

64 FR 53771, 53777 (Oct. 4, 1999), 1228 *Off. Gaz. Pat. Office* 15, 20 (Nov. 2, 1999) (proposed rule) (declining to adopt a review service for applicant-created forms). In addition, paragraph (b) of § 1.69 is proposed to be amended to require that the statement that the translation is accurate be signed by the individual who made the translation. The Office has received a number of inquiries as to who may sign the statement required by the current rule and how the statement must be signed. The Office has decided to clarify that the signature required is that of the translator. See also the proposed amendments to §§ 1.52(b)(1)(ii), 1.52(d)(1), 1.55(a)(4) and 1.78(a)(5)(iv). The requirement that the person who made the translation sign the statement that the translation is accurate is consistent with current § 3.26.

Section 1.76: Section 1.76(a) is proposed to be amended to require that any application data sheet (ADS) contain the seven headings listed in § 1.76(b) and all of the appropriate data for each section heading. The proposed amendment would also require that the ADS be titled "Application Data Sheet." Any label (*e.g.*, the label "Given Name" in the "Applicant Information" heading) that does not contain any corresponding data will be interpreted by the Office to mean that there is no corresponding data for that label anywhere in the application. By requiring an ADS to contain all seven section headings, and any appropriate data for the sections, the accuracy of bibliographic data in patent applications will be enhanced and the need for corrected filing receipts related to Office errors will be reduced.

Section 1.76(c)(2) is proposed to be amended to require a supplemental application data sheet to be labeled "Supplemental Application Data Sheet" and to also contain all of the headings listed in § 1.76(b) with any appropriate data for each heading, rather than only identifying the information that is being changed (added, deleted, or modified) in the supplemental ADS. Requiring a supplemental ADS to contain all of the information from the ADS with the changes indicated is consistent with the ADS guide posted on the Office's Internet Web site at: <http://www.uspto.gov/web/offices/pac/dapp/sir/doc/patappde.html>. A supplemental ADS containing only new or changed information is likely to confuse the record, create unnecessary work for the Office, and would not comply with § 1.76 if amended as proposed. When submitting an ADS after the initial filing of the application to correct, modify, or augment the original application data included in an ADS, the following

applies: (1) The supplemental application data sheet must be labeled "Supplemental Application Data Sheet"; (2) the "Supplemental Application Data Sheet" is a full replacement copy of the original application data sheet, with each of the seven section headings, and with any appropriate data for the section headings; and (3) the "Supplemental Application Data Sheet" must be submitted with any changes or additions underlined (for deletions without replacement data, use strike-through or brackets).

When submitting an ADS to correct, modify, or augment application data (*see* § 1.76(d)), when an ADS has not been previously filed, the first-filed ADS is not considered a supplemental ADS even if such is filed subsequent to the initial filing of the oath or declaration. When submitting such an ADS: (1) The application data sheet must be labeled "Application Data Sheet"; and (2) a complete application data sheet including all appropriate information for each heading must be submitted.

Section 1.78: Section 1.78(a)(1) is proposed to be amended to delete an unnecessary alternate condition to permit a claim for the benefit of a prior-filed application. Sections 1.78(a)(2) and (a)(5) are proposed to be amended to permit the required reference to the prior application(s) to be in multiple sentences at the beginning of the specification, rather than being limited to the first sentence of the specification.

Section 1.78(a)(1) sets forth the conditions under which a nonprovisional application may claim the benefit of one or more prior-filed copending U.S. nonprovisional applications or international applications designating the United States of America. Where the prior-filed application is a nonprovisional application (filed under 35 U.S.C. 111(a)), one of the conditions under § 1.78(a)(1) is met when the prior-filed application satisfied any one of paragraphs (ii), (iii) or (iv) of § 1.78(a)(1). To satisfy paragraph (ii), the prior-filed application must be "[c]omplete as set forth in § 1.51(b)." To satisfy paragraph (iii), the prior-filed application must be "[e]ntitled to a filing date as set forth in § 1.53(b) or § 1.53(d) and include the basic filing fee set forth in § 1.16." Considering that paragraph (iii) is less restrictive than paragraph (ii), it is proposed to delete paragraph (ii) (and redesignate paragraphs (iii) and (iv) as paragraphs (ii) and (iii), respectively) as it is unnecessary because any prior-filed application that would satisfy paragraph (ii) would also satisfy paragraph (iii).

Sections 1.78(a)(2)(iii) and (a)(5)(iii) are proposed to be amended to change the word "sentence" to "sentence(s)". The proposed change would permit the required reference to the prior application(s) to be in more than one sentence at the beginning of the specification. In some situations, it would be easier and clearer to set forth the relationship between prior applications if more than one sentence were permitted. For example, where there is a provisional application and multiple intermediate nonprovisional applications, the required identification in the latest nonprovisional application as to which intermediate nonprovisional application(s) claims benefit to the provisional application (*i.e.*, is within one year of the provisional application's filing date), could be set forth in a clearer manner using multiple sentences.

Section 1.78(a)(5)(iv) is proposed to be amended to require that the statement that the translation is accurate be signed by the individual who made the translation. The Office has received a number of inquiries as to who may sign the statement, and has decided that it is appropriate to include the requirement that the signature required is that of the translator into the rules of practice. See also the proposed amendments to §§ 1.52(b)(1)(ii) and (d)(1), 1.55(a)(4) and 1.69(b). The requirement that the person who made the translation sign the statement that the translation is accurate is consistent with current § 3.26.

Section 1.78(c) is proposed to be amended to clarify that the prior art exception under 35 U.S.C. 103(c) does not apply to double patenting rejections by the addition of the last sentence, which states "Even if the claimed inventions were commonly owned, or subject to an obligation of assignment to the same person, at the time the later invention was made, the conflicting claims may be rejected under the doctrine of double patenting in view of such commonly owned or assigned applications or patents under reexamination." Therefore, § 1.78(c) emphasizes that double patenting rejections should still be made, when appropriate, even if a reference is disqualified from being used in a rejection under 35 U.S.C. 103(a) via the prior art exclusion under 35 U.S.C. 103(c). This clarification codifies patent policy regarding double patenting rejections and the prior art exclusion under 35 U.S.C. 103(c) as set forth in the notice *Guidelines Concerning the Implementation of Changes to 35 U.S.C. 102(g) and 103(c) and the Interpretation of the Term "Original Application" in*