

Trademark Office authorized by the Director.” Section 13203(c) of Public Law 107–273 eliminated the requirement in 35 U.S.C. 153 that the signature of the Director for issued patents be attested to by an officer of the Office. To achieve further efficiencies, certified copies of documents will no longer include an attestation for the Director’s signature. Accordingly, § 1.13(b) is amended to eliminate the requirement for an attestation for certified copies of documents.

Section 1.14: Section 1.14(g)(2) is amended to correct the reference to “35 U.S.C. 154(d)(4)”.

Section 1.78: Section 1.78(a)(3) is amended by deleting the phrase “in a nonprovisional application.” Section 4508 of the AIPA as originally enacted did not make the eighteen-month publication amendments to 35 U.S.C. 119 and 120 applicable to an international application unless and until it enters the national stage under 35 U.S.C. 371. *See* Public Law 106–113, 113 Stat. at 1501A–566 through 1501A–567. Section 13205 of Public Law 107–273 amended section 4508 of the AIPA to make the eighteen-month publication amendments to 35 U.S.C. 119 and 120 also applicable during the international stage of an international application. With regard to international applications, § 1.78(a)(2)(ii) requires that the reference required by § 1.78(a)(2)(i) be submitted: (1) during the pendency of the later-filed application; and (2) within the later of (A) four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application, or (B) sixteen months from the filing date of the prior-filed application. Since an abandoned international application is not a nonprovisional application, the petition procedure set forth in former § 1.78(a)(3) was not applicable to a delayed priority claim in an abandoned international application. Section 1.78(a)(3) as amended now makes the petition procedure set forth in § 1.78(a)(3) applicable to submitting a delayed priority claim in an abandoned international application including an international application that has not entered the national stage under 35 U.S.C. 371. Therefore, when filing a “bypass” continuation application under 35 U.S.C. 111(a) that claims the benefit of the international application with a filing date on or after November 29, 2000, that could have but did not claim the benefit of an earlier U.S. nonprovisional application or international application designating the United States and the benefit claim is to be added, a petition under

§ 1.78(a)(3) will be required in the abandoned international application. A “bypass” continuation application is an application for patent filed under 35 U.S.C. 111(a) that claims the benefit of the filing date of an earlier international application designating the United States that did not enter the national stage under 35 U.S.C. 371. *See* H.R. Rep. No. 107–685, at 222 (2002). The Office previously indicated that to amend a later-filed abandoned international application to add a claim to the benefit of a prior-filed nonprovisional application, or a prior-filed international application designating the United States, an applicant need only file a petition under § 1.182 to amend an abandoned application (the later-filed international application) with the claim to the benefit of a prior-filed application. *See Requirements for Claiming the Benefit of Prior-Filed Applications Under Eighteen-Month Publication of Patent Applications*, 66 FR 67087, 67092 (Dec. 28, 2001), 1254 *Off. Gaz. Pat. Office* 121, 125 (Jan. 22, 2002) (final rule) (response to comment 6). In view of this change to § 1.78(a), applicants should no longer rely upon that advice.

Section 1.191: Section 1.191(a) is amended to delete each appearance of the phrase “for a patent that issued from an original application filed in the United States.” Section 13202(d) of Public Law 107–273 provides a technical correction for the effective date set forth in the AIPA for appeals to the BPAI as follows:

Effective Date—The amendments made by Section 4605(b), (c), and (e) of the Intellectual Property and Communications Omnibus Reform Act, as enacted by Section 1000(a)(9) of Public Law 106–113, shall apply to any reexamination filed in the United States Patent and Trademark Office on or after the date of enactment of Public Law 106–113.

The effective date language in section 4608 of the AIPA limited the applicability of the conforming amendments to 35 U.S.C. 134 to a reexamination of a patent that issued from an original application which was filed on or after November 29, 1999. Thus, the conforming amendments to 35 U.S.C. 134 applied only to those *ex parte* reexamination proceedings filed under § 1.510 for patents that issued from an original application which was filed on or after November 29, 1999. Public Law 107–273 revised the applicability of the conforming amendments to 35 U.S.C. 134 such that the conforming amendments are applicable to a reexamination of a patent where the request for *ex parte* reexamination was filed on or after November 29, 1999. Accordingly,

§ 1.191 is amended to track the statutory revision of the effective date.

Section 1.191(a) is also subdivided into paragraphs (a)(1) (for applications and *ex parte* reexamination proceedings filed before November 29, 1999), (a)(2) (for *ex parte* reexamination proceedings filed on or after November 29, 1999), and (a)(3) (for *inter partes* reexamination proceedings).

Section 1.197: Section 1.197(c) is amended to provide that an appeal to the Federal Circuit is terminated when the mandate is issued by the Court, rather than when the mandate is received by the Office. This change to § 1.197(c) is for consistency with a 1998 amendment to Rule 41 of the Federal Rules of Appellate Procedure. The commentary on the addition of subdivision (c) to Rule 41 of the Federal Rules of Appellate Procedure indicates that this provision is intended to make clear that the Court’s mandate is effective upon issuance, and that its effectiveness is not delayed until receipt of the mandate by the trial court or agency.

Section 1.301: Section 1.301 (last sentence) is amended by inserting the phrase “appeals by patent owners and third party requesters in” before “*inter partes* reexamination proceedings.” The revision makes it clear that appeals by third party requesters of *inter partes* reexamination proceedings are controlled by § 1.983.

Section 1.302: Section 1.302 is amended by adding new paragraphs (c) and (d), and redesignating existing paragraph (c) as paragraph (e). New paragraph (c) points out that when an appeal is taken to the Federal Circuit in an *ex parte* reexamination proceeding, the appellant must serve notice as provided in § 1.550(f). New paragraph (d) points out that when an appeal is taken to the Federal Circuit in an *inter partes* reexamination proceeding, the appellant must serve notice as provided in § 1.903. These revisions are intended to focus parties on the unique service requirements in *ex parte* and *inter partes* reexamination proceedings, when appealing to the Federal Circuit.

Section 1.303: Section 1.303 is amended by revising paragraphs (a), (b) and (d) to delete the appearance of “for a patent that issued from an original application filed in the United States” in each paragraph. This revision is made for the reasons stated in the discussion of § 1.191.

Section 1.304: Section 1.304 is amended by revising paragraph (a)(1) to add after the second sentence, the following sentence: “If a request for rehearing or reconsideration of the decision is filed within the time period