

application) be accompanied by a written statement of consent of the applicant to the filing of the protest. The written statement must indicate that applicant is consenting to the specific protest being submitted. A blanket consent upon publication of an application would not be sufficient to permit admission of the subsequently filed individual protests; applicant's consent must be specifically directed to the protest being filed. It should be noted, however, that applicant's consent need not be directed to a document that applicant has already looked at or reviewed, but rather may be directed to the "protest that party Smith has informed me that he will be submitting during the week of November 26th."

Where the protest can be "matched" with an application, it will be "entered" into the file (*i.e.*, it has an entry right), if the protest: (1) Is timely filed; (2) indicates that it has been served on the applicant, and (3) properly identifies the real party in interest, or contains the statement pursuant to paragraph (b)(3) of the section. If the protest is not entered, it will be so marked, and it may be returned to the protestor.

Section 1.291(c): Where the protest is "entered" into the application, the items of information submitted with the protest, and the argument directed to the items of information, will be "considered" by the examiner, if the protest includes: (1) A listing of patents, publications, or other information relied upon; (2) a concise explanation of the relevance of each listed patent, publication and other item of information; (3) a copy of each listed patent, publication, or other item of information in written form, or at least pertinent portions thereof; (4) an English language translation of all the necessary and pertinent parts of any non-English language patent, publication, or other item of information relied upon; and (5) if a second or subsequent protest in the case, an explanation why the additional art or other item(s) of information presented are significantly different, and why they were not earlier presented. Any item of information for which § 1.291(c)(1) through (c)(5) is not complied with would not be entitled to "consideration."

Section 1.291(e): This paragraph is proposed to be added to reiterate and confirm the Office's long-standing practice to enter protests raising inequitable conduct issues without comment on such issues. *See* MPEP § 1901.02.

Section 1.295: Section 1.295(a) 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 1.296: Section 1.296 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 1.311: Section 1.311(b) is proposed to be amended to provide that the submission after the mailing of a notice of allowance of either: (1) An incorrect issue fee or publication fee; or (2) a fee transmittal form (or letter) for payment of issue fee or publication fee, will operate as a valid request to charge the correct issue fee, or any publication fee due, to any deposit account identified in a previously filed authorization to charge such fees. Additionally, non-Office provided issue and publication fee forms would now be permitted. It is proposed to be clarified that for previous authorizations to be effective under the exceptions provided for, the previous authorizations must cover the issue and publication fees to be charged.

Current § 1.311(b) sets forth that an authorization to charge the issue fee or other post-allowance fees (such as any publication fee due) to a deposit account may be filed only after the mailing of a notice of allowance in part to encourage the use (return) of the PTOL-85B form as that form contains important information, such as the name of the assignee. The last sentence of § 1.311(b), however, provides an exception for charging the issue fee to a deposit account identified in a previously filed authorization if the applicant submits either an incorrect issue fee or an Office-provided fee transmittal form (*i.e.*, Part B—Fee(s) Transmittal of a Notice of Allowance and Fee(s) Due, form PTOL-85). The proposed amendment to § 1.311(b) would extend the exception to any publication fee due and expand the exception to apply where an applicant's own fee transmittal form or letter for submitting issue fee or publication fee is submitted. Further, the term "such" is proposed to be added before "fees" in the last line of section 1.311(b) to clarify that the previously filed authorization must be an authorization to charge the appropriate fee due to an identified deposit account. For example, if the previously filed fee authorization only authorizes the Office to charge the issue fee, the Office would *not* be able to charge any publication fee due to the identified deposit account in the previously filed authorization even when the applicant submitted an issue fee transmittal form. For such authorization, the Office could only

charge the correct issue fee to the identified deposit account.

The phrase "A completed Office-provided issue fee transmittal form (where no issue fee has been submitted)" in the last sentence of § 1.311(b) is proposed to be changed to "A fee transmittal form (or letter) for payment of issue fee or publication fee" to provide that a submission of an Office-provided fee transmittal form (*i.e.*, Part B of the form PTOL-85), or applicant's own fee transmittal form or letter for submitting issue fee or publication fee, (incomplete as well as a complete, but for a fee authorization) would operate as a request to charge the correct issue fee due, or any publication fee due, to any deposit account identified in a previously filed authorization to charge such fees, even if the issue fee has been previously submitted.

Where an issue fee has been previously submitted, and the application is withdrawn from issue and is allowed again, since November 13, 2001, the Notice of Allowance has indicated the current amount due as the difference between the previously paid issue fee and the current amount for an issue fee. In such situation, a payment of only the difference, or a response to the notice where there is no issue fee due (or only the return of the Part B—Fee(s) Transmittal of form PTOL-85 as the current issue fee is the same amount as previously paid), will be treated as a ratification of the Office's decision to apply the previously paid issue fee. If the fee was paid in a different application (*e.g.*, the parent application of a continued prosecution application under § 1.53(d) (CPA)), the fee indicated in the notice as due is the current issue fee. The issue fee paid in the parent application cannot be refunded, or applied, to the notice of allowance mailed in the CPA.

Section 1.324: Section 1.324(a) and (b) would be amended to provide an informational reference to 35 U.S.C. 256 and to replace "petition" with "request." Section 1.324(b) would be amended to alert patentees to the availability of reissue to correct inventorship in a patent where § 1.324 is not available.

Section 1.324(a) is proposed to be amended by adding an explicit reference to 35 U.S.C. 256 and its requirement in order to clarify that the inventorship of a patent may be changed only by way of request from *all* of the inventors together with assignees of the entire interest, or on order of a court, and the Office will then issue a certificate naming the correct inventors. 35 U.S.C. 256 requires that there be