

# Proposed Rules

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This section of the FEDERAL REGISTER contains notices to the public of the proposed issuance of rules and regulations. The purpose of these notices is to give interested persons an opportunity to participate in the rule making prior to the adoption of the final rules.

## DEPARTMENT OF COMMERCE

### United States Patent and Trademark Office

#### 37 CFR Part 1

[Docket No.: 010606145-1145-01]

RIN 0651-AB37

#### Elimination of Continued Prosecution Application Practice as to Utility and Plant Patent Applications

**AGENCY:** United States Patent and Trademark Office, Commerce.

**ACTION:** Notice of proposed rulemaking.

**SUMMARY:** The American Inventors Protection Act of 1999 (AIPA) enacted provisions for the continued examination of a utility or plant application at the request of the applicant (request for continued examination or RCE practice). Therefore, there no longer appears to be a need for continued prosecution application (CPA) practice as to utility and plant applications. Thus, the Office is proposing to eliminate CPA practice as to utility and plant applications. An applicant for a utility or plant patent may also continue to effectively obtain further examination of the application by filing a continuing application under section 1.53(b). Since RCE practice does not apply to design applications, CPA practice will remain in place for design applications.

**DATES:** To be ensured of consideration, written comments must be received on or before September 7, 2001. No public hearing will be held.

**ADDRESSES:** Comments should be sent by electronic mail message over the Internet addressed to [ab37.comments@uspto.gov](mailto:ab37.comments@uspto.gov). Comments may also be submitted by mail addressed to: Box Comments—Patents, Commissioner for Patents, Washington, DC 20231, or by facsimile to (703) 872-9411, marked to the attention of Eugenia A. Jones. Although comments may be submitted by mail or facsimile, the Office prefers to receive comments via

the Internet. If comments are submitted by mail, the Office prefers that the comments be submitted on a DOS formatted 3½ inch disk accompanied by a paper copy.

The comments will be available for public inspection at the Office of the Commissioner for Patents, located in Crystal Park 2, Suite 910, 2121 Crystal Drive, Arlington, Virginia, and will be available through anonymous file transfer protocol (ftp) via the Internet (address: <http://www.uspto.gov>). Since comments will be made available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included in the comments.

**FOR FURTHER INFORMATION CONTACT:**

Eugenia A. Jones, by telephone at (703) 306-5586, or by mail addressed to: Box Comments—Patents, Commissioner for Patents, Washington, DC 20231, or by facsimile to (703) 872-9411, marked to the attention of Eugenia A. Jones.

**SUPPLEMENTARY INFORMATION:** The AIPA was enacted into law on November 29, 1999. See Pub. L. 106-113, 113 Stat. 1501, 1501A-552 through 1501A-591 (1999). Among other things, the AIPA amended Title 35 of the United States Code to provide for a request for continued examination (RCE) practice. See 35 U.S.C. 132(b). RCE practice is applicable to any utility or plant application filed on or after June 8, 1995. See 113 Stat. at 1501A-560 through 1501A-561. The Office amended the rules of practice in Title 37 of the Code of Federal Regulations to implement the RCE provisions of the AIPA via an interim rule published in March 2000 and a final rule published in August 2000. See *Changes to Application Examination and Provisional Application Practice*, 65 FR 14865 (Mar. 20, 2000), 1233 *Off. Gaz. Pat. Office* 47 (Apr. 11, 2000) (interim rule), and *Request for Continued Examination Practice and Changes to Provisional Application Practice*, 65 FR 50091 (Aug. 16, 2000), 1238 *Off. Gaz. Pat. Office* 13 (Sept. 5, 2000) (final rule).

The AIPA also amended Title 35 of the United States Code to provide, with certain exceptions, for the publication of pending patent applications (other than design applications) eighteen months after the earliest claimed priority date. See 35 U.S.C. 122(b) (applies to utility and plant applications filed on or after November 29, 2000, including any CPA

filed on or after November 29, 2000). The Office amended the rules of practice in Title 37 of the Code of Federal Regulations to implement the eighteen-month publication provisions of the AIPA by a final rule published in September of 2000. See *Changes to Implement Eighteen-Month Publication of Patent Applications*, 65 FR 57023 (Sept. 20, 2000), 1239 *Off. Gaz. Pat. Office* 63 (Oct. 10, 2000) (final rule). That notice indicated that the publication of a CPA is both costly and inefficient. See *Changes to Implement Eighteen-Month Publication of Patent Applications*, 65 FR at 57047, 1239 *Off. Gaz. Pat. Office* at 84 (comment 58 and response).

The Office created CPA practice under § 1.53(d) in 1997 to permit applicants to effectively obtain continued examination of an application using a streamlined continuing application practice (*i.e.*, CPA practice). CPA practice was a substitute for a continued examination practice. See *Changes to Patent Practice and Procedures*, 62 FR 53131, 53142 (Oct. 10, 1997), 1203 *Off. Gaz. Pat. Office* 63, 72 (Oct. 21, 1997) (final rule) (comment 17 and response). While the Office did not completely eliminate CPA practice for utility and plant applications (as a convenience to applicants) when it implemented RCE practice, it has now determined that CPA practice for utility or plant applications is redundant (in view of RCE practice), costly, and inefficient. Thus, the Office is now proposing to eliminate CPA practice as to utility and plant applications.

#### Discussion of Specific Rule

Title 37 of the Code of Federal Regulations, Part 1, is proposed to be amended as follows:

Section 1.53(d)(1)(i) is proposed to be amended to provide that an application may be filed as a CPA under § 1.53(d) only for a design patent (either an original or reissue design patent) and the prior nonprovisional application (of which the CPA is a continuation or divisional) is a design application that is complete as defined by § 1.51(b).

In the event that an applicant files a request for a CPA of a utility or plant application (to which CPA practice no longer applies) and the utility or plant application was filed on or after June 8, 1995, the Office will automatically treat the improper request for a CPA as an

RCE under § 1.114 of the utility or plant application identified in the request for CPA. Experience, however, has shown that such requests for a CPA may not satisfy the requirements of § 1.114 to be a proper RCE (e.g., the request may lack a submission under § 1.114(b), or may not be accompanied by the fee set forth in § 1.17(e)). In such situations, the Office will treat the improper request for a CPA as an RCE (albeit an improper RCE), and the time period set in the last Office action (or notice of allowance) will continue to run. If the time period (considering any available extension under § 1.136(a)) has expired, the applicant must file a petition under § 1.137 (with the lacking submission under § 1.114(b) and/or fee set forth in § 1.17(e)) to revive the abandoned application.

In the event that an applicant files a request for a CPA of a utility or plant application and the utility or plant application was filed before June 8, 1995, the Office will treat the improper request for a CPA as an improper application under the provisions set forth in § 1.53(e).

Section 1.53(d)(3) is proposed to be amended to provide that the filing fee for a CPA filed under § 1.53(d) is the basic filing fee as set forth in § 1.16(f) if the application is for an original design patent or § 1.16(h) if the application is for a reissue design patent. Since § 1.53(d) as proposed would no longer apply to utility or plant applications and a design application may contain only a single claim (§ 1.154(b)(6)), there is no need for § 1.53(d)(3) to provide for additional claims fees.

## Classification

### Regulatory Flexibility Act

The Chief Counsel for Regulation of the Department of Commerce certified to the Chief Counsel for Advocacy, Small Business Administration, that the changes proposed in this notice, if adopted, would not have a significant impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)). The changes proposed in this notice (if adopted) would eliminate CPA practice as to utility and plant applications. The changes proposed in this notice (if adopted) would not have a significant economic impact on any business because: (1) Any applicant (including small entities) in a utility or plant application filed before June 8, 1995, can obtain further examination of the application by filing either a continuing application under § 1.53(b) or a submission under § 1.129(a) (if the application is eligible for § 1.129(a) practice); (2) any applicant (including

small entities) in a utility or plant application filed on or after June 8, 1995, can obtain further examination of the application by filing either an RCE under 35 U.S.C. 132(b) and § 1.114 or a continuing application under § 1.53(b); and (3) any applicant (including small entities) in a design application can continue to obtain further examination of the application by filing either a CPA under § 1.53(d) or a continuing application under § 1.53(b).

### Executive Order 13132

This rulemaking does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

### Executive Order 12866

This rulemaking has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

### Paperwork Reduction Act

This notice of proposed rulemaking involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*). As required by the Paperwork Reduction Act of 1995 (44 U.S.C. 3507(d)), the Office has submitted an information collection package to OMB for its review and approval of the proposed information collections under OMB control numbers 0651-0031 and 0651-0032. The Office is submitting these information collections to OMB for its review and approval because this notice of proposed rulemaking will increase the number of RCEs. The principal impact of the changes in this notice of proposed rulemaking is to eliminate CPA practice with respect to utility and plant applications.

The title, description and respondent description of each of the information collections are shown below with an estimate of each of the annual reporting burdens. Included in each estimate is the time for reviewing instructions, gathering and maintaining the data needed, and completing and reviewing the collection of information.

OMB Number: 0651-0031.

Title: Patent Processing (Updating).

Form Numbers: PTO/SB/08/21-27/30/31/35/36/42/43/61/62/63/64/67/68/91/92/ 96/97.

Type of Review: Approved through October of 2002.

Affected Public: Individuals or Households, Business or Other For-Profit Institutions, Not-for-Profit Institutions and Federal Government.

Estimated Number of Respondents: 2,247,389.

Estimated Time Per Response: 0.45 hours.

Estimated Total Annual Burden Hours: 1,021,941 hours.

Needs and Uses: During the processing of an application for a patent, the applicant/agent may be required or desire to submit additional information to the United States Patent and Trademark Office concerning the examination of a specific application. The specific information required or which may be submitted includes: Information Disclosure Statements; Terminal Disclaimers; Petitions to Revive; Express Abandonments; Appeal Notices; Petitions for Access; Powers to Inspect; Certificates of Mailing or Transmission; Statements under § 3.73(b); Amendments; Petitions and their Transmittal Letters; and Deposit Account Order Forms.

OMB Number: 0651-0032.

Title: Initial Patent Application.

Form Number: PTO/SB/01-07/13PCT/17-19/29/101-110.

Type of Review: Approved through October of 2002.

Affected Public: Individuals or Households, Business or Other For-Profit Institutions, Not-for-Profit Institutions and Federal Government.

Estimated Number of Respondents: 319,350.

Estimated Time Per Response: 9.35 hours.

Estimated Total Annual Burden Hours: 2,984,360 hours.

Needs and Uses: The purpose of this information collection is to permit the Office to determine whether an application meets the criteria set forth in the patent statute and regulations. The standard Fee Transmittal form, New Utility Patent Application Transmittal form, New Design Patent Application Transmittal form, New Plant Patent Application Transmittal form, Declaration, and Plant Patent Application Declaration will assist applicants in complying with the requirements of the patent statute and regulations, and will further assist the Office in the processing and examination of the application.

Comments are invited on: (1) Whether the collection of information is necessary for proper performance of the functions of the agency; (2) the accuracy of the agency's estimate of the burden; (3) ways to enhance the quality, utility, and clarity of the information to be collected; and (4) ways to minimize the burden of the collection of information to respondents.

Interested persons are requested to send comments regarding these

information collections, including suggestions for reducing this burden, to Robert J. Spar, Director, Office of Patent Legal Administration, United States Patent and Trademark Office, Washington, DC 20231, or to the Office of Information and Regulatory Affairs of OMB, New Executive Office Building, Room 10235, 725 17th Street NW., Washington, DC 20503, Attention: Desk Officer for the United States Patent and Trademark Office.

Notwithstanding any other provision of law, no person is required to respond to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

#### List of Subjects in 37 CFR Part 1

Administrative practice and procedure, Courts, Freedom of information, Inventions and patents, Reporting and record keeping requirements, Small businesses.

For the reasons set forth in the preamble, 37 CFR Part 1 is proposed to be amended as follows:

#### 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. 2(b)(2).

2. Section 1.53 is proposed to be amended by revising paragraphs (d)(1) and (d)(3) to read as follows:

\* \* \* \* \*

(d) \* \* \*

(1) A continuation or divisional application (but not a continuation-in-part) of a prior nonprovisional application may be filed as a continued prosecution application under this paragraph, provided that:

(i) The application is for a design patent;

(ii) The prior nonprovisional application is a design application that is complete as defined by § 1.51(b); and

(iii) The application under this paragraph is filed before the earliest of:

(A) Payment of the issue fee on the prior application, unless a petition under § 1.313(c) is granted in the prior application;

(B) Abandonment of the prior application; or

(C) Termination of proceedings on the prior application.

\* \* \* \* \*

(3) The filing fee for a continued prosecution application filed under this

paragraph is the basic filing fee as set forth in § 1.16(f) or § 1.16(h).

\* \* \* \* \*

Dated: June 22, 2001.

**Nicholas P. Godici,**

*Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the United States Patent and Trademark Office.*

[FR Doc. 01-17100 Filed 7-6-01; 8:45 am]

**BILLING CODE 3510-16-P**

#### FEDERAL COMMUNICATIONS COMMISSION

#### 47 CFR PART 64

[CC Docket No. 98-67; DA 00-2739]

#### Interstate Telecommunication Relay Service (TRS) Fund Advisory Council and TRS Fund Administrator's Recommended TRS Cost Recovery Guidelines

**AGENCY:** Federal Communications Commission.

**ACTION:** Proposed rule.

**SUMMARY:** On December 6, 2000, the Commission released a document seeking comment on the cost recovery guidelines recommended by the Interstate Telecommunications Relay Service (TRS) Fund Advisory Council and the TRS Fund Administrator (Advisory Council and Fund Administrator, respectively).

**DATES:** Comments due July 30, 2001. Reply comments due August 6, 2001.

**FOR FURTHER INFORMATION CONTACT:** Pam Slipakoff at (202) 418-7705 or [pslipako@fcc.gov](mailto:pslipako@fcc.gov) of the Common Carrier Bureau, Network Services Division. The address is: Network Services Division, Common Carrier Bureau, Federal Communications Commission, The Portals II, 445 12th Street, SW., Suite 6A207, Washington, DC 20554. The fax number is: (202) 418-2345. The TTY number is: (202) 418-0484.

**SUPPLEMENTARY INFORMATION:** In the March 6, 2000 *Improved TRS Order*, 65 FR 38432 (June 21, 2000), the Commission amended the TRS rules to expand the kinds of relay services available to consumers and to improve the quality of TRS. The Commission also required the Advisory Council and the Fund Administrator to recommend a cost methodology to cover the additional requirements. In their recommendations, the Advisory Council and the Fund Administrator propose, among other things, applying the traditional TRS cost recovery model to each service, but capturing minutes of use and costs separately and

establishing separate reimbursement rates.

On November 9, 2000 the Advisory Council and the Fund Administrator filed their recommended TRS cost recovery guidelines as required by the *Improved TRS Order*. Those recommendations propose methodologies for recovering costs associated with the provision of traditional Telecommunications Relay Service (TRS), Speech-to-Speech (STS) Service, and Video Relay Service (VRS). These recommendations were placed on public notice on December 6, 2000. Comments were initially due on January 5, 2001 and reply comments were due on January 19, 2001. We now seek additional comment on these recommendations.

The Advisory Council and Fund Administrator's Recommended TRS Cost Recovery Guidelines will be available for review and copying during regular business hours at the FCC Reference Center, Portals II, 445 12th Street, SW, Room CY-A257, Washington, DC 20554, (202) 418-0270. It may also be viewed at [https://haifoss.fcc.gov/cgi-bin.ws.exe/prod/ecfs/comsrch\\_v2.hts](https://haifoss.fcc.gov/cgi-bin.ws.exe/prod/ecfs/comsrch_v2.hts), by typing 98-67 in the proceeding box and 11/09/2000 in the date box. The recommended guidelines may also be purchased from the Commission's copy contractor, International Transcription Service, Inc. (ITS), 1231 20th Street, NW., Washington, DC 20036, telephone 202-857-3800, facsimile 202-857-3805, TTY 202-293-8810.

#### Initial Regulatory Flexibility Analysis

1. As required by the Regulatory Flexibility Act (RFA), the Commission has prepared this present Initial Regulatory Flexibility Analysis (IRFA) of the possible significant economic impact on small entities by the policies and rules in this document. Written public comments are requested on this IRFA. Comments must be identified as responses to the IRFA and must be filed by the deadlines for comments on the document. The Commission will send a copy of the document including this IRFA, to the Chief Counsel for Advocacy of the Small Business Administration. See 5 U.S.C. 603(a). In addition, the document and IRFA (or summaries thereof) will be published in the **Federal Register**. See id.

#### A. Need for, and Objective of, the Proposed Rules

2. The Commission is issuing this document to seek comment on the recommended TRS cost recovery guidelines filed by the Advisory Council and the Fund Administrator on