

First, "person" recited in 37 CFR 1.131(a)(1) in regard to 37 CFR 1.42, 1.43 and 1.47 is being changed to "party" as 37 CFR 1.47(b) provides for corporate assignees to petition thereunder.

Second, reference to 35 U.S.C. 102 (a) or (e) and 35 U.S.C. 103 has been added to more clearly identify the rejections that can be overcome (35 U.S.C. 102 (a), (b), (d) and (e) are the only sections that recite the use of a domestic or foreign patent and a printed publication referred to in 37 CFR 1.131 as capable of being overcome as references—section (b) (35 U.S.C. 102(b)) is precluded by the terms of 37 CFR 1.131(a) and section (d) (35 U.S.C. 102(d) is applicant's own invention, MPEP 715).

Additionally, the Office recognizes that there is a potential conflict between existing 37 CFR 1.131(a) and 37 CFR 1.602(a). Section 1.131(a) prohibits affidavits or declarations thereunder when the same patentable invention, as defined in 37 CFR 1.601(n) (i.e., patentable indistinct inventions), is claimed. An interference under 35 U.S.C. 135(a), rather than antedating under 37 CFR 1.131(a), is generally the available remedy. However, 37 CFR 1.602(a) provides that when the applications or the application and the patent are owned by a single party, interferences are not declared or continued unless "good cause" is shown. This can result in a hardship where there is an issued patent that can no longer be amended as by filing a continuation-in-part application. Where there are two or more pending applications, the conflict can be avoided by filing a continuation-in-part application merging the conflicting inventions into a single application.

The Office proposed amending 37 CFR 1.131 to broaden its application to a single party where claimed inventions in a pending application or in a patent undergoing reexamination and a patent owned by the party are patentably indistinct but not identical. Under the proposed addition to 37 CFR 1.131, an affidavit or declaration could be filed by a party to overcome a 35 U.S.C. 103 rejection based on a 35 U.S.C. 102 (a) or (e) patent owned by that party, where the patent claimed an invention that was patentably indistinct, but not identical to an invention claimed in an application or patent undergoing reexamination.

The proposed addition to 37 CFR 1.131 would not affect the use of the issued patent in a rejection of the pending application or the patent undergoing reexamination based on double patenting. A Rule 1.131 affidavit

or declaration would continue to be inappropriate where a claim in a pending application or a patent undergoing reexamination is subject to a double patenting rejection under 35 U.S.C. 101 because the pending application or the patent undergoing reexamination claims the identical invention in the issued patent. However, where patentably indistinct but not identical inventions are claimed, an obvious type double patenting rejection can be avoided by filing an appropriate terminal disclaimer. In addition, petitions under 37 CFR 1.183 would be entertained for waiver of 37 CFR 1.131 requirements in appropriate instances where two pending applications claiming patentable indistinct but not identical inventions are held by a single party.

Third, the basis for requiring under proposed 37 CFR 1.131(a)(3) common ownership of the pending application or patent undergoing reexamination and the patent at the time the later invention was made rather than simply ownership by a single party as is used in 37 CFR 1.602(a). Also it is questioned whether the proposed 37 CFR 1.131(a)(3) and existing 37 CFR 1.78 (c) and (d) were consistent or in-part duplicative.

In view of the third consideration regarding the proposed 37 CFR 1.131(a)(3) relating to the date of common ownership between a pending application or a patent undergoing reexamination and an issued patent, further study of the proposal is deemed warranted and the proposed 37 CFR 1.131(a)(3) is not being adopted at this time.

Discussion of Specific Rules

Section 1.131(a) as amended, contains paragraphs (a)(1) and (a)(2). Previous paragraph (a) is now designated as (a)(1) and amended to allow a 37 CFR 1.131 affiant or declarant to rely upon facts occurring in a NAFTA member country or a WTO member country to show completion of the invention. The term "domestic" is being changed to "U.S." References to 35 U.S.C. 102 (a) and (e) and 35 U.S.C. 103 as the rejections to be overcome by the section have been added. The paragraph is being amended from a single sentence to three sentences.

Section 1.131(a)(2) is being added, as proposed, to provide that a date of completion of the invention may not be established before December 8, 1993, in a NAFTA country, or before January 1, 1996, in a WTO Member country other than a NAFTA country.

Other Considerations

This rule change is in conformity with the requirements of the Regulatory Flexibility Act, 5 U.S.C. 601 *et seq.*, Executive Order 12612, and the Paperwork Reduction Act at 1980, 44 U.S.C. 3501 *et seq.* It has been determined that the rule changes are not significant for the purposes of Executive Order 12866.

The Assistant General Counsel for Legislation and Regulation of the Department of Commerce has certified to the Chief Counsel for Advocacy, Small Business Administration, that this rule change will not have a significant economic impact on a substantial number of small entities, Regulatory Flexibility Act, 5 U.S.C. 605(b), because the rule would affect only a small number of applications and would provide a streamlined and simplified procedure, eliminating the need for requesting waiver of the rules.

The Patent and Trademark Office has also determined that this notice has no Federalism implications affecting the relationship between the National Government and the States outlined in Executive Order 12612.

This rule change will not impose any additional burden under the Paperwork Reduction Act of 1980, 44 U.S.C. 3501 *et seq.*, since no record keeping or reporting requirements within the coverage of the Act are placed upon the public.

List of Subjects in 37 CFR Part 1

Administrative practice and procedure, Inventions and patents, Lawyers, Reporting and record keeping requirements.

For the reasons set forth in the preamble, and pursuant to the authority granted to the Commissioner of Patents and Trademarks by 35 U.S.C. 6, Part 1 of Title 37 of the Code of Federal Regulations is amended as set forth below:

PART 1—RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR Part 1, continues to read as follows:

Authority: 35 U.S.C. 6, unless otherwise noted.

2. Section 1.131 is amended by revising paragraph (a) to read as follows:

§ 1.131 Affidavit or declaration of prior invention to overcome cited patent or publication.

(a)(1) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 102 (a) or (e), or 35 U.S.C. 103 based on a U.S. patent to another which