

not provide a means for changing the name of a signer. For example, when an inventor changes her/his name and the inventor desires to change her/his name in the application, such change must be accompanied by a petition under § 1.182. See *Manual of Patent Examining Procedure* § 605.04(c) (8th. ed. 2001) (Rev. 1, Feb. 2003) (MPEP).

The Office is proposing to treat failure to follow the format and content of a standard signature as an unsigned document. Treating the documents as being unsigned could have varying results dependent on the nature of the document. For example, in new applications, treating an oath or declaration as an unsigned oath or declaration could result in the imposition of a surcharge. See § 1.53(f)(1). Other correspondence could be treated under the procedures for unsigned amendment documents set forth in MPEP §§ 714.01 and 714.01(a).

As previously indicated, the Office is requesting comments on the alternative of requiring labeling the order of names in a signature in place of the proposed rule requiring capitalization of the entire family name.

Section 1.6: Section 1.6(d)(4) is proposed to be amended to provide that black and white drawings in patent applications may be transmitted to the Office by facsimile in order to provide more flexibility to applicants for filing individual papers in applications that contain drawings. Drawings are now permitted to be transmitted to the Office by facsimile when accompanied by payment of the issue fee, and drawings received by facsimile have been of an acceptable quality. See *Payment of the Issue Fee and Filing Related Correspondence by Facsimile*, 1254 Off. Gaz. Pat. Office 91 (Jan. 15, 2002). Although the rules of practice will now permit the submission of black and white drawings by facsimile, photographs or drawings with detail should not be transmitted by facsimile. Furthermore, color drawings must continue to be hand-carried or mailed to the Office instead of being transmitted by facsimile. In addition, the Office will publish drawings that are received as long as they can be scanned, and will not, in general require replacement drawings to replace drawings transmitted by facsimile, even if the facsimile transmission process results in the drawings being less sharp than the original drawings.

Section 1.6(e) is proposed to be removed and reserved because the provisions of § 1.6(e) are deemed more appropriately placed in § 1.10. This is because the "Express Mail" provisions of § 1.10 are the only means by which

correspondence can be accorded a filing date other than the actual date of receipt in the Office. Thus, the provisions of § 1.6(e) are proposed to be transferred to § 1.10 along with some changes.

Proposed § 1.10(g) and (h) specifically address situations in which "Express Mail" is returned or refused by the United States Postal Service (USPS). Proposed § 1.10(i) is similar to § 1.6(e) and addresses situations where there is a designated interruption or emergency in "Express Mail" service.

Section 1.8: Section 1.8(a) is proposed to be amended to clarify that the provisions of this section do not apply to time periods or situations set forth in sections that have been expressly excluded from § 1.8 as well as situations enumerated in § 1.8(a)(2).

Section 1.8(b) is also proposed to be amended to permit notifying the Office of a previous mailing, or transmitting, of correspondence, when "a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence."

Section 1.8(b) is also proposed to be amended to make it clear that it is not the reexamination proceeding which is concluded under §§ 1.550(d) or 1.957(b), but rather the prosecution of the reexamination. See the discussion as to the amendment of § 1.550 for the rationale for this change.

It is further proposed that § 1.8(b) be revised to more appropriately set forth the § 1.957(c) consequences of a failure to respond in an *inter partes* reexamination.

The proposed amendment to § 1.8(a) is to clarify that the list enumerated in § 1.8(a)(2) is not exhaustive. Provisions of § 1.8 also do not apply to the time periods or situations set forth in sections that have been explicitly excluded from § 1.8. For example, provisions of § 1.8(a) do not apply to time periods and situations set forth in §§ 1.217(e) and 1.703(f) because the exceptions are provided explicitly in § 1.217(e), "[t]he provisions of § 1.8 do not apply to the time periods set forth in this section" and § 1.703(f), "[t]he date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in [a patent term adjustment] calculation."

Recently, many applicants had experienced substantial delays in delivery of their correspondence by the USPS to the Office. These applicants did not wish to wait until the application is held to be abandoned before notifying the Office of the previous mailing, or transmitting, of the correspondence and supplying a duplicate copy of the correspondence

and requisite statement in accordance with § 1.8(b)(3).

Under the proposed amendment to § 1.8(b), in the event that correspondence is considered timely filed by being mailed or transmitted in accordance with § 1.8(a), but not received in the Office after a reasonable amount of time has elapsed (e.g., more than one month from the time the correspondence was mailed), the applicants would not be required to wait until the end of the maximum extendable period for reply set in a prior Office action (for the Office to hold the application to be abandoned) before informing the Office of the previous submitted correspondence and supplying a duplicate copy and requisite statement. Thus, filing a petition to withdraw the holding of abandonment would not be necessary in such circumstance. The proposed amendment to § 1.8(b) would provide applicants an expedited procedure in resolving substantial delayed mail problems.

Before notifying the Office of a previously submitted correspondence that is not received by the Office, applicants are encouraged to check the Patent Application Information Retrieval (PAIR) System (which can be accessed over the Office's Internet Web site at <http://pair.uspto.gov>) to see if the correspondence has been entered into the application file. The PAIR system is a system which enables applicants to access the Office's electronic records for a patent application or patent. Private PAIR is available to applicants who have a customer number associated with the correspondence address for an application and who have acquired the access software (Entrust Direct Software and a PKI certificate). Applicants may contact the Electronic Business Center (EBC) at (703) 305-3028 for more information on PAIR.

The proposal that § 1.8(b) be revised to more appropriately set forth the § 1.957(c) consequences of a failure to respond in an *inter partes* reexamination is necessary to clarify that the *inter partes* reexamination prosecution is neither terminated nor concluded where the patent owner fails to timely respond to an Office action, and claims in the proceeding remain patentable. Rather, an Office action is issued to thereby permit the third party requester to challenge the claims found patentable. As set forth in § 1.957(c), "[i]f claims are found patentable and the patent owner fails to file a timely and appropriate response to any Office action in an *inter partes* reexamination proceeding, further prosecution will be limited to the claims found patentable at