

**PART 165—[AMENDED]**

1. The authority citation for Part 165 continues to read as follows:

**Authority:** 33 U.S.C. 1231; 50 U.S.C. 191; 49 CFR 1.46 and 33 CFR 1.05–1(g), 6.04–1, 6.04–6, and 160.5.

2. Temporary 165.T07–013 is added to read as follows:

**165.T07–013 Safety Zone; San Juan, Puerto Rico.**

(a) *Regulated Area.* A temporary fixed safety zone is established within a 500 yard radius surrounding the M/V SERGO ZAKARIADZE which is grounded at the entrance to San Juan Harbor in position 18°28'3"N, 066°07'5"W.

(b) *Regulations.* In accordance with the general regulations in 165.23 of this part, anchoring, mooring or transiting in this zone is prohibited unless authorized by the Coast Guard Captain of the Port.

(c) *Dates.* These regulations become effective and terminate upon a broadcast notice to mariners issued by the Captain of the Port San Juan during the period from 7 a.m. on March 1, 2000, to 7 a.m. on March 22, 2000.

Dated: February 29, 2000.

**J. Servidio,**

*Commander, U.S. Coast Guard, Captain of the Port, San Juan, Puerto Rico.*

[FR Doc. 00–6684 Filed 3–17–00; 8:45 am]

**BILLING CODE 4910–15–M**

**DEPARTMENT OF COMMERCE****Patent and Trademark Office****37 CFR Part 1**

[Docket No. 000301056–0056–01]

RIN 0651–AB13

**Changes to Application Examination and Provisional Application Practice**

**AGENCY:** United States Patent and Trademark Office, Commerce.

**ACTION:** Interim rule.

**SUMMARY:** The United States Patent and Trademark Office (Office) is revising the rules of practice in patent cases to implement certain provisions of the “American Inventors Protection Act of 1999.” These provisions of the “American Inventors Protection Act of 1999” provide for continued examination of an application for a fee, extend the pendency of a provisional application if the date that is twelve months after the filing date of the provisional application falls on a Saturday, Sunday, or a Federal holiday

within the District of Columbia, eliminate the copendency requirement for a nonprovisional application to claim the benefit of a provisional application, provide for the conversion of a provisional application to a nonprovisional application, and to provide a prior art exclusion for certain commonly assigned patents.

**DATES:** Effective Date: May 29, 2000.

**COMMENTS:** To be ensured of consideration, written comments must be received on or before May 19, 2000. No public hearing will be held.

**ADDRESSES:** Comments should be sent by electronic mail message over the Internet addressed to:

rc.comments@uspto.gov. Comments may also be submitted by mail addressed to: Box Comments—Patents, Assistant Commissioner for Patents, Washington, D.C. 20231, or by facsimile to (703) 872–9411, marked to the attention of Robert W. Bahr. Although comments may be submitted by mail or facsimile, the Office prefers to receive comments via the Internet. If comments are submitted by mail, the Office would prefer that the comments be submitted on a DOS formatted 3½ inch disk accompanied by a paper copy.

The comments will be available for public inspection at the Special Program Law Office, Office of the Deputy Assistant Commissioner for Patent Policy and Projects, located at Room 3-C23 of Crystal Plaza 4, 2201 South Clark Place, Arlington, Virginia, and will be available through anonymous file transfer protocol (ftp) via the Internet (address: <http://www.uspto.gov>). Since comments will be made available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included in the comments.

**FOR FURTHER INFORMATION CONTACT:**

Robert W. Bahr, Karin L. Tyson, or Robert A. Clarke by telephone at (703) 308–6906, or by mail addressed to: Box Comments—Patents, Assistant Commissioner for Patents, Washington, DC 20231, or by facsimile to (703) 872–9411, marked to the attention of Robert W. Bahr.

**SUPPLEMENTARY INFORMATION:** The “American Inventors Protection Act of 1999” (Title IV of the “Intellectual Property and Communications Omnibus Reform Act of 1999” (S. 1948) as introduced in the 106th Congress on November 17, 1999) was incorporated and enacted into law on November 29, 1999, by § 1000(a)(9), Division B, of Public Law 106–113, 113 Stat. 1501 (1999). The “American Inventors Protection Act of 1999” contains a number of changes to title 35, United

States Code. This interim rule changes the rules of practice to implement the provisions of §§ 4403, 4801, and 4807 of the “American Inventors Protection Act of 1999.”

Section 4403 of the “American Inventors Protection Act of 1999” is effective on the date six months after the date of enactment of the “American Inventors Protection Act of 1999” (May 29, 2000), and applies to applications (other than for a design patent) filed on or after June 8, 1995. Section 4801 of the “American Inventors Protection Act of 1999” is effective on the date of enactment of the “American Inventors Protection Act of 1999” (November 29, 1999) and applies to all provisional applications (with limited exception) filed on or after June 8, 1995. Section 4807 of the “American Inventors Protection Act of 1999” is effective on the date of enactment of the “American Inventors Protection Act of 1999” (November 29, 1999) and applies to all applications filed on or after November 29, 1999.

*Section 4403 (Continued Examination of Patent Applications):* Section 4403 of the “American Inventors Protection Act of 1999” amends 35 U.S.C. 132 to state that the Office “shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant,” and that the Office “may establish appropriate fees for such continued examinations and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under [35 U.S.C. 41(h)(1)].” Currently, an applicant must file a continuing application (a continuing application under § 1.53(b) or a continued prosecution application under § 1.53(d)) to obtain continued examination of an application for a fee (the application filing fee). Section 4403 of the “American Inventors Protection Act of 1999” will provide statutory authority for the continued examination of an application for a fee (to which the small entity reduction will be applicable) without requiring the applicant to file a continuing application.

*Section 4801 (Provisional Applications):* Section 4801(a) of the “American Inventors Protection Act of 1999” amends 35 U.S.C. 111(b)(5) to provide that “[n]otwithstanding the absence of a claim, upon timely request and as prescribed by the Director, a provisional application may be treated as an application filed under [35 U.S.C. 111(a)]” but that if “no such request is made, the provisional application shall be regarded as abandoned 12 months after the filing date of such application and shall not be subject to revival

thereafter.” Section 1.53(c), which currently provides for the conversion of a nonprovisional application (35 U.S.C. 111(a) and § 1.53(b)) to a provisional application (35 U.S.C. 111(b) and § 1.53(c)), is thus being amended to also provide for the conversion of a provisional application (35 U.S.C. 111(b) and § 1.53(c)) to a nonprovisional application (35 U.S.C. 111(a) and § 1.53(b)).

Section 4801 of the “American Inventors Protection Act of 1999” contains no provision for according the resulting nonprovisional application a filing date other than the original filing date of the provisional application. Thus, under 35 U.S.C. 154(b), the term of a nonprovisional application resulting from the conversion of a provisional application pursuant to 35 U.S.C. 111(b)(5) will be measured from the original filing date of the provisional application (which is the filing date accorded the nonprovisional application resulting from conversion under § 4801 of the “American Inventors Protection Act of 1999”). Applicants are strongly cautioned to consider the patent term implications of converting a provisional application into a nonprovisional application pursuant to 35 U.S.C. 111(b)(5), rather than simply filing a nonprovisional application within twelve months of the filing date of the provisional application and claiming the benefit of that provisional application under 35 U.S.C. 119(e).

Section 4801(b) of the “American Inventors Protection Act of 1999” also amends 35 U.S.C. 119(e) to provide that “[i]f the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day.”

Section 4801(c) of the “American Inventors Protection Act of 1999” also amends 35 U.S.C. 119(e) to eliminate the requirement that a provisional application be pending on the filing date of the nonprovisional application for the nonprovisional application to claim the benefit of the provisional application.

*Section 4807 (Prior Art Exclusion):* 35 U.S.C. 103 was amended in 1984 to exclude subject matter developed by another person which qualifies as prior art only under 35 U.S.C. 102(f) or (g) as prior art under 35 U.S.C. 103 against a claimed invention, provided that the subject matter and the claimed invention were commonly owned by the same person or organization or subject to an obligation of assignment to the

same person or organization at the time the claimed invention was made. *See* Public Law 98–622, § 103, 98 Stat. 3384 (1984). Section 4807 of the “American Inventors Protection Act of 1999” amends 35 U.S.C. 103(c) to exclude subject matter developed by another person which qualifies as prior art only under one or more of 35 U.S.C. 102(e), (f), or (g) as prior art under 35 U.S.C. 103 against a claimed invention, again provided that the subject matter and the claimed invention were commonly owned by the same person or organization or subject to an obligation of assignment to the same person or organization at the time the claimed invention was made. The Office is in the process of developing guidelines concerning the implementation of this change to 35 U.S.C. 103(c).

#### Discussion of Specific Rules

Title 37 of the Code of Federal Regulations, Part 1, is amended as follows:

Section 1.7 is amended by designating the current text as paragraph (a) and adding a new paragraph (b) to provide that if the day that is twelve months after the filing date of a provisional application under 35 U.S.C. 111(b) and § 1.53(c) falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the period of pendency shall be extended to the next succeeding secular or business day which is not a Saturday, Sunday, or a Federal holiday.

Section 1.17(e) sets forth the fee to request continued examination pursuant to new § 1.114, which is set at an amount equal to the basic filing fee for a utility application. Therefore, the fee for considering a submission pursuant to § 1.114 is \$690.00 (\$345.00 for a small entity).

Section 1.17(i) is amended to include a reference to the fee to convert a provisional application filed under § 1.53(c) to a nonprovisional application under § 1.53(b), and to eliminate the reference to § 1.312.

Section 1.53 is amended by redesignating paragraph (c)(3) as paragraph (c)(4) and adding a new paragraph (c)(3) to provide for the conversion of a provisional application to a nonprovisional application. Section 1.53(c)(3) provides that a request to convert a provisional application filed under § 1.53(c) to a nonprovisional application under § 1.53(b) must be accompanied by the fee set forth in § 1.17(i) and an amendment including at least one claim as prescribed by the second paragraph of 35 U.S.C. 112, unless the provisional application otherwise contains at least one claim. Section 1.53(c)(3) also provides that

such a request must be filed prior to the earliest of: (1) abandonment of the provisional application; or (2) expiration of twelve months after the filing date of the provisional application. Section 1.53(c)(3) also provides that the conversion of a provisional application to a nonprovisional application will not result in either the refund of any fee properly paid in the provisional application or the application of any such fee to the filing fee, or any other fee, for the nonprovisional application.

The conversion of a provisional application to a nonprovisional application will not result in any savings in filing fees over the filing of a nonprovisional application claiming the benefit under 35 U.S.C. 119(e) and § 1.78 of the earlier provisional application. Thus, an applicant may simply file a nonprovisional application claiming the benefit under 35 U.S.C. 119(e) and § 1.78 of the earlier provisional application and avoid the fee set forth in § 1.17(i) required to convert a provisional application to a nonprovisional application (as well as the adverse patent term effects discussed above).

Section 1.53(d)(1)(i) is amended to provide that continued prosecution application (CPA) practice under § 1.53(d) does not apply to applications (other than design) if the prior application has a filing date on or after May 29, 2000. Thus, an application (except for a design application) must have an actual filing date before May 29, 2000, for the applicant to be able to file a CPA of that application. While the Office uses the filing date (and application number) of the prior application of a CPA for identification purposes, the filing date of a CPA under § 1.53(d) is the date the request for a CPA is filed. *See* § 1.53(d)(2). Thus, if a CPA of an application (other than for a design patent) is filed on or after May 29, 2000, § 1.53(d)(1)(i) does not permit the filing of a further CPA, regardless of the filing date of the prior application as to the first CPA (*i.e.*, the filing date used for identification purposes for the CPA).

In the event that an applicant files a request for a CPA of a utility or plant application that was filed on or after May 29, 2000 (to which CPA practice no longer applies), the Office will automatically treat the improper CPA as a request for continued examination of the prior application (identified in the request for CPA) under new § 1.114. If an applicant files a request for a CPA of an application to which CPA practice no longer applies and does not want the request for a CPA to be treated as a request for continued examination

under § 1.114 (e.g., the CPA is a divisional CPA), the applicant may file a petition under § 1.53(e) requesting that the improper CPA be converted to an application under § 1.53(b). The requirements for such a petition under § 1.53(e) are identical to those set forth in section 201.06(b) of the Manual of Patent Examining Procedure (7th ed.1998) (MPEP) for converting an improper file wrapper continuing (FWC) application under former § 1.62 to an application under § 1.53(b). The Office will not grant such a petition unless it is before the appropriate deciding official before an Office action has been mailed in response to the request for continued examination under § 1.114 (as the improper CPA is being treated). If an Office action has been mailed in response to the request for continued examination under § 1.114, the applicant should simply file an application under § 1.53(b) within the period for reply to such Office action.

Section 1.53(d)(1)(ii)(A) is amended to refer to “§ 1.313(c)” rather than “§ 1.313(b)(5)” for consistency with the change to § 1.313.

Section 1.78 is amended to eliminate the requirement that a nonprovisional application be “copending” with a provisional application for the nonprovisional application to claim the benefit under 35 U.S.C. 119(e) of a provisional application. Section 1.78 is also amended to require that, for a nonprovisional application to claim the benefit of a provisional application, the provisional application must be entitled to a filing date as set forth in § 1.53(c), and have paid therein the basic filing fee set forth in § 1.16(k) within the time period set forth in § 1.53(g), and have any required English-language translation filed therein within the time period set forth in § 1.52(d).

Section 1.97(b) is amended to indicate that an information disclosure statement will also be considered if it is filed before the mailing of a first Office action after the filing of a request for continued examination under § 1.114.

Section 1.104(c)(4) is revised to replace “35 U.S.C. 102(f) or (g)” with “35 U.S.C. 102(e), (f) or (g)” for consistency with 35 U.S.C. 103(c) as amended by § 4807 of the “American Inventors Protection Act of 1999.”

Section 1.113 is amended to take into account that an applicant’s after final reply options include filing a request for continued examination under § 1.114. Section 1.113 is also amended to locate the last two sentences of paragraph (a) in a new paragraph (c).

Section 1.114 is added to implement § 4403 of the “American Inventors Protection Act of 1999.” The Office is

providing a procedure under which an applicant may obtain continued examination of an application by filing a submission and paying a specified fee, even if the application is under a final rejection, appeal, or a notice of allowance. If a subsequent rejection or action is made final (or if the application is subsequently allowed), the applicant may again obtain continued examination of an application (consideration of a submission) upon the filing of a submission and an additional payment of the specified fee prior to abandonment of the application. This procedure will not be available for: (1) a provisional application (which is not examined under 35 U.S.C. chapter 12); (2) an application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995; (3) an international application filed under 35 U.S.C. 363 before June 8, 1995; (4) an application for a design patent; or (5) a patent under reexamination.

Under this procedure, the filing of a request for continued examination after the filing of a Notice of Appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal, will be considered a request to withdraw the appeal and to reopen prosecution of the application before the examiner. The filing of a request for continued examination (accompanied by the fee and a submission) after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit (Federal Circuit) or the commencement of a civil action, will also result in the finality of the rejection or action being withdrawn and the submission being considered.

In addition to the *res judicata* effect of a Board of Patent Appeals and Interferences decision in an application (see MPEP 706.03(w)), a Board of Patent Appeals and Interferences decision in an application is the “law of the case,” and is thus controlling in that application and any subsequent related application. See MPEP 1214.01 (where a new ground of rejection is entered by the Board of Patent Appeals and Interferences pursuant to § 1.196(b), argument without either amendment of the claims so rejected or the submission of a showing of facts can only result in a final rejection of the claims, since the examiner is without authority to allow the claims unless amended or unless the rejection is overcome by a showing of facts not before the Board of Patent Appeals and Interferences). As such, a submission containing arguments without either amendment of the rejected claims or the submission of a

showing of facts will not be effective to remove such rejection.

The procedure set forth in § 1.114 will not be available in an application after the filing of a Notice of Appeal to the Federal Circuit or the commencement of a civil action, unless the appeal or civil action is terminated and the application is still pending. Unless an application contains allowed claims (or the court’s mandate clearly indicates that further action is to be taken in the Office), the termination of an unsuccessful court appeal or civil action results in the abandonment of the application. See MPEP 1216.01.

If the application is under final rejection, the fee acts only to withdraw the finality of an Office action. If reply to a final or non-final Office action is outstanding, a submission meeting the reply requirements of § 1.111 must be timely received to continue prosecution of an application. Put simply, the mere payment of the fee for continued examination will not operate to toll the running of any time period set in the previous Office action for reply to avoid abandonment of the application. Likewise, payment of the fee (and a submission) in an allowed application without a petition under § 1.313 to withdraw the application from issue will not operate to toll the period for payment of the issue fee (if running) or avoid issuance of the application as a patent (if the issue fee has been paid).

To avoid confusion as to whether an applicant desires to amend the application prior to receiving continued examination of the application, an appeal brief under § 1.192 or a reply brief under § 1.193(b), or related submissions, are expressly excluded as a submission for the purposes of § 1.114. The submission, however, may consist of the arguments in a previously filed appeal brief or reply brief submitted as a reply to the final rejection, or may simply consist of a submission that incorporates by reference the arguments in a previously filed appeal brief or reply brief.

35 U.S.C. 132 provides that “[n]o amendment shall introduce new matter into the disclosure of the invention.” Any amendment entered pursuant to § 1.114 that is determined to contain new matter will be treated in the same manner that a reply under § 1.111 determined to contain new matter is currently treated. In those instances in which an applicant seeks to add new matter to the disclosure of an application, the procedure in § 1.114 is not available, and the applicant must file a continuation-in-part application under § 1.53(b) containing such new matter. In addition, as 35 U.S.C. 132(b)

and § 1.114 provide continued examination of an application (and not examination of a continuing application), the Office will not permit an applicant to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined (*see* § 1.145).

The request for continued examination procedure in § 1.114 should not be confused with the transitional procedure for the further limited examination of patent applications set forth in § 1.129(a) (*see Changes to Implement 20-Year Patent Term and Provisional Applications*, Final Rule Notice, 60 FR 20195 (April 25, 1995), 1174 *Off. Gaz. Pat. Office* 15 (May 2, 1995)) or the continued prosecution application (CPA) procedure set forth in § 1.53(d) (*see Changes to Patent Practice and Procedure*; Final Rule Notice, 62 FR 53131 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* 63 (October 21, 1997)).

*Comparison of the request for continued examination procedure in § 1.114 with the transitional procedure for the further limited examination of patent application set forth in § 1.129(a):* The procedure set forth in this notice does not apply to any application that was filed prior to June 8, 1995. The transitional procedure set forth in § 1.129(a) applies only to applications, other than for reissue or design patent, that have been pending for at least two years as of June 8, 1995, taking into account any references in such applications to any earlier filed application under 35 U.S.C. 120, 121, or 365(c), and is not applicable to any application filed after June 8, 1995. Therefore, an application eligible for the transitional procedure set forth in § 1.129(a) (unless filed on June 8, 1995), or any application filed before June 8, 1995, is not eligible for the procedure for continued examination set forth in this notice.

In addition, an applicant in an application eligible for the procedure for continued examination set forth in this notice is not limited in the number of times the fee for continued examination may be submitted. An applicant in an application eligible for the transitional procedure set forth in § 1.129(a), however, is limited to two opportunities to pay the fee for further examination of the application.

Moreover, under the transitional procedure set forth in § 1.129(a), a submission after final rejection or action will be considered if the submission and the requisite fee are filed prior to abandonment of the application and prior to the filing of an appeal brief.

Under the request for continued examination procedure set forth in this notice, a submission will be considered if the submission and the requisite fee is filed prior to abandonment of the application. That is, under the request for continued examination procedure, a submission (and requisite fee) need not be filed prior to the filing of an appeal brief. In addition, under the request for continued examination procedure, a submission will be considered in an allowed application if the submission and the requisite fee are filed prior to payment of the issue fee (or later if a petition under § 1.313(c) to withdraw the application from issue is granted).

*Comparison of the request for continued examination procedure in § 1.114 with the CPA procedure set forth in § 1.53(d):* Section 1.53(d) is amended to make CPA practice inapplicable to applications (other than for a design patent) filed under 35 U.S.C. 111(a) on or after May 29, 2000, or resulting from international applications filed under 35 U.S.C. 363 on or after May 29, 2000. CPA practice was adopted to permit applicants to obtain continued examination of an application (for a fee) via the filing of a continuing application. 35 U.S.C. 132(b), however, provides statutory authority for the Office to prescribe regulations to permit applicants to obtain continued examination of an application (for a fee) without the need for a continuing application. The Office is not completely abolishing CPA practice in favor of the request for continued examination practice in § 1.114 because the request for continued examination practice in § 1.114 is not applicable to applications filed before June 8, 1995 (or design applications), and the patent term adjustment provisions of Public Law 106-113 do not apply to applications filed before May 29, 2000. The Office, however, is restricting CPA practice to utility and plant applications filed before May 29, 2000, and design applications because maintaining two practices (as to applications eligible for the continued examination procedure of § 1.114) designed for the same purpose (obtaining continued examination of an application) is unnecessary and will result in confusion.

Since the request for continued examination practice in § 1.114 is applicable to utility and plant applications filed on or after June 8, 1995, and continued prosecution application (CPA) practice in § 1.53(d) is applicable to utility and plant applications filed before May 29, 2000 (and design applications), an applicant in a utility or plant application filed on or after June 8, 1995, but before May 29,

2000, may obtain further examination either by filing a request for continued examination under § 1.114 or by filing a CPA under § 1.53(d). Since the patent term adjustment provisions of Public Law 106-113 do not apply to applications filed before May 29, 2000, and a request for continued examination practice under § 1.114 (unlike a CPA under § 1.53(d)) is not the filing of a new application, whether further examination of such an application is sought by a request for continued examination under § 1.114 or a CPA under § 1.53(d) has an impact on whether any resulting patent is entitled to the patent term adjustment provisions of Public Law 106-113. Specifically, if an applicant in a utility or plant application filed before May 29, 2000 files a CPA under § 1.53(d) after May 29, 2000, the application being prosecuted (now a CPA) is an application filed on or after May 29, 2000 and is entitled to the patent term adjustment provisions of Public Law 106-113. If, however, an applicant in a utility or plant application filed before May 29, 2000 (but on or after June 8, 1995) files a request for continued examination under § 1.114, the application being prosecuted is not an application filed on or after May 29, 2000, and is not entitled to the patent term adjustment provisions of Public Law 106-113.

In addition, there are a number of additional differences between request for continued examination procedure set forth in this notice with the CPA procedure set forth in § 1.53(d) resulting from the fact that a CPA is the filing of a new application whereas continued examination under § 1.114 merely continues the examination of the same application: (1) the fee for continued examination under § 1.114 (§ 1.17(e)) does not include additional claims fees (*cf.* 1.53(d)(3)(ii)); (2) the fee for continued examination under § 1.114 may not be deferred (*cf.* § 1.53(f)); (3) a request for continued examination under § 1.114 is entitled to the benefit of a certificate of mailing under § 1.8 (*cf.* 1.8(a)(2)(i)(A)); (4) an applicant may not obtain examination of a different or non-elected invention (*e.g.*, a divisional) in a request for continued examination under § 1.114; and (5) any change of inventors must be via the procedure set forth in § 1.48 (*cf.* 1.53(d)(4)).

*Discussion of the specific provisions of new § 1.114:* Section 1.114 is added to provide for continued examination of an application under 35 U.S.C. 132(b).

Section 1.114(a) provides that an applicant may obtain continued examination of an application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of: (1)

payment of the issue fee, unless a petition under § 1.313 is granted; (2) abandonment of the application; or (3) the filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated. The action immediately subsequent to the filing of a submission and fee under § 1.114 may be made final only if the conditions set forth in MPEP 706.07(b) for making a first action final in a continuing application are met.

Section 1.114(b) provides that a submission as used in § 1.114 includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. This definition in § 1.114 for "submission" is taken from § 1.129(a). Section 1.114(b) also provides that if reply to a final or non-final Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111. This will permit applicants to file a submission under § 1.114 containing only an information disclosure statement (§§ 1.97 and 1.98) in an application subject to a notice of allowance under 35 U.S.C. 151.

Section 1.114(c) provides that if an applicant timely files the fee set forth in § 1.17(e) and a submission, the Office will withdraw the finality of any Office action to which a reply is outstanding and the submission will be entered and considered. The phrase "withdraw the finality of any Office action" includes the withdrawal of the finality of a final rejection, as well as the closing of prosecution by an Office action under *Ex parte Quayle*, 1935 Comm'r Dec. 11 (1935), or notice of allowance under 35 U.S.C. 151 (or notice of allowability). Section 1.114(c) also provides that if an applicant files a request for continued examination under § 1.114 after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. Thus, the filing of a request for continued examination under § 1.114 in an application containing an appeal awaiting decision after appeal will be treated as a withdrawal of the appeal by the applicant, regardless of whether the request for continued examination under § 1.114 includes the appropriate fee (§ 1.17(e)) or a submission (§ 1.114(b)). Applicants should advise the Board of Patent Appeals and Interferences when a request for continued examination under § 1.114 is

filed in an application containing an appeal awaiting decision. Otherwise, the Board of Patent Appeals and Interferences may refuse to vacate a decision rendered after the filing (but before recognition by the Office) of a request for continued examination under § 1.114. Section 1.114(c) also provides that an appeal brief or a reply brief (or related papers) will not be considered submission under § 1.114 (discussed above).

Section 1.114(d) provides that an applicant cannot request continued examination of an application until after the Office acts on the application by mailing at least one of an Office action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151. Section 1.114(d) also provides that the request for continued examination provisions of § 1.114 do not apply to: (1) a provisional application; (2) an application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995; (3) an international application filed under 35 U.S.C. 363 before June 8, 1995; (4) an application for a design patent; or (5) a patent under reexamination.

Section 1.116 is amended to add a paragraph (a) that takes into account that an applicant's after final amendment options include filing a request for continued examination under § 1.114, and to redesignate existing paragraphs (a), (b), and (c) as paragraphs (b), (c), and (d), respectively.

Section 1.198 is amended to take into account that an application in which an appeal has been decided by the Board of Patent Appeals and Interferences may also be reopened under the request for continued examination provisions of § 1.114.

Section 1.312 is amended based upon previously proposed changes to that section. *See Changes to Implement the Patent Business Goals*, Notice of Proposed Rulemaking, 64 FR 53772, 53810, 53838 (October 4, 1999), 1228 *Off. Gaz. Pat. Office* 15, 49, 76 (November 2, 1999). These changes are being adopted in this interim rule because of the overlap between the continued examination provisions of new § 1.114 and the withdrawal from issue provisions of § 1.313 (which in turn overlaps with the provisions of § 1.312).

The Office proposed changing § 1.312 to provide that any amendment filed after the date the issue fee is paid must be accompanied by: (1) A petition under § 1.313(c)(1) to withdraw the application from issue; (2) an unequivocal statement that one or more claims are unpatentable; and (3) an explanation as to how the amendment is necessary to render such claim or claims

patentable. The Office is adopting this change to § 1.312 by clarifying that an amendment under § 1.312 (after allowance) must be filed prior to or with payment of the issue fee, and eliminating § 1.312(b) (since the provisions of proposed § 1.312(b) are duplicative of the provisions of proposed and adopted § 1.313(c)(1)).

Section 1.313 is amended to provide that an application may also be withdrawn from issue after payment of the issue fee on petition by the applicant for consideration of a submission pursuant to § 1.114. Section 1.313, as amended, also adopts previously proposed changes to that section. *See Changes to Implement the Patent Business Goals*, 64 FR at 53810-11, 53838-39, 1228 *Off. Gaz. Pat. Office* at 49-50, 76-77.

Of the comments submitted in response to that notice of proposed rulemaking, three comments addressed the proposed changes to §§ 1.312 and 1.313.

*Comment (1):* One comment addressing the proposed change to § 1.313 favored the proposed change to § 1.313, but suggested that § 1.313(c) and § 1.53(d) be amended to clarify that an application may be withdrawn from issue after payment of the issue fee for express abandonment in favor of a continued prosecution application (CPA) under § 1.53(d). The comment also suggested that the Office provide a notice of rule change to accompany the notice of allowance for some time after adoption of the change to provide further notice to the public of the rule change.

*Response:* Section 1.53(d)(1)(ii)(A) as amended provides that a CPA under § 1.53(d) must be filed prior to payment of the issue fee on the prior application unless a petition under § 1.313(c) is granted in the prior application. Since a CPA under § 1.53(d) is a continuing application, there is no need to amend § 1.313(c) to specifically refer to a CPA. Specifically referring to a CPA under § 1.53(d) in § 1.313(c) may result in confusion because: (1) An application may be withdrawn from issue after payment of the issue fee for express abandonment (without the filing of any type of continuing application); (2) an application may also be withdrawn from issue after payment of the issue fee for express abandonment in favor of a continuing application under § 1.53(b); and (3) an application may be withdrawn from issue after payment of the issue fee for continued examination under § 1.114 (if eligible for that practice). The suggestion concerning the notice of rule change will be taken into account in preparing training materials

related to the implementation of the rule changes related to the Patent Business Goals and the "American Inventors Protection Act of 1999."

*Comment (2):* Two comments addressing the proposed change to § 1.313 suggested that the conditions under which an applicant could withdraw an application from issue after payment of the issue fee was too limited, and that § 1.313 should not preclude a request to withdraw an application from issue when reasonably efficient processing could prevent the patent from issuing without having some important matter considered.

*Response:* The Office must limit withdrawal from issue after payment of the issue fee (at applicant's initiative) to those conditions specified in § 1.313(c) due to changes to the patent printing process, which will dramatically reduce the period between the date of issue fee payment and the date a patent is issued. An applicant who must have an important matter considered by the Office before a patent is issued must file a petition under § 1.313(c) to withdraw the application from issue to have such matter considered during continued examination under § 1.114 (if eligible) or in a continuing application, unless the applicant can meet the conditions specified in § 1.313(c)(1).

The Office cannot ensure that any petition under § 1.313(c) will be acted upon prior to the date of patent grant. See *Filing of Continuing Applications, Amendments, or Petitions after Payment of Issue Fee*, Notice, 1221 *Off. Gaz. Pat. Office* 14 (April 6, 1999). Since a request for continued examination under § 1.114 (unlike a CPA under § 1.53(d)) is not any type of new application filing, the Office cannot grant a petition to convert an untimely request for continued examination under § 1.114 to a continuing application under § 1.53(b). Therefore, applicants are strongly cautioned to file any desired request for continued examination under § 1.114 prior to payment of the issue fee. In addition, applicants considering filing a request for continued examination under § 1.114 after payment of the issue fee are strongly cautioned to call the Office of Petitions to determine whether sufficient time remains before the patent issue date to consider (and grant) a petition under § 1.313(c) and what steps are needed to ensure that a grantable petition under § 1.313(c) is before an appropriate official in the Office of Petitions in sufficient time to grant the petition before the patent is issued. Finally, applicants filing a request for continued examination under § 1.114 after allowance but prior to payment of

the issue fee are cautioned against subsequently paying the issue fee because doing so may result in the prompt issuance of a patent.

#### Classification

##### *Administrative Procedure Act*

The changes in this interim rule concern only the manner by which an applicant obtains continued examination of a nonprovisional application, requests conversion of a provisional application into a nonprovisional application, or claims the benefit of a provisional application, as provided for in §§ 4403 and 4801 of the "American Inventors Protection Act of 1999" (Title IV of S. 1948, incorporated into Pub. L. 106-113). Therefore, prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553(b)(A), or any other law.

##### *Regulatory Flexibility Act*

As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 (or any other law), the analytical requirements of the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*) are inapplicable.

##### *Executive Order 13132*

This interim rule does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (August 4, 1999).

##### *Executive Order 12866*

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

##### *Paperwork Reduction Act*

This interim rule involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*). The collections of information involved in this interim rule have been reviewed and previously approved by OMB under the following control numbers: 0651-0031, 0651-0032, and 0651-0033. The United States Patent and Trademark Office is not resubmitting information collection packages to OMB for its review and approval because the changes in this interim rule do not affect the information collection requirements associated with the information collections under these OMB control numbers.

The title, description and respondent description of each of the information collections are shown below with an

estimate of each of the annual reporting burdens. Included in each estimate is the time for reviewing instructions, gathering and maintaining the data needed, and completing and reviewing the collection of information. The principal impact of the changes in this interim rule is to implement the changes to Office practice necessitated by sections 4403, 4801, and 4807 of the "American Inventors Protection Act of 1999."

*OMB Number:* 0651-0031.

*Title:* Patent Processing (Updating).

*Form Numbers:* PTO/SB/08/21-27/31/42/43/61/62/63/64/67/68/91/92/96/97.

*Type of Review:* Approved through October of 2002.

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

*Estimated Number of Respondents:* 2,040,630.

*Estimated Time Per Response:* 0.39 hours.

*Estimated Total Annual Burden Hours:* 788,421 hours.

*Needs and Uses:* During the processing for an application for a patent, the applicant/agent may be required or desire to submit additional information to the United States Patent and Trademark Office concerning the examination of a specific application.

The specific information required or which may be submitted includes: Information Disclosure Statements; Terminal Disclaimers; Petitions to Revive; Express Abandonments; Appeal Notices; Petitions for Access; Powers to Inspect; Certificates of Mailing or Transmission; Statements under § 3.73(b); Amendments, Petitions and their Transmittal Letters; and Deposit Account Order Forms.

*OMB Number:* 0651-0032.

*Title:* Initial Patent Application.

*Form Number:* PTO/SB/01-07/13PCT/17-19/29/101-110.

*Type of Review:* Approved through October of 2002.

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

*Estimated Number of Respondents:* 344,100.

*Estimated Time Per Response:* 8.7 hours.

*Estimated Total Annual Burden Hours:* 2,994,160 hours.

*Needs and Uses:* The purpose of this information collection is to permit the United States Patent and Trademark Office to determine whether an application meets the criteria set forth in the patent statute and regulations.

The standard Fee Transmittal form, New Utility Patent Application Transmittal form, New Design Patent Application Transmittal form, New Plant Patent Application Transmittal form, Declaration, and Plant Patent Application Declaration will assist applicants in complying with the requirements of the patent statute and regulations, and will further assist the United States Patent and Trademark Office in processing and examination of the application.

OMB Number: 0651-0033.

Title: Post Allowance and Refiling.

Form Numbers: PTO/SB/13/14/44/50-57; PTOL-85b.

Type of Review: Approved through September of 2000.

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

Estimated Number of Respondents: 135,250.

Estimated Time Per Response: 0.325 hour.

Estimated Total Annual Burden Hours: 43,893 hours.

Needs and Uses: This collection of information is required to administer the patent laws pursuant to title 35, U.S.C., concerning the issuance of patents and related actions including correcting errors in printed patents, refiling of patent applications, requesting reexamination of a patent, and requesting a reissue patent to correct an error in a patent. The affected public includes any individual or institution whose application for a patent has been allowed or who takes action as covered by the applicable rules.

Comments are invited on: (1) Whether the collection of information is necessary for proper performance of the functions of the agency; (2) the accuracy of the agency's estimate of the burden; (3) ways to enhance the quality, utility, and clarity of the information to be collected; and (4) ways to minimize the burden of the collection of information to respondents.

Interested persons are requested to send comments regarding these information collections, including suggestions for reducing this burden, to Robert J. Spar, Director, Special Program Law Office, United States Patent and Trademark Office, Washington, D.C. 20231, or to the Office of Information and Regulatory Affairs, OMB, 725 17th Street, N.W., Washington, D.C. 20503, (Attn: PTO Desk Officer).

Notwithstanding any other provision of law, no person is required to respond to nor shall a person be subject to a penalty for failure to comply with a

collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

List of Subjects in 37 CFR Part 1

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

For the reasons set forth in the preamble, 37 CFR Part 1 is amended as follows:

PART 1—RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR Part 1 is revised to read as follows:

Authority: 35 U.S.C. 2(b)(2), unless otherwise noted.

2. Section 1.7 is revised to read as follows:

§ 1.7 Times for taking action; Expiration on Saturday, Sunday or Federal holiday.

(a) Whenever periods of time are specified in this part in days, calendar days are intended. When the day, or the last day fixed by statute or by or under this part for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or on a Federal holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding business day which is not a Saturday, Sunday, or a Federal holiday. See § 1.304 for time for appeal or for commencing civil action.

(b) If the day that is twelve months after the filing date of a provisional application under 35 U.S.C. 111(b) and § 1.53(c) falls on Saturday, Sunday, or on a Federal holiday within the District of Columbia, the period of pendency shall be extended to the next succeeding secular or business day which is not a Saturday, Sunday, or a Federal holiday.

3. Section 1.17 is amended by adding paragraph (e) and revising paragraph (i) to read as follows:

§ 1.17 Patent application processing fees.

\* \* \* \* \*

(e) To request continued examination pursuant to § 1.114:

By a small entity	345.00
By other than a small entity	690.00

\* \* \* \* \*

(i) For filing a petition to the Commissioner under one of the following sections which refers to this paragraph 130.00

§ 1.12—for access to an assignment record.

§ 1.14—for access to an application.

§ 1.41—to supply the name or names of the inventor or inventors after the filing date without an oath or declaration as prescribed by § 1.63, except in provisional applications.

§ 1.47—for filing by other than all the inventors or a person not the inventor.

§ 1.48—for correction of inventorship, except in provisional applications.

§ 1.53—to accord a filing date, except in provisional applications.

§ 1.53(c)—to convert a provisional application filed under § 1.53(c) to a nonprovisional application under § 1.53(b).

§ 1.55—for entry of late priority papers.

§ 1.59—for expungement and return of information.

§ 1.84—for accepting color drawings or photographs.

§ 1.91—for entry of a model or exhibit.

§ 1.97(d)—to consider an information disclosure statement.

§ 1.102—to make an application special.

§ 1.103—to suspend action in application.

§ 1.177—for divisional reissues to issue separately.

§ 1.313—to withdraw an application from issue.

§ 1.314—to defer issuance of a patent.

§ 1.666(b)—for access to an interference settlement agreement.

§ 3.81—for a patent to issue to assignee, assignment submitted after payment of the issue fee.

\* \* \* \* \*

4. Section 1.53 is amended by redesignating paragraph (c)(3) as paragraph (c)(4), adding a new paragraph (c)(3), and revising paragraph (d)(1) to read as follows:

§ 1.53 Application number, filing date, and completion of application.

\* \* \* \* \*

(c) \* \* \*

(3) A provisional application filed under paragraph (c) of this section may be converted to a nonprovisional application filed under paragraph (b) of this section and accorded the original filing date of the provisional application. The conversion of a provisional application to a nonprovisional application will not result in either the refund of any fee properly paid in the provisional application or the application of any such fee to the filing fee, or any other fee, for the nonprovisional application. A request to convert a provisional application to a nonprovisional application must be accompanied by the fee set forth in § 1.17(i) and an

amendment including at least one claim as prescribed by the second paragraph of 35 U.S.C. 112, unless the provisional application under paragraph (c) of this section otherwise contains at least one claim as prescribed by the second paragraph of 35 U.S.C. 112. A request to convert a provisional application to a nonprovisional application must also be filed prior to the earliest of:

(i) Abandonment of the provisional application filed under paragraph (c) of this section; or

(ii) Expiration of twelve months after the filing date of the provisional application filed under paragraph (c) of this section.

\* \* \* \* \*

(d) \* \* \*

(1) A continuation or divisional application (but not a continuation-in-part) of a prior nonprovisional application may be filed as a continued prosecution application under this paragraph, provided that:

(i) The prior nonprovisional application is:

(A) A utility or plant application that was filed under 35 U.S.C. 111(a) before May 29, 2000, and is complete as defined by § 1.51(b);

(B) A design application that is complete as defined by § 1.51(b); or

(C) The national stage of an international application that was filed under 35 U.S.C. 363 before May 29, 2000, and is in compliance with 35 U.S.C. 371; and

(ii) The application under this paragraph is filed before the earliest of:

(A) Payment of the issue fee on the prior application, unless a petition under § 1.313(c) is granted in the prior application;

(B) Abandonment of the prior application; or

(C) Termination of proceedings on the prior application.

\* \* \* \* \*

Section 1.78 is amended by revising paragraph (a)(3) to read as follows:

**§ 1.78 Claiming benefit of earlier filing date and cross-references to other applications.**

(a) \* \* \*

(3) A nonprovisional application other than for a design patent may claim an invention disclosed in one or more prior filed provisional applications. In order for a nonprovisional application to claim the benefit of one or more prior filed provisional applications, each prior provisional application must name as an inventor at least one inventor named in the later filed nonprovisional application and disclose the named inventor's invention claimed in at least one claim of the later filed nonprovisional application in the

manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior provisional application must be entitled to a filing date as set forth in § 1.53(c), have any required English-language translation filed therein within the time period set forth in § 1.52(d), and have paid therein the basic filing fee set forth in § 1.16(k) within the time period set forth in § 1.53(g).

\* \* \* \* \*

5. Section 1.97 is amended by revising paragraph (b) to read as follows:

**§ 1.97 Filing of information disclosure statement.**

\* \* \* \* \*

(b) An information disclosure statement shall be considered by the Office if filed by the applicant within any one of the following time periods:

(1) Within three months of the filing date of a national application;

(2) Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application;

(3) Before the mailing of a first Office action on the merits; or

(4) Before the mailing of a first Office action after the filing of a request for continued examination under § 1.114.

\* \* \* \* \*

6. Section 1.104 is amended by revising paragraph (c)(4) to read as follows:

**§ 1.104 Nature of examination.**

\* \* \* \* \*

(c) \* \* \*

(4) Subject matter which is developed by another person which qualifies as prior art only under 35 U.S.C. 102(e), (f) or (g) may be used as prior art under 35 U.S.C. 103 against a claimed invention unless the entire rights to the subject matter and the claimed invention were commonly owned by the same person or organization or subject to an obligation of assignment to the same person or organization at the time the claimed invention was made.

\* \* \* \* \*

7. Section 1.113 is revised to read as follows:

**§ 1.113 Final rejection or action.**

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's or patent owner's reply is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to

a final rejection or action must comply with § 1.114 or paragraph (c) of this section.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

8. Section 1.114 is added immediately following § 1.113 to read as follows:

**§ 1.114 Request for continued examination.**

(a) An applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:

(1) Payment of the issue fee, unless a petition under § 1.313 is granted;

(2) Abandonment of the application; or

(3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

(b) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.

(c) If an applicant timely files a submission and fee set forth in § 1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. An appeal brief under § 1.192 or a reply brief under § 1.193(b), or related papers, will not be considered a submission under this section.

(d) The provisions of this section do not apply in any application in which the Office has not mailed at least one of an Office action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151. The provisions of this section also do not apply to:

(1) A provisional application;

(2) An application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995;

(3) An international application filed under 35 U.S.C. 363 before June 8, 1995;

(4) An application for a design patent; or

(5) A patent under reexamination.

9. Section 1.116 is revised to read as follows:

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

(a) An amendment after final action or appeal must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113), 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 final rejection, and any related proceedings, will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135.

(c) If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented.

(d) No amendment can be made as a matter of right in appealed cases. After decision on appeal, amendments can only be made as provided in § 1.198, or to carry into effect a recommendation under § 1.196.

10. Section 1.198 is revised to read as follows:

**§ 1.198 Reopening after decision.**

Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 1.196 without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

11. Section 1.312 is revised to read as follows:

**§ 1.312 Amendments after allowance.**

No amendment may be made as a matter of right in an application after the mailing of the notice of allowance.

Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee, and may be entered on the recommendation of the primary examiner, approved by the Commissioner, without withdrawing the application from issue.

12. Section 1.313 is revised to read as follows:

**§ 1.313 Withdrawal from issue.**

(a) Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(i) and a showing of good and sufficient reasons why withdrawal of the application is necessary. If the Office withdraws the application from issue, the Office will issue a new notice of allowance if the Office again allows the application.

(b) Once the issue fee has been paid, the Office will not withdraw the application from issue at its own initiative for any reason except:

(1) A mistake on the part of the Office;

(2) A violation of § 1.56 or illegality in the application;

(3) Unpatentability of one or more claims; or

(4) For interference.

(c) Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:

(1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;

(2) Consideration of a submission pursuant to § 1.114; or

(3) Express abandonment of the application. Such express abandonment may be in favor of a continuing application.

(d) A petition under this section will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate officials before the date of issue. Withdrawal of an application from issue after payment of the issue fee may not be effective to avoid publication of application information.

Dated: March 10, 2000.

**Q. Todd Dickinson,**

*Assistant Secretary of Commerce and Commissioner of Patents and Trademarks.*

[FR Doc. 00-6514 Filed 3-17-00; 8:45 am]

**BILLING CODE 3510-16-P**

**ENVIRONMENTAL PROTECTION AGENCY**

**40 CFR Part 52**

[NM-26-1-6944a; FRL-6561-6]

**Approval and Promulgation of Implementation Plan for New Mexico: Transportation Conformity Rule**

**AGENCY:** Environmental Protection Agency (EPA).

**ACTION:** Direct final rule.

**SUMMARY:** The EPA is approving a revision to the New Mexico State Implementation Plan (SIP) that contains the transportation conformity rule. The conformity rules assure that in air quality nonattainment or maintenance areas, projected emissions from transportation plans and projects stay within the motor vehicle emissions ceiling in the SIP. The transportation conformity SIP revision enables the State to implement and enforce the Federal transportation conformity requirements in regulations on Conformity to State or Federal Implementation Plans of Transportation Developed, Funded or Approved Under Title 23 U.S.C. or the Federal Transit Laws. The EPA's approval action streamlines the conformity process and allows direct consultation among agencies at the local levels. The final approval action is limited to regulations on Transportation Conformity. We approved the SIP revision on conformity of general Federal actions on September 9, 1998 (61 FR 48407).

The EPA approves this SIP revision under sections 110(k) and 176 of the Federal Clean Air Act (Act). We have given our rationale for approving this SIP revision in this action.

**DATES:** This rule is effective on May 19, 2000 without further notice, unless EPA receives adverse comment by April 19, 2000. If we receive adverse comment, we will publish a timely withdrawal in the **Federal Register** informing the public that this rule will not take effect.

**ADDRESSES:** You should send your written comments to Mr. Thomas H. Diggs, Chief, Air Planning Section (6PDL) at the address given below. You may inspect copies of the State's SIP revision and other relevant information during normal business hours at the following locations. If you wish to examine these documents, you should make an appointment with the appropriate office at least 24 hours before the visiting day.

Air Planning Section (6PDL),  
Multimedia Planning and Permitting