

## **POTENTIAL UPCOMING CHANGES IN U.S. PATENT LAWS: THE PUBLICATION OF PATENT APPLICATIONS**

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### I. Introduction

This article concerns potential upcoming changes in United States patent law that may require publication of patent applications 18 months after the earliest filing date for which priority is sought.

Under present U.S. practice, patent applications are maintained in secrecy until the patent issues. However, the United States has committed internationally to begin publishing patent applications, and the Patent Application Publication Act of 1995 is presently before Congress. [n.1] While the Act has not been enacted to date, the United States Patent and Trademark Office (PTO) has nevertheless issued proposed regulations to implement the publication of patent applications in the event that the statute is enacted. [n.2]

### \*310 II. The Current State of U.S. Law Regarding the Secrecy of Patent Applications

Currently, access to pending patent applications in the PTO is governed by 35 U.S.C. § 122, which provides:

Applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner. [n.3]

Therefore, patent applications are presently not published, and it is not possible to learn the contents of an application until it issues as a United States patent.

However, in certain limited circumstances it is possible to discover the status of pending patent applications prior to issuance. For example, when an application has been identified by serial number in a published patent document, or where the United States has been indicated as a designated state in a published international application, it is

possible to determine whether the application is pending, has been abandoned, or has issued as a patent in the United States. [n.4]

Abandoned patent applications are also maintained in secrecy, unless the abandoned application is referred to in an issued United States patent. In this instance, the file may be made available to anyone who requests access. [n.5] An abandoned file may also be made available to anyone who requests access where the applicant has "filed an authorization to open the complete application to the public...." [n.6]

United States law regarding the secrecy of patent applications is in contrast with the applicable laws and procedures in most of the major patent offices around the world. [n.7]

For example, the rules of the European Patent Office (EPO) provide that an application is published 18 months after the filing date or priority date, whichever is earlier. [n.8] In the Japanese Patent Office, patent \*311 applications are published, or "laid-open," 18 months after the filing of the application. [n.9] Canada has published patent applications 18 months from the date of filing since 1989. [n.10] Additionally, international patent applications filed under the Patent Cooperation Treaty (PCT) are published "promptly after the expiration of 18 months from the priority date of the application." [n.11]

### III. Proposed Revisions to U.S. Law Mandating the Publication of Patent Applications-- H.R. 1733

While the present state of U.S. law provides that patent applications are to be maintained in secrecy, the U.S. government has agreed to change the law and adopt a procedure to publish applications. The United States and Japan entered into an agreement on August 16, 1994, for both countries to make significant changes in their patent laws. [n.12] The United States agreed to publish patent applications beginning January 1, 1996. [n.13]

A bill to provide for the publication of patent applications was introduced into the House of Representatives on May 25, 1995, as House of Representatives Bill 1733 (H.R. 1733), the "Patent Application Publication Act of 1995." [n.14] H.R. 1733 amends 35 U.S.C. § 122 by incorporating all of the present language of § 122 into subsection (a) of § 122 and adding new subsection (b) of § 122. [n.15]

\*312 The proposed 35 U.S.C. § 122(b)(1) provides that, except for design and provisional patent applications, [n.16] all patent applications will be published:

[A]s soon as possible after the expiration of a period of 18 months from the earliest filing date for which a benefit is sought under this title, except that an application that is no longer pending shall not be published and an application that is subject to a secrecy order pursuant to § 181 of this title shall not be published. [n.17]

The proposed § 122(b)(1) also provides that the patent application may be published earlier than the 18 month period at the request of the applicant. [n.18]

The publication process in proposed § 122(b)(1) calls for delegating a large degree of regulatory power to the Commissioner of Patents and Trademarks. The proposed bill provides that applications are to be published "in accordance with procedures as determined by the Commissioner." [n.19] The bill further states:

No information concerning published patent applications shall be made available to the public except as the Commissioner shall determine. Notwithstanding any other provision of law, a determination by the Commissioner to release or not to release information concerning a published patent application shall be final and non-reviewable. [n.20]

The bill further provides for 35 U.S.C. § 122(b)(2), which states that upon request of an applicant, an application will not be published until three months after the applicant has received a notice of rejection under 35 U.S.C. § 132. [n.21] The bill establishes that the right to request a delay after a notice of rejection does not apply to applications claiming priority of an earlier filed foreign application under 35 U.S.C. §§ 119 and 365, or to applications claiming priority from an earlier filing date in the United States under 35 U.S.C. §§ 119, 120, or 121. The bill provides that \*313 the Commissioner may establish fees and procedures to carry out this section. [n.22]

Section 3 of the Act grants the Commissioner full authority to determine when a certified copy of a foreign priority document must be submitted to the PTO and when an amendment containing the reference to the foreign priority document must be submitted. [n.23] This Act will give the Commissioner authority to set the required submittal dates for priority documents in advance of the application's publication date, and thus require the applicant to submit these necessary documents before the publication date.

Section 4 of H.R. Bill 1733 adds subsection (d) to 35 U.S.C. § 154. The proposed § 154(d)(1) is entitled "Provisional Rights," and provides that a patent owner shall have the right to obtain a reasonable royalty from any person who, during the period from publication of the patent application until issuance, infringes any of the published application's claims and "had actual notice or knowledge of the published patent application." [n.24] The Act also provides in § 154(d)(2) that the right to a royalty "shall not be available under this subsection unless the invention claimed in the patent is identical to the invention as claimed in the published patent application." [n.25]

Section 5 of the Act is entitled "Prior Art Effect of Published Applications." This section will amend 35 U.S.C. § 102(e) to provide that a person shall not be entitled to a patent when the invention was described in:

(1)(A) an application for patent, published pursuant to § 122(b) of this title, by another filed in the United States before the invention thereof by the applicant for patent, or

(B) an international application, published pursuant to § 122(b) of this title, by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of § 371(c) of this title before the invention thereof by the applicant for patent, or

(2) a patent granted on an application for patent by an other filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), \*314 (2), and (4) of § 371(c) of this title before the invention thereof by the applicant for patent, or.... [n.26]

Additionally, H.R. 1733 provides in § 6 that the PTO may recover the cost of publishing patent applications by charging a fee for publication or by increasing existing fees. [n.27] H.R. 1733 also includes § 8, which amends the language of various existing statutes to conform to the publication of patent applications.

Finally, § 10 of the Act provides that the amendments made by §§ 2-7 of the Act "shall take effect on January 1, 1996," and will apply to all United States applications filed after that date, as well as all United States applications that result from international applications filed after that date. [n.28]

H.R. 1733 was forwarded to the House Judiciary Committee for study. On June 8, 1995, hearings were held by the House Subcommittee on Courts and Intellectual Property. [n.29] PTO Commissioner Bruce Lehman spoke at the hearings in favor of H.R. 1733 [n.30] and stated that "early publication of applications decreases the likelihood that the technology they disclose will be overlooked as prior art" and that publication "will result in better examinations." [n.31]

At the time this article went to press, H.R. 1733 was still pending in Congress. According to some sources, the bill is effectively being blocked by Congressional opponents, including most prominently, Representative Dana Rohrbacher (R-Calif.), who oppose the publication of patent applications. [n.32]

#### \*315 IV. Proposed PTO Regulations Concerning the Publication of Patent Applications

In preparation for the enactment of H.R. 1733, the PTO issued a Notice of Proposed Rulemaking on August 14, 1995, entitled "Changes to Implement 18-Month Publication of Patent Applications." [n.33]

The proposed regulations provide that a patent application will be published 18 months after the filing date, including the earliest date for which priority is sought, unless:

- (1) the application is national security classified under proposed 37 C.F.R. § 5.9(b) or subject to a secrecy order under 35 U.S.C. § 181;
- (2) the application has already issued as a patent;
- (3) the application is no longer pending; or
- (4) the application was published earlier pursuant to a petition by the applicant. [n.34]

Provisional applications, design applications, and reissue applications are exempt from the publication rules. [n.35]

The publication under proposed regulation 37 C.F.R. § 1.306(b) will consist of the following:

(1) a "Gazette Entry" in a published "Gazette of Patent Application Notices," which will consist of the application \*316 number, filing date, title, inventor's name, abstract, a drawing and representative claim, and classification information; [n.36]

(2) a "Patent Application Notice" (PAN) which contains the same information as that in the Gazette Entry; [n.37]

(3) a "Technical Contents Publication" (TCP) which contains the PAN and the specification, claims and drawings of the application; and

(4) public access to a full copy of the application and all papers in the application file. [n.38]

On the day of publication, the PAN will be mailed to the applicant. [n.39]

As noted earlier, the proposed regulations allow for early publication upon petition by the applicant. [n.40] As for delayed publication, an independent inventor, under proposed 35 U.S.C. § 41(h), who has not requested priority from an earlier filed application can, by petition, delay publication "until three months after an action on the merits...." [n.41] The petition for delayed publication must be accompanied by certification that the invention was not and will not be the subject of a foreign application. [n.42] The proposed regulations also permit an application's withdrawal from publication either by the PTO or at the applicant's request for any of the following reasons:

(1) a mistake on the part of the PTO;

(2) the application is national security classified or subject to a secrecy order; or

\*317 (3) express abandonment under 37 C.F.R. § 1.138. [n.43]

As noted above, once the application has been published, a third party may obtain access to the entire file of the application [n.44] by payment of a fee. [n.45] Assignments are also available to third parties under the proposed regulations. [n.46]

The proposed regulations also reflect other changes in the prosecution of patent applications that are necessitated or caused by the publication process. For example, the rules on obtaining priority from prior filed U.S. applications, international applications designating the U.S., and foreign applications will be changed.

Under proposed regulation 37 C.F.R. § 1.78, applications seeking priority from a previously filed non-provisional U.S. application or an international application designating the U.S. must contain, or be amended to contain, a reference to the priority application. [n.47] If amended, this must be done within two months of the filing or within fourteen months of the filing date of the prior application, whichever is later. The reference to the priority application must be by application number and filing date, and must be made in the first sentence of the specification. [n.48] The same requirement applies to an applicant seeking priority from a provisional application under proposed 35 U.S.C. § 111(b). [n.49] The time period for filing a priority claim from a non-\*318

provisional U.S. application, an international application, or a provisional application may not be extended. [n.50]

Similarly, under proposed regulation 37 C.F.R. § 1.55, to claim priority of a foreign application the application must contain, or be amended to contain, a reference to each priority application by application number and filing date. [n.51] Again, the reference to the priority application must be included within two months of filing or within fourteen months of the filing date of the priority application, whichever is later. The time period for filing a priority claim from a foreign application may not be extended. [n.52]

Under certain limited circumstances, the proposed regulations permit an applicant to file a priority claim after expiration of the time periods designated in proposed 37 C.F.R. § 1.55 for foreign applications, and § 1.78(a)(2) and (4) for prior filed U.S. non-provisional and provisional applications and international applications designating the U.S. To file a late priority claim, the applicant must file a petition during the pendency of the application, accompanied by a surcharge fee and statement that the delay was unintentional. If made by a person not admitted to practice before the PTO, the statement must be verified. [n.53]

The proposed regulations also revise the rules on third party protests to pending patent applications to reflect the publication of applications. The proposed rules permit filing a protest either prior to the publication date or within two months from the date of publication. [n.54] In either event, the protest must be made prior to mailing the notice of allowance. [n.55] If filed after the application's publication, the protest must be served on the applicant. [n.56] Similarly, the proposed regulations also \*319 revise the rules on public use proceedings by permitting a third party to file a petition for a public use proceeding either prior to the publication date or within two months from the publication date. [n.57] In either event, the petition must be filed prior to mailing a notice of allowance. [n.58]

The proposed regulations also include revisions to some of the technical formalities of filing patent applications. These revisions are considered necessary by the PTO in order to permit the publication of applications 18 months after filing.

First, the proposed regulations require that applications be legibly typed, on only one side of the page. [n.59] Additionally, the application must be presented in a form that allows it to be subjected to "electronic reproduction by use of digital imaging and optical character recognition." [n.60] With the exception of the drawings, the papers of the application must be numbered consecutively and must be on the same size paper, either 8 1/2" x 11" or A4 size paper (21.0 cm. x 29.7 cm.). [n.61] The proposed regulations also make various revisions to the requirements for submitting drawings [n.62] and for computer program listings. [n.63]

Furthermore, the claims of the application, like the abstract, must be submitted on a separate sheet under the proposed rules. [n.64] The least restrictive claim should be

presented as claim 1, [n.65] and if a claim contains a plurality of elements, each element should be separated by a line indentation. [n.66]

\*320 The proposed regulations also provide that the applicant must file a complete application, including a specification, an abstract, at least one claim, an oath or declaration, drawings when necessary, and the appropriate fee in order to be accorded a filing date. [n.67] The present rules do not include the abstract in the definition of a complete application. [n.68] Additionally, the proposed rules state that the abstract should be submitted "preferably prior to the first page of the specification." [n.69]

The proposed regulations also provide that the elements of the application, if applicable, should be arranged in the following order:

- (1) Utility Transmittal Form;
- (2) Fee Transmittal Form;
- (3) Abstract;
- (4) Title of Invention;
- (5) Cross-reference to Related Applications;
- (6) Statement Regarding Federally Sponsored Research Development;
- (7) Reference to Microfiche Appendix;
- (8) Background of the Invention;
- (9) Brief Summary of the Invention;
- (10) Brief Description of the Drawings;
- (11) Detailed Description of the Invention;
- (12) Claims;
- (13) Drawings;
- (14) Oath of Declaration; and
- (15) Sequence Listings. [n.70]

The title of each element of the application should appear in upper case writing, without underlining and not in bold-face print. [n.71] The proposed regulations contain similar rules on the arrangement of the elements for design applications [n.72] and plant applications. [n.73]

In the event that the application as filed does not comply with the required format set forth in the proposed 37 C.F.R. § 1.52(a) and (b), but otherwise complies with the requirements for a complete application under proposed 37 C.F.R. § 1.51, the applicant will be granted a filing date and will be notified by a Notice to File Missing Parts to submit a \*321 substitute document or documents. [n.74] The proposed regulations state that no extensions of time will be available to respond to a Notice to File Missing Parts. [n.75] Similarly, no extensions of time are available for filing a response to a requirement for an English language translation of the specification. [n.76]

The proposed regulations also change the rules on filing continuation-in-part (CIP) applications under the file wrapper continuation procedure of 37 C.F.R. § 1.62. Under the proposed regulations a substitute specification and drawings must be filed for a CIP application if the file wrapper continuation procedure is used. [n.77]

The proposed regulations also cover issues not directly related to the publication process. For example, the proposed regulations revise the circumstances under which a patent holder can obtain extension of a patent term. [n.78] The proposed regulations also address the present rules regarding affidavit practice when an invention in a pending patent application, or a patent under reexamination, is patentably indistinct from that of a patent held by a single party. [n.79]

At a public hearing on September 19, 1995, the PTO received comments from the intellectual property community on the proposed regulations. [n.80] The comments were generally favorable, although some of the commentators raised concerns about certain regulations.

Speakers at the hearings urged that the TCP, the published patent application document, contain the claims in the application at the time of publication, including any added claims or amendments made to the \*322 claims since filing. Herbert C. Wamsley, speaking on behalf of the Intellectual Property Owners (IPO) organization, stated that having the latest form of the claims in the published application document would assist in the study of the application for possible infringement and validity issues. [n.81]

Robert Armitage, speaking on behalf of the American Intellectual Property Lawyers' Association (AIPLA), added that "we believe ... that it's very important that what be available for citation, not be the application as filed but the application that was prepared for publication, the application that would include amendments made up to three months before the date of publication." [n.82]

Donald Dunner, speaking on behalf of the American Bar Association, Intellectual Property Law Section, urged that the PTO provide a first office action within 14 months of the filing for all applications. [n.83] Mr. Dunner stated as follows:

There are two basic reasons for the Section's position on this issue, which is that a first office action should be available in all cases [14 months] after the filing date. First of all, trade secret rights which hitherto had been protected under Section 122 of the statute will be given up to the extent that they had not been given up already in foreign applications and publications. And it is critical, our members feel, that applicants ... have the views of a full search report and an examination to determine whether or not they should give up those trade secret rights.

Secondly, assuming there are provisional rights between publication and the issuance of the patent, it is important that applicants be able to amend their claims prior to having the application published since the provisional rights are keyed to the application claims as they existed at the time of publication, and without a first office action the ability to know how to amend the claims will be severely limited. [n.84]

## V. Strategies for Adapting to the Publication of Patent Applications

The publication of patent applications represents a major change in United States patent practice. Patent attorneys should be prepared for \*323 the change in the law, and should consider strategies for the most effective representation of their clients in view of the new proposed laws.

#### A. Strategies for Patent Applicants

Patent applicants must be aware that patent applications will no longer be maintained in secrecy until the patent issues. Instead, 18 months after the earliest filing date for which priority is sought, the applicant will find his invention or technology open to public view. Patent applicants should learn to use the patent application publication process to their advantage.

The first strategy applicants should adopt is timely prosecution of their patent application. [n.85] It is in the applicant's best interest to have the published application in as close a form as possible to the language of the issued patent. If the invention claimed in the patent is identical to the invention as claimed in the published patent application, then under the proposed statute the applicant will be able to sue an infringer for damages caused by infringement between the date of publication and the issue date. [n.86]

In addition to prosecuting the application in a timely manner, the applicant will be required to submit documents supporting foreign priority claims within a short period after the filing date. [n.87] In order for the PAN to contain assignment data, the assignment must be submitted to the PTO within two months of filing or 14 months from the earliest priority date, whichever is later. [n.88] The drawings as originally filed must be in a form suitable for electronic reproduction by digital imaging. [n.89]

Once the patent application is published, the applicant should provide formal notice of the application to any persons it believes may be infringing the patent. As § 4 of H.R. 1733 provides, the infringer must have actual notice of the application in order for that applicant to \*324 obtain damages for infringement for the period dating from publication to issue. [n.90]

Proposed PTO regulations will allow access to the files of applications after publication. [n.91] Applicants should be conscious of this access and should seek to keep potential infringers abreast of the application process. Since the potential infringer could get access to the file on its own, there is no apparent drawback to advising the alleged infringer of the application's status. The applicant may attempt to use the continued notice of the application's status to influence the alleged infringer into entering into a licensing agreement. Alternatively, the applicant may, by continuing to give notice to the infringer of the status of the application, establish a record for damages for willful infringement at trial. [n.92]

#### B. Strategies for Third Parties or Competitors of Patent Applicants

When the publication of patent applications begins, competitors of patent applicants or other interested third parties should scan the PTO's Gazette of Patent Application Notices for applications in the technologies of interest. [n.93] For applications that claim subject matter that appears to read on the third party's technology, the third party should obtain the entire application and, perhaps, the prosecution history file. The third party may then conduct a detailed study of the application and its claimed subject matter. Third parties should specifically consider the scope of the claims in the application under the doctrine of equivalents in view of the prosecution history. Third parties should also take note of the prior art submitted by the applicant and cited by the Examiner.

The present proposed regulations provide that the published version of the application will be a copy of the application as filed. Should the PTO adopt the suggestions raised at the hearings, it may publish a version of the application that includes any amendments made up to the date shortly before publication. [n.94] The version containing the \*325 amendments will provide a better indication of the scope of coverage provided by the issued application.

Under the existing regulations on filing protests in applications, third parties may take action in response to a published application that the third party believes does not claim patentable subject matter. If the third party believes that the claimed subject matter in the application is invalid over the prior art, the third party may submit prior art, with a short statement of its relevance, in opposition to the published application. [n.95]

If the third party believes that the subject matter claimed in the application is not patentable because of a public use or on sale bar under 35 U.S.C. § 102, the third party may petition for a public use proceeding. [n.96] However, prior art submissions or the request for a public use proceeding must be made within two months of the publication date. [n.97] Hence, third parties must be timely in their review of published applications and in their submission of prior art or other protests. After submitting protests, third parties should then keep abreast of the prosecution of the case by the applicant by monitoring the file wrapper of the application. [n.98]

A third party should also consider obtaining opinions of counsel on whether the claims of a particular application will, if the application issues, read on the third party's invention. Third parties should also seek additional legal opinions on whether the claims of the application, if issued, would be valid.

## VI. Conclusion

In light of the United States agreement with Japan and the almost uniform practice in foreign patent offices, it is likely that legislation, in some form, may eventually be enacted to require the publication of United States patent applications 18 months after filing. Publication of patent applications could begin in 1996, with the enactment of H.R. 1733. In advance of the changes in the law, patent applicants and other interested parties

should consider various strategies and establish procedures for maximizing their intellectual property rights.

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[n.1]. H.R. 1733, 104th Cong., 1st Sess. (1995).

[n.2]. The text of the proposed regulations is available on the Internet at <http://www.uspto.gov>. The proposed regulations can also be found at 1177 Off. Gaz. Pat. Office 61 (Aug. 15, 1995). See also Notice of Public Hearing and Request for Comments on 18-month Publication of Patent Applications, 1170 Off. Gaz. Pat. Office 390, 391 (Jan. 3, 1995).

[n.3]. 35 U.S.C. § 122 (1984). See also 37 C.F.R. § 1.14 (1994). Access to a pending application can be obtained by a third party where the applicant, the applicant's assignee, or the applicant's attorney gives written authority in the application to allow access.

[n.4]. See 37 C.F.R. § 1.14(a) (1994).

[n.5]. See 37 C.F.R. § 1.14(b) (1994).

[n.6]. Id.

[n.7]. See K. Murashige, Harmonization of Patent Laws, 16 Hous. J. Int'l. L. 591, 612 (1994).

[n.8]. See A. Jacobs, Patents Throughout the World E28-E29 (4th ed. 1995).

[n.9]. 1 Digest of Intellectual Property Laws of the World: Japan 2 (1991).

[n.10]. 1 Digest of Intellectual Property Laws of the World: Canada 8 (1994). Applications filed after October 1, 1989 are published 18 months after the date of filing. Applications filed before October 1, 1989 are maintained in secrecy.

[n.11]. Patent Cooperation Treaty, Art. 21. See also Patent Cooperation Treaty, Rule 48, regarding the content of a published international application.

[n.12]. See T. Riordan, U.S., Japan In Accord on Patents, N.Y. Times, Aug. 17, 1994, at D1.

[n.13]. See Notice of Public Hearing and Request for Comments on 18-month Publication of Patent Applications, *supra* note 2 at 391. In addition to agreeing that patent applications will be published 18 months after the date of filing, the United States also agreed to implement the previous General Agreement on Tariffs and Trade (GATT) provision to change the term of a patent from 17 years from the date of issue to 20 years from the date of the filing of the application. *Id.* The GATT agreement was enacted into law on December 8, 1994 as part of the Uruguay Round Agreement Act, Pub. L. No. 103-465 (1995). See especially § 531-34.

[n.14]. H.R. 1733. The bill was introduced by Representatives Carlos Moorehead and Patricia Schroeder. See Bill Would Provide Early Publication of Patents, 50 Pat. Trademark & Copyright J. (BNA) 114 (June 1, 1995).

[n.15]. H.R. 1733 at § 2.

[n.16]. Provisional patent applications, which are governed by 35 U.S.C. § 111(b), allow an applicant to obtain a priority date if another application for the same subject matter is filed within 12 months of the filing of the provisional application. A provisional application, however, cannot issue as a patent. See generally G. Yacura, A Patent Practitioner's Guide to Understanding GATT and its Implications, 4 Fed. Cir. B. J. 424, 445 (1994).

[n.17]. H.R. 1733 at § 2.

[n.18]. *Id.*

[n.19]. *Id.*

[n.20]. Id.

[n.21]. Id.

[n.22]. Id.

[n.23]. Id. at § 3.

[n.24]. Id. at § 4.

[n.25]. Id. Also, § 154(d)(2) states that the right to obtain a royalty under § 154(d)(1) for the publication of an international application designating the United States begins on the date the PTO makes a translation of the international application available to the public.

[n.26]. Id. at § 5.

[n.27]. Id. at § 6.

[n.28]. Id. at § 10. H.R. 1733 has additional provisions which do not relate to the publication of patent applications. For example, § 8 of the Act, entitled "Patent Term Extension Authority" allows for the extension of patent terms for various reasons, including "an unusual administrative delay" on behalf of the PTO in issuing the patent. Section 9 amends 35 U.S.C. § 119(e), regarding provisional patent applications to provide that if the last day of the 12-month period after the filing of a provisional application falls on a Saturday, Sunday, or a federal holiday within the District of Columbia, the period shall be extended to the succeeding business day.

[n.29]. See House Subcommittee Considers Bills on Reexamination and Early Publication, 50 Pat. Trademark & Copyright J. (BNA) 174-76 (June 15, 1995).

[n.30]. See Id. at 175.

[n.31]. Id.

[n.32]. See Congressional Outlook '96, Chemical & Engineering News 18 (Jan. 8, 1996). See also House Panel Examines Bills on Patent Law Reforms, 51 Pat. Trademark & Copyright J. (BNA) 50-52 (Nov. 9, 1995).

[n.33]. See supra note 2 and accompanying text. Even before H.R. 1733 was introduced into Congress in May 1995, the PTO had acknowledged that the publication of U.S. patent applications was inevitable. The PTO solicited comments from the Patent Bar and conducted hearings in February, 1995, concerning patent application publication. See Notice of Public Hearing and Request for Comments on 18-month Publication of Patent Applications, supra note 2. The hearings were held on February 15, 1995. The transcript of the hearings may be obtained via the Internet at <http://ftp.uspto.gov>. Written comments submitted to the PTO may also be obtained via the Internet at <http://www.uspto.gov/web/18mnth/comments>. A summary of the comments at the February hearing and the accompanying written comments is contained in the Notice of Proposed Rulemaking.

[n.34]. Proposed 37 C.F.R. § 1.306(a). The proposed new regulation 37 C.F.R. § 5.9 provides that applications that are national security classified and contain authorized national security warnings are not to be published until the application is declassified. Under proposed 37 C.F.R. § 1.9(h), "national security classified" refers to material deemed to be kept secret in the interest of national security by Act of Congress or by Executive Order.

[n.35]. Proposed 37 C.F.R. § 1.306(c).

[n.36]. The Gazette of Patent Application Notices will be made available to depository libraries in the same manner as the Official Gazette.

[n.37]. Each PAN will be assigned a Patent Application Number. See proposed 37 C.F.R. § 1.5(g). Assignment data will be included on the PAN if the cover sheet of the patent application contains the relevant assignment information and states that the applicant wishes that the assignment information should be published. The assignment and cover sheet must be submitted within two months of filing or 14 months from the earliest filing date for which priority is claimed, whichever is earlier. See proposed 37 C.F.R. § 3.31(b).

[n.38]. Proposed 37 C.F.R. § 1.11(a). The proposed regulations allow for obtaining both non-certified and certified copies of PANs, TCPs, and the file wrapper and contents of the published application. See proposed 37 C.F.R. § 1.13.

[n.39]. Proposed 37 C.F.R. § 1.307.

[n.40]. Proposed 37 C.F.R. § 1.306(d). The petition fee is \$130 for both small entities and large entities. See proposed 37 C.F.R. § 1.17(i).

[n.41]. Proposed 37 C.F.R. § 1.306(e).

[n.42]. Proposed 37 C.F.R. § 1.307(e)(2). The petition fee is \$130 for both small entities and large entities. See proposed 37 C.F.R. § 1.17(i).

[n.43]. Proposed 37 C.F.R. § 1.305. The proposed regulations would amend 37 C.F.R. § 1.138 by adding the following language: An applicant seeking to abandon an application to avoid publication of the application must submit a proper letter of express abandonment more than two months prior to the projected date of publication to allow sufficient time to permit the appropriate officials to recognize the abandonment and remove the application from the publication process, and unless an applicant receives written acknowledgment of the letter of express abandonment prior to the projected date of publication, applicant should expect that the application will be published in regular course.

[n.44]. See proposed 37 C.F.R. § 1.11. This includes access to abandoned applications that have previously been published.

[n.45]. The proposed 37 C.F.R. § 1.19(b)(2) sets a fee schedule which varies depending on whether the petitioner is seeking a copy of the entire file wrapper (\$150.00) or a selected document or documents (\$75.00 for a first document and \$25.00 per document thereafter).

[n.46]. See proposed 37 C.F.R. § 1.12.

[n.47]. See proposed 37 C.F.R. § 1.78(a)(2).

[n.48]. Id.

[n.49]. See proposed 37 C.F.R. § 1.78(a)(4). The time period for filing a claim for priority cannot be extended. See also proposed 37 C.F.R. § 1.78(a)(6).

[n.50]. See proposed 37 C.F.R. § 1.78(a)(6).

[n.51]. See proposed 37 C.F.R. § 1.55(a).

[n.52]. See proposed 37 C.F.R. § 1.55(d).

[n.53]. See proposed 37 C.F.R. §§ 1.55(c) and 1.78(a)(5). The fee is \$1,500.00 both for a small entity and a large entity.

[n.54]. Proposed 37 C.F.R. § 1.291(a)(1). The fee for filing a protest under the proposed section is \$220.00 for both a small entity and a large entity. See proposed 37 C.F.R. § 1.17(t).

[n.55]. Id.

[n.56]. Proposed 37 C.F.R. § 1.291(a)(2). The other elements of the protest proceeding are maintained from the present law. Thus, under present practice, a protest submitted under 37 C.F.R. § 1.291 must contain a list of the patents, publications, or information relied upon, a concise explanation of the relevance of each item, and a copy of each item. The party who files the protest will not receive any correspondence except for the return of a self-addressed stamped post card acknowledging receipt. The PTO may ask the applicant to reply to the issues raised by the protest. See 37 C.F.R. § 1.291 (1994).

[n.57]. Proposed 37 C.F.R. § 1.292. The fee for filing a petition under this section is \$1,390.00 for both a small entity and a large entity.

[n.58]. Id.

[n.59]. Proposed 37 C.F.R. § 1.52(b). The previous regulations had permitted the filing of an application that was "legibly written" as well as typed.

[n.60]. Proposed 37 C.F.R. § 1.52(a). If the application papers are not in suitable form, substitute papers will be required.

[n.61]. Proposed 37 C.F.R. § 1.52(b). The proposed regulation also requires top and bottom margins of at least 2.0 cm, a left margin of at least 2.5 cm, and a right margin of at least 2.0 cm. Id.

[n.62]. See proposed 37 C.F.R. § 1.84. As explained generally by the PTO in its discussion of the proposed rules in the Notice of Proposed Rulemaking, "[a]s a drawing figure will be included in the Gazette Entry in the Gazette of Patent Application Notices and the Patent Application Notice, drawings suitable for electronic reproduction by digital imaging would be necessary for the initial processing of the application."

[n.63]. See proposed 37 C.F.R. § 1.96.

[n.64]. Proposed 37 C.F.R. § 1.75(h).

[n.65]. Proposed 37 C.F.R. § 1.75(g).

[n.66]. Proposed 37 C.F.R. § 1.75(i).

[n.67]. Proposed 37 C.F.R. § 1.51(a).

[n.68]. 37 C.F.R. § 1.51(a) (1994).

[n.69]. Proposed 37 C.F.R. § 1.72(b).

[n.70]. Proposed 37 C.F.R. § 1.77(a). A sample Utility Transmittal Form is contained in an Appendix to the Notice of Proposed Rulemaking, along with additional forms including transmittal forms for design and patent applications.

[n.71]. Proposed 37 C.F.R. § 1.77(b).

[n.72]. Proposed 37 C.F.R. § 1.154(a).

[n.73]. Proposed 37 C.F.R. § 1.163(c).

[n.74]. Proposed 37 C.F.R. § 1.53(d)(1).

[n.75]. *Id.*

[n.76]. Proposed 37 C.F.R. § 1.136(a)(1)(ii). The same requirements for filing applications in proper form apply under the proposed regulations to applications filed under 37 C.F.R. §§ 1.60 and 1.62. Additionally, under proposed versions of §§ 1.60 and 1.62, no extensions of time are permitted for filing an abstract and claims on a separate sheet, a substitute specification, and sheets of drawings suitable for optical character recognition. As explained by the PTO in its discussion of the proposed rule changes in the Notice of Proposed Rulemaking, "[a]s any substituted typewritten papers containing the subject matter of the originally filed application papers would constitute a substitute specification, the provisions of § 1.125 governing the entry of a substitute specification would be applicable, and § 1.52(a), as proposed, would include a specific reference to § 1.125."

[n.77]. Proposed 37 C.F.R. § 1.62(e)(2).

[n.78]. See proposed 37 C.F.R. § 1.701. The revisions to this section generally allow an applicant to obtain an extension for "an unusual administrative delay" on behalf of the PTO.

[n.79]. See proposed 37 C.F.R. § 1.31.

[n.80]. The text of the hearings is available over the Internet at <http://www.uspto.gov>.

[n.81]. Hearings on the Notice of Proposed Rulemaking to Implement 18-Month Publication of Patent Applications, 104th Cong., 1st Sess. (1995) [hereinafter Hearings] (testimony of Herbert C. Wamsley).

[n.82]. Hearings, *supra* note 81 (testimony of Robert Armitage).

[n.83]. Hearings, *supra* note 81 (testimony of Donald Dunner).

[n.84]. *Id.*

[n.85]. The patent application publication process is similar in this regard to the 20 year from filing date patent term law enacted by Congress as part of the Uruguay Round Agreement Act, Pub. L. No. 103-465 (1995). See also *supra* note 13. Both of these laws encourage applicants to prosecute their patent applications as quickly as possible.

[n.86]. See *supra* note 29 and accompanying text. The patent application publication process is similar in this regard to the GATT-related 20 year from filing date patent term laws. Both of these laws encourage applicants to prosecute their patent applications as quickly as possible.

[n.87]. See *supra* notes 51-53 and accompanying text.

[n.88]. See proposed 37 C.F.R. § 3.31(b).

[n.89]. See proposed 37 C.F.R. § 1.85(a).

[n.90]. See *supra* notes 24-25 and accompanying text.

[n.91]. See proposed 37 C.F.R. § 1.306(b)(4).

[n.92]. See 35 U.S.C. § 271 (1984) which provides that after a finding of patent infringement a court "may increase the damages up to three times the amount found or assessed."

[n.93]. Aside from concerns about patent rights, third parties may take advantage of the earlier dissemination of technological advances by the publication process for their own research and development.

[n.94]. See *supra* notes 81-84 and accompanying text.

[n.95]. Proposed 37 C.F.R. § 1.291 (1994).

[n.96]. Proposed 37 C.F.R. § 1.292.

[n.97]. Proposed 37 C.F.R. §§ 1.291 and 1.292.

[n.98]. Proposed 37 C.F.R. §§ 1.291 and 1.292 state that after the filing of a protest the third party protester will not receive any correspondence on the further prosecution of the case.