

such number is not known, then applicant must identify the prior application by filing date, title, and name of applicant (and preferably the application docket number) so that the Office will be able to identify the prior application.

Section 1.445(a)(2)(ii) is proposed to be amended to increase the search fee charged by the ISA/US in situations not covered by § 1.445(a)(2)(i) from \$700 to \$1,000. This search fee amount more accurately reflects the Office's actual average costs of searching international applications in situations not covered by § 1.445(a)(2)(i). This search fee amount is higher than the search fee amount for applications under 35 U.S.C. 111(a) as proposed by the Administration because of additional costs associated with both searching international applications and the preparation and transmittal of a written opinion of the ISA. Additionally, international applications must be searched (and examined) under the PCT unity of invention standard, where applications under 35 U.S.C. 111(a) are searched (and examined) under the restriction standard set forth in 35 U.S.C. 121. Moreover, the search fee set forth in § 1.445(a)(2)(i) must also cover preparation of a written opinion (the "International Preliminary Report on Patentability (Chapter I of the Patent Cooperation Treaty)" ("IPRP")) under the revised system.

In addition, the fee charged by the ISA/US for searching an additional invention is proposed to be increased from \$210 to \$1,000. This amount more accurately reflects the Office's actual average costs of searching and examining additional inventions. In this regard, it is noted that the search fee and the supplemental search fee charged by every other international searching authority are the same (except for the ISA/JP, which charges a supplemental search fee that is only slightly lower than the search fee).

Section 1.445(a)(4) is proposed to be deleted, as confirmation fees will no longer be applicable.

Section 1.445(b) is amended to reflect the combining of the basic and designation fees into a single "international filing fee".

*Section 1.455:* Section 1.455(b) is proposed to be amended to be consistent with PCT rule 90.4 as it relates to the manner of appointment of agent, attorney or common representative.

*Section 1.480:* Section 1.480(a) is proposed to be amended to reflect the new time limits in PCT rule 57.3 and 58.2 for submitting the handling and preliminary examination fees.

Section 1.480(d) is proposed to be added, consistent with PCT rule 53.7 (as amended), to provide that the filing of a Demand shall constitute the election of all Contracting States that are designated and bound by chapter II of the Treaty on the international filing date. Accordingly, it will no longer be necessary to specify in the Demand those States that are elected.

Section 1.480(e) is proposed to be added to provide that any Demand filed after the expiration of the applicable time limit in PCT rule 54*bis*.1(a) shall be considered as if it had not been submitted. *See* PCT rule 54*bis*.1(b) (as amended).

*Section 1.481:* Section 1.481(a) is proposed to be amended to provide that the handling fee and preliminary examination fee that are due are those fees in effect on the date of payment of the handling and preliminary examination fees. *See* PCT rules 57.3(d) and 58.1(b).

*Section 1.482:* Section 1.482(a)(1) is proposed to be amended to increase the preliminary examination fee charged by the IPEA/US from \$490 to \$600 if the international search fee was paid to the United States Patent and Trademark Office as an ISA (the preliminary examination fee charged by the IPEA/US if the international search fee was not paid to the United States Patent and Trademark Office as an ISA will remain at \$750). This proposed increase is necessary to cover the additional cost associated with conducting the preliminary examination by the IPEA/US. Under the enhanced international search and preliminary examination system, a written opinion will be established by the ISA and sent to applicant. As a result of the change to the time limit in PCT Article 22(1), it is no longer necessary, in most cases, to file a Demand in order to delay entry into the national stage to thirty months from the priority date. In view of these changes, it is anticipated the majority of applicants filing a Demand under the revised system will no longer be doing so to simply further delay entry into the national stage, but rather will be doing so to obtain a positive "International Preliminary Report on Patentability (Chapter II of the Patent Cooperation Treaty)" by the IPEA. As such applicant will need to file one or more amendments under PCT Article 34 in the international application to overcome any negative determinations set forth in the written opinion by the ISA, the Office's costs of examining each international application as the US/IPEA for applicants who file a Demand under the revised system will increase.

For the same reason, as well as reasons set forth with regard to the increase in the supplemental search fee under § 1.445(a)(3), § 1.482(a)(2) is proposed to be amended to increase the additional preliminary examination fee for examining additional inventions to \$600 (regardless of whether the international search fee was paid to the United States Patent and Trademark Office as an ISA).

Section 1.482(b) is proposed to be amended to refer to revised PCT rule 57 as it relates to handling fee requirements.

*Section 1.484:* Section 1.484(b) is proposed to be amended to refer to revised PCT rule 69.1 as to when the IPEA/US may start international preliminary examination. PCT rule 69.1 was revised to prohibit the IPEA from starting preliminary examination until it is in possession of, *inter alia*, the written opinion of the ISA. PCT rule 69.1 provides for two exceptions to this requirement. Both exceptions apply when the IPEA and the ISA for the international application are the same authority. The first exception permits the IPEA to start examination at the same time as the international search, subject to certain limitations. *See* PCT rule 69.1(b). The second exception occurs when the ISA considers the conditions under PCT Article 34(2)(c)(i) to (iii) to be fulfilled. In such cases, a written opinion by the ISA need not be established. *See* PCT rule 69.1(b)*bis*.

Sections 1.484(e) through (g) are proposed to be redesignated as §§ 1.484(g) through (i), respectively. Proposed § 1.484(e) now provides, consistent with PCT rule 66.1*bis*, that the written opinion of the ISA shall be considered to be the written opinion of the IPEA/US.

Proposed § 1.484(f) now provides that the IPEA may establish further written opinions, subject to the conditions specified in § 1.484(d). Establishment of additional written opinions by the IPEA is provided for in PCT rule 66.4(a).

Section 1.484(g) is proposed to be amended as a consequence of the amendment to § 1.484(f).

Section 1.484(h) is proposed to be amended to provide clarification regarding conducting personal and telephonic interviews with the examiner under the revised system.

#### Rulemaking Considerations

*Regulatory Flexibility Act:* The Deputy General Counsel for General Law of the United States Patent and Trademark Office has certified to the Chief Counsel for Advocacy of the Small Business Administration that changes proposed in this notice will not have a significant