

*Comment 7:* Several comments indicated approval of proposed new § 1.14(e) to § 1.14. One comment requested that the Office streamline the global patenting process by relieving applicants of the burden of having to place and track orders for certified copies and then ship them around the world by relieving applicants who consent to sharing the electronic file of their applications of the need to request that the Office transmit their application to other IP offices in which they are claiming priority, by deeming a priority claim made in an IP office with which the Office has a bilateral agreement as authorization for the Office to transmit the file to that IP office or provide that office with access to the file.

*Response:* Pending implementation of the system to provide document exchange, the revision to § 1.14(e) has been postponed. Deeming a priority claim made in an IP office with which the Office has a bilateral agreement as an authorization for the Office to transmit a file to that Office and for the Office to electronically obtain the priority document is an excellent suggestion that the Office will explore further. At this time, however, the Office does not consider it advisable to treat a priority claim as being sufficient to permit an office of subsequent filing to “pull” the priority document from the office of first filing. The Office prefers to provide for the office of first filing to “push” the priority document to the office of subsequent filing at the request of the applicant to do so. This is because applicants do sometimes inadvertently provide the wrong application number in their priority claim.

*Comment 8:* Another comment requested that the Office create a process by which the applicant provides express written consent to the sharing of its electronic application with other IP offices as simply as possible by allowing the consent to be incorporated into the Application Transmittal as well as being submitted as a separate paper either at the time the application is filed or subsequent thereto.

*Response:* The proposed changes to § 1.14(e) have been postponed. The comments made will be considered when the proposed change is reconsidered. The Office plans to make consent to share its electronic application as simple as possible. The Office has a strong interest in sharing search results and other information with other IP offices.

*Comment 9:* One comment stated that proposed new § 1.14(e) indicates that the Office may share unpublished applications with other IP offices, if the

applicant consents, and presumed that the Office will implement a procedure wherein the applicant is notified of an intent to share the application with the other IP offices, and then requires the applicant to take some affirmative action after notice by the Office, as is proposed in § 1.14(f)(2) regarding decisions the Director wants to publish for Board proceedings that are not otherwise public.

*Response:* The proposed changes to § 1.14(e) have been postponed. The comments made will be considered when the proposed change is reconsidered.

*Comment 10:* Finally, under § 1.14(f)(2) (as proposed), another comment encouraged the Office to make any action or decision that involves an interpretation of patent laws and regulations that would be of important precedential value available to the public regardless of whether the decision discloses a trade secret or other confidential information. The comment explained that the great majority of applications will be available to the public by virtue of a publication of most applications eighteen months after first filing, and argued that the policy and practice of applications being published represents the rule rather than the exception. In the unique circumstances where an action or decision is considered to have important precedential value, the comment argued that the general rule of transparency to the public should prevail over the interests of confidentiality of an individual application that is not even available to most applicants.

In addition as to § 1.14(f) (as proposed), which indicates that the Office may publish certain decisions of the BPAI, several comments on the proposal stated that the Director has authority for publication of such decisions based upon the Director's authority specified in 35 U.S.C. 122(a) to make “information concerning” patent applications public in “special circumstances as may be determined by the Director.” The comments in response to the notice of proposed rule making listed one special circumstance as an opinion concerning an application that claims the benefit of a published application, including a published foreign priority application, but the comments in response to this proposed change argued that there is no logical relationship between foreign priority and a benefit to the public, and that there is no logical reason for the Director to treat a claim to priority of a published foreign application as a “special circumstance.” Another comment stated that there is a public

purpose served by publication of BPAI decisions, even if the BPAI does not think those decisions, as noted in the comments, “involve an interpretation of patent laws or regulations that would be precedential,” and argued that the Director should state that any decision of the BPAI concerning a patent application is a special circumstance warranting publication of the decision.

*Response:* 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 on the proposed changes, may be reconsidered in the future.

*Comment 11:* One comment requested clarification on whether the Office intended to require all pages of a paper submitted to the Office in a particular paper to be the same size (e.g., all either on 21.6 cm by 27.9 cm (8½ by 11 inch) or 21.0 cm by 29.7 cm (DIN size A4) paper) in proposed § 1.52(a)(1).

*Response:* All papers being submitted to the Office should 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. Rule 1.52(a)(1) currently requires all papers to be on sheets of paper being the same size. For example, each page of an amendment must be on the same size paper. This rule does not, however, require that all correspondence in an application be on the same size paper. As a result, if a foreign client forwards to the patent practitioner prior art on 21.0 cm by 29.7 cm (DIN size A4) paper, a transmittal letter and form USPTO/SB/08 on 21.6 cm by 27.9 cm (8½ by 11 inch) paper may be submitted together with copies of the cited references on 21.0 cm by 29.7 cm (DIN size A4) paper and be consistent with § 1.52.

*Comment 12:* One comment requested that either the Office change its practice and specifically identify what specific provision or provisions of § 1.52 were not complied with in making a decision of non-compliance or assist applicants in submitting proper papers after a notice has been mailed.

*Response:* The Office did not propose any changes to its practice of treating papers not in compliance with § 1.52. Nevertheless, several of the most common errors are, in fact, described with particular detail in notices of non-compliance mailed by the Office. Other less common errors are more generally described. This represents a balancing of the need to process application papers in a timely manner with the desire to assist applicants. Further, when assistance is timely requested, the Office makes efforts to assist applicants in submitting papers.