

the time of the failure to respond, and to any claims added thereafter which do not expand the scope of the claims which were found patentable at that time" (emphasis added). The proposed revision accordingly would apply the § 1.8(b) remedy to an *inter partes* reexamination prosecution which has been limited as to further prosecution under § 1.957(c). In addition, the amendment is intended to apply to the § 1.957(a) situation where the third party requester files an untimely comment, notice of appeal or brief in an *inter partes* reexamination, and the paper would thus be refused consideration (to thereby limit the requester's prosecution) if not for the operation of the § 1.8(b) remedy.

Section 1.10: Section 1.10 is proposed to be amended to add paragraphs (g), (h), and (i) to address the effects of interruptions or emergencies in USPS "Express Mail" service. For example, Friday, November 16, 2001, the USPS issued a memorandum temporarily and immediately suspending "Express Mail" service to Washington DC zip codes 202xx through 205xx. The suspension included service to the zip code for certain correspondence mailed to the Office (20231).

Applicants frequently rely on the benefits under § 1.10 to obtain a particular filing date for a new application. The filing date accorded to an application is often critical. For example, applicants who do not file their applications in the United States within one year from when their invention was first described in a printed publication or in public use or on sale in this country are not entitled to a patent. (See 35 U.S.C. 102(b)). Furthermore, to be able to claim the benefit of a provisional application or to claim priority to a foreign application, the nonprovisional application claiming benefit or priority must be filed within one year from the filing of the provisional application or foreign application, respectively. Therefore, the means by which applicants may remedy the effects of an interruption or emergency in USPS Express Mail service which has been so designated by the Director should be specifically addressed in the rules of practice.

The Office published a notice on October 9, 2001, that provides guidance in the situations in which a post office refuses to accept the deposit of mail for delivery by "Express Mail" Service and situations in which "Express Mail" is deposited into an "Express Mail" drop box and given an incorrect "date-in." See *United States Postal Service Interruption and Emergency*, 1251 *Off. Gaz. Pat. Office* 55 (Oct. 9, 2001). The

procedure for where the USPS refuses to accept the deposit of mail for delivery by "Express Mail" as contained in the notice, however, has not been incorporated into the rules of practice.

The Office's existing framework to address postal emergencies is detailed in § 1.6(e), "Interruptions in U.S. Postal Service." Section 1.6(e) provides that if interruptions or emergencies in the USPS which have been so designated by the Director occur, the Office will consider as filed on a particular date in the Office any correspondence which is: (1) Promptly filed after the ending of the interruption or emergency; and (2) accompanied by a statement indicating that the correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the USPS.

The provisions of § 1.6(e) are more appropriate in § 1.10 since "Express Mail" is 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 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 1.10(g) is proposed to be added to provide that any person who attempts to file correspondence by "Express Mail" that was returned by the USPS may petition the Director to consider the correspondence as filed on a particular date in the Office. The petition must be filed promptly after the person becomes aware of the return of the correspondence and the number of the "Express Mail" mailing label must have been placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail." The petition must also include the original correspondence or a copy of the original correspondence showing the number of the "Express Mail" mailing label thereon and a copy of the "Express Mail" mailing label showing the "date-in." Furthermore, the petition must include a statement, which establishes to the satisfaction of the Director, the original deposit of the correspondence and that the correspondence or the copy is the original correspondence or a true copy of the correspondence originally deposited with the USPS on the requested filing date.

Section 1.10(h) is proposed to be added to provide that any person who attempts to file correspondence by

"Express Mail" that was not accepted by the USPS may petition the Director to consider the correspondence as filed on a particular date in the Office. The petition must be filed promptly after the person becomes aware of the refusal of the correspondence and the number of the "Express Mail" mailing label must have been placed on the paper(s) or fee(s) that constitute the correspondence prior to the attempted mailing by "Express Mail." The petition must also include the original correspondence or a copy of the original correspondence showing the number of the "Express Mail" mailing label thereon. In addition, the petition must include a statement by the person who originally attempted to deposit the correspondence with the USPS which establishes, to the satisfaction of the Director, the original attempt to deposit the correspondence and that the correspondence or the copy is the original correspondence or a true copy of the correspondence originally attempted to be deposited with the USPS on the requested filing date.

Section 1.10(i) is proposed to be added to provide that any person attempting to file correspondence by "Express Mail" who was unable to deposit the correspondence with the USPS due to an interruption or emergency in "Express Mail" service which has been so designated by the Director, may petition the Director to consider such correspondence as filed on a particular date in the Office. This material is proposed to be transferred from § 1.6. The petition must be filed in a manner designated by the Director promptly after the person becomes aware of the designated interruption or emergency in "Express Mail" service. The petition must also include the original correspondence or a copy of the original correspondence, and a statement which establishes, to the satisfaction of the Director, that the correspondence would have been deposited with the USPS but for the designated interruption or emergency in "Express Mail" service, and that the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally attempted to be deposited with the USPS on the requested filing date.

Proposed § 1.10(i) requires the Director to designate an interruption or emergency in "Express Mail" service. It is envisioned that in the notice designating the interruption or emergency the Director would provide guidance on the manner in which petitions under proposed § 1.10(i) should be filed. This is similar to what occurred when "Express Mail" was