

opposed to the international application, is required to be filed in order for a patent owner to obtain provisional rights pursuant to 35 U.S.C. 154(d). In view of this change to the statute, the corresponding reference to the translation in § 1.14 is changed to add “a publication of an international patent application” after “English language translation of.” In addition, the parenthetical phrase at the end of § 1.14(g)(1), referencing the fee for a copy of an international application file, or a copy of a document in a file, has been changed from a reference to § 1.19(b) rather than § 1.19(b)(2) or § 1.19(b)(3), the fees for the contents of a file or a CD, and the parenthetical phrase at the end of § 1.14(g)(2), referencing the fee for a copy of an English language translation in a file, has been corrected to refer to § 1.19(b)(4), the fee for a document, rather than § 1.19(b)(2) or § 1.19(b)(3).

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

The changes that had been proposed in 1.14(e) have been postponed pending successful negotiation and implementation of agreements with other IP offices to provide for electronic document exchange. The Office will at that time publish a final rule amending § 1.14 to provide for an applicant to provide consent (if the application is being maintained in confidence under 35 U.S.C. 122(a) and § 1.14) to electronic document exchange of the applications with the IP offices with which the Office has such an agreement.

Section 1.17

Section 1.17 has been amended to eliminate the reference to returning information that has been expunged in § 1.17(h) because expunged information need not be returned under § 1.59 as amended.

Section 1.19

The proposed changes to § 1.19 to eliminate the required fee for providing a copy of an application as filed to certain other IP offices following an agreement with other IP offices to electronically share such document has been postponed pending successful implementation of such agreements. The Office will at that time publish a final rule amending § 1.19 to eliminate its fee for applicants who consent to electronic document exchange of the applications with the IP offices with which the Office has such an agreement.

Section 1.52

Section 1.52 has been amended to clarify the requirement for proper paper

sizes in paper communications submitted to the Office and to set forth the analogous requirements for electronic communications.

The Office plans to capture electronic images of all documents that form the record of patent application examination. These images will form the Official file of the application. See *Notification of United States Patent and Trademark Office Patent Application Records being Stored and Processed in Electronic Form*, 1271 Off. Gaz. Pat. Office at 100. Applicants will have the option of submitting application documents and other communications to the Office on paper, by facsimile transmission, or via the Office's electronic filing system (EFS). The existing requirements for paper and facsimile submissions (as well as the prohibition against filing patent applications by facsimile, see § 1.6(d)(3)) are retained, and the requirements for electronic submissions are added. One newly added requirement for paper submissions requires that the papers not be permanently bound because the papers must be readily separable for scanned entry into the image system. The use of binder clips or standard office staples will generally be acceptable. The detailed requirements for electronic submissions are provided in the Office's EFS documentation (available electronically at <http://www.uspto.gov>) and the proposed amendments direct the affected party's attention to those requirements.

Paragraph (a)(1) of § 1.52 has been amended to clarify that it pertains to paper and facsimile submissions, and that such submissions must not be permanently bound together. Correspondence may include multiple papers each of which may be on either 21.6 cm by 27.9 cm (8½ by 11 inch) or 21.0 cm by 29.7 cm (DIN size A4) paper. For example, a transmittal letter and Information Disclosure Statement (IDS) on 21.6 cm by 27.9 cm (8½ by 11 inch) paper accompanied by copies of cited references on 21.0 cm by 29.7 cm (DIN size A4) paper is permitted.

Paragraph (a)(2) of § 1.52 has been amended to clarify that it pertains to paper and facsimile submissions.

Paragraph (a)(5) of § 1.52 has been amended to clarify that it pertains to paper and facsimile submissions.

Paragraph (a) of § 1.52 has also been amended by adding §§ 1.52(a)(6) and (a)(7) to set forth that papers submitted electronically must comply with the Office's EFS requirements and that failure to comply will result in a requirement for correction.

Paragraphs (b)(3) and (b)(4) of § 1.52 have been amended to clarify that the requirements for the abstract and claims to begin on a separate sheet on physical paper are similarly required to begin on a separate electronic page in an electronic submission.

Paragraph (b)(7) of § 1.52 has been amended to explain the consequences of a failure to provide compliant papers within the set time period. That is, § 1.52(b)(7) provides that compliant papers must be provided within the set time period in order to avoid abandonment of the application in the case of an applicant for patent, termination of proceedings in the case of a patent owner in a reexamination proceeding, or refusal of consideration of the papers in the case of a third party requester in a reexamination proceeding.

Section 1.59

Section 1.59 has been amended to eliminate references to returning documents that have been expunged to recognize that, with electronic Official files, there will be nothing to return when a paper is expunged. The Office is capturing electronic images of all documents that form the Official file. Where the image is generated from a physical source document, the originating document may be disposed of once the electronic image accuracy is verified. The paper source document will eventually be destroyed under a United States National Archives and Records Administration (NARA) approved schedule. Therefore, if a document is to be expunged from the record, the only operation that will be required will be removal of the image from the Official file.

Paragraph (a)(1) of § 1.59 has been amended by deleting the phrase “and returned” from the first sentence, and deleting the second sentence.

Paragraph (b) of § 1.59 has been amended by deleting the phrase “and return” from each of the first and second sentences. The Office will continue to provide notice in the Official file that a paper has been expunged and the Office will send a decision to the applicant notifying the applicant that the paper has been expunged.

Section 1.71

Section 1.71 has been amended by adding a new § 1.71(f) to require that the first page of a specification commence on a new sheet and to require that no sheet including part of the text of the specification include any other material. Further, the claims, abstract or sequence listing (if any) should not be included