(a)(3) would be applicable to submitting a delayed priority claim in an abandoned international application including an international application that has not entered the national stage under 35 U.S.C. 371. In view of the statutory change to the applicability of the 18-month publication amendments to 35 U.S.C. 119 and 120 and the presently proposed change to § 1.78(a)(3), when filing a “bypass” continuation application under 35 U.S.C. 111(a) that claims the benefit of the international application with a filing date on or after November 29, 2000, that could have but did not claim the benefit of an earlier U.S. application and the benefit claim is to be added, a petition under § 1.78(a)(3) will be required in the international application. A “bypass” continuation application is an application for patent filed under 35 U.S.C. 111(a) that claims the benefit of the filing date of an earlier international application that did not

enter the national stage under 35 U.S.C. 371. *See* H.R. Rep. No. 107–685, at 222 (2002). Thus, applicants should no longer rely upon the advice that to amend a later-filed abandoned international application to add a claim to the benefit of a prior-filed nonprovisional application, or a prior-filed international application designating the United States, an applicant need only file a petition under § 1.182 to amend an abandoned application (the later-filed international application) with the claim to the benefit of a prior-filed application. *See Requirements for Claiming the Benefit of Prior-Filed Applications Under Eighteen-Month Publication of Patent Applications*, 66 FR 67087, 67092 (Dec. 28, 2001), 1254 *Off. Gaz. Pat. Office* 121, 125 (Jan. 22, 2002) (final rule) (response to comment 6).

Section 1.191: It is proposed that § 1.191 be amended by revising paragraph (a) to delete each appearance of “for a patent that issued from an original application filed in the United States.” Section 13202(d) of Public Law 107–273 provided a technical correction for the effective date set forth in the AIPA for appeals to the BPAI as follows:

Effective Date—The amendments made by section 4605(b), (c), and (e) of the Intellectual Property and Communications Omnibus Reform Act, as enacted by section 1000(a)(9) of Public Law 106–113, shall apply to any reexamination filed in the United States Patent and Trademark Office on or after the date of enactment of Public Law 106–113.

The effective date language in section 4608 of the AIPA limited the applicability of the conforming amendments to 35 U.S.C. 134 to a reexamination of a patent that issued from an original application which was filed on or after November 29, 1999. Thus, the conforming amendments to 35 U.S.C. 134 applied only to those *ex parte* reexamination proceedings filed under § 1.510 for patents that issued from an original application which was filed on or after November 29, 1999. Public Law 107–273 revised the applicability of the conforming amendments to 35 U.S.C. 134 such that the conforming amendments are applicable to a reexamination of a patent where the request for *ex parte* reexamination was filed on or after November 29, 1999. Accordingly, § 1.191 is proposed to be amended to track the statutory revision of effective date.

Section 1.197: It is proposed that § 1.197(c) be amended to provide that an appeal to the Federal Circuit is terminated when the mandate is issued by the Court, rather than when the mandate is received by the Office. This

proposed change to § 1.197(c) is for consistency with a 1998 amendment to rule 41 of the Federal Rules of Appellate Procedure. The commentary on the addition of subdivision (c) to rule 41 of the Federal Rules of Appellate Procedure indicates that this provision is intended to make clear that the court’s mandate is effective upon issuance, and that its effectiveness is not delayed until receipt of the mandate by the trial court or agency, or until the trial court or agency acts upon the mandate.

Section 1.301: It is proposed that the last sentence of § 1.301 be amended by inserting “appeals by patent owners and third party requesters in” before “*inter partes* reexamination proceedings.” The revision would make it clear that appeals by third party requesters of *inter partes* reexamination proceedings are controlled by § 1.983.

Section 1.302: It is proposed that § 1.302 be revised by adding new paragraphs (c) and (d), and redesignating existing paragraph (c) as paragraph (e). New paragraph (c) would point out that when an appeal is taken to the Federal Circuit in an *ex parte* reexamination proceeding, the appellant must serve notice as provided in § 1.550(f). New paragraph (d) would point out that when an appeal is taken to the Federal Circuit in an *inter partes* reexamination proceeding, the appellant must serve notice as provided in § 1.903. The proposed revisions are made to focus parties on the unique service that must be made in *ex parte* and *inter partes* reexamination proceedings, when appealing to the Federal Circuit.

Section 1.303: It is proposed that § 1.303 be amended by revising paragraphs (a), (b) and (d) to delete the appearance of “for a patent that issued from an original application filed in the United States” in each paragraph. This proposed revision is made for the reasons stated in the above discussion of the proposed revision of § 1.191.

Section 1.304: It is proposed that § 1.304 be amended by revising paragraph (a)(1) to add after the second sentence, the following sentence: “If a request for rehearing or reconsideration of the decision is filed within the time period provided under § 1.979(a), the time for filing an appeal shall expire two months after action on the last such request made by the parties.” In addition, reference to § 1.979(a) in the second sentence would be deleted. Further, it is proposed that all of the current provisions relating to interferences be included in § 1.304(i), and that § 1.304(ii) provide that in *inter partes* reexaminations, the time for