

a design patent, that has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 U.S.C. 120, 121 and 365(c).

92. *Comment:* One comment asked (1) whether it would be necessary to file a Notice of Appeal and appeal fee with or after the first submission and fee if the examiner acts on the first submission and before the end of the six months from the date of the final rejection issues (a) a notice of allowance, (b) a non-final action, or (c) a second final rejection; (2) would the Notice of Appeal and fee be due only at the end of the six months from the date of the final rejection regardless of whether the examiner has acted on the submission by then; and (3) if the Notice of Appeal and fee have once been paid following a first final rejection, would a second notice and fee need to be paid if a second final rejection were issued and applicant desired to file a second submission under § 1.129(a).

Another comment suggested that the appeal fee set forth in § 1.17(e) should not be required where the Notice of Appeal is filed with a § 1.129(a) submission and the fee set forth in § 1.17(r).

*Response:* As to questions (1) and (2) and the second comment, if the first submission and the proper fee set forth in § 1.17(r) are timely filed in response to the final rejection, the finality of the previous rejection will be automatically withdrawn and applicant need not file the Notice of Appeal or the appeal fee. For example, if the first submission and the proper fee set forth in § 1.17(r) were filed on the last day of the six-month period for response to the final rejection, applicant must also file a petition for three months extension of time with the appropriate fee in order to avoid abandonment of the application. In such case, applicant need not file the Notice of Appeal or the appeal fee if the proper fee set forth in § 1.17(r) was timely paid. However, under the same fact situation, if applicant failed to submit the proper fee set forth in § 1.17(r), the finality of the previous rejection would not be withdrawn and the time period for response would still be running against applicant. In such case, a Notice of Appeal and appeal fee must also accompany the papers filed at the six-month period in order to avoid abandonment of the application. The proper fee set forth in § 1.17(r) must be filed prior to the filing of the Appeal Brief and prior to the abandonment of the application.

As to question (3), if the Notice of Appeal and fee have once been paid

following a first final rejection and applicant timely files a first submission and the proper fee set forth in § 1.17(r), the finality of the previous final rejection will be withdrawn and the appeal fee paid could be applied against any subsequent appeal. If the examiner issues a non-final rejection in response to applicant's first submission, a further response from applicant will be entered and considered as a matter of right. If any subsequent Office action is made final, applicant may file a second submission along with the proper fee pursuant to § 1.129(a). If the second submission and the proper fee set forth in § 1.17(r) are timely filed in response to the subsequent final rejection, the finality of the previous final rejection will be withdrawn. Any submission filed after a final rejection made in the application subsequent to the fee under § 1.129(a) having been paid twice will be treated as set forth in § 1.116. Applicant may, upon payment of the appeal fee, appeal a final rejection within the time allowed for response pursuant to § 1.191.

93. *Comment:* One comment questioned whether the "first submission" under § 1.129(a) has to be the first response filed after a final rejection or could it include subsequent responses to the same final rejection.

*Response:* The "first submission" under § 1.129(a) would include all responses filed prior to and with the payment of the fee required by § 1.129(a) provided the submission and fee are filed prior to the filing of the Appeal Brief and prior to abandonment of the application.

94. *Comment:* One comment suggested that § 1.129(a) be changed to permit the procedure to be available up until the filing of an Appeal Brief since it is not uncommon to file an amendment after a Notice of Appeal is filed but before the filing of an Appeal Brief.

*Response:* The suggestion has been adopted. Section 1.129(a) is being amended to indicate that the submission and the fee set forth in § 1.17(r) must be submitted before the filing of the Appeal Brief and prior to abandonment of the application.

95. *Comment:* One comment suggested that the transitional after-final practice be available at any time after final, including after the resolution of an appeal unfavorable to applicant in whole or in part.

*Response:* The suggestion has not been adopted. Section 1.129(a) is being amended to indicate that the submission and the fee set forth in § 1.17(r) must be submitted before the filing of the Appeal Brief and prior to abandonment of the

application. The suggestion to extend the period to after the resolution of an appeal unfavorable to applicant in whole or in part has not been adopted because the suggestion would further unduly extend prosecution of the application.

96. *Comment:* One comment stated that if an examiner must withdraw the finality of the rejection as a result of the transitional provision, the examiner should be credited with two counts in order to be compensated for the additional work.

*Response:* The examiner credit system is not part of this rulemaking package. However, as part of the Public Law 103-465 implementation plan, some accommodation will be made for the extra work performed.

97. *Comment:* One comment stated that regarding the transitional after-final practice, the fee should not be required if the only reason is to have the PTO consider recently obtained art.

*Response:* Under current practice, if applicant submits prior art after final rejection but before the payment of issue fee, the art will be considered if applicant makes the required certification and submits a petition with the required petition fee of \$130.00 (see section 609 of the MPEP). If applicant can make the certification, applicant would not have to rely on the transitional after-final procedure to have the prior art considered. In the event that applicant cannot make the certification, then the procedure under § 1.129(a) is available if applicant wishes the PTO to consider the prior art without refiling the application.

98. *Comment:* One comment suggested that the PTO modify existing restriction practice to make it more difficult for examiners to require restriction, for example, by requiring every restriction requirement to show two-way distinctness and separate status in the art established by means other than reference to the PTO's classification system.

*Response:* The suggestion has not been adopted. However, the PTO is undertaking a project to reengineer the entire patent process. This suggestion will be taken under advisement in that project.

99. *Comment:* One comment suggested that the pendency periods required by §§ 1.129(a) and (b) should be 18 months rather than 2-year and 3-year, respectively.

*Response:* The pendency periods set forth in the rule which establish eligibility for the transitional procedures are set forth in Public Law 103-465.

100. *Comment:* One comment suggested that § 1.129(a) be amended to