

suspended in November of 2001, when applicants were advised that if the USPS refused to accept correspondence for delivery to the Office by "Express Mail" they should mail the correspondence by registered or first class mail with a statement by the person who originally attempted to deposit the correspondence with the USPS by "Express Mail."

Section 1.14: Section 1.14(h)(1) is proposed to be amended to refer to the petition fee set forth in § 1.17(g) for consistency with the change to § 1.17. See discussion of § 1.17.

Section 1.17: Section 1.17 is proposed to be amended to adjust petition fees to more accurately reflect the Office's cost of treating petitions. The petitions whose fees are currently provided for in § 1.17(h) are outside the scope of the usual processing of patent applications provided for in 35 U.S.C. 41(a) and (b). The Office is directed by 35 U.S.C. 41(d) to set fees for services not set under 35 U.S.C. 41(a) or (b) so as to recover the average costs of performing the processing or service.

The Office has conducted an activity-based-accounting cost (ABC) analysis of the Office's cost of treating the various petitions enumerated under § 1.17(h) based on current practices and staffing costs. The Office has determined that the petition fee set forth in § 1.17(h) does not recover the Office's costs of treating petitions for a number of the types of petitions enumerated under § 1.17(h). The Office has also determined that there is a significant difference in the Office's costs for treating the various types of petitions enumerated under § 1.17(h). Therefore, the Office is proposing to separate the petitions enumerated under § 1.17(h) into three groups, and to charge separate petition fees for each of these three groups of petitions, which petition fees will more accurately reflect the cost of treating petitions in these three groups.

The first group of petitions will be covered by a new § 1.17(f), which will specify a petition fee of \$400. The petitions in this group are: (1) Petitions under § 1.53(e) to accord a filing date; (2) petitions under § 1.57(a) to accord a filing date; (3) petitions under § 1.182 for decision on a question not specifically provided for; (4) petitions under § 1.183 to suspend the rules; (5) petitions under § 1.378(e) for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent; (6) petitions under § 1.644(e) in an interference; (7) petitions under § 1.644(f) for requesting reconsideration of a decision on petition in an interference; (8) petitions under

§ 1.666(b) for access to an interference settlement agreement; (9) petitions under § 1.666(c) for late filing of an interference settlement agreement; and (10) petitions under § 1.741(b) to accord a filing date to an application under § 1.740 for extension of a patent term. Petitions in this first group require analysis of complex and unique factual situations and evidentiary showings. Often a petition in this group will involve an issue of first impression requiring review and approval of a course of action by senior Office officials.

The second group of petitions will be covered by a new § 1.17(g), which will specify a petition fee of \$200. The petitions in this group are: (1) Petitions under § 1.12 for access to an assignment record; (2) petitions under § 1.14 for access to an application; (3) petitions under § 1.47 for filing by other than all the inventors or a person not the inventor; (4) petitions under § 1.59 for expungement of information; (5) petitions under § 1.103(a) to suspend action in an application; (6) petitions under § 1.136(b) to review requests for extension of time when the provisions of section 1.136(a) are not available; (7) petitions under § 1.138(c) to expressly abandon an application to avoid publication; (8) petitions under § 1.295 for review of refusal to publish a statutory invention registration; (9) petitions under § 1.296 to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued; (10) petitions under § 1.377 for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent; (11) petitions under § 1.550(c) for patent owner requests for extension of time in *ex parte* reexamination proceedings; (12) petitions under § 1.956 for patent owner requests for extension of time in *inter partes* reexamination proceedings; (13) petitions under § 5.12 for expedited handling of a foreign filing license; (14) petitions under § 5.15 for changing the scope of a license; and (15) petitions under § 5.25 for a retroactive license. Petitions in this second group also require analysis of factual situations and evidentiary showings; however, the factual situations and evidentiary showings for this second group of petitions often fall into recognizable patterns. On occasion, however, a petition in this second group will involve an issue of first impression requiring review and approval of a course of action by senior Office officials.

The third group of petitions will be covered by § 1.17(h), which will

continue to specify a petition fee of \$130. The petitions in this group are: (1) Petitions under § 1.19(h) to request documents in a form other than that provided in this part; (2) petitions under § 1.84 for accepting color drawings or photographs; (3) petitions under § 1.91 for entry of a model or exhibit; (4) petitions under § 1.102(d) to make an application special; (5) § 1.313 to withdraw an application from issue; and (6) petitions under § 1.314 to defer issuance of a patent. Petitions in this third group require review for compliance with the applicable procedural requirements, but do not often require analysis of varied factual situations or evidentiary showings.

Section 1.17(i) is proposed to be amended to provide a processing fee so that replacement drawings submitted within the period set forth in § 1.215(a) can be included in any patent application publication. This will replace the current requirement for a petition fee under § 1.17(h) for the petition under § 1.182 which is required for such replacement drawings to be accepted for inclusion in any patent application publication. See *Drawings in Patent Application Publications and Patents*, 1242 Off. Gaz. Pat. Office 114 (Jan. 16, 2001). See also a conforming amendment to § 1.215(a).

Sections 1.17(l) and (m) are proposed to be revised to make it clear that the reexamination proceeding is not terminated under §§ 1.550(d) or 1.957(b), but rather the prosecution of the reexamination is concluded under §§ 1.550(d) or 1.957(b). See the discussion below as to the amendment of § 1.550 for the rationale for this change.

Section 1.19: Section 1.19 is proposed to be amended to clarify that copies of documents may be provided in whole, or in part, in electronic image form at the Office's option. Additionally, § 1.19(b) is proposed to be amended to provide how copies of Image File Wrapper (IFW) contents are to be charged. Further, it is proposed to eliminate the seven-day requirement of § 1.19(b)(1) for processing copy requests, and to eliminate the phrase "that were submitted in electronic form on a physical media" from § 1.19(b)(3). Paragraphs (g) and (h) would be added to provide for supplying copies of unscanned documents and to provide for a petition to obtain copies of documents in a form other than provided for in the rules of practice.

In view of the ever-increasing (paper) submissions, many of the Office official records need to be, and are going to be, stored and maintained in electronic form. As a result of the Office's