PATENT COOPERATION TREATY

PCT

NOTICE OF CONFIRMATION OF PRECAUTIONARY DESIGNATIONS

(to be filed with the receiving Office)

(PCT Rules 4.9(c) and 15.5)

Applicant's or agent's file reference	International filing date *(day/month/year)*
International application No.	(Earliest) Priority date *(day/month/year)*
Applicant	

1. The applicant hereby **confirms** the following designations made under Rule 4.9(b):

Name of State *(specify if a regional patent and/or another kind of protection or treatment is/are desired)*	**Name of Applicant(s) for that State**

2. **Prescribed fees** *(payment must accompany this notice):*

Number of designations confirmed	x Amount of designation fee	= Total designation fee

Confirmation fee = 50% of the above total + _____

Total fees payable = _____

for receiving Office use only

_____

_____

_____

Mode of payment

- ☐ authorization to charge deposit account (see below)
- ☐ bank draft
- ☐ coupons
- ☐ cheque
- ☐ cash
- ☐ other *(specify):*
- ☐ postal money order
- ☐ revenue stamps

3. **Signature of applicant or agent**

Deposit account authorization

The RO/ _____

☐ is hereby authorized to charge the total fees indicated above to my deposit account.

☐ is hereby authorized to charge any deficiency or credit any overpayment in the total fees indicated above to my deposit account.

Deposit Account Number	Date *(day/month/year)*	Signature

Customs Regulations (19 CFR part 133), as set forth below.

PART 133--TRADEMARKS, TRADE NAMES, AND COPYRIGHTS

1. The authority citation for part 133 would be revised, and would include the specific sectional authority thereunder, as follows:

Authority: 17 U.S.C. 101, 601, 602, 603; 19 U.S.C. 66, 1624; 31 U.S.C. 9701.

Section 133.1 also issued under 15 U.S.C. 1096, 1124.

Sections 133.2 through 133.7, 133.11 through 133.13, and 133.15 also issued under 15 U.S.C. 1124.

Section 133.21 also issued under 15 U.S.C. 1124, 19 U.S.C. 1526.

Sections 133.24 and 133.46 also issued under 19 U.S.C. 1623.

Section 133.53 also issued under 19 U.S.C. 1558(a).

2. It is proposed to amend § 133.43 by revising paragraphs (c)(1) and (c)(4), to read as follows:

§ 133.43 Procedure on suspicion of infringing copies.

* * * * *

(c) * * *

(1) *Demand and bond; exchange of briefs.* If the copyright owner files a written demand for exclusion of the suspected infringing copies together with a proper bond, the district director shall promptly notify the importer and copyright owner that, during a specified time limited to not more than 30 days, they may submit any further evidence, legal briefs or other pertinent material to substantiate the claim or denial of infringement. The burden of proof shall be upon the party claiming that the article is in fact an infringing copy.

(i) *Exchange of briefs.* Before timely submitting the additional evidence, legal briefs, or other pertinent material to Customs, pursuant to paragraph (c)(1) of this section, in regard to the disputed claim of infringement, the importer and the copyright owner shall first provide each other with a copy of all such information. The subsequent submission of this information to Customs shall be accompanied by a written statement confirming that a copy has already been provided to the opposing party. The district director shall notify the importer and the copyright owner that they shall have additional time, not to exceed 30 days, in which to provide a response to the arguments submitted by the opposing party, and that rebuttal arguments, timely submitted, shall be fully considered in the decision-making process.

(ii) *Decision.* Upon receipt of rebuttal arguments, or 30 days after notification if no rebuttal arguments are submitted, the district director shall forward the entire file, together with a sample of each style that is considered possibly infringing, to Customs Headquarters, (Attention: International Trade Compliance Division, Office of Regulations and Rulings), for decision on the disputed claim of infringement. The final decision on the disputed claim of infringement shall be forwarded to the district director who shall send a copy thereof to the copyright owner as well as to the importer.

* * * * *

(4) *Withdrawal of bond.* Where the copyright owner has posted a bond on the grounds that the imported article is infringing, the copyright owner may not withdraw the bond until a decision on the issue of infringement has been reached.

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Carol Hallett,

Commissioner of Customs.

Approved: June 10, 1992.

Peter K. Nunez,

Assistant Secretary of the Treasury.

BILLING CODE 4820-02-M

PROPOSED AMENDMENTS TO PTO RULES ON PATENT COOPERATION TREATY PRACTICE

57 FR 29248

DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Parts 1 and 10

[Docket No. 920539-2139]

RIN 0651-AA51

Revision of Patent Cooperation Treaty Provisions

AGENCY: Patent and Trademark Office, Commerce.

ACTION: Notice of proposed rulemaking.

SUMMARY: The Patent and Trademark Office (Office) proposes (1) to amend the rules of practice relating to applications filed under the Patent Cooperation Treaty (PCT) in accordance with revised regulations under the PCT; (2) to bring the rules regarding applications entering the national stage under 35 U.S.C. 371 more in line with existing regulations applicable to national applications filed under 35 U.S.C. 111; and (3) to clarify existing practice under the PCT. The proposed changes will result in more streamlined and simplified procedures for filing and prosecuting international and national stage applications under the PCT.

DATES: Written comments must be submitted on or before July 31, 1992.

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ADDRESSES: Address written comments to the Commissioner of Patents and Trademarks, Box PCT, Washington, DC 20231, Attention: Vincent Turner, CP-6, room 1205 or by Fax to (703) 305-8825.

FOR FURTHER INFORMATION CONTACT: Vincent Turner by telephone at (703) 305-3174 or by mail marked to his attention and addressed to the Commissioner of Patents and Trademarks, Box PCT, Washington, DC 20231.

SUPPLEMENTARY INFORMATION: This proposed rule change will improve filing and processing procedures for applicants both in the filing of international applications and in the filing of national stage applications under 35 U.S.C. 371.

During the first 14 years under the PCT, the annual volume of international patent applications filed in the U.S. Receiving Office has increased from just under 100 to almost 10,000 in fiscal year 1991. The volume of U.S. national stage applications has shown similar growth to the point that the U.S. is now designated more than 10,000 times each year by applicants filing international applications under the PCT. Historically, approximately 60% of those applicants that designate the U.S. enter the national stage in the United States.

On July 8 to 12, 1991, representatives of the patent offices of the member countries, in a series of meetings held in Geneva, Switzerland, agreed upon several changes to the PCT regulations which are designed to make the PCT more user-friendly. These adopted changes require corresponding changes in title 37, CFR.

Under the present regulations, an applicant is required on filing the international application to specify all designations of countries, or regions of countries (regions), in which a patent is sought. Failure to designate a member

country, or region, on filing, results in the loss of the right to file in the desired country, or region, using the benefits of the Treaty. The practice under the revised PCT regulations will permit an applicant to provide a generic designation of all PCT member countries and regions so that any intended designation which may have been overlooked on filing can be corrected within 15 months of the priority date.

International applications are searched and published prior to the 20-month deadline for entry into the national stage. If a demand for examination if filed before expiration of 19 months from the priority date, the time for entry into the national stage is extended to 30 months and the international application will be subject to preliminary examination under chapter II of the PCT. Under the present regulations preliminary examination may be based on an amendment which accompanies the demand. Amendments filed after the demand are not considered. The practice under the revised PCT regulations permits an applicant to indicate in the demand that preliminary examination is to be based on an accompanying Article 34 amendment and, if the amendment is not received with the demand, the applicant will be notified and given a time period within which to file the missing amendment. This new procedure will ensure that examination will go forward based on the desired Article 34 amendment.

Also, the Office is aware that certain applicants have had difficulty in properly filing national stage applications due to the different requirements in the rules for PCT and U.S. national applications. Some differences cannot be avoided due to different procedures required under the PCT from U.S. national practice. It is desirable, however, to minimize these differences and to simplify national stage filing procedures.

International applications have become abandoned for failure to timely provide an oath or declaration, a filing fee and/or an accurate translation. In national practice under 35 U.S.C. 111, if any of these items were not presented at the time of filing, a notice would be mailed to the applicant setting a period of time to provide the missing item(s) and to pay a fee. The proposed amendments to the rules governing entering the national stage will establish a greater degree of uniformity of practice and requirements for filing an application under 35 U.S.C. 111 and entering the national stage in an international application under 35 U.S.C. 371.

The proposal to amend §§ 1.494 and 1.495 would result in regulations much like the present § 1.53. The major exception would be that a notification of any missing parts in proposed sections 1.494 and 1.495 would only be mailed in those instances where the applicant has paid the national stage filing fee within 20 or 30 months from the priority date, depending on whether election of the U.S. under chapter II of the PCT has been made prior to 19 months. Paying the fee will give a clear indication to the Office that the applicant desires to enter the national stage and that a period of time should be set to supply any missing oath, declaration or translation. At the same time, the applicant will have the opportunity to inform the Office of the U.S. correspondence address. Thus, the Office will avoid unnecessary handling of approximately 40% of those applications that designate the U.S. but do not enter the national stage, and will be able to send a notice to a U.S. correspondence address in most cases.

Often at 20 or 30 months from the priority date, the only communication which has been received by the Office is a copy of the international application from the International Bureau with the address of the foreign attorney who represented the applicant in the international stage. The foreign attorney or agent may not be conversant in English or knowledgeable about U.S. practice, factors which often contribute to complicating the processing of applications. Thus, the proposed practice will have several advantages: (1) It will enable the applicant to identify the U.S. attorney or agent for correspondence from the Office; (2) the Office, after a check of the national stage papers at 20 or 30 months, will mail a notice identifying any deficiencies and affording applicant a period for correction of those deficiencies; and (3) as in national practice under § 1.53, it will enable applicants to extend the period of time under § 1.136 for submission of a proper oath, declaration or translation.

The proposed changes to §§ 1.494 and 1.495 address the problems which have been most frequently encountered. By far, the greatest hurdle for entry into the national stage has been submission of the oath or declaration by the 22 or 32 month deadline. There is no opportunity for extension beyond 22 or 32 months. Similarly, submission of the translation within these time limits has posed a problem for many applicants. The proposed practice of notifying applicants of deficiencies and setting an extendable period of time for correction would allow applicants greater flexibility in the time for submission of these documents, thus avoiding the consequence of abandonment and potential loss of rights in the United States.

Discussion of Specific Rules

The following is a table correlating PCT Rule changes with proposed 37 CFR changes. Sections 1.431(b)(1), 1.431(b)(3)(ii), 1.451(a), 1.482(a)(2)(i), 1.492(e), 1.494 and 1.495, which are proposed to be amended, are not shown in the table because they are changes being proposed that are not required by PCT rule changes.

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RULE CORRELATION TABLE

37 CFR change	PCT rule change
1.431(c)–(3)	16bis, 27.1
1.432(a)	4.1(b(iv), 4.9
1.432(b)	5.5, 16bis
1.432(c)	15.5
1.434(a)	3.1
1.445(a)(4)	15.5
1.446(d)	15.6, 16.2
1.446(e)	57.6
1.455(a)	90, 2.2bis
1.475	13
1.476(a)	13
1.480(b)	53.1
1.482(b)	57.5
1.484(b)	60.1(g), 66, 69.1
1.485	60.1(g)
1.487	13
1.488(a)	13
1.499	13
1.821(h)	13ter.1(c)
10.9(c)	90

Section 1.431(b)(1), if amended as proposed, would clarify that, for an international filing date to be accorded, at least one applicant (rather than all applicants) must be a resident or national of the United States and the papers as filed must so indicate. The only way the United States Receiving Office can determine whether, as required by Article 11, "the applicant does not obviously lack" the requisite residence or nationally is by inspection of the papers as filed. Accordingly, in order to be accorded an international filing date by the U.S. Receiving Office, the papers must indicate a U.S. residency or nationality of at least one applicant.

Section 1.431(b)(3)(ii), if amended as proposed, would add a cross-reference to § 1.432 which sets forth the requirements regarding designations.

Section 1.431(c), if amended as proposed, would reflect that the United States Receiving Office, rather than the International Bureau, will be responsible for collecting fees not paid in full at the time of filing the international application or within one month thereafter. These fees are not new. The proposed change merely reflects that the Receiving Office, rather than the International Bureau, will be responsible for communicating deficiency notices to the applicant. Under the procedure proposed in paragraph (c), a notice of any fee deficiency will be mailed by the Receiving Office setting a time period of one month for payment of the fee deficiency and a late payment fee equal to the greater of (1) 50% of the amount of the deficient fees up to a maximum amount equal to the basic fee, or (2) an amount equal to the transmittal fee. The time period of one month for response to this notice cannot be extended.

Section 1.431(d), if amended as proposed, will be eliminated as unnecessary since the United States Receiving Office will take over the responsibility for collecting fees in place of the International Bureau.

Section 1.431(e), if amended as proposed, would be redesignated as § 1.431(d) and would clarify that the failure to timely pay the fees pursuant to paragraph (c) will result in the withdrawal of the international application.

Section 1.432(a), if amended as proposed, would clarify that the applicant must specify, on filing, at least one state or region in order to be granted a filing date for the international application. This specific designation is required whether or not all designations are indicated pursuant to paragraph (c) of this section. The reference to section 201 of the Administrative Instructions is proposed to be changed to section 115 to correspond to the change in the Administrative Instructions.

Section 1.432(b), if amended as proposed, would establish a procedure for the late payment of fees for designations that were specified on filing an international application, and a procedure, pursuant to PCT rule 16bis.1(c), in accordance with section 321 of the PCT Administrative Instructions for allocating fees, where the amount paid is insufficient to cover all the fees. The payment of the designation fees with a late payment fee is now new. Under the revised PCT regulations, however, the Receiving Office, rather than the International Bureau, will be responsible for communicating deficiency notices to the applicant. The designation fees may be paid, without necessity for a late payment fee, within one year from the priority date or within one month from the date of receipt of the international application if that month expires after the expiration of one year from the priority date. As proposed the applicant would be notified and given one month within which to pay any deficient designation fees plus a late payment fee. The amount of the late payment fee is equal to 50% of the deficient fees, but will not be less than the amount of the transmittal fee (currently $190) and will not exceed the amount of the basic fee (currently $525). The one-month time limit for payment of the deficient designation fees and late payment fee may not be extended. If, after expiration of the one-month time period, at least one designation fee has not been paid (with any late payment fee which is due), the international application will be withdrawn. If, after expiration of the one-month time period, at least one designation fee has been paid (with any late payment fee which is due) but the amount paid is not sufficient to cover all the designation fees or late payment fee, the amount paid will be allocated, pursuant to PCT rule 16bis.1(c), in accordance with section 321 of the Administrative Instructions. Section 321 of the Administrative Instructions provides that the amount will be allocated in accordance with any instructions received from the applicant or, if no instructions have been received, in the order in which the designations appear in the request part of the international application. Unpaid designations will be withdrawn.

Section 1.432(c), if added as proposed, would establish a procedure wherein, in addition to the designation(s) under paragraph (a), the applicant could indicate, on filing, all designations permitted under the Treaty and confirm desired designations of countries or regions up to 15 months from the priority date. The confirmation must include both a written notice of the countries or regions being confirmed, the appropriate designation fees and a confirmation fee based on the number of countries or regions being confirmed. If the amount of the fees is insufficient, the Receiving Office will allocate the amount paid in accordance with any priority of designations specified by the applicant or, if no priority is specified, in accordance with section 321 of the Administrative Instructions. A notice reminding applicant of the 15-month deadline will not be provided. Unconfirmed designations will be considered withdrawn.

Section 1.434, if amended as proposed, would allow applicants to develop their own computer-generated Request form so long as the forms comply with the requirements of sections 102(h) and (i) of the Administrative Instructions. Printed Request forms will continue to be available from the United States Patent and Trademark Office.

Section 1.445(a)(4), if added as proposed, would define the confirmation free required for the designations confirmed under § 1.432(c). The confirmation fee is equal to 50% of the sum of the designation fees for the designations being confirmed. For example, a confirmation of four additional designations (at $127 per designation, or $508) would require a $254 confirmation fee. The total amount of the fees due would be $762, which is the sum of $500 and $254.

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Section 1.446(d), if amended as proposed, would clarify that the international and search fees may be refunded under certain circumstances linked to whether the record copy or search copy has been transmitted to the International Bureau or International Searching Authority, respectively. The transmittal fee will not be refunded, but will be retained to cover Office processing costs. If the record copy or search copy has been transmitted, the Receiving Office cannot refund or authorize the refund of the international or search fees. Any request for a refund filed after the record copy or search copy has been transmitted should be directed to the International Bureau (for the international fee) or the International Searching Authority (for the international search fee) for consideration of whether a refund should be made.

Section 1.446(e), if added as proposed, would indicate that a refund of the handling fee by the International Preliminary Examining Authority is permitted only in the situations where the demand is considered not to have been submitted or upon withdrawal of the demand before the demand has been sent to the International Bureau. If the demand has been sent to the International Bureau, requests for refund of the handling fee should be directed to the International Bureau.

Section 1.451(a), if amended as proposed, would clarify that in order to be entitled to the priority of a previously filed application, the priority claim must

be made in the international application papers as filed. The right to priority is not necessarily lost if the claim is not on the Request per se, but will be lost if the claim does not appear in the papers presented on filing of the application.

Section 1.445(a), if amended as proposed, would clarify that the term "common representative" means an applicant appointed as the representative of the other applicants. The paragraph would also clarify who can represent applicants in an international application before the U.S. International Searching Authority or the U.S. International Preliminary Examining Authority, e.g., (1) an attorney or agent registered to practice before the Office, and (2) an attorney or agent not registered to practice before the Office, but authorized to practice before the national office with which the international application was filed and for which the United States is an International Searching Authority or International Preliminary Examining Authority. In the latter case, representation is restricted to practicing before the U.S. International Searching Authority and/or the U.S. International Preliminary Examining Authority. For example, if an international application is filed in the Brazilian Patent Office, an agent authorized to practice before the Brazilian Patent Office may prosecute that application before the U.S. International Searching Authority or the U.S. International Preliminary Examining Authority. Paragraph (a) would also provide that, unless otherwise indicated, the appointment of an attorney or agent revokes any earlier appointment as specified in PCT Rule 90.6(b).

Section 1.475, if amended as proposed, would adopt the unity of invention principles of PCT Rule 13, as amended. Section 1.475 is further proposed to be amended to reflect that the same unity of invention principles are applied by the international searching and preliminary examining authorities and during the national stage. Duplicative provisions in §§ 1.487 and 1.499 are proposed to be deleted.

The principles of unity of invention are used to determine the types of claimed subject matter and the combinations of claims to different categories of invention that are permitted to be included in a single international or national stage patent application. The basic principle is that an application should relate to only one invention or, if there is more than one invention, that applicant would have a right to include in a single application only those inventions which are so linked as to form a single general inventive concept.

Section 1.475(a), if amended as proposed, would contain both the definition of the requirement for unity of invention, and the unity of invention criteria that must be satisfied, where a group of inventions is claimed, in order to have a right to include multiple inventions in a single application. A group of inventions is linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression "special technical features" is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art. For example, a compound is the common technical feature in an application claiming (1) the compound per se, (2) a method of making the compound and (3) a method of using the compound. A corresponding technical feature is exemplified by a key defined by certain claimed structural characteristics which correspond to the claimed features of a lock to be used with the claimed key.

Section 1.475(b), if amended as proposed, defines several combinations of different categories of claims which always fulfill the unity of invention requirements of § 1.475(a) where the same or corresponding special technical feature is claimed. There may be other combinations of different categories of claims which fulfill the requirement for unity of invention, but the determination of unity must be made under § 1.475(a), not § 1.475(b).

As proposed in § 1.475(b), a process is "specially adapted" for the manufacture of a product if the claimed process inherently produces the claimed product with the technical relationship defined in § 1.475(a) being present between the claimed process and the claimed product. The expression "specially adapted"as used in this section does not imply that the product could not also be manufactured by a different process, nor does it imply that the same kind of process of manufacture could not also be used for the manufacture of other products.

As proposed in § 1.475(b), an apparatus or means is "specifically designed" for carrying out the process when the apparatus or means is suitable for carrying out the process with the technical relationship defined in § 1.475(a) being present between the claimed apparatus or means and the claimed process. The expression "specifically designed" does not imply that the apparatus or means could not be used for carrying out another process, nor does it imply that the process could not be carried out using an alternative apparatus or means.

Section 1.475(c), if amended as proposed, would require that unity of invention might not be present if a combination of categories of invention different from those described in § 1.475(b) are presented in an application. The requirements of § 1.475(a) are always met by the combinations described in § 1.475(b) where the same or corresponding special technical feature is claimed. All other combinations must be tested against the unity of invention standard of § 1.475(a).

Section 1.475(d) is proposed to be amended by deleting reference to the different combinations of categories of invention that always meet the unity of invention standard (now set forth in proposed § 1.475(b)), and to make reference to the determination of the main invention where multiple products, processes of manufacture or uses are

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claimed. The significance of determining the main invention is set forth in § 1.476(c).

Section 1.475(e), if amended as proposed, would require that the determination regarding unity of invention be made without regard to whether a group of inventions is claimed in separate claims or as alternatives within a single claim. The basic criteria for unity of invention are the same, regardless of the manner in which applicant chooses to draft a claim or claims.

Section 1.475(f) is proposed to be deleted since PCT Rule 13 has been amended and the basic principles of unity of invention are proposed to be incorporated into other portions of § 1.475.

Section 1.476(a), if amended as proposed, would delete the reference to § 1.475(f) (proposed to be deleted) and PCT Rule 13.

Section 1.480(b), if amended as proposed, would allow applicants to develop their own computer generated Demand form so long as the limitations in sections 102(h) and (i) of the Administrative Instructions are met. Printed Demand forms will continue to be available from the United States Patent and Trademark Office.

Section 1.482(a)(2)(i), if amended as proposed, would clarify that an

additional preliminary examination fee may be charged for lack of unity in chapter II irrespective of whether there was a similar charge in chapter I. Normally there will be a charge for lack of unity both in chapter I and in chapter II. In some instances, although a charge for the search of an additional invention is justified in chapter I, the examiner chooses to proceed without charging for the search of the additional invention(s). However, circumstances may change (e.g. an amendment submitted with the Demand expanding the claims to the additional invention(s)) in chapter II so as to warrant the examiner's requirement for an additional fee for examination of the additional invention(s).

Section 1.482(b), if amended as proposed, would remove the reference to the supplement to the handling fee which had been collected for the benefit of the International Bureau and which has been deleted from the PCT Regulations. At present, applicants must pay as many supplements to the handling fee as there are languages into which the elected Offices require translations of the international preliminary examination report. Under the new PCT Regulations, all countries will accept an English translation of the International preliminary examination report, thus limiting the International Bureau's translation costs. Accordingly, only one handling fee will need to be paid by the applicant, without any supplement, irrespective of the need for a translation of the report.

Section 1.484(b), if amended as proposed, would permit an applicant to indicate in the demand that international preliminary examination is to begin based on the application as amended rather than on the application as filed. If an Article 19 amendment is not received by the Office by 20 months from the priority date, preliminary examination will proceed. Where the demand indicates examination is to be based on an accompanying Article 34 amendment, but the Article 34 amendment has not been provided to the Office with the demand, the applicant will be notified and given a time period to submit the amendment. Thus, if the applicant wishes preliminary examination based on an amended version of the international application, the demand must so indicate and the amendment (Article 19 or 34) must (1) accompany the demand; or (2) in the case of an Article 19 amendment, be received by 20 months from the priority date; or (3) in the case of an Article 34 amendment, be submitted within the nonextendable time period set by the Office.

Section 1.485, if amended as proposed, would be consistent with proposed § 1.484 and would provide for amendments to be filed with the demand or within a time period set by the International Preliminary Examining Authority.

Section 1.487 is proposed to be removed as unnecessary because the proposed amendments to § 1.475 address the unity of invention principles to be applied by the International Preliminary Examining Authority.

Section 1.488(a), if amended as proposed, would replace the reference to § 1.487, which is proposed to be removed, with a reference to § 1.475.

Section 1.492(e), if amended as proposed, would eliminate the surcharge for filing the basic national fee after 20 or 30 months from the priority date. In accordance with the new practice under proposed §§ 1.494 and 1.495, the basic national fee must be filed no later than 20 months, or 30 months, if a timely election was filed, from the priority date in order to avoid abandonment of the application. If the new practice is adopted as proposed, a short transition period will be provided before the surcharge is eliminated to avoid any retroactive effect of the new practice.

Sections 1.494 and 1.495, if amended as proposed, would modify the practice for entering the national stage as a designated or elected office by more closely aligning it with national application practice under § 1.53.

Section 1.494(a), if amended as proposed, would clarify that absence of a Demand form is no longer the controlling event, but rather failure to elect the United States within 19 months of the priority date will trigger the time periods set forth in paragraphs (b) and (c) of this section.

Section 1.494(b), if amended as proposed, would clarify that the basic national stage filing fee and a copy of the international application must be filed with the Office by 20 months from the priority date to avoid abandonment. The International Bureau normally provides the copy of the international application to the Office in accordance with Article 20. At the same time, the International Bureau notifies the applicant of the communication to the Office. In accordance with PCT Rule 47.1, that notice shall be accepted by all designated offices as conclusive evidence that the communication has duly taken place. Thus, if the applicant desires to enter the national stage, the applicant normally need only check to be sure the notice from the International Bureau has been received and then pay the basic national stage filing fee by 20 months from the priority date. The 20-month time limit for submission of the basic national stage filing fee and a copy of the international application is not extendable.

Section 1.494(c), if amended as proposed, would provide that applicants who have provided the basic national stage filing fee and a copy of the international application by 20 months from the priority date but who omit a proper translation, oath or declaration will receive a notification setting a time period for submission of the omitted requirements. The time period set in the notice can be extended pursuant to § 1.136. Filing of the oath or declaration later than 20 months will require the payment of the surcharge set forth in § 1.492(e). Filing of the translation later than 20 months will require the payment of the processing fee set forth in § 1.492(f).

Section 1.494(d), if amended as proposed, would clarify the existing practice that Article 19 amendments must be submitted by 20 months from the priority date, which time may not be extended. Of course the failure to do so does not result in loss of the subject matter of the Article 19 amendments. The applicant may submit that subject matter in a preliminary amendment filed under § 1.121. In many cases, filing an

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amendment under § 1.121 is preferable since grammatical or idiomatic errors may be corrected.

Section 1.494(g), if amended as proposed, would be removed in view of the proposed amendments to sections (b), (c) and (d).

Section 1.494(h), if amended as proposed, would be redesignated as § 1.494(g) and would specify when an application that fails to enter the national stage becomes abandoned. Abandonment occurs at 20 months from the priority date if the basic national stage filing fee and a copy of the international application have not been provided to the Office. If they have been provided to the Office within 20 months and the translation and/or oath or declaration are not filed timely, abandonment occurs upon expiration of the time limit set in the notification pursuant to paragraph (c). Thus, in the latter situation, abandonment would occur at the expiration of the time period set in the notice to file the missing translation, and/or oath or declaration.

Section 1.495(a), if amended as proposed, would clarify that the election

of the U.S. need not be made in the Demand, but can be made subsequently if filed before expiration of 19 months from the priority date to start the time periods set forth in paragraphs (b) and (c) of this section.

Section 1.495(b), if amended as proposed, would clarify that the basic national fee and a copy of the international application must be filed with the Office by 30 months from the priority date to avoid abandonment. The International Bureau normally provides the copy of the international application to the Office in accordance with Article 20. At the same time the International Bureau notifies applicant of the communication to the Office. In accordance with PCT Rule 47.1, that notice shall be accepted by all designated offices as conclusive evidence that the communication has duly taken place. Thus, if the applicant desires to enter the national stage, the applicant normally need only check to be sure the notice from the International Bureau has been received and then pay the basic national fee by 30 months from the priority date. The 30-month time limit for submission of the basic national fee and copy of the international application is not expendable.

Section 1.495(c), if amended as proposed, would provide that applicants who have provided the basic national fee and a copy of the international application by 30 months from the priority date but who omit a proper translation, oath or declaration will receive a notification setting a time period for submission of the omitted requirements. The time period set in the notice can be extended pursuant to § 1.136. Filing of the oath or declaration later than 30 months will require the payment of the surcharge set forth in § 1.492(e). Filing of the translation later than 30 months will require the payment of the processing fee set forth in § 1.492(f).

Section 1.495(d), if amended as proposed, would clarify the existing and continuing practice that the Article 19 amendments must be submitted by 30 months from the priority date, which time may not be extended. The failure to do so will not result in loss of the subject matter of the Article 19 amendments. Applicant may submit that subject matter in a preliminary amendment filed under § 1.121. In many cases, filing an amendment under § 1.121 is preferable since grammatical or idiomatic errors may be corrected.

Section 1.495(e), if amended as proposed, would specify that a translation into English of any annexes to the international preliminary examining report which are not received by 30 months from the priority date may only be submitted within the time period set in paragraph (c) for submission of any omitted translation of the international application, or oath or declaration. If any required translation of the international application and oath or declaration have been provided to the Office by 30 months, a notice under paragraph (c) will not be sent, and if the translation of annexes is not submitted within 30 months, the annexes will be considered cancelled.

Section 1.495(h), if amended as proposed, would be removed in view of the proposed amendments to sections (b), (c), (d) and (e).

Section 1.495(i), if amended as proposed, would be redesignated as § 1.495(h) and would specify when an application that fails to enter the national stage becomes abandoned if the United States was elected prior to 19 months from the priority date. Abandonment occurs at 30 months from the priority date if the basic national stage filing fee and a copy of the international application have not been provided to the Office. If they have been provided to the Office within 30 months and the translation and/or oath or declaration are not filed timely, abandonment occurs upon expiration of the time limit set in the notification pursuant to paragraph (c). Thus, in the latter situation, abandonment would occur at the expiration of the time period set in the notice to file the missing translation, and/or oath or declaration.

Section 1.499 is proposed to be amended by removing paragraphs (a) through (e) because the proposed amendments to § 1.475 address the unity of invention principles to be applied in the national stage.

Section 1.821(h), if amended as proposed, would provide that if applicant fails to timely provide the required computer readable form, the United States International Searching Authority shall search only to the extent that a meaningful search can be carried out.

Section 10.9, if amended as proposed, would add a new paragraph (c) to be consistent with § 1.455, clarifying that an attorney or agent having the right to act before the national office with which the international application is filed may represent the applicant before the U.S. International Searching Authority or the U.S. International Preliminary Examining Authority. An individual who has the right to practice before the national office with which an international application is filed, and who is not registered under § 10.6, may not prosecute patent applications in the national stage in the Office.

Other Considerations

The proposed rule changes are in conformity with the requirements of the Regulatory Flexibility Act, 5 U.S.C. 601 *et seq.*, Executive Orders 12291 and 12612, and the Paperwork Reduction Act of 1980, 44 U.S.C. 3501 *et seq.*

The General Counsel of the Department of Commerce has certified to the Chief Counsel for Advocacy, Small Business Administration, that the proposed rule changes will not have a significant adverse economic impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)), because the proposed rules would provide more streamlined and simplified procedures for filing and prosecuting international and national stage applications under the PCT. Thus, costs to all applicants using the PCT, including small entities, would be reduced.

The Patent and Trademark Office has determined that these proposed rule changes are not a major rule under Executive Order 12291. The annual effect on the economy will be less than $100 million. There will be no major increase in costs or prices for consumers; individual industries; Federal, state or local government agencies; or geographic regions. There will be no significant adverse effects on competition, employment, investment,

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productivity, innovation, or on the ability of United States-based enterprises to compete with foreign-based enterprises in domestic or export markets.

The Patent and Trademark Office has also determined that this notice has no federalism implications affecting the relationship between the National government and the States as outlined in Executive Order 12612.

These rule changes will not impose any additional burden under the Paperwork Reduction Act of 1980, 44 U.S.C. 3501 *et seq.* The paperwork burden imposed by adherence to the PCT is currently approved by the Office of Management and Budget under control number 0651-0021.

Notice is hereby given that pursuant to the authority granted to the Commissioner of Patents and Trademarks by 35 U.S.C. 6, the Patent and Trademark Office proposes to amend title 37 of the Code of Federal Regulations as set forth below.

List of Subjects

37 CFR Part 1

Administrative practice and procedure, Courts, Freedom of information, Inventions and patents, Reporting and recordkeeping requirements, Small businesses.

37 CFR Part 10

Administrative practice and procedure, Inventions and patents, Lawyers, Reporting and recordkeeping requirements, Trademarks.

For the reasons set forth in the preamble, 37 CFR parts 1 and 10 are proposed to be amended as follows, with removals indicated by brackets ([ ]) and additions by arrows (<):

PART 1—RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR part 1 would continue to read as follows:

Authority: 35 U.S.C. 6 unless otherwise noted.

2. Section 1.431 is proposed to be amended by revising paragraphs (b) introductory text through (b)(3)(ii), (c), (d), and (e) to read as follows:

§ 1.431 International application requirements.

* * * * *

(b) An international filing date will be accorded by the United States Receiving Office, at the time of receipt of the international application, provided that:

(1) >At least one< [The] applicant >(§ 1.421)< is a United States resident or national >and the papers filed at the time of receipt of the international application so indicate< (35 U.S.C. 361(a), PCT Art. 11(1)(i)).

(2) The international application is in the English language (35 U.S.C. 361(c), PCT Art. 11(1)(ii)).

(3) The international application contains at least the following elements (PCT Art. 11(1)(iii)):

(i) An indication that it is intended as an international application (PCT Rule 4.2);

(ii) The designation of at least one Contracting State of the International Patent Cooperation Union >(§ 1.432)< ;

* * * * *

(c) Payment of the basic portion of the international fee (PCT Rule 15.2) and the transmittal and search fees (§ 1.445) may be made in full at the time the international application papers required by paragraph (b) of this section are deposited or within one month thereafter. >If the basic, transmittal and search fees are not paid within one month from the date of receipt of the international application, applicant will be notified and given one month within which to pay the deficient fees plus a late payment fee equal to the greater of (1) 50% of the amount of the deficient fees up to a maximum amount equal to the basic fee, or (2) an amount equal to the transmittal fee (PCT Rule 16bis). The one-month time limit set in the notice to pay deficient fees may not be extended.< [Failure to make full payment within one month of the deposit of the international application papers required by paragraph (b) of this section will result in the fees being charged to the International Bureau under the provision of paragraph (d) of this section and PCT Rule 16bis.]

(d) [The United States Receiving Office will charge to the International Bureau in accordance with PCT Rule 16bis and will consider as having been timely paid:

(1) The transmittal fee, the basic fee portion of the international fee, or the search fee where these fees have not been fully paid by the applicant within one month of the date of deposit of the international application,

(2) The designation fee, or the amount necessary to cover all the designations made in the request if not paid by the applicant within one year from the priority date or within one month from the date of receipt of the international application if that month expires after the expiration of one year from the priority date.

(e) The International Bureau will notify applicant of any amount charged under paragraph (d) of this section and invite the applicant to pay directly to the International Bureau within one month from the date of the notification, the amount charged, augmented by a surcharge of 50%, provided the surcharge will not be less, and will not be more, than the amounts indicated in the Schedule of Fees appended to the PCT Rules.] If the payment needed to cover the transmittal >fee< [fees], the basic fee, the search fee, one designation fee and the >late payment fee pursuant to paragraph (c) of this section< [surcharge] is not timely made [to the International Bureau], [the International Bureau will notify] the Receiving Office [which] will declare the international application withdrawn under PCT Article 14(3)(a). [If the applicant makes timely payment of the fees referred to in the previous sentence, but the amount paid is not sufficient to cover all the designation fees, the Receiving Office will declare any designation not paid withdrawn under PCT Article 14(3)(b) in accordance with PCT Rule 16bis.2(c).]

3. Section 1.432 is proposed to be amended by revising paragraphs (a) and (b) and adding new paragraph (c) to read as follows:

§ 1.432 Designation of States and payment of designation fees.

(a) The >designation of< [names of Designated] States >or Regions< shall appear in the >request< [Request] upon filing and must be indicated as set forth in >PCT Rule 4.9 and< Section >115< [201] of the Administrative Instructions. >Applicant must specify at least one national or regional designation on filing of the international application for a filing date to be granted.<

(b) >If the fees necessary to cover all the national and regional designations specified in the request are not paid by the applicant within one year from the priority date or within one month from the date of receipt of the international application if that month expires after the expiration of one year from the priority date, applicant will be notified and given one month within which to pay the deficient designation fees plus a late payment fee equal to the greater of (1) 50% of the amount of the deficient fees up to a maximum amount equal to the basic fee, or (2) an amount equal to the transmittal fee (PCT Rule 16bis). The one-month time limit set in the notification of deficient designation fees may not be extended.< [The designation fees may be paid upon filing of the international application, but must be paid before the expiration of one year from the priority date or within one month from the date of receipt of

the international application if that month expires after the expiration of one year from the priority date. Failure to timely pay the designation fee for a particular Designated State will result in the withdrawal of that designation.] Failure to timely pay at least one designation fee will result in the withdrawal of the international application. >The one designation fee may be paid (1) within one year from the priority date, (2) within one month from the date of receipt of the international application if that month expires after the expiration of one year from the priority date, or (3) with the late payment fee defined in this paragraph within the time set in the notification of the deficient designation fees. If after a notification of deficient designation fees the applicant makes timely payment, but the amount paid is not sufficient to cover the late payment fee and all

designation fees, the Receiving Office will, after allocating payment for the basic, search, transmittal and late payment fees, allocate the amount paid in accordance with PCT Rule 16bis.1(c) and withdraw the unpaid designations. The notification of deficient designation fees pursuant to this paragraph may be made simultaneously with any notification pursuant to § 1.431(c).<

>(c) On filing the international application, in addition to specifying at least one national or regional designation, applicant may also indicate that all designations permitted under the Treaty are made. The latter indication is subject to confirmation (PCT Rule 4.9(c)) not later than the expiration of 15 months from the priority date by:

(1) Filing a written notice with the United States Receiving Office specifying the national and/or regional designations being confirmed;

(2) Paying the designation fee for each designation being confirmed; and

(3) Paying the confirmation fee specified in § 1.445(a)(4). Unconfirmed designations will be considered withdrawn. If the amount submitted is not sufficient to cover the designation fee and the confirmation fee for each designation being confirmed, the Receiving Office will allocate the amount paid in accordance with any priority of designations specified by applicant. If applicant does not specify any priority of designations, the allocation of the amount paid will be made in accordance with PCT Rule 16bis.1(c).<

4. Section 1.434 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.434 The request.

(a) The request shall be made on a standardized [printed] form (PCT Rules 3 and 4). Copies of [such] printed Request forms are available for the Patent and Trademark Office. Letters requesting [such] >printed< forms should be marked "Box PCT."

* * * * *

5. Section 1.445 is proposed to be amended by adding new paragraph (a)(4) to read as follows:

§ 1.445 International application filing, processing and search fees.

(a) * * *

>(4) A confirmation fee (PCT Rule 96) equal to 50% of the sum of designation fees for the national and regional designations being confirmed (§ 1.432(c)).<

* * * * *

6. Section 1.446 is proposed to be amended by revising paragraph (d) and adding paragraph (e) to read as follows:

§ 1.446 Refund of international application filing and processing fees.

* * * * *

(d) The international and search fees will be refunded if no international filing date is accorded >or if the application is withdrawn before transmittal of the record copy to the International Bureau< (PCT Rules 15.6 and 16.2). >The search fee will be refunded if the application is withdrawn before transmittal of the search copy to the International Searching Authority. The transmittal fee will not be refunded<.

>(e) The handling fee (§ 1.482(b)) will be refunded (PCT Rule 57.6) only if:

(1) The demand is withdrawn before the demand has been sent by the International Preliminary Examining Authority to the International Bureau, or

(2) The demand is considered not to have been submitted (PCT Rule 54.4(a)).<

7. Section 1.451 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.451 The priority claim and priority document in an international application.

(a) The claim for priority must be made >in< [on] the >request< [Request] (PCT Rule 4.10) in a manner complying with Sections 110 and 201 of the Administrative Instructions.

* * * * *

8. Section 1.455 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.455 Representation in international applications.

(a) Applicants of international applications may be represented by attorneys or agents licensed to practice before the Patent and Trademark Office or by >an applicant appointed as< a common representative PCT Art. 49, Rules 4.8 and 90 and § 10.10(a)). >An attorney or agent having the right to practice before a national office with which an international application is filed and for which the United States is an International Searching Authority or International Preliminary Examining Authority may be appointed to represent the applicants in the international application before that authority. An attorney or agent may appoint an associate attorney or agent who shall also then be of record (PCT Rule 90.1(d)). The appointment of an attorney or agent revokes any earlier appointment unless otherwise indicated (PCT Rule 90.6(b)).<

* * * * *

9. Section 1.475 is proposed to be revised to read as follows:

§ 1.475 Unity of invention before the International Searching Authority >, the International Preliminary Examining Authority and during the national stage<.

(a) >An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among these inventions involving one ore more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.< [An international application before the International Searching Authority will be considered to have unity of invention if the claims are in accordance with PCT Rule 13 (see paragraph (f) of this section).]

(b) An international >or a national stage< application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the >following< combinations of categories >:< [as set forth in PCT Rule 13.2 (see paragraph (f) of this section) or to the combination of -]

(1) A product and a process >specially adapted< for the manufacture of said product >;< or

(2) A product and a process of use of said product[.] >; or

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

(4) A process and a apparatus or means specifically designed for carrying out the said process; or

(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.< [If an application contains claims to more or less than one of the combinations of categories set forth in PCT Rule 13.2 (see paragraph (f) of this section) or a combination set forth in paragraphs (b)(1) or (2) of this section, unity of invention may not be present.]

(c) >If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.< [If an international application contains claims to a category of invention in addition to those categories included in any one of the combinations specified in paragraph (b) of this section, lack of unity of invention may be held between the categories included in the combination and the claims to the additional category of invention.]

(d) [Unity of invention will exist where the claims are limited to one of the combinations of categories set forth in PCT Rule 13.2 (see paragraph (f) of this section) or in a combination set forth in paragraphs (b)(1) or (2) of this section.] If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the >main invention in the claims, see PCT Article 17(3)(a) and § 1.476(c).< [inventions to be searched. Any such holding by the examiner will be made of record as a holding of lack of unity of invention.]

(e) >The determination whether a group of investions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.< [The inventions recited by the claims of different categories must be related rather than independent inventions.

(f) The wording of PCT Rule 13 is as follows:

"PCT Rule 13—Unity of Invention

13.1 Requirement

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention").

13.2 Claims of Different Categories

Rule 13.1 shall be construed as permitting, in particular, one of the following three possibilities:

(i) In addition to an independent claim for a given product, the inclusion in the same international application of an independent claim for a process specially adapted for the manufacture of the said product, and the inclusion in the same international application of an independent claim for a use of the said product, or

(ii) In addition to an independent claim for a given process, the inclusion in the same international application of an independent claim for an apparatus or means specifically designed for carrying out the said process, or

(iii) In addition to an independent claim for a given product, the inclusion in the same international application of an independent claim for a process specially adapted for the manufacture of the product, and the inclusion in the same international application of an independent claim for an apparatus or means specifically designed for carrying out the process.

13.3 Claims of One and the Same Category

Subject to Rule 13.1, it shall be permitted to include in the same international application two or more independent claims of the same category (i.e., product, process, apparatus, or use) which cannot readily be covered by a single generic claim.

13.4 Dependent Claims

Subject to Rule 13.1, it shall be permitted to include in the same international application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention.

13.5 Utility Models

Any designated State in which the grant of a utility model is sought on the basis of an international application may, instead of Rules 13.1 to 13.4, apply in respect of the matters regulated in those Rules the provisions of its national law concerning utility models once the processing of the international application has started in that State, provided that the applicant shall be allowed at least two months from the expiration of the time limit applicable under Article 22 to adapt his application to the requirements of the said provisions of the national law.]

10. Section 1.476 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.476 Determination of unity of invention before the International Searching Authority.

(a) Before establishing the international search report, the International Searching Authority will determine whether the international application complies with the requirement of unity of invention as set forth in [PCT Rule 13 (see § 1.475(f)) and] § 1.475.

* * * * *

11. Section 1.480 is proposed to be amended by revising paragraph (b) to read as follows:

§ 1.480 Demand for international preliminary examination.

* * * * *

(b) The Demand shall be made on a standardized [printed] form. Copies of [the] printed Demand forms are available from the Patent and Trademark Office. Letters requesting printed >Demand< forms should be marked "Box PCT".

* * * * *

12. Section 1.482 is proposed to be amended by revising paragraphs (a)(2)(i) and (b) to read as follows:

§ 1.482 International preliminary examination fees.

(a) * * *

(2) * * *

(i) >Where the International Searching Authority for the international application was the United States Patent and Trademark Office< [Where a supplemental search fee as set forth in § 1.445(a)(3) has been paid on the international application to the United States Patent and Trademark Office as an International Searching Authority]—$140.00.

* * * * *

(b) The handling fee is due on filing the Demand. [Any necessary supplement to the handling fee shall be paid directly to the International Bureau.]

13. Section 1.484 is proposed to be amended by revising paragraph (b) to read as follows:

§ 1.484 Conduct of international preliminary examination.

* * * * *

(b) >International preliminary examination will begin promptly upon receipt of a Demand which requests examination based on the application as filed, or an amendment which has been received by the United States International Preliminary Examining Authority. Where a Demand requests examination based on an Article 19 amendment which has not been

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expiration of 20 months after the priority date. The payment of the surcharge set forth in § 1.492(e) is required for acceptance of the [basic national fee or the] oath or declaration of the inventor later than the expiration of 20 months after the priority date. >A copy of the notification mailed to applicant should accompany any response thereto submitted to the Office.<

(d) A copy of any amendments to the claims made under PCT Article 19, and a translation of those amendments into English, if they were made in another language, must be furnished not later than the expiration of 20 months from

the priority date. Amendments under PCT Article 19 which are not received by the expiration of 20 months from the priority date will be considered to be cancelled. >The 20-month time limit may not be extended.<

* * * * *

(g) [The time limits set out in paragraphs (b), (c) and (d) of this section may not be extended pursuant to § 1.136 or otherwise.

(h)] An international application becomes abandoned as to the United States 20 months from the priority date if >the requirements of paragraph (b) of this section have not been complied with within< [a copy of the international application is not communicated to the Patent and Trademark Office prior to] 20 months from the priority date where the United States has been designated but not elected prior to 19 months from the priority date. If >the requirements of paragraph (b) of this section are complied with< [a copy of the international application is communicated] within 20 months >from the priority date but the translation and/or the oath or declaration are not timely filed,< [to the Patent and Trademark Office,] an international application will become abandoned as to the United States >upon expiration of the time period set pursuant to paragraph (c) of this section.< [22 months from the priority date if the required English translation(s), fees and oath or declaration under 35 U.S.C. 371(c) are not filed within 22 months from the priority date.]

19. Section 1.495 is proposed to be amended by revising paragraphs (a), (b), (c), (d), (e), (h), and (i) to read as follows:

§ 1.495 Entering the national stage in the United States of America as an elected office.

(a) Where >the United States of America has been elected< [a Demand has been filed with an appropriate International Preliminary Examining Authority and not withdrawn] by the expiration of 19 months from the priority date, the applicant must fulfill the rquirements of 35 U.S.C. 371 within the time periods set forth in paragraphs (b) and (c) of this section in order to prevent the abandonment of the international application as to the United States of America. International applications for which those requirements are timely fulfilled will enter the national stage and obtain an examination as to the patentability of the invention in the United States of America.

(b) >To avoid abandonment of the application the< [The] applicant shall furnish to the United States Patent and Trademark Office not later than the expiration of 30 months from the priority date—

(1) a copy of the international application, unless it has been previously communicated by the International Bureau or unless it was originally filed in the United States Patent and Trademark Office;>and<

(2) [a translation of the international application into the English language, if it was originally filed in another language;

(3)] the basic national fee (see § 1.492(a)) [; and

(4) an oath or declaration of the inventor (see § 1.497)].

>The 30-month time limit may not be extended.<

(c) >If applicant complies with paragraph (b) this section before expiration of 30 months from the priority date but omits (1) a translation of the international application, as filed, into the English language, if it was originally filed in another language (35 U.S.C. 371(c)(2)) and/or (2) the oath or declaration of the inventor (35 U.S.C. 371(c)(4)); (see § 1.497), applicant will be so notified and given a period of time within which to file the translation and/or oath or declaration order to prevent abandonment of the application.< [The applicant may furnish any required English translation of the international application, the basic national fee and the oath or declaration of the inventor after 30 months but not later than the expiration of 32 months from the priority date.] The payment of the processing fee set forth in § 1.492(f) is required for acceptance of an English translation later than the expiration of 20 months after the priority date. The payment of the surcharge set forth in § 1.492(e) is required for acceptance of the [basic national fee or the] oath or declaration of the inventor later than the expiration of 30 months after the priority date. <A copy of the notification mailed to applicant should accompany any response thereto submitted to the Office.<

(d) A copy of any amendments to the claims made under PCT Article 19, and a translation of those amendments into English, if they were made in another language, must be furnished not later than the expiration of 30 months from the priority date. Amendments under PCT Article 19 which are not received by the expiration of 30 months from the priority date will be considered to be cancelled. >The 30-month time limit may not be extended.<

(e) A translation into English of any annexes to the international preliminary examination report, if the annexes were made in another language, must be furnished not later than the expiration of 30 months from the priority date. Translations of annexes which are not received by the expiration of 30 months from the priority date may be submitted within >any period set pursuant to paragraph (c) of this section< [32 months from the priority date] accompanied by the processing fee set forth in § 1.492(f). [Translations of the annexes] >Annexes for which translations< [which] are not timely received will be considered [to be] cancelled. >The 30-month time limit may not be extended.<

* * * * *

(h) [The time limits set out in paragraphs (b), (c), (d), and (e) of this section may not be extended pursuant to § 1.136 or otherwise.

(i)] An international application becomes abandoned as to the United States 30 months from the priority date if >the requirements of paragraph (b) of this section have not been complied with within< [a copy of the international application is not communicated to the Patent and Trademark Office prior to] 30 months from the priority date and >the United States has been elected< [a Demand for International Preliminary Examination which elected the United States of America has been filed] prior to the expiration of 19 months from the priority date. If >the requirements of paragraph (b) of this section are complied with< [a coy of the international application is communicated] within 30 months >from the priority date but the translation and/or the oath or declaration are not timely filed,< [to the Patent and Trademark Office,] an international application will become abandoned as to the United States >upon expiration of the time period set pursuant to paragraph (c) of this section.< [32 months from the priority date if the required English translation(s), fees and oath or declaration under 35 U.S.C. 371(c) are received, examination may begin at 20 months without receipt of an Article 19 amendment. Where a Demand requests examination based on an Article 34 amendment which has not been received, applicant will be notified and given a time period within which to submit the amendment. Examination will begin after the earliest of:

(1) receipt of the amendment;

(2) receipt of applicant's statement that no amendment will be made; or

(3) expiration of the time period set in

the notification.< No international preliminary examination report will be established prior to issuance of an international search report.

* * * * *

14. Section 1.485 is proposed to be revised to read as follows:

§ 1.485 Amendments by applicant during international preliminary examination.

(a) The applicant may make amendments at the time of filing of the Demand and within the time limit set by the International Preliminary Examining Authority for response to any >notification under § 1.484(b) or to any< written opinion. Any such amendments must—

(1) Be made by submitting a replacement sheet for every sheet of the application which differs from the sheet it replaces unless an entire sheet is cancelled >,< and

(2) Include a description of how the replacement sheet differs from the replaced sheet.

(b) If an amendment cancels an entire sheet of the international application, that amendment shall be communicated in a letter.

15. Section 1.487 is proposed to be removed:

§ 1.487 Unity of invention before the International Preliminary Examining Authority.

(a) An international application before the International Preliminary Examining Authority will be considered to have unity of invention if the claims are in accordance with PCT Rule 13 (see § 1.475(f)].

(b) An international application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the combinations of categories as set forth in PCT Rule 13.2 (see § 1.475(f)] or to the combination of

(1) a product and a process for the manufacture of said product or

(2) a product and a process of use of said product. If an application contains claims to more or less than one of the combinations of categories of invention set forth in PCT Rule 13.2 (see § 1.475(f)) or a combination set forth in paragraphs (b) (1) or (2) of this section, unity of invention may not be present.

(c) If an international application contains claims to a category of invention in addition to those categories included in any one of the combinations specified in paragraph (b) of this section, lack of unity of invention may be held between the categories included in the combination and the claims to the additional category of invention.

(d) Unity of invention will exist where the claims are limited to one of the combinations of categories set forth in PCT Rule 13.2 (see § 1.475(f)) or combination set forth in paragraphs (b)(1) or (2) of this section. If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the inventions to be examined. Any such holding by the examiner will be made of record as a holding of lack of unity of invention.

(e) The inventions recited by the claims of different categories must be related rather than independent inventions.]

16. Section 1.488 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.488 Determination of unity of invention before the International Preliminary Examining Authority.

(a) Before establishing any written opinion or the international preliminary examination report, the International Preliminary Examining Authority will determine whether the international application complies with the requirement of unity of invention as set forth in >§ 1.475< [§ 1.487].

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17. Section 1.492 is proposed to be amended by revising paragraph (e) to read as follows:

§ 1.492 National stage fees.

* * * * *

(e) Surcharge for filing the [basic national fee or] oath or declaration later than 20 months from the priority date pursuant to § 1.494(c) or later than 30 months from the priority date pursuant to § 1.495(c):

By a small entity (§ 1.9(f).....$85.00
By other than a small entity.....$130.00

* * * * *

18. Section 1.494 is proposed to be amended by revising paragraphs (a), (b), (c), (d), (g), and (h) to read as follows:

§ 1.494 Entering the national stage in the United States of America as a Designated Office.

(a) Where >the United States of America has not been elected< [no Demand has been filed with an appropriate International preliminary Examining Authority] by the expiration of 19 months from the priority date (see § 1.495), the applicant must fulfill the requirements of PCT Article 22 and 35 U.S.C. 371 within the time periods set forth in paragraphs (b) and (c) of this section in order to prevent the abandonment of the international application as to the United States of America. International applications for which those requirements are timely fulfilled will enter the national stage and obtain an examination as to the patentability of the invention in the United States of America.

(b) >To avoid abandonment of the application, the< [The] applicant shall furnish to the United States Patent and Trademark Office not later than the expiration of 20 months from the priority date—

(1) a copy of the international application, unless it has been previously communicated by the International Bureau or unless it was originally filed in the United States Patent and Trademark Office; >and<

(2) [a translation of the international application into the English language, if it was originally filed in another language;

(3)] the basic national fee (see § 1.492(a)) [; and

(4) an oath or declaration of the inventor (see § 1.497)].

>The 20-month time limit may not be extended.<

(c) >If applicant complies with paragraph (b) of this section before expiration of 20 months from the priority date but omits (1) a translation of the international application as filed into the English language, if it was originally filed in another language (35 U.S.C. 371(c)(2)) and/or (2) the oath or declaration of the inventor (35 U.S.C. 371(c)(4); see § 1.497), applicant will be so notified and given a period of time within which to file the translation and/or oath or declaration in order to prevent abandonment of the application.< [The applicant may furnish any required English translation of the international application, the basic national fee and the oath or declaration of the inventor after 20 months but not later than the expiration of 22 months from the priority date.] The payment of the processing fee set forth in § 1.492(f) is required for acceptance of an English translation later than the

not filed within 32 months from the priority date.]

20. Section 1.499 is proposed to be revised to read as follows:

§ 1.499 Unity of invention during the national stage.

[(a) An international application which has entered the national stage by meeting the requirements of 35 U.S.C.

371 will be considered to have unity of invention if the claims are in accordance with PCT Rule 13 (see § 1.475(f)).

(b) An application in the national stage containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the combinations of categories as set forth in PCT Rule 13.2 (see § 1.475(f)) or to the combination of—

(1) A product and a process for the manufacture of said product or

(2) A product and a process of use of said product. If an application contains claims to more or less than one of the combinations of categories of invention set forth in PCT Rule 13.2 (see § 1.475(f)) or a combination set forth in paragraphs (b)(1) and (2) of this section, unity of invention may not be present.

(c) If an application in the national stage contains claims to a category of invention in addition to those categories included in any one of the combinations specified in paragraph (b) of this section, lack of unity of invention may be held between the categories included in the combination and the claims to the additional category of invention.

(d) Unity of invention will exist in an application in the national stage where the claims are limited to one of the combinations of categories set forth in PCT Rule 13.2 (see § 1.475(f)) or a combination set forth in paragraphs (b)(1) or (2) of this section. If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the elected invention to be examined. Any such holding of an election by the examiner will be made in the form of a restriction requirement which confirms the election made by the presentation of claims. Such a restriction requirement would be made on the basis of whether the inventions are independent and distinct. Applicant has the right to traverse such a restriction requirement in the response to the Office action in which the election is indicated.

(e) The inventions recited by the claims of different categories must re related rather than independent inventions.

(f)] If the examiner finds that a national stage application lacks unity of invention >under § 1.475<, the examiner may in an Office action require the applicant in the response to that Office action to elect the invention to which the claims shall be restricted, this official action being called a requirement for restriction. Such requirement may be made before any action on the merits but may be made at any time before the final action at the discretion of the examiner. Review of any such requirement is provided under §§ 1.143 and 1.144.

21. Section 1.821 is proposed to be amended by revising paragraph (h) to read as follows:

§ 1.821 Nucleotide and/or amino acid sequence disclosures in patent applications.

* * * * *

(h) If any of the requirements of paragraphs (b) through (f) of this section are not satisfied at the time of filing, in the United States Receiving Office, an international application under the Patent Cooperation Treaty (PCT), applicant has one month from the date of a notice which will be sent requiring compliance with the requirements, or such other time as may be set by the Commissioner, in which to comply. Any submission in response to a requirement under this paragraph must be accompanied by a statement that the submission does not include new matter or go beyond the disclosure in the international application as filed. Such a statement must be a verified statement if made by a person not registered to practice before the Office. >If applicant fails to timely provide the required computer readable form, the United States International Searching Authority shall search only to the extent that a meaningful search can be performed.<

* * * * *

22. The authority citation for 37 CFR part 10 would continue to read as follows:

Authority: 5 U.S.C. 500; 15 U.S.C. 1123; 35 U.S.C. 6, 31, 32, 41.

23. Section 10.9 is proposed to be amended by adding new paragraph (c) to read as follows:

§ 10.9 Limited recognition in patent cases.

* * * * *

>(c) An individual not registered under § 10.6 may prosecute an international application only before the U.S. International Searching Authority and the U.S. International Preliminary Examining Authority, provided: the individual has the right to practice before the national office with which the international application is filed (PCT Art. 49, Rule 90 and § 1.455).<

Dated: June 24, 1992.

Douglas B. Comer,

Acting Assistant Secretary and Acting Commissioner of Patents and Trademarks.