

permit prosecution to be reopened after a Notice of Allowance or final rejection upon the filing of a form requesting that prosecution be reopened and payment of the necessary fee.

*Response:* The procedures set forth in § 1.129(a) are not applicable to amendments filed after a Notice of Allowance. Amendments filed after the mailing of a Notice of Allowance are governed by § 1.312. The procedures set forth in § 1.129(a) are applicable to amendments filed after a final rejection. If applicant submits an amendment after final and the examiner notifies the applicant in writing that the amendment is not entered, § 1.129(a) permits applicant to submit a letter prior to abandonment of the application and prior to the filing of the Appeal Brief, requesting entry of the prior filed amendment along with the payment of the appropriate fee set forth in § 1.17(r). The letter requesting entry of the prior filed amendment would be equivalent to "a form" as suggested in the comment.

*101. Comment:* One comment suggested that the PTO liberalize its current practice under § 1.116 to make it easier for amendments or evidence to be entered and considered after a final rejection.

*Response:* The suggestion has not been adopted since no change was proposed to § 1.116 in the Notice of Proposed Rulemaking. However, the suggestion will be taken under advisement as part of a comprehensive effort being conducted by the PTO to reengineer the entire patent process. It should be noted that any change to liberalize the current practice under § 1.116 would necessitate increasing fees.

*102. Comment:* Several comments suggested that the transitional restriction provision be modified to state that no restriction requirement shall be made or maintained in any application pending for three years on the effective date of the legislation. The comment stated that if restriction requirements made prior to April 8, 1995, are permitted to be maintained then applicants will be forced to file divisional applications resulting in the automatic loss of term after June 8, 1995. A heavy penalty will be placed on the chemical, pharmaceutical and biotechnology industries, who have less than 4 months to search through the ancestors of all pending applications and to identify all restriction requirements and to file divisional applications before June 8, 1995. The comment further suggested that the current restriction practice be changed in view of the implementation of the 20-year term.

*Response:* The suggestion has not been adopted. The two-month date set forth in § 1.129(b)(1)(i) is from the Statement of Administrative Action, which is part of Public Law 103-465. Under section 102 of Public Law 103-465, "the statement of administrative action approved by the Congress shall be regarded as an authoritative expression by the United States concerning the interpretation and application of the Uruguay Round Agreements and this Act in any judicial proceeding in which a question arises concerning such interpretation or application." The Commissioner does not have any authority to establish rules which are inconsistent with the Act. It is noted that in cases where a restriction requirement was made prior to April 8, 1995, applicant will have sufficient time to file divisional applications prior to June 8, 1995, so as to retain the benefit of the 17-year patent term for those divisional applications.

The PTO is currently reviewing the restriction practice in view of the implementation of the 20-year patent term. It is noted that a change in restriction practice without changes to other fees would have a negative impact on funding needed to operate the PTO.

*103. Comment:* Several comments suggested that proposed exceptions (1) and (2) in § 1.129(b) ignore the mandatory language of section 532(2)(B) of Public Law 103-465 and should be deleted.

*Response:* The suggestion has not been adopted. The exceptions referred to are contained in the Statement of Administrative Action, which is part of Public Law 103-465. Under section 102 of Public Law 103-465, "the statement of administrative action approved by the Congress shall be regarded as an authoritative expression by the United States concerning the interpretation and application of the Uruguay Round Agreements and this Act in any judicial proceeding in which a question arises concerning such interpretation or application."

*104. Comment:* One comment asked whether "restriction" under § 1.129(b) apply to election of species under § 1.146.

*Response:* "Restriction" under § 1.129(b) applies to both requirements under § 1.142 and elections under § 1.146.

*105. Comment:* Several comments requested that clarification be made as to what constitutes "actions by the applicant" in § 1.129(b)(1) and specifically, whether a request for extension of time under § 1.136(a) constitutes such "actions" by the applicant.

*Response:* Examples of what constitute "actions by the applicant" in § 1.129(b)(1) are: (1) applicant abandons the application and continues to refile the application such that no Office action can be issued in the application, and (2) applicant requests suspension of prosecution under § 1.103(a) such that no Office action can be issued in the application. Extension of time under § 1.136(a) would not constitute such "actions by the applicant" under § 1.129(b)(1).

*106. Comment:* One comment suggested that the one-month period set forth in § 1.129(b) is insufficient to give an applicant time to file a petition under § 1.144 from a restriction requirement. Several comments suggested that § 1.129(b) be amended to permit applicant to challenge the restriction requirement by way of a petition before being required to pay the fees set forth in § 1.17(s).

*Response:* Section 1.129(b)(2) is being amended in the final rule package to indicate that applicant will be given "a time period" to (1) make an election, if no election has been previously made, and pay the fee set forth in § 1.17(s), (2) confirm an earlier election and pay the fee set forth in § 1.17(s), or (3) file a petition under § 1.129(b)(2) traversing the restriction requirement. If applicant chooses not to pay the fee set forth in § 1.17(s), applicant may file a petition under § 1.129(b)(2) requesting immediate review by the Group Director of the restriction requirement. No petition fee is required. A petition under § 1.129(b)(2) rather than under § 1.144 would be more appropriate under the circumstances since a petition under § 1.144 requires the examiner to make the restriction final before the petition can be considered.

*107. Comment:* One comment suggested that if applicant elects not to pay the fee set forth in § 1.17(s), applicant should be allowed to elect the invention to be examined.

*Response:* The suggestion has been adopted. Section 1.129(b) is being amended to indicate that if applicant chooses not to pay the fees for the additional inventions, applicant must elect the invention to be examined and the claims directed to the non-elected inventions for which no fee has been paid will be withdrawn from consideration.

*108. Comment:* One comment suggested that the PTO amend the rules to permit all, or at least several, inventions to be examined in a single application upon payment of an appropriate fee.

*Response:* The suggestion has not been adopted at this time. However, the