

filed before June 8, 1995, that are still pending. In view of the patent term implications of abandoning an application filed before June 8, 1995, in favor of a continuing application, maintaining a streamlined practice (CPA practice) for filing a continuing application may result in applicants inadvertently taking this course of action to their detriment.

An applicant cannot obtain examination of a patentably distinct invention via an RCE (*i.e.*, as with a divisional CPA). The Office's experience with divisional CPA practice, however, has shown that divisional CPA practice is less than desirable. *See Request for Continued Examination Practice and Changes to Provisional Application Practice*, 65 FR at 50100, 1238 *Off. Gaz. Pat. Office* at 20 (response to comment 10). Therefore, the "benefits" of divisional CPA practice do not warrant continuing to maintain a burdensome CPA practice.

An applicant cannot file an RCE to change inventorship without a request to correct inventorship under § 1.48 (as can be done in a CPA). The requirements of § 1.48, however, have now been streamlined sufficiently that this benefit of CPA practice does not justify maintaining a burdensome CPA practice.

A continuing application (unlike an RCE) can be filed without a submission and before prosecution in the prior application is closed. These courses of action, however, tend to extend application pendency and thus tend to have an effect that is contrary to the Office's goal of reducing patent application pendency. Therefore, the Office will not maintain CPA practice to allow applicants to easily file a continuing application without a submission to advance prosecution or before prosecution in the prior application is closed.

Comment 3: One comment opposed the proposed change to CPA practice on the basis that it was unnecessary to abruptly end CPA practice as CPA practice is being phased out (as to utility and plant applications). Another comment suggested that the Office wait until all of the applications filed before May 29, 2000, are no longer pending before eliminating CPA practice.

Response: The phasing out of CPA practice has resulted in many requests for a CPA now being improper because they are filed in utility or plant applications that were filed on or after May 29, 2000. The Office considers it appropriate to now eliminate CPA practice outright such that the Office can treat any subsequently filed request for a CPA as an RCE rather than

continue the burdensome process of separately tracking proper CPAs and improper CPAs.

Comment 4: One comment that opposed the proposed change to CPA practice suggested that abruptly eliminating CPA practice will likely result in an increase in CPA filings immediately before the effective date of the change.

Response: The Office anticipates that eliminating CPA practice as to utility and plant application effective July 14, 2003, may result in an increase in the number of CPA filings between now and July 14, 2003.

Comment 5: One comment that opposed the proposed change to CPA practice stated that eliminating CPA practice will likely result in an increase in the number of applications that are abandoned when a CPA (now treated as an RCE) is filed without a submission.

Response: As discussed above, the practice of filing continuing applications without any submission to advance prosecution tends to extend application pendency and thus tends to have an effect that is contrary to the Office's goal of reducing patent application pendency. If an improper CPA (the CPA being improper because CPA practice has been eliminated as to utility and plant applications) does not satisfy the requirements of § 1.114 to be treated as a proper RCE, the Office will treat the improper request for a CPA as an RCE (albeit an improper RCE). If the applicant does not supply a submission as defined by § 1.114(c) and/or fee set forth in § 1.17(e) within the time period for reply set in the Office action or notice of allowance (considering any available extension under § 1.136(a)), the applicant will need to file a petition under § 1.137 to revive the abandoned application and supply a submission as defined by § 1.114(c) and/or fee set forth in § 1.17(e), unless previously submitted.

Comment 6: One comment that opposed the proposed change to CPA practice stated that the increased cost of handling CPAs is offset by the publication fee. Another comment that opposed the proposed change to CPA practice stated that if CPAs are more costly to process, the Office should not eliminate CPAs but just charge additional fees for CPAs.

Response: The Office cannot simply offset the additional costs of publishing CPAs under eighteen-month publication with additional fees (the publication fee or a higher publication fee for CPAs). The Office cannot spend the fees it collects absent authority from Congress to do so. Congress generally does not authorize the Office to spend all of the

fees it collects; rather, Congress generally authorizes the Office to spend up to only a certain amount of the fees it collects and diverts the remaining fees to other programs. Thus, even if the Office collects additional publication fees (ostensibly to recover the Office's cost of publishing CPAs), such fee revenue would likely be diverted from the Office leaving the Office with no funding to actually cover the increased cost of publishing CPAs.

Comment 7: One comment that opposed the proposed change to CPA practice suggested that the Office provide by rule that a CPA will not be published (under 35 U.S.C. 122(b) and § 1.211). Another comment suggested that the Office require applicant to file a nonpublication request under § 1.213(a) with any CPA, or require that any applicant filing a CPA without a nonpublication request under § 1.213(a) provide a copy of the application by the Office's electronic filing system (§ 1.215(c)).

Response: 35 U.S.C. 122(b)(2) does not provide an exception to eighteen-month publication for CPAs. The Office cannot simply require every applicant filing a request for a CPA to also file a nonpublication request under § 1.213(a) because not every applicant can properly make the certification required by 35 U.S.C. 122(b)(2)(B)(i) and § 1.213(a). In addition, the current CPA filing levels do not justify engaging in further refinements of CPA practice (as opposed to simply eliminating CPA practice as to utility and plant applications).

Comment 8: One comment stated that after a notice of appeal has been filed but an agreement with the examiner is reached, the applicant cannot file an RCE and that a CPA is the most efficient mechanism to effect the agreement.

Response: An applicant can file an RCE after a notice of appeal has been filed to effect any agreement with the examiner (or to obtain continued examination of the application before the examiner). *See* § 1.114(a). There is no reason why a CPA would be a more effective mechanism than an RCE to effect any such agreement.

Comment 9: One comment questioned whether the examination given to an application after the filing of an RCE is the same as for a CPA.

Response: The examination given to an application after the filing of an RCE is the same as for a CPA, except that an applicant cannot file an RCE to obtain examination of a patentably distinct invention as in a divisional CPA. With regard to first action final practice, the action immediately subsequent to the filing of an RCE may be made final only