

patent owner's failure to file a timely response will result in the concluding of prosecution of the *inter partes* reexamination proceeding, but will not conclude or terminate the reexamination proceeding. See the discussion as to the amendment of § 1.550 for the rationale for this change. See also §§ 1.116, 1.502, 1.570, 1.902, 1.953, 1.958, 1.979, and 1.997.

Section 1.958: The heading of § 1.958 is proposed to be amended to state the concluding of prosecution of the reexamination proceeding, rather than conclusion or termination of the reexamination proceeding, since that is what the materials which follow deal with. See the discussion above as to the amendment of § 1.550 for the rationale for this change. Note that both § 1.957(b) and (c) result in the concluding of reexamination prosecution. Under § 1.957(b), prosecution is concluded *in toto*; under § 1.957(c), prosecution is concluded as to the non-patentable claims. See also §§ 1.116, 1.502, 1.570, 1.902, 1.953, 1.957, 1.979, and 1.997.

Section 1.979: Section 1.979(f) is proposed to be amended to state that patent owner's failure to file a timely response will result in a concluding of prosecution of the reexamination proceeding, but will not conclude or terminate the reexamination proceeding, and that it is the reexamination certificate under § 1.997 that terminates the reexamination proceeding. See the discussion as to the amendment of § 1.550 for the rationale for this change. See also §§ 1.116, 1.502, 1.570, 1.902, 1.953, 1.957, 1.958, and 1.997.

Section 1.997: The heading of § 1.997 is proposed to be amended to refer to the issuance and publication of *inter partes* reexamination certificates. The heading of § 1.997 and § 1.997(a) are proposed to be amended to make it clear that the issuance and publication of the *inter partes* reexamination certificate terminates the reexamination proceeding. The failure to timely respond, or the issuance of the NIRC does not terminate the reexamination proceeding. See the discussion as to the amendment of § 1.550. See also §§ 1.116, 1.502, 1.570, 1.902, 1.953, 1.957, 1.958, and 1.979. Section 1.997(a) is also proposed to be revised to make its language consistent with that of § 1.570(a).

Section 1.997, paragraphs (b) and (d), are proposed to be amended to recite that the reexamination certificate is both issued and published for consistency with the language of 35 U.S.C. 316.

Section 5.12: Section 5.12(b) 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 5.15: Section 5.15(c) 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 5.25: Section 5.25 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.

Rule Making Considerations

Regulatory Flexibility Act

The Deputy General Counsel for General Law, United States Patent and Trademark Office certified to the Chief Counsel for Advocacy, Small Business Administration, that the changes proposed in this notice (if adopted) would not have a significant impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)). The primary impact of the changes proposed in this notice are to: (1) Permit electronic signatures on a number of patent-related submissions; (2) streamline the requirements for incorporation by reference of prior-filed applications; and (3) clarify the qualifications for claiming small entity status for purposes of paying reduced patent fees. These changes to the rules of practice (if adopted) will simplify the patent application, and as such, will benefit all patent applicants (including small entities).

The Office is also proposing to adjust certain petition fees that are set under the Office's authority under 35 U.S.C. 41(d) to adjust these petition fees to be in alignment with the actual average costs of deciding such petitions. There are approximately 7,500 petitions filed each year of the type that would be affected by the proposed patent fee changes. Since the Office received over 400,000 applications (provisional and nonprovisional) in fiscal year 2002, this proposed change would impact relatively few (less than 2% of) patent applicants. In addition, the petition fee amounts proposed by the Office for petitions whose fees are set under the authority in 35 U.S.C. 41(d) are comparable or lower than the petition fee amounts for petitions whose fees are set by statute in 35 U.S.C. 41(a) (\$110.00 to \$1,970.00 for extension of time petitions (35 U.S.C. 41(a)(8)), or \$1,300.00 to revive an unintentionally abandoned application (35 U.S.C. 41(a)(7)).

Executive Order 13132

This rule making does not contain policies with federalism implications

sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

Executive Order 12866

This rule making has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

Paperwork Reduction Act

This rule making involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*). The collections of information involved in this final rule have been reviewed and previously approved by OMB under the following control numbers: 0651-0016, 0651-0020, 0651-0031, 0651-0032, 0651-0033, 0651-0034 and 0651-0036.

The title, description and respondent description of each of the information collections is shown below with an estimate of the annual reporting burdens. Included in the estimate is the time for reviewing instructions, gathering and maintaining the data needed, and completing and reviewing the collection of information. The principal impacts of the changes in this proposed rule are to (1) expressly provide for the electronic submission of an information disclosure statement; (2) provide for a slight change in the format of an application being filed in order to accommodate for the scanning and indexing of different sections of the application file; and (3) provide for a change in the manner of making amendments to an application consistent with the Office's efforts to establish a patent electronic image management system.

OMB Number: 0651-0016.

Title: Rules for Patent Maintenance Fees.

Form Numbers: PTO/SB/45/47/65/66.

Type of Review: Approved through May of 2006.

Affected Public: Individuals or Households, Business or Other For-Profit Institutions, Not-For-Profit Institutions and Federal Government.

Estimated Number of Respondents: 348,110.

Estimated Time Per Response: Between 20 seconds and 8 hours.

Estimated Total Annual Burden Hours: 30,495 hours.

Needs and Uses: Maintenance fees are required to maintain a patent, except for design or plant patents, in force under 35 U.S.C. 41(b). Payment of maintenance fees are required at 3½, 7½ and 11½ years after the grant of the patent. A patent number and application number of the patent on