

¶ 2, was not entitled to a filing date under 35 U.S.C. 111(a) until the date an amendment including at least one claim was filed in the application. Following *Baxter*, the Office changed its practice and no longer accorded a filing date to any application that was accompanied by a preliminary amendment which canceled all claims and failed to simultaneously submit any new claims. See *Any Application Filed With Instructions to Cancel All of the Claims in the Application is Not Entitled to a Filing Date*, 1216 Off. Gaz. Pat. Office 46 (Nov. 10, 1998).

Subsequently, in *Exxon Corp. v. Phillips Petroleum Co.*, 265 F.3d 1249, 60 USPQ2d 1368 (Fed. Cir. 2001), the Federal Circuit affirmed that the Office may refuse to enter an improper amendment that would cancel all of the claims in an application to avert harm (loss of a filing date) to an applicant. The Federal Circuit distinguished its decision in *Baxter* since in *Baxter* the Office did enter the amendment that canceled all of the claims in the application, thus resulting in the application not being entitled to a filing date. In contrast, in *Exxon* the Office refused to enter the amendment cancelling all the claims. The Office did, however, cancel all the dependent claims and preserve one claim for filing purposes only. Thus, all the claims were never canceled.

Consistent with *Exxon Corp. v. Phillips Petroleum Co.* and MPEP §§ 711.01 and 714.19, paragraph (H), (8th ed. 2001), the Office would disapprove entry of any amendment (whether submitted prior to, on or after the filing date of the application) that seeks cancellation of all claims but does not present any new or substitute claims. For filing purposes, that is, fee calculation purposes, the Office would treat such an application as containing a single claim, which would be the first independent claim, claim 1, wherein such claim would be the only claim that would be considered part of the original disclosure. See *Example A* above for an illustration of a preliminary amendment filed prior to the filing date of an application.

The proposed amendment to § 1.115(c)(1) would be a codification of the Office's current practice as set forth in MPEP §§ 711.01 and 714.19, paragraph (H). In addition, the provision in MPEP § 601.01(e) concerning the treatment of a nonprovisional application accompanied by a preliminary amendment which cancels all claims and fails to simultaneously submit any new claim(s) would be revised to be in conformance with current practice. See *Treatment of*

*Amendments that if Entered Would Cancel All of the Claims in an Application*, 1255 Off. Gaz. Pat. Office 827 (Feb. 5, 2002).

This change to § 1.115 (if adopted) would apply to any applications filed before the effective date of the rule change, as it is a codification of current Office practice.

*Section 1.116:* Section 1.116(b) is 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. See also §§ 1.502, 1.570, 1.902, 1.953, 1.957, 1.958, 1.979, and 1.997.

It is further proposed that § 1.116(b) be revised to more appropriately set forth the § 1.957(c) consequences of a failure to respond in an *inter partes* reexamination. 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.

*Section 1.131:* Section 1.131(b) is proposed to be amended for correction of a typographical error that was inadvertently introduced in the final rule *Miscellaneous Amendments of Patent Rules*, 53 FR 23728 (June 23, 1988) (final rule). The typographical error to be corrected is contained in the text at the end of the second (and last) sentence of § 1.131(b), which pertains to exhibits or records needed to substantiate an oath or declaration of prior invention swearing behind a reference applied in a rejection of a claim. Specifically, the text "of their absence satisfactorily explained" should read "or their absence satisfactorily explained" (emphasis added). Thus, § 1.131(b) would be amended to clarify that for any oath or declaration under § 1.131 lacking original exhibits of drawings or records in support thereof, the absence of such original exhibits of drawings or records must be satisfactorily explained.

*Section 1.136:* Section 1.136(b) is proposed to be amended to add a petition fee requirement. Paragraph 1.136(a)(2), for example, specifically refers to § 1.136(b) for extensions of time to file replies under §§ 1.193(b), 1.194, 1.196 or 1.197 after a notice of appeal is filed. For such replies on appeal § 1.136(a) is not available for extending the time period for reply, and applicants may be able to make the § 1.136(b)

"sufficient cause" showing. To evaluate whether a showing of "sufficient cause" exists, decisions on § 1.136(b) requests require a thorough evaluation of facts and circumstances on a case-by-case basis. Furthermore, requests under § 1.136(b) are generally treated expeditiously by the deciding official. At MPEP § 710.02(e), it is recommended that requests under § 1.136(b) be filed in duplicate with a stamped return-address envelope to assist the Office in processing these requests with special dispatch. To reflect the Office's cost of deciding requests under § 1.136(b), it is proposed that a requirement for a petition fee be added to § 1.136(b). Evaluation of a request for an extension of time under § 1.136(b) for sufficient cause is analogous to evaluation of a request for the Office to suspend action for sufficient cause pursuant to § 1.103(a). See discussion of § 1.17.

*Section 1.137:* Sections 1.137(a), (b) and (e) are proposed to be amended to clarify that the reexamination proceedings under § 1.957(c) referred to in §§ 1.137(b) and (c) are "limited as to further prosecution." Section 1.137(d) is also proposed to be amended to clarify that when reviving a reissue application pursuant to § 1.137 a terminal disclaimer is not required.

Sections 1.137(a), (b) and (e) are proposed to be amended to more appropriately set forth the consequences of a failure to respond when governed by § 1.957(c). An *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. An Office action is issued instead 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 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." The proposed revision refers accordingly to "revival" of an *inter partes* reexamination prosecution which has been "limited" under § 1.957(c).

Section 1.137(d)(3) is proposed to be amended to clarify that the terminal disclaimer requirements of paragraph (d)(1) do not apply to reissue applications.

Pursuant to 35 U.S.C. 251, a patent is reissued "for the unexpired part of the term of the original patent." Hence, any