

month publication process for an ever decreasing number of CPAs. Since CPA practice for utility or plant applications is largely redundant in view of RCE practice and is also costly and inefficient, the Office has determined that it is now appropriate to eliminate CPA practice as to utility and plant applications.

Discussion of Specific Rule

Title 37 of the Code of Federal Regulations, part 1, is amended as follows:

Section 1.53(d)(1) is amended to provide that an application may be filed as a CPA under § 1.53(d) only if the application is for a design patent (either an original or reissue design patent) and the prior nonprovisional application (of which the CPA is a continuation or divisional) is a design application that is complete as defined by § 1.51(b).

Section 1.53(d)(3) is amended to provide that the filing fee for a CPA filed under § 1.53(d) is the basic filing fee as set forth in § 1.16(f). Since § 1.53(d) no longer applies to utility or plant applications and a design application may contain only a single claim (§ 1.154(b)(6)), there is no need for § 1.53(d)(3) to provide for additional claims fees.

Section 1.53(e)(1) is amended to provide that if a request for an application under § 1.53(d) (a CPA) does not meet the requirements of § 1.53(d) because the application in which the request was filed is not a design application, and if the application in which the request was filed was itself filed on or after June 8, 1995, the request for an application under § 1.53(d) will be treated as an RCE under § 1.114. This change to § 1.53(e)(1) incorporates into the rules of practice the Office's current procedures for handling improper CPAs.

Experience has shown that such requests for a CPA may not satisfy the requirements of § 1.114 to be a proper RCE (e.g., the request may lack a submission as defined by § 1.114(c), or may not be accompanied by the fee set forth in § 1.17(e)). In such situations, the Office will treat the improper request for a CPA as an RCE (albeit an improper RCE), and the time period set in the last Office action (or notice of allowance) will continue to run. If the time period (considering any available extension under § 1.136(a)) has expired, the applicant must file a petition under § 1.137 (with a submission as defined by § 1.114(c), unless previously filed, and/or fee set forth in § 1.17(e)) to revive the abandoned application.

During the implementation of RCE practice, the Office indicated that if an applicant files a request for a CPA of an

application to which CPA practice no longer applies and the applicant does not want the CPA request to be treated as an RCE (e.g., the CPA is a divisional CPA), the applicant may file a petition under § 1.53(e) requesting that the improper CPA be converted to an application under § 1.53(b). *See Request for Continued Examination Practice and Changes to Provisional Application Practice*, 65 FR at 50093–94, 1238 *Off. Gaz. Pat. Office* at 15. Since RCE practice has been in place for over three years and it is burdensome on the Office to treat petitions requesting conversion of a CPA into an application under § 1.53(b), the Office will no longer convert an improper CPA into an application under § 1.53(b) simply because it is requested by the applicant. Therefore, the Office will now convert an improper CPA into an application under § 1.53(b) only if the applicant shows that there are extenuating circumstances that warrant the burdensome process of converting a CPA into an application under § 1.53(b) (e.g., restoring the application to pending status and correcting the improper RCE is not possible because the application has issued as a patent).

In the event that an applicant files a request for a CPA of a utility or plant application that was filed before June 8, 1995, the Office will treat the improper CPA request as an improper application under the provisions set forth in the first sentence of § 1.53(e)(1).

Response to comments: The Office published a notice proposing changes to the rules of practice to eliminate CPA practice as to utility and plant applications. *See Elimination of Continued Prosecution Application Practice as to Utility and Plant Patent Applications*, 66 FR 35763 (July 9, 2001), 1248 *Off. Gaz. Pat. Office* 167 (July 31, 2001) (proposed rule). The Office received nineteen written comments (from intellectual property organizations, patent practitioners, and the general public) in response to this notice. The comments and the Office's responses to the comments follow:

Comment 1: One comment that supported the proposal to eliminate CPA practice (as to utility and plant applications) also suggested that RCE practice be extended to design applications so that the Office could also eliminate CPA practice as to design applications, thus completely eliminating CPA practice.

Response: Section 4404(b)(2) of the AIPA provides that the RCE provisions of 35 U.S.C. 132(b) do not apply to applications for a design patent. *See* 113 Stat. at 1501A–561. Therefore, the Office is prohibited by statute from

making RCE practice applicable to design applications.

Comment 2: Several comments opposing the proposed elimination of CPA practice as to utility and plant applications argued that an RCE is not the equivalent of a CPA, and that the Office has acknowledged as much in its publications. The comments specifically indicate that an RCE is not equivalent to a CPA because: (1) One must file a CPA in an application filed before November 29, 1999, to take advantage of the common prior art exclusion in 35 U.S.C. 103(c) as amended by § 4807 of the AIPA; (2) one must file a CPA in an application filed before May 29, 2000, to take advantage of the patent term adjustment provisions of 35 U.S.C. 154(b) as amended by § 4402 of the AIPA; (3) one must file a CPA in an application filed before November 29, 2000, to take advantage of the eighteen-month publication provisions of the AIPA (without having to file a copy of the application by the Office's electronic filing system (EFS)); (4) one cannot file an RCE in an application filed before June 8, 1995; (5) one cannot file an RCE to obtain examination of a patentably distinct invention (i.e., analogous to a divisional CPA); (6) one cannot file an RCE to change inventorship without a request to correct inventorship under § 1.48; (7) one cannot file an RCE without a submission; and (8) one cannot file an RCE before prosecution in the application is closed.

Response: The Office recognizes that an RCE is not a complete equivalent to a CPA. The Office has addressed the public's concerns regarding the elimination of CPA practice by delaying the elimination of CPA practice (which was initially proposed in July of 2001) until July of 2003, after more than three years have passed since the enactment of the AIPA. Since CPA practice has remained in effect for over three years since the enactment of the AIPA, any applicant wishing to file a CPA to take advantage of the amendment to 35 U.S.C. 103(c) in the AIPA, the patent term adjustment provisions of the AIPA, or the eighteen-month publication provision of the AIPA, has had sufficient time to do so. Any applicant now wishing to file a CPA to take advantage of any provision of the AIPA should file a CPA before July 14, 2003, the effective date of this change to § 1.53(d).

The RCE provisions of 35 U.S.C. 132(b) do not apply to applications filed before June 8, 1995. *See* 113 Stat. at 1501A–560 through 1501A–561. Based upon the current low usage of § 1.129(a) submission practice, it appears that there are relatively few applications