

Sections 1.83 (a) and (c) are being amended to clarify that the sections apply to nonprovisional applications.

Section 1.97(d) is being amended to replace the reference to § 1.17(i)(1) with a reference to § 1.17(i) to be consistent with the change to § 1.17.

Section 1.101(a) is being amended to indicate that the section applies to nonprovisional applications.

Section 1.102(d) is being amended to replace the reference to § 1.17(i)(2) with a reference to § 1.17(i) to be consistent with the change to § 1.17.

Section 1.103(a) is amended to replace the reference to § 1.17(i)(1) with a reference to § 1.17(i) to be consistent with the change to § 1.17.

Section 1.129 is being added to set forth the procedure for implementing certain transitional provisions contained in Public Law 103-465. Section 1.129(a) provides for limited reexamination of applications pending for 2 years or longer as of June 8, 1995, taking into account any reference to any earlier application under 35 U.S.C. 120, 121 or 365(c). An applicant will be entitled to have a first submission entered and considered on the merits after final rejection if the submission and the fee set forth in § 1.17(r) are filed prior to the filing of an Appeal Brief and prior to abandonment of the application. Section 1.129(a) also provides that the finality of the final rejection is automatically withdrawn upon the timely filing of the submission and payment of the fee set forth in § 1.17(r). After submission and payment of the fee set forth in § 1.17(r), the next PTO action on the merits may be made final only under the conditions currently followed by the PTO for making a first action in a continuing application final. If a subsequent final rejection is made in the application, applicant would be entitled to have a second submission entered and considered on the merits under the same conditions set forth for consideration of the first submission. Section 1.129(a) defines the term "submission" as including, but not limited to, an information disclosure statement, an amendment to the written description, claims or drawings, and a new substantive argument or new evidence in support of patentability. For example, the submission may include an amendment, a new substantive argument and an information disclosure statement. In view of the fee set forth in § 1.17(r), any information disclosure statement previously refused consideration in the application because of applicant's failure to comply with § 1.97 (c) or (d) or which is filed as part of either the first or second submission will be treated as though it had been

filed within one of the time periods set forth in § 1.97(b) and will be considered without the petition and petition fee required in § 1.97(d), if it complies with the requirements of § 1.98. In view of 35 U.S.C. 132, no amendment considered as a result of the payment of the fee set forth in § 1.17(r) may introduce new matter into the disclosure of the application.

Section 1.129(b)(1) is being added to provide for examination of more than one independent and distinct invention in certain applications pending for 3 years or longer as of June 8, 1995, taking into account any reference to any earlier application under 35 U.S.C. 120, 121 or 365(c). Under § 1.129(b)(1), a requirement for restriction or for the filing of divisional applications would only be made or maintained in the application after June 8, 1995, if: (1) The requirement was made in the application or in an earlier application relied on under 35 U.S.C. 120, 121 or 365(c) prior to April 8, 1995; (2) the examiner has not made a requirement for restriction in the present or parent application prior to April 8, 1995, due to actions by the applicant; or (3) the required fee for examination of each additional invention was not paid. Under § 1.129(b)(2), if the application contains claims to more than one independent and distinct invention, and no requirement for restriction or for the filing of divisional applications can be made or maintained, applicant will be notified and given a time period to (i) elect the invention or inventions to be searched and examined, if no election has been made prior to the notice, and pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects, (ii) in situations where an election was made in response to a requirement for restriction that cannot be maintained, confirm the election made prior to the notice and pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in addition to the one invention which applicant previously elected, or (iii) file a petition under § 1.129(b)(2) traversing the requirement without regard to whether the requirement has been made final. No petition fee is required. Section 1.129(b)(2) also provides that if the petition is filed in a timely manner, the original time period for electing and paying the fee set forth in § 1.17(s) will be deferred and any decision on the petition affirming or modifying the requirement will set a new time period to elect the invention or inventions to be

searched and examined and to pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects. Under § 1.129(b)(3), each additional invention for which the required fee set forth in § 1.17(s) has not been paid will be withdrawn from consideration under § 1.142(b). An applicant who desires examination of an invention so withdrawn from consideration can file a divisional application under 35 U.S.C. 121.

Section 1.129(c) is being added to clarify that the provisions of §§ 1.129 (a) and (b) are not applicable to any application filed after June 8, 1995. However, any application filed on June 8, 1995, would be subject to a 20-year patent term.

Section 1.137 is being amended by revising paragraph (c) to eliminate, in all applications filed on or after June 8, 1995, except design applications, the requirement that a terminal disclaimer accompany any petition under § 1.137(a) not filed within six (6) months of the date of the abandonment of the application. The language "filed before June 8, 1995" and "filed on or after June 8, 1995" as used in the amended rule, refer to the actual United States filing date, without reference to any claim for benefit under 35 U.S.C. 120, 121 or 365.

Section 1.139 is being added to set forth the procedure for reviving a provisional application where the delay was unavoidable or unintentional. Section 1.139(a) addresses the revival of a provisional application where the delay was unavoidable and § 1.139(b) addresses the revival of a provisional application where the delay was unintentional. Applicant may petition to have an abandoned provisional application revived as a pending provisional application for a period of no longer than twelve months from the filing date of the provisional application where the delay was unavoidable or unintentional. It would be permissible to file a petition for revival later than twelve months from the filing date of the provisional application but only to revive the application for the twelve-month period following the filing of the provisional application. Thus, even if the petition were granted to reestablish the pendency up to the end of the twelve-month period, the provisional application would not be considered pending after twelve months from its filing date. The requirements for reviving an abandoned provisional application set forth in § 1.139 parallel the existing requirements set forth in § 1.137.