

application information will be negotiated shortly. Transmission of priority documents electronically directly to the other IP offices on request of the applicant is anticipated to reduce the overall costs to the applicant and to the other IP offices (which would receive the certified copy in a format that is easily stored and retrieved on demand). In tandem with this effort is a parallel effort to promote the sharing of information (e.g., search results) concerning related applications by the various IP offices in order to reduce duplication of efforts, improve the efficiency and quality of examination efforts, and decrease workload. Thus, it is anticipated that the Office's migration to an electronic environment together with international negotiations will improve the efficiency and work quality of the Office.

### Discussion of Specific Rules

#### Section 1.3

Section 1.3 has been amended to provide that papers presented in violation of the decorum and courtesy requirements will not be entered. The Office is capturing electronic images of all documents (papers) that will be the official records of certain applications. If the Office has captured the image of a paper violating § 1.3 as an electronic sheet(s), the Office will electronically remove the document from the Official file (the collection of documents related to a patent application or patent and which would be in this instance an electronic file) and from the Office computer systems. If the application has not yet been captured as an image file, the paper will not be entered in the Official file (which would in this instance be a paper file). In either event, the Office will provide notice in the Official file that the paper will not be available to the public and send a decision to the applicant notifying the applicant of the non-entry. If the paper is intended as a reply to an Office action, the reply will not be considered a *bona fide* reply under § 1.135(c) and the period set in the prior Office action will continue to run.

Similarly, a paper submitted in violation of § 10.10(b) that is intended as a reply will not be entered in the Official file and will not be treated as an unsigned reply (nor as a signed reply) as is the current practice. Therefore, the reply will not toll the time period set in a prior Office action. The Office will provide notice of the non-entry to the applicant or patent owner.

#### Section 1.9

Section 1.9 has been amended to clarify that the word "paper" and "papers" refer to a document or documents, which may be electronic records or physical paper sheet(s).

#### Section 1.14

Section 1.14 explains that applications for patents are generally preserved in confidence, and sets forth the special circumstances (35 U.S.C. 122(a)) under which a member of the public may have information about, copies of, or access to a patent application. Section 1.14 has been revised to clarify the rule and to expand the rule to provide for electronic files.

Paragraph (a)(1) has been rewritten to list the records that may be made available. The term "file wrapper and contents" has been replaced with the term "file contents" to avoid confusion with the paper (non-electronic) file jacket and its contents. Paragraph (a)(1) rephrases the provisions of former §§ 1.14(c) and (e) to assist the public in understanding what applications may be made available to the public. Accordingly, § 1.14(a)(1), as rewritten, is divided into §§ 1.14(a)(1)(i) through (a)(1)(vii) listing different types of application files and explaining whether any part of the file contents may be made available to the public. For example, § 1.14(a)(1)(iii) explains that copies of published pending applications may be made available to the public, upon written request, and payment of the appropriate fee, and that the original paper file of the pending application that was published as a patent application publication is not available to the public. The explanation for when an application may be made available in § 1.14(a)(1)(iv) rephrases the "referred to" provision of former § 1.14(e)(2) with "identified or relied upon" and adds a definition of "identified" that conforms with current Office policy interpreting "referred to." An application is "referred to" when it is identified by application number or serial number and filing date, first named inventor, title and filing date or other application specific information are provided in the text. In addition, in the new § 1.14(a)(1)(v) where the benefit of a pending application is relied upon pursuant to 35 U.S.C. 119(e), 120, 121 or 365 in certain applications, copies of the application file contents may be made available in the same manner that copies of the application would have been had the application been published as a U.S. patent application publication (§ 1.14(a)(1)(iii)). As a result of this change to § 1.14, if an application

is a continuation of an earlier application, and the Office publishes the continuation as a patent application publication but without an identification of the earlier application in the published document, a copy of the file contents of the earlier-filed application may be made available to the public, upon payment of the required fee for a copy, if the application is still pending. This is because the Office (PALM) records for continuation applications, which are available to the public following publication, will indicate the status as a continuation and information about the earlier application.

Paragraph (a)(2) has been revised to combine and restate former §§ 1.14(a)(1) and (b) which address status information. The application number of any application that claims the benefit of the filing date of a patent or an application that has been published may be obtained from the PAIR system on the Office's Internet Web site at: <http://pair.uspto.gov>.

Section 1.14 is also amended to have a new § 1.14(b), to explain that electronic access may be provided to all or part of certain applications. Following migration to an electronic image file as the Official file of patent applications, access will be provided solely to the electronic Official file and not to the original paper document sheets used to create electronic images within the Official file.

Section 1.14(c) is the same as former § 1.14(d). Paragraph (d) of former § 1.14 has been redesignated as § 1.14(c).

Section 1.14(d) is the same as former § 1.14(f). Paragraph (f) of former § 1.14 has been redesignated as § 1.14(d).

Section 1.14(e) is the same as former § 1.14(g). Paragraph (g) of former § 1.14 has been redesignated as § 1.14(e). On reconsideration, the changes proposed in § 1.14(f)(1) and (2) were not necessary to implement an image file wrapper system. The proposed changes, including the public comments, may be reconsidered in the future.

Section 1.14(f) is the same as former § 1.14(h). Paragraph (h) of former § 1.14 has been redesignated as § 1.14(f).

Section 1.14(g) of § 1.14 corresponds to former § 1.14(i), and is further amended to explain the meaning of the terms "Home Copy," "Search Copy," and "Examination Copy," and by inserting "of a publication" after "English language translation" in § 1.14(g)(2). Section 13204 of Public Law 107-273 made a technical change to the provisional rights provisions of the patent statute as to international applications to clarify that a translation of the international publication, as