

under a NARA approved schedule. The Office has also amended § 1.3 to provide that notice of non-entry will be provided.

*Comment 2:* One comment indicated that there was no reasonable basis for the proposed change to § 1.3.

*Response:* It is noted that following transition to an image file wrapper environment, the physical paper constituting a failure of proper decorum and courtesy will either have been previously physically destroyed or will be in a temporary storage facility arranged by date order of scanning. Therefore, the Office will be unable to provide the document or, if the document is still in temporary storage, would incur unnecessary costs and delays to provide the physical paper document.

*Comment 3:* One comment indicated that the proposed change to § 1.9 to add a new § 1.9 (R) should be revised to indicate that a new § 1.9 “k” has been added.

*Response:* The comment has been adopted. The rule has been revised to add a new § 1.9 “k” rather than a § 1.9 (R).

*Comment 4:* As to § 1.14(a), two responses suggested expanding the applications that are available to the public without a petition for access to also include unpublished pending applications that are either incorporated by reference in certain documents or relied upon under 35 U.S.C. 119(e), 120, 121 or 365 by an application that has issued as a U.S. patent or in an application that has published as a statutory invention registration, or with effect as a U.S. application. One comment stated that since almost ninety percent of pending U.S. applications are now published, there is no sound public policy or unusual Office burden that should prevent public access to these unpublished pending applications, and argued that these unpublished pending applications can be an essential source of prosecution history that is necessary, for example, to interpret the scope of claims in a patent that relies on the unpublished pending application for filing date benefit.

*Response:* The comment that pending applications that are relied upon under 35 U.S.C. 119(e), 120, 121 or 365 should be more readily available to the public has been adopted, but the limited access to applications that are incorporated by reference remains. Accordingly, proposed § 1.14(a)(1)(v) (which address unpublished pending applications) has been separated into §§ 1.14(a)(1)(v) (for benefit situations) and (vi) (for incorporation by reference or otherwise identified situations). A copy of the

application as originally filed, the file contents, or any document in the file of an unpublished pending application that is relied upon in a benefit claim will be available upon written request pursuant to § 1.14(a)(1)(v). A copy of the application as originally filed for an unpublished pending application that is incorporated by reference will also be available upon payment of the required fee pursuant to § 1.14(a)(1)(vi). Thus, these types of pending applications will continue to require payment of a fee for copies, as access to these applications is limited. The Office will continue to require that an order for a copy of the file contents, or any paper in the file, be placed with the Office of Public Records (OPR) in order to reduce the amount of time that the application is removed from the examination process. Of course, pursuant to § 1.14(b), if the Office has an image file wrapper (IFW) and once the public inspection utility is available to the public, the public would be permitted to inspect the IFW at any time, even when the application is in final data capture for issuance of the application as a patent.

*Comment 5:* One comment also requested clarification as to the definition of “referenced.” Another comment indicated that there is a defect with § 1.14 in that it does not notify the public that the Office will provide either a copy of or access to a file for an abandoned unpublished application if the application number for that abandoned unpublished application is referenced in a document in the file of a publicly available application, such as in an IDS in the publicly available application. The Office should revise § 1.14 to clarify that point.

*Response:* In the final rule, the term “identified” has been used instead of “referenced” in order to provide greater clarity. For an application to be “identified” there must be a reference to the application in the published patent or patent application document itself. In § 1.14(a)(iv), the following sentence has been added: “An application is considered to have been identified in a document, such as a patent, when the 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 of the patent, but not when the same identification is made in a paper in the file content of the patent and is not included in the printed patent or application publication.” As a result, any application that is identified in a patent whether on the front page of the patent, in the “References Cited” section, incorporated-by-reference in the specification, or relied upon for priority,

or in some other manner, is available to the public. If an application is identified in an amendment to the specification of an application, and that amendment is later canceled, then the application is not identified in the patent document.

Note that if the application was relied upon under 35 U.S.C. 119(e) or 120, but for some reason, the application was not identified in the patent application publication (e.g., the benefit claim was made in a preliminary amendment and preliminary amendments are not reflected in patent application publications (see § 1.215(a))), the application is still available to the public because Office computer records will show the benefit claim.

It not enough that the application has been referenced somewhere in the file content, such as in an examiner’s Office action. An application that is mentioned in an examiner’s Office action may be available on petition, but not automatically by operation of the rule. Examiners need to be able to mention copending commonly assigned applications and to distinguish the application that they are examining from other applications of the applicant, and the record needs to be clear as to discussion of other relevant applications, but if such a discussion also had the effect of laying open the related applications, then the Office would continually be subjected to requests to expunge the record of allegedly unnecessary references to other applications.

*Comment 6:* One comment noted that proposed new § 1.14(b) states that “the Office may at its discretion provide access only to an electronic copy of the specification, drawings, and file contents of the application.” The comment further noted that the proposed rule does not indicate how the Office will “provide access only to an electronic copy” and requested that the proposed rule be revised to clarify what “access only to an electronic copy” means to apprise practitioners of what they need to do to get that access.

*Response:* The comment has not been adopted. The mechanism by which the Office will provide electronic copies is anticipated to change rapidly over the next five years, and the text of proposed § 1.14(b) was chosen to give the Office flexibility in the mechanism in which electronic access will be provided. At this time, the Office does not limit access for any patent applications to electronic copies, and when the Office does limit such access, the Office will explain how to obtain such access on the Office’s Internet Web site as well as in other documents.