

a second file wrapper continuation application and the fee for the second submission is appropriately set at the same amount as a filing fee. As to the fee required by § 1.129(b), the procedures set forth in § 1.129(b) permit applicants to retain multiple inventions in a single application rather than having to file multiple divisional applications. The fee for each independent and distinct invention in excess of one is appropriately set at the same amount as the filing fee for a divisional application, which is \$730.00. The \$730.00 fee is subject to a 50% reduction for small entities.

83. Comment: One comment suggested that the time period for the payment of the \$730.00 fee for the transitional after-final practice be extended if applicant files a petition seeking reversal of the examiner's refusal to enter the amendment after final without fee, until one month after an unfavorable decision on the petition.

Response: If an earlier filed petition seeking reversal of the examiner's refusal to enter the amendment after final is granted by the Director finding that the final rejection was premature, but the petition had not been decided by the time the § 1.129(a) fee was due, applicant must submit the § 1.129(a) fee so as to toll the time period for response to the final rejection. Otherwise, the application would be abandoned. Upon granting of such a petition by the Director, the § 1.129(a) fee paid will be refundable to applicant on request. Applications that fall under § 1.129(a) are under final rejection and there is a time period running against the applicant. Applicant must toll that time period by paying the transitional after-final fee set forth in § 1.129(a) and any necessary extension of time fees and Notice of Appeal fee. Section 1.129(a) is being amended to indicate that the submission and the fee set forth in § 1.17(r) may be submitted before the filing of the Appeal Brief and prior to abandonment of the application.

84. Comment: One comment suggested that if it is decided that the transitional after-final practice is made permanent, the PTO should seek legislative authorization to provide reduced fees for small entities.

Response: If it is decided that the transitional after-final practice be made permanent, the PTO will propose legislation to accomplish this change.

85. Comment: Several comments suggested that §§ 1.129 (a) and (b) should apply to all applications regardless of whether they were filed before or after June 8, 1995.

Several comments suggested that the practices set forth in §§ 1.129 (a) and (b) should be made permanent.

Several comments suggested that an applicant should be permitted to have a submission entered and considered after any final rejection upon payment of a fee as set forth in § 1.17(r), not just the first and second final rejections.

Response: The suggestions have not been adopted at this time. However, the PTO is undertaking a project to reengineer the entire patent process. These suggestions will be taken under advisement in that project.

86. Comment: One comment suggested that the PTO make an effort to treat applications in which a submission under § 1.129(a) has been filed on an expedited basis.

Response: Once the submission is filed and the fee set forth in § 1.17(r) is paid the finality of the last PTO action is withdrawn. The filing of the submission and the fee under § 1.129(a) is equivalent to the filing of a continuing application and will be treated in the same fashion and under the same turnaround time frame as a continuing application.

87. Comment: One comment suggested that PTO practice be changed so that a first Office action in a continuing application cannot be made final.

One comment suggested that PTO practice regarding second action final be relaxed.

Response: The suggestions have not been adopted at this time. However, the PTO is undertaking a project to reengineer the entire patent process. These suggestions will be taken under advisement in that project.

88. Comment: One comment stated that in proposed § 1.129, there is no express provision for the finality of the previous rejection to be withdrawn if applicant complies with the proposed rule. It is suggested that the proposed rule state that the finality of the previous action would be withdrawn if applicant complied with the rule when making a first or second submission after a final action.

Response: The suggestion has been adopted.

89. Comment: One comment requested that the PTO clarify whether § 1.129(a) required the first final rejection to be specifically withdrawn and a different final (i.e., one containing a new ground of rejection) rejection made before applicant is entitled to make a second submission.

Response: The final rule provides that the finality of the previous final office action is automatically withdrawn upon the timely filing of the first § 1.129(a)

submission and the fee set forth in § 1.17(r). If the first PTO action following the payment of the § 1.17(r) fee is a non-final office action, a further response from applicant will be entered and considered as a matter of right without payment of the fee set forth in § 1.17(r). If the next office action or any subsequent action is made final, the finality of that office action will be automatically withdrawn upon the timely filing of a second § 1.129(a) submission and the fee set forth in § 1.17(r).

90. Comment: One comment suggested that the PTO not permit the first PTO action following the payment of the § 1.17(r) fee to be made final under any circumstances.

Response: The suggestion has not been adopted. The first PTO action following the payment of the § 1.17(r) fee may be made final under the same conditions that a first office action may be made final in a continuing application (see section 706.07(b) of the MPEP). However, it would not be proper to make final a first Office action in a continuing or substitute application where the continuing or substitute application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (1) new issues were raised that required further consideration and/or search, or (2) the issue of new matter was raised. The procedure set forth in section 706.07(b) of the MPEP will apply to examination of a submission considered as a result of the procedure under § 1.129(a).

91. Comment: Several comments suggested that the filing of the first submission under § 1.129(a) within the statutory period for response set in final rejection should toll the running of the six-month statutory period.

Response: The filing of a submission, e.g., an information disclosure statement or an amendment, after a final rejection without payment of the fee set forth in § 1.17(r) will not toll the period for response set in the final rejection. However, § 1.129(a) is being amended to provide in the rule that the finality of the previous Office action is automatically withdrawn upon the filing of the submission and the payment of the fee set forth in § 1.17(r). Thus, the filing of a submission and the payment of the fee set forth in § 1.17(r) and any extension of time fees and Notice of Appeal fee, if they are necessary to avoid abandonment of the application, will automatically toll the period for response set in the final rejection. It must be kept in mind that the provisions of § 1.129 apply only to an application, other than for reissue or