

**DEPARTMENT OF COMMERCE****Patent and Trademark Office****37 CFR Parts 1 and 5**

[Docket No.: 2003-P-020]

RIN 0651-AB64

**Changes To Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan****AGENCY:** United States Patent and Trademark Office, Commerce.**ACTION:** Notice of proposed rulemaking.

**SUMMARY:** The United States Patent and Trademark Office (Office) has established a 21st Century Strategic Plan to transform the Office into a quality-focused, highly productive, responsive organization supporting a market-driven intellectual property system. The Office is proposing to revise the rules of practice to support the implementation of the 21st Century Strategic Plan, which involves improving the patent application and examination process by promoting quality enhancement, reducing patent pendency, and using information technology to simplify the patent application process. The more notable changes being proposed in this document involve permitting electronic signatures on a number of submissions, streamlining the requirements for incorporation by reference of prior-filed applications, and clarifying the qualifications for claiming small entity status for purposes of paying reduced patent fees. These changes to the patent application and examination process are necessary for the Office to be able to process the long-term trend of increasing numbers of applications within a reasonable time frame.

**COMMENT DEADLINE DATE:** To be ensured of consideration, written comments must be received on or before November 12, 2003. No public hearing will be held.

**ADDRESSES:** Comments should be sent by electronic mail message over the Internet addressed to [ab64.comments@uspto.gov](mailto:ab64.comments@uspto.gov). Comments may also be submitted by mail addressed to: Mail Stop Comments—Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 or by facsimile to (703) 305-1013, marked to the attention of Hiram Bernstein. Although comments may be submitted by mail or facsimile, the Office prefers to receive comments via the Internet.

The comments will be available for public inspection at the Office of Patent

Legal Administration, located at Room 3-C23 of Crystal Plaza 4, 2201 South Clark Place, Arlington, Virginia, and will be available through anonymous file transfer protocol (ftp) via the Internet (address: <http://www.uspto.gov>). Since comments will be made available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included in the comments.

**FOR FURTHER INFORMATION CONTACT:**

Hiram H. Bernstein, Senior Legal Advisor, by telephone at (703) 305-8713 or Robert J. Spar, Director, Office of Patent Legal Administration (OPLA), at (703) 308-5107, or by facsimile to (703) 305-1013, marked to the attention of Mr. Bernstein, or by mail addressed to: Mail Stop Comments—Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

**SUPPLEMENTARY INFORMATION:** The Office has conducted a “top to bottom” review of the patent application and examination process (among other processes) as part of the 21st Century Strategic Plan. The 21st Century Strategic Plan is available on the Office’s Internet Web site ([www.uspto.gov](http://www.uspto.gov)). While many of the changes to the patent application and examination process necessary to support the 21st Century Strategic Plan require enabling legislation (and implementing rule changes), the Office has determined that a number of initiatives can be implemented under the Office’s current rule making and patent examination authority set forth in 35 U.S.C. 2(b)(2), 131, and 132. This document proposes changes to the rules of practice in title 37 of the Code of Federal Regulations (CFR) to improve the patent application and examination process by promoting quality enhancement, reducing patent pendency, and using information technology to simplify the patent application process.

This document specifically proposes changes to the following sections of title 37 CFR: 1.4, 1.6, 1.8, 1.10, 1.14, 1.17, 1.19, 1.27, 1.47, 1.52, 1.53, 1.55, 1.58, 1.59, 1.69, 1.76, 1.78, 1.83, 1.84, 1.91, 1.94, 1.98, 1.102, 1.103, 1.105, 1.111, 1.115, 1.116, 1.131, 1.136, 1.137, 1.165, 1.173, 1.175, 1.178, 1.182, 1.183, 1.213, 1.215, 1.291, 1.295, 1.296, 1.311, 1.324, 1.377, 1.378, 1.502, 1.530, 1.550, 1.570, 1.644, 1.666, 1.704, 1.705, 1.741, 1.902, 1.953, 1.956, 1.957, 1.958, 1.979, 1.997, 5.12, 5.15, and 5.25. Additionally, this document proposes to amend title 37 CFR by adding new § 1.57 and removing § 1.179.

The following members of the Office of Patent Legal Administration may be contacted directly for the matters indicated:

Joni Chang ((703) 308-3858): §§ 1.8, 1.10, 1.98, 1.111, and 1.311  
 Jeanne Clark ((703) 306-5603): § 1.98  
 James Engel ((703) 308-5106): §§ 1.14, 1.17, 1.53, 1.59, 1.103, 1.131, 1.182, 1.183, 1.295, 1.296, 1.377, 1.378, 1.644, 1.666, 1.741, 5.12, 5.15, and 5.25  
 Karin Ferriter ((703) 306-3159): §§ 1.6, 1.47, 1.52 (other than (e)(1)(iii) and (e)(3)), 1.58, 1.83, 1.84, and 1.165  
 Anton Fetting ((703) 305-8449): §§ 1.17, 1.53, 1.59, 1.103, 1.105, 1.182, 1.183, 1.295, 1.296, 1.377, 1.378, 1.644, 1.666, 1.741, 5.12, 5.15, and 5.25  
 Kery Fries ((703) 308-0687): §§ 1.76, 1.704, and 1.705  
 Hiram Bernstein ((703) 305-8713): §§ 1.91 and 1.94  
 Eugenia Jones ((703) 306-5586): §§ 1.8, 1.10, 1.27, 1.55, 1.57(a), and 1.78  
 Michael Lewis ((703) 306-5585): §§ 1.4, 1.19, 1.52(e)(1)(iii) and (e)(3), 1.57, and 1.58(b)  
 Joe Narcavage ((703) 305-1795): §§ 1.173, 1.175, 1.178, 1.179, 1.291, and 1.324  
 Mark Polutta ((703) 308-8122): §§ 1.213, and 1.215  
 Kenneth Schor ((703) 308-6710): §§ 1.98, 1.116, 1.136, 1.137, 1.291, 1.502, 1.550, 1.570, 1.902, 1.953, 1.956, 1.957, 1.958, 1.979, and 1.997  
 Fred Silverberg ((703) 305-8986): § 1.115

The Office will post a copy of this notice on its Internet Web site ([www.uspto.gov](http://www.uspto.gov)). Additionally, individuals or organizations, that need a copy for the purpose of providing comments, may send a request by phone or e-mail to Elizabeth Polley at ((703) 308-6202, or [elizabeth.polley@uspto.gov](mailto:elizabeth.polley@uspto.gov)) or Terry Dey at ((703) 308-1201 or [terry.dey@uspto.gov](mailto:terry.dey@uspto.gov)) to receive an e-mail copy of the notice. When making a request for an e-mail copy, it is requested that persons please specify whether they wish to receive the document in MS-Word, WordPerfect, or HTML format.

**Discussion of Specific Rules**

**Section 1.4:** Section 1.4(d) is proposed to be amended to provide for filing correspondence with electronic signatures on electronically created correspondence documents that are filed by facsimile transmission, or hand-carried or mailed to the Office, for entry in a patent application, patent file, or