

(viii) *Technical information known to applicant.* Technical information known to applicant concerning the interpretation of the related art, the disclosure, the claimed subject matter, other information pertinent to patentability, or the accuracy of the examiner's stated interpretation of such items.

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(3) Requirements for information may be presented in any appropriate form, for example:

(i) A requirement for documents;  
(ii) Interrogatories in the form of specific questions seeking applicant's knowledge; or

(iii) Stipulations in the form of statements with which the applicant may agree or disagree.

(4) Any reply to a requirement for information, apart from requirements for answers based on applicant's opinion, that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply. Any reply to a requirement for answers based on applicant's opinion that states that an opinion is not held by the party or parties from which it was requested will be accepted as a complete reply.

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28. Section 1.111 is amended by revising paragraph (a)(2) to read as follows:

**§ 1.111 Reply by applicant or patent owner to a non-final Office action.**

(a) \* \* \*

(2) *Supplemental replies.* (i) A supplemental reply will not be entered as matter of right except as provided in paragraph (a)(2)(ii) of this section. The Office may enter a supplemental reply that is filed before the expiration of the statutory period (*i.e.*, within six months from the mailing date of the non-final Office action) if the supplemental reply is clearly limited to:

(A) Cancellation of a claim(s);

(B) Adoption of an examiner suggestion(s); or

(C) Placement of the application in condition for allowance.

(ii) A supplemental reply will be entered if the supplemental reply is filed within the period during which action by the Office is suspended under § 1.103(a) through (c).

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29. Section 1.115 is revised to read as follows:

**§ 1.115 Preliminary amendments.**

(a) A preliminary amendment is an amendment that is received in the Office (*see* § 1.6) on or before the mail

date of the first Office action under § 1.104.

(b) A preliminary amendment submitted on or prior to the filing date of an application is part of the original disclosure of the application. If a preliminary amendment is determined to contain matter not otherwise included in the contents of the originally filed specification, including claims, and drawings, and the preliminary amendment is not specifically referred to in the oath or declaration under § 1.63, a new oath or declaration in compliance with § 1.63 will be required.

(c)(1) A preliminary amendment will be entered unless disapproved by the Director.

(i) A preliminary amendment seeking cancellation of all the claims without presenting any new or substitute claims will be disapproved. However, for filing and fee calculation purposes, such an amendment will cause the application to be treated as containing a single claim, which would be the first independent claim.

(ii) A preliminary amendment may be disapproved if the preliminary amendment unduly interferes with the preparation of a first Office action in an application. Factors that will be considered in disapproving a preliminary amendment include:

(A) The state of preparation of a first Office action as of the date of receipt (*see* § 1.6) of the preliminary amendment by the Office; and

(B) The nature of any changes to the specification or claims that would result from entry of the preliminary amendment.

(2) A preliminary amendment will not be disapproved under (c)(1)(ii) of this section if it is filed no later than:

(i) Three months from the filing date of an application under § 1.53(b);

(ii) The filing date of a continued prosecution application under § 1.53(d); or

(iii) Three months from the date the national stage is entered as set forth in § 1.491 in an international application.

(d) The time periods specified in paragraph (c)(2) of this section are not extendable.

30. Section 1.116 is amended by revising paragraph (b) to read as follows:

**§ 1.116 Amendments after final action or appeal.**

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(b) After a final rejection or other final action (*see* § 1.113) in an application or in an *ex parte* reexamination filed under § 1.510, or an action closing prosecution (*see* § 1.949) in an *inter partes* reexamination filed under § 1.913,

amendments may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or reexamination proceeding from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination prosecution from concluding under § 1.550(d) or § 1.957(b) or limitation of further prosecution under § 1.957(c). No amendment can be made in an *inter partes* reexamination proceeding after the right of appeal notice under § 1.953 except as provided for in paragraph (d) of this section.

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31. Section 1.131 is amended by revising paragraph (b) to read as follows:

**§ 1.131 Affidavit or declaration of prior invention.**

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(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

32. Section 1.136 is amended by revising paragraph (b) to read as follows:

**§ 1.136 Extensions of time.**

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(b) When a reply cannot be filed within the time period set for such reply and the provisions of paragraph (a) of this section are not available, the period for reply will be extended only for sufficient cause and for a reasonable time specified. Any request for an extension of time under this paragraph must be filed on or before the day on which such reply is due, but the mere filing of such a request will not affect any extension under this paragraph. In no situation can any extension carry the date on which reply is due beyond the maximum time period set by statute. *See* § 1.304 for extensions of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a