

**ACTION:** Guidance on reporting requirement effective date and form.

**SUMMARY:** This document reminds money transmitters and money order and traveler's check issuers, sellers, and redeemers of the January 1, 2002 effective date for the requirement to report suspicious transactions. In addition, this document explains which form these businesses must use to report suspicious transactions.

**FOR FURTHER INFORMATION CONTACT:** Patrice Motz, Money Services Business Program, Office of Compliance and Regulatory Enforcement, FinCEN (800) 949-2732; Judith Starr, Chief Counsel or Cynthia L. Clark, Deputy Chief Counsel, FinCEN (703) 905-3590.

**SUPPLEMENTARY INFORMATION:**

**I. Introduction**

The statute generally referred to as the "Bank Secrecy Act," Titles I and II of Public Law 91-508, as amended, codified at 12 U.S.C. 1829b, 12 U.S.C. 1951-1959, and 31 U.S.C. 5311-5331, authorizes the Secretary of the Treasury, *inter alia*, to require financial institutions to keep records and file reports that are determined to have a high degree of usefulness in criminal, tax, and regulatory matters, or in the conduct of intelligence or counter-intelligence activities, to protect against international terrorism, and to implement counter-money laundering programs and compliance procedures. Regulations implementing Title II of the Bank Secrecy Act appear at 31 CFR part 103. The authority of the Secretary to administer the Bank Secrecy Act has been delegated to the Director of FinCEN.

The Secretary of the Treasury was granted authority in 1992, with the enactment of 31 U.S.C. 5318(g), to require financial institutions to report suspicious transactions. On March 14, 2000, FinCEN issued a final rule requiring money transmitters, and issuers, sellers, and redeemers of money orders and traveler's checks, to report suspicious transactions. (65 FR 13683).

**II. FinCEN Issuance 2001-2**

This document, FinCEN Issuance 2001-2, reminds money transmitters and issuers, sellers, and redeemers of money orders and traveler's checks that the requirement to report suspicious transactions applies to transactions occurring on or after January 1, 2002.<sup>1</sup>

<sup>1</sup> The information collection in this Issuance has been approved by the Office of Management and Budget ("OMB") in accordance with the requirements of the Paperwork Reduction Act (44 U.S.C. 3507(d)) under control number 1506-0001.

A report of a suspicious transaction must be filed no later than 30 calendar days after the date of initial detection of facts that may constitute a basis for filing a report of the suspicious transaction. *See*, 31 CFR 103.20(b)(3).

FinCEN is developing a form to be used solely by money transmitters and issuers, sellers, and redeemers of money orders and traveler's checks to report suspicious transactions. That form, the Suspicious Activity Report—MSB ("SAR—MSB"), will be published in the **Federal Register** for public comment. In the meantime, money transmitters and issuers, sellers, and redeemers of money orders and traveler's checks are to use the existing bank suspicious activity report, Form TD F 90-22.47, to report suspicious activities. Money transmitters and issuers, sellers, and redeemers of money orders and traveler's checks are requested to enter the letters "MSB" in block letters at the top of the form and in the empty space in item 5 of the TD F 90-22.47. Further information about completing the TD F 90-22.47 is available on the general FinCEN Web site at <http://www.treas.gov/fincen> and on the site specific to money services businesses at <http://www.msb.gov>.

Money services businesses are encouraged to continue to use the Financial Institutions Hotline to voluntarily report to law enforcement suspicious transactions that may relate to recent terrorist activity against the United States. The Hotline was established to facilitate the immediate transmittal of this information to law enforcement. The use of the Hotline is voluntary and does not negate the responsibility of a particular money services business to file a TD F 90-22.47.

Dated: December 20, 2001.

**James F. Sloan,**

*Director, Financial Crimes Enforcement Network.*

[FR Doc. 01-31851 Filed 12-27-01; 8:45 am]

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**DEPARTMENT OF COMMERCE**

**Patent and Trademark Office**

**37 CFR Part 1**

[Docket No.: 010815207-1285-03]

RIN 0651-AB41

**Requirements for Claiming the Benefit of Prior-Filed Applications Under Eighteen-Month Publication of Patent Applications**

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

**ACTION:** Final rule.

**SUMMARY:** In implementing the provisions of the American Inventors Protection Act of 1999 related to the eighteen-month publication of patent applications, the United States Patent and Trademark Office (Office) revised the rules of practice related to requirements for claiming the benefit of a prior-filed application. The Office is now revising the time period for claiming the benefit of a prior-filed application in an application filed under the Patent Cooperation Treaty (PCT), revising the time period for filing an English language translation of a non-English language provisional application, and making other technical corrections to the rules of practice related to eighteen-month publication.

**EFFECTIVE DATE:** December 28, 2001.

**FOR FURTHER INFORMATION CONTACT:** Robert A. Clarke or Joni Y. Chang, Legal Advisors, Office of Patent Legal Administration, by telephone at (703) 308-6906, or by mail addressed to: Box Comments—Patents, Commissioner for Patents, Washington, DC 20231, or by facsimile to (703) 872-9399, marked to the attention of Robert A. Clarke.

**SUPPLEMENTARY INFORMATION:** The American Inventors Protection Act of 1999 was enacted into law on November 29, 1999. *See* Pub. L. 106-113, 113 Stat. 1501, 1501A-552 through 1501A-591 (1999). The American Inventors Protection Act of 1999 contained a number of changes to title 35, United States Code, including provisions for the publication of pending applications for patent, with certain exceptions, promptly after the expiration of a period of eighteen months from the earliest filing date for which a benefit is sought under title 35, United States Code ("eighteen-month publication"). The Office implemented the eighteen-month publication provisions of the American Inventors Protection Act of 1999 in 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).

Section 4503(a) of the American Inventors Protection Act of 1999 amended 35 U.S.C. 119(b) to provide that no application for patent shall be entitled to a right of priority under 35 U.S.C. 119(a)-(d) unless a claim identifying the foreign application is filed at such time during the pendency of the application as required by the Office. Section 4503(b) of the American Inventors Protection Act of 1999 amended 35 U.S.C. 119(e) and 120 to provide that no application shall be entitled to the benefit of a prior-filed application unless an amendment containing the specific reference to the prior-filed application is submitted at such time during the pendency of the application as required by the Office. Section 4503 of the American Inventors Protection Act of 1999 also amended 35 U.S.C. 119 and 120 to permit the Office to establish procedures for accepting an unintentionally delayed claim for the benefit of a prior-filed application. Section 4503 of the American Inventors Protection Act of 1999 applies to applications filed under 35 U.S.C. 111 on or after November 29, 2000, and to applications entering the national stage after compliance with 35 U.S.C. 371 that resulted from international applications filed on or after November 29, 2000. *See* Pub. L. 106-113, § 4508, 113 Stat. at 1501A-566 through 1501A-567. This final rule amends 37 CFR 1.55 and 1.78 to: (1) Revise the requirements for claiming the benefit of a prior-filed application in an application filed under the PCT; (2) revise the time period and requirements for filing an English language translation of a non-English language provisional application; and (3) expressly indicate that the time period requirements which implement the provisions of § 4503 of the American Inventors Protection Act of 1999 do not apply to applications filed before November 29, 2000.

#### Discussion of Specific Rules

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

*Section 1.14:* Section 1.14(i)(2) is amended to correct its reference to “35 U.S.C. 154(d)(4) (formerly indicated as “35 U.S.C. 154(2)(d)(4)”).

*Section 1.55:* Section 1.55(a)(1)(i) is amended such that the rules of practice expressly indicate that the time periods in § 1.55(a)(1)(i) do not apply in an application under 35 U.S.C. 111(a) if the application is: (1) an application for a design patent; or (2) an application filed before November 29, 2000. The Office

indicated that the changes to § 1.55 (and § 1.78) to implement eighteen-month publication applied only to applications filed on or after November 29, 2000. *See Changes to Implement Eighteen-Month Publication of Patent Applications*, 65 FR at 57024, 1239 *Off. Gaz. Pat. Office* at 63. The Office, however, has received enough inquiries about whether the time periods set forth in § 1.55(a)(1)(i) (and § 1.78(a)(2) and § 1.78(a)(5)) apply to particular applications that the Office has decided to place this information in § 1.55 (and § 1.78) itself.

Section 1.55(c) is amended to expressly indicate that a petition under § 1.55(c) to accept the delayed claim must also be accompanied by the claim (*i.e.*, the claim required by 35 U.S.C. 119(a)-(d) and § 1.55) for priority to the prior foreign application, unless previously submitted.

*Section 1.78:* Section 1.78(a)(1) is amended to Make its provisions applicable to international applications designating the United States of America. The phrase “nonprovisional application” as used in the rules of practice means either an application filed under 35 U.S.C. 111(a) or an international application filed under 35 U.S.C. 363 that entered the national stage after compliance with 35 U.S.C. 371. *See* § 1.9(a)(3). Thus, provisions which apply only to a nonprovisional application (*e.g.*, the requirement in § 1.78(a)(2)(iii) for a specific reference in an application data sheet (§ 1.76) or the specification) do not apply to any international application that does not enter national stage processing under 35 U.S.C. 371. The specific reference requirements of 35 U.S.C. 119(e) and 120 are met in such an international application by a specific reference to the prior-filed application in the international application papers (*e.g.*, in the Request (PCT Rule 4.10 and § 1.434(d)(2)), or a correction or addition in accordance with PCT Rule 26*bis*).

Section 1.78(a)(2) is amended to place its provisions in separate paragraphs (a)(2)(i) through (a)(2)(iv) for clarity. Section 1.78(a)(2) is also amended to make its provisions applicable to international applications designating the United States of America, and to set forth the time period for making a claim (providing the specific reference required by § 1.78(a)(2)(i)) for both an application filed under 35 U.S.C. 111(a) and an international application designating the United States of America which entered the national stage after compliance with 35 U.S.C. 371.

Specifically, if the later-filed application is an application filed under 35 U.S.C. 111(a), the specific reference

required by § 1.78(a)(2)(i) must be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If, however, the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, the specific reference required by § 1.78(a)(2)(i) must be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed application. This reference must, in any event, be submitted during the pendency of the later-filed application. The provisions relating to an application filed under 35 U.S.C. 111(a) do not change the time period for submitting a specific reference in such applications. The provisions relating to an international application designating the United States of America which entered the national stage after compliance with 35 U.S.C. 371, however, do change the time period for submitting a specific reference to any prior-filed application for which a benefit is claimed in such international applications in that the four-month period is measured from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) rather than the actual filing date of the international application under 35 U.S.C. 363.

Section 1.78(a)(2) is also amended to eliminate the requirement that if the application claims the benefit of an international application, the first sentence of the specification must include an indication of whether the international application was published under PCT Article 21(2) in English. The Office is eliminating this requirement because: (1) The Office will not delay publication of the application if this requirement is not met; and (2) this information can be obtained from other sources.

Section 1.78(a)(2) is also amended such that the rules of practice expressly indicate that the time periods in § 1.78(a)(2)(ii) do not apply if the later-filed application is: (1) An application for a design patent; (2) an application filed under 35 U.S.C. 111(a) before November 29, 2000; or (3) a nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000. The Office indicated that the changes to § 1.78 to implement eighteen-month publication applied only to applications

filed on or after November 29, 2000. *See Changes to Implement Eighteen-Month Publication of Patent Applications*, 65 FR at 57024, 1239 *Off. Gaz. Pat. Office* at 63. The Office, however, has received enough inquiries about whether the time periods set forth in § 1.78 apply to particular applications that the Office has decided to place this information in § 1.78 itself.

Section 1.78(a)(2) is also amended to change the sentence “[t]he identification of an application by application number under this section is the specific reference required by 35 U.S.C. 120 to every application assigned that application number” to “[t]he identification of an application by application number under this section is the identification of every application assigned that application number necessary for a specific reference required by 35 U.S.C. 120 to every such application assigned that application number.” That is, a continued prosecution application under § 1.53(d) (CPA) does not require any additional identification of or reference to the prior application (or any prior application assigned the application number of such application under § 1.53(d)) under 35 U.S.C. 120 and § 1.78(a)(2) other than the identification of the prior application in the request required by § 1.53(d) for a CPA. *See Changes to Patent Practice and Procedure*, 62 FR 53131, 53144 (Oct. 10, 1997), 1203 *Off. Gaz. Pat. Office* 63, 73 (Oct. 21, 1997) (final rule). The change to this provision clarifies that the other provisions of § 1.78(a)(2) (e.g., that the claim be in the application data sheet or the first sentence of the specification) remain applicable when an application under § 1.53(b) claims the benefit under 35 U.S.C. 120 of a continued prosecution application filed under § 1.53(d).

Section 1.78(a)(3) is amended to expressly indicate that a petition under § 1.78(a)(3) to accept the delayed claim must also be accompanied by the claim (i.e., the reference required by 35 U.S.C. 120 and § 1.78(a)(2)) to the benefit of the prior-filed application, unless previously submitted. Section 1.78(a)(3) is also amended to change “paragraph (a)(2)” to paragraph “(a)(2)(ii)” for consistency with the changes to § 1.78(a)(2).

Section 1.78(a)(3) provides that if the reference required by 35 U.S.C. 120 and § 1.78(a)(2) of this section is presented in a nonprovisional application after the time period provided by § 1.78(a)(2)(ii), the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed copending nonprovisional application or international application designating the United States may be accepted if the

applicant files a petition to accept the delayed claim that is accompanied by: (1) the reference required by 35 U.S.C. 120 and § 1.78(a)(2) to the prior-filed application (unless previously submitted); (2) the surcharge set forth in § 1.17(t); and (3) a statement that the entire delay between the date the claim was due under § 1.78(a)(2)(ii) and the date the claim was filed was unintentional.

If an applicant includes a claim to the benefit of a prior-filed nonprovisional application or international application designating the United States elsewhere in the application but not in the manner specified in § 1.78(a)(2)(i) and (iii) (e.g., if the claim is included in an unexecuted oath or declaration or the application transmittal letter) within the time period set forth in § 1.78(a)(2)(ii), the Office will not require a petition (and the surcharge under § 1.17(t)) to correct the claim if the information concerning the claim contained elsewhere in the application was recognized by the Office as shown by its inclusion on a filing receipt. This is because the application will have been scheduled for publication on the basis of the information concerning the claim contained elsewhere in the application within the time period set forth in § 1.78(a)(2)(ii). Of course, the applicant must still submit the claim in the manner specified in § 1.78(a)(2)(i) and (iii) (i.e., by an amendment in the first sentence of the specification or in an application data sheet) to have a proper claim under 35 U.S.C. 120 and § 1.78 to the benefit of a prior-filed application. If, however, an applicant includes such a claim elsewhere in the application and not in the manner specified in § 1.78(a)(2)(i) and (iii), and the claim is not recognized by the Office as shown by its absence on the filing receipt (e.g., if the claim is in a part of the application where priority or continuity claims are not conventionally located, such as the body of the specification), the Office will require a petition (and the surcharge under § 1.17(t)) to correct such claim. This is because the application will not have been scheduled for publication on the basis of the information concerning the claim contained elsewhere in the application.

Section 1.78(a)(4) is amended to make its provisions applicable to international applications designating the United States of America.

Section 1.78(a)(5) is amended to place its provisions in separate paragraphs (a)(5)(i) through (a)(5)(iv) for clarity. Section 1.78(a)(5) is also amended to: (1) Make its provisions applicable to international applications designating the United States of America; (2) set

forth the time period for making a claim (providing the specific reference required by § 1.78(a)(5)) for both an application filed under 35 U.S.C. 111(a) and an international application designating the United States of America which entered the national stage after compliance with 35 U.S.C. 371; and (3) change the time period and requirements for filing an English language translation of a non-English language provisional application.

Specifically, if the later-filed application is an application filed under 35 U.S.C. 111(a), the specific reference required by § 1.78(a)(5)(i) must be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If, however, the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, the specific reference required by § 1.78(a)(5)(i) must be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed application. This reference must, in any event, be submitted during the pendency of the later-filed application. The provisions relating to an application filed under 35 U.S.C. 111(a) do not change the time period for submitting a specific reference in such applications. The provisions relating to an international application designating the United States of America which entered the national stage after compliance with 35 U.S.C. 371, however, do change the time period for submitting a specific reference to any prior-filed application for which a benefit is claimed in such international applications in that the four-month period is measured from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) rather than the actual filing date of the international application under 35 U.S.C. 363.

Section 1.78(a)(5) is also amended such that the rules of practice expressly indicate that the time periods in § 1.78(a)(5)(ii) do not apply if the later-filed application is: (1) an application filed under 35 U.S.C. 111(a) before November 29, 2000; or (2) a nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.

Section 1.78(a)(5) is also amended to provide that if a provisional application was filed in a language other than

English and an English-language translation of the provisional application and a statement that the translation is accurate were not previously filed in the provisional application or the nonprovisional application, applicant will be notified and given a period of time within which to file an English-language translation of the non-English-language provisional application and a statement that the translation is accurate. In a pending nonprovisional application, failure to timely reply to such a notice will result in abandonment of the application. Thus, § 1.78(a)(5) no longer provides that if a provisional application was filed in a language other than English, a claim to the benefit of such provisional application is waived if an English language translation of a non-English language provisional application is not submitted within the later of four months from the actual filing date of the nonprovisional application or sixteen months from the filing date of the prior-filed provisional application. In the event that the Office schedules an application that claims the benefit of a provisional application filed in a language other than English for publication without issuing a notice requiring the applicant to file English-language translation of the non-English-language provisional application, the applicant should file the English-language translation of the non-English-language provisional application and a statement that the translation is accurate before the scheduled publication date. This change to § 1.78(a)(5) allows applicant to file an English-language translation of a non-English language provisional application either in the provisional application or in each nonprovisional application that claims the benefit of the provisional application.

Section 1.78(a)(5) is also amended to delete the term “copending,” as 35 U.S.C. 119(e) no longer requires copendency between a nonprovisional application and a provisional application for the nonprovisional application to claim the benefit of the filing date of the provisional application under 35 U.S.C. 119(e). 35 U.S.C. 119(e)(1) continues to require that any nonprovisional application claiming the benefit of a provisional application be filed within twelve months after the filing date of the provisional application (or the next succeeding business day if the date that is twelve months after the filing date of the provisional application falls on a Saturday, Sunday, or Federal holiday). See *Request for Continued Examination Practice and Changes to*

*Provisional Application Practice*, 65 FR 50092, 50098 (Aug. 16, 2000), 1238 *Off. Gaz. Pat. Office* 13, 18–19 (Sept. 5, 2000) (final rule) (comment 2 and response).

Section 1.78(a)(6) is amended to expressly indicate that a petition under § 1.78(a)(6) to accept the delayed claim must also be accompanied by the claim (*i.e.*, the reference required by 35 U.S.C. 119(e) and § 1.78(a)(5)) to the benefit of the prior-filed provisional application, unless previously submitted. Section 1.78(a)(6) is also amended to change “paragraph (a)(5)” to paragraph “(a)(5)(ii)” for consistency with the changes to § 1.78(a)(5).

Section 1.78(a)(6) provides that if the reference required by 35 U.S.C. 119(e) and paragraph (a)(5) of this section is presented in a nonprovisional application after the time period provided by § 1.78(a)(5)(ii), the claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application may be accepted if the applicant files a petition to accept the delayed claim that is accompanied by: (1) the reference required by 35 U.S.C. 119(e) and § 1.78(a)(5) to the prior-filed provisional application (unless previously submitted); (2) the surcharge set forth in § 1.17(t); and (3) a statement that the entire delay between the date the claim was due under § 1.78(a)(5)(ii) and the date the claim was filed was unintentional.

If an applicant includes a claim to the benefit of a prior-filed provisional application elsewhere in the application but not in the manner specified in § 1.78(a)(5)(i) and (iii) (*e.g.*, if the claim is included in an unexecuted oath or declaration or the application transmittal letter) within the time period set forth in § 1.78(a)(5)(ii), the Office will not require a petition (and the surcharge under § 1.17(t)) to correct the claim if the information concerning the claim contained elsewhere in the application was recognized by the Office as shown by its inclusion on a filing receipt. This is because the application will have been scheduled for publication on the basis of the information concerning the claim contained elsewhere in the application within the time period set forth in § 1.78(a)(5)(ii). Of course, the applicant must still submit the claim in the manner specified in § 1.78(a)(5)(i) and (iii) (*i.e.*, by an amendment in the first sentence of the specification or in an application data sheet) to have a proper claim under 35 U.S.C. 119(e) and § 1.78 to the benefit of a prior-filed provisional application. If, however, an applicant includes such a claim elsewhere in the application and not in the manner

specified in § 1.78(a)(5)(i) and (iii), and the claim is not recognized by the Office as shown by its absence on a filing receipt (*e.g.*, if the claim is in a part of the application where priority or continuity claims are not conventionally located, such as the body of the specification), the Office will require a petition (and the surcharge under § 1.17(t)) to correct such claim. This is because the application will not have been scheduled for publication on the basis of the information concerning the claim contained elsewhere in the application.

*Section 1.311*: Section 1.311(a) is amended to correct the parenthetical reference to “(§ 1.211(f))” to “(§ 1.211(e)).”

*Section 1.434*: Section 1.434(d)(2) is amended by deleting the term “copending,” as the prior national application may be a provisional application and 35 U.S.C. 119(e) no longer requires copendency for a nonprovisional application to claim the benefit of the filing date of a provisional application under 35 U.S.C. 119(e).

*Section 1.491*: The Office proposed amending § 1.491 such that the regulations set forth the current language of 35 U.S.C. 371(b) that defines when national stage commencement occurs. The Office will adopt that proposed change to § 1.491 in a separate final rule that implements an amendment to PCT Article 22.

### Response to Comments

The Office published a notice proposing the above-mentioned changes to the rules of practice. See *Requirements for Claiming the Benefit of Prior-Filed Applications Under Eighteen-Month Publication of Patent Applications*, 66 FR 46409 (Sept. 5, 2001), 1251 *Off. Gaz. Pat. Office* 16 (Oct. 2, 2001) (notice of proposed rulemaking). The Office received seven written comments (from intellectual property organizations, patent practitioners, and the general public) in response to the notice of proposed rulemaking. The comments are 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 are also posted on the Office's Internet Web site (address: <http://www.uspto.gov>).

Most of the comments expressed support for the proposed changes. None of the comments opposed the proposed changes, but several comments included additional suggestions. Those comments and the Office's responses follow (comments that generally support the proposed changes are not discussed):

*Comment 1:* Several comments suggested that the Office make clear that the time period requirements in § 1.78(a)(2)(ii) and § 1.78(a)(5)(ii) (and resulting waiver if these time period requirements are not met) do not apply to applications filed before November 29, 2000. Another comment suggested that the change to § 1.78 be made retroactive to all applications filed on or after November 29, 2000.

*Response:* Sections 1.55 and 1.78 are now amended to expressly state that the time period requirements of § 1.55(a)(1)(i), § 1.78(a)(2)(ii) and § 1.78(a)(5)(ii) do not apply to applications filed before November 29, 2000. Therefore, there is no waiver of a benefit under 35 U.S.C. 119 or 120 for failure to comply with the time period requirements of § 1.55(a)(1)(i), § 1.78(a)(2)(ii) or § 1.78(a)(5)(ii) in an application filed before November 29, 2000.

Except where the terms of § 1.55 and § 1.78 indicate that a provision of § 1.55 or § 1.78 applies only to applications filed on or after November 29, 2000 (*i.e.*, § 1.55(a)(1)(i), § 1.78(a)(2)(ii), and § 1.78(a)(5)(2)(ii)), the provisions of § 1.55 and § 1.78 as now amended are applicable to applications filed before, on, or after November 29, 2000. For example, both the elimination of the requirement that if the application claims the benefit of an international application, the first sentence of the specification must include an indication of whether the international application was published under PCT Article 21(2) in English (§ 1.78(a)(2)), and the more liberal time period and provisions for filing an English language translation of a non-English language provisional application (§ 1.78(a)(5)), apply to applications filed before, on, or after November 29, 2000. Sections 1.55 and 1.78 as now amended, however, provide that the time period requirements of § 1.55(a)(1)(i), § 1.78(a)(2)(ii) and § 1.78(a)(5)(ii) do not apply to applications filed before November 29, 2000.

*Comment 2:* Several comments suggested that § 1.78 be amended to state that, if an applicant includes a claim under § 1.78 to the benefit of a prior-filed application elsewhere in the application, but not in the manner specified in § 1.78(a)(2)(i) and (iii) or § 1.78(a)(5)(i) and (iii), within the time period set forth in § 1.78(a)(2)(ii) or § 1.78(a)(5)(ii), respectively, the Office will not require a petition (and the surcharge under § 1.17(t)) to correct the claim if the information concerning the claim contained elsewhere in the application was recognized by the Office as shown by its inclusion on a

filing receipt or in the patent application publication.

*Response:* The Office has adopted the following practice: if an applicant includes a claim under § 1.78 to the benefit of a prior-filed application elsewhere in the application, but not in the manner specified in § 1.78(a)(2)(i) and (iii) or § 1.78(a)(5)(i) and (iii), within the time period set forth in § 1.78(a)(2)(ii) or § 1.78(a)(5)(ii), respectively, the Office will not require a petition (and the surcharge under § 1.17(t)) to correct the claim if the information concerning the claim contained elsewhere in the application was recognized by the Office as shown by its inclusion on a filing receipt (not as shown by its inclusion in the patent application publication). The reason for this practice is to avoid the situation in which an applicant is required to file a petition (and pay the surcharge under § 1.17(t)) even though the application was scheduled for publication on the basis of the information concerning the claim contained elsewhere in the application, but not in the manner specified in § 1.78(a)(2)(i) and (iii) or § 1.78(a)(5)(i) and (iii), within the time period set forth in § 1.78(a)(2)(ii). That is, whether an applicant is required to file a petition (and pay the surcharge under § 1.17(t)) to correct a claim that does not comply with § 1.78(a)(2)(i) and (iii) or § 1.78(a)(5)(i) and (iii) is based upon the effect the informal claim has on the scheduling of the application for publication, and not whether the informal claim is ultimately included in the patent application publication.

The Office's goal is to encourage applicants to provide claims to the benefit of any prior-filed application in the manner specified in § 1.78(a)(2)(i) and (iii) or § 1.78(a)(5)(i) and (iii) within the time period set forth in § 1.78(a)(2)(ii) or § 1.78(a)(5)(ii). Amending § 1.78 itself to expressly include the above-stated practice would give tacit approval to providing claim to the benefit of a prior-filed application in a manner that does not comply with § 1.78(a)(2)(i) and (iii) or § 1.78(a)(5)(i) and (iii). The commentors' proposed amendment to § 1.78 would have an effect contrary to the Office's goal of encouraging applicants to provide claims to the benefit of any prior-filed application in the manner specified in § 1.78(a)(2)(i) and (iii) or § 1.78(a)(5)(i) and (iii) within the time period set forth in § 1.78(a)(2)(ii) or § 1.78(a)(5)(ii).

Finally, if a claim under § 1.78 does not comply with § 1.78(a)(2)(i) and (iii) or § 1.78(a)(5)(i) and (iii) (but is stated elsewhere in the application), such claim must eventually be presented in the manner specified in § 1.78(a)(2)(i)

and (iii) or § 1.78(a)(5)(i) and (iii) (*i.e.*, by an amendment in the first sentence of the specification or in an application data sheet) to be a proper claim under 35 U.S.C. 119(e) or 120 and § 1.78 to the benefit of a prior-filed application.

*Comment 3:* Several comments suggested that the Office should make it clear that if the requirements of § 1.78(a)(2)(ii) have been met, the applicant has not waived priority or continuity benefits even if the priority or continuity claim is not included in the patent application publication.

*Response:* If a claim under § 1.78 to the benefit of a prior-filed application is stated in the manner specified in § 1.78(a)(2)(i) and (iii) or § 1.78(a)(5)(i) and (iii) within the time period set forth in § 1.78(a)(2)(ii) or § 1.78(a)(5)(ii), the applicant has not waived the claim regardless of whether the Office includes the claim in the patent application publication. Nothing in § 1.78 suggests that the propriety of claim under § 1.78 is dependent upon its inclusion in the patent application publication.

*Comment 4:* Several comments suggested that the Office should provide applicants with the greatest possible flexibility in satisfying priority claim requirements, and should avoid adding technical requirements that may result in a loss of patent rights. The comments specifically suggested that since Office employees are familiar with checking the declaration for priority claims, § 1.78(a)(2)(iii) should be further amended to allow the reference required by § 1.78(a)(2)(i) to be included in the declaration.

*Response:* The Office allows applicants to provide claims under § 1.78 to the benefit of any prior-filed application either in the first line of the specification (where § 1.78 formerly required such a claim to be) or in an application data sheet (§ 1.76). Providing even this level of flexibility hinders the patent application publication and patent printing process when the specification and application data sheet (§ 1.76) contain conflicting information. Providing the oath or declaration under § 1.63 as an additional possible location for claims under § 1.78 to the benefit of any prior-filed application would result in confusion in situations in which: (1) the applicant has submitted multiple oaths or declarations under § 1.63; or (2) information submitted in the oath or declaration conflicts with information submitted in the specification or the application data sheet (§ 1.76). Providing the oath or declaration under § 1.63 as an additional possible location for claims to the benefit of any prior-

filed application would also cause problems in the situation in which it is desirable to delete a claim to the benefit of a prior-filed application (for patent term purposes), in that a substitute oath or declaration not containing the claim would be necessary to eliminate a claim if such claim is made by a statement in the oath or declaration (§ 1.63).

*Comment 5:* Several comments suggested that the Office should take all steps necessary to ensure that all proper priority or benefit claims are included in the first paragraph of the patent application publication.

*Response:* The applicant and application information (*i.e.*, inventor names, including order, title, priority/benefit, assignee name) that is in the Office's Patent Application Locating and Monitoring (PALM) system at the time the application content is extracted from the Office's Patent Application Capture and Review (PACR) database for publication will be reflected on the front page of the patent application publication. Thus, if an application is filed without any priority or benefit claim, but a priority or benefit claim is subsequently submitted before the application content has been extracted for publication, the priority or benefit claim will be reflected on the front page of the patent application publication. The application content is currently extracted for publication approximately nine weeks before the projected publication date. The time period in § 1.55(a)(1), § 1.78(a)(2)(ii), and § 1.78(a)(5)(ii) for submitting a priority or continuity claim is four months from the actual filing date of the application or sixteen months from the filing date of the prior-filed application, which does not appear to expire until after the time at which application content is extracted for publication. As a practical matter, however, this time period will expire before the time at which application content is extracted for publication (and, as such, any timely priority or continuity claim should be entered into the Office's PALM system before the time at which application content is extracted for publication) because the failure to state a priority or continuity claim before a publication date is originally calculated will result in projected publication date that is later than the projected publication date would have been if such priority or continuity claim were taken into account.

If an untimely claim under § 1.78 to the benefit of a prior-filed application is accepted under § 1.78(a)(3) or § 1.78(a)(6) after the application content has been extracted for publication purposes, the Office plans to correct its

electronic records relating to the patent application publication such that the claim under § 1.78 will be reflected on the Office's electronic records of the patent application publication (the eighteen-month publication process does not involve the creation of paper-based records).

Finally, while priority and continuity claims will be reflected on the front page of the patent application publication, continuity claims under § 1.78 will not additionally be stated on the first line of the specification unless the claim is included in the first line of the specification as originally filed or as filed in a copy of the application submitted by the Office electronic filing system under § 1.215(c). Specifically, claims under § 1.78 will not additionally be stated on the first line of the specification if the claim is included in a preliminary amendment to the specification (*see* § 1.215(c) (the patent application publication will not include any amendments, including preliminary amendments, unless applicant supplies a copy of the application containing the amendment pursuant to § 1.215(c))) or in an application data sheet (*cf. Changes to Implement the Patent Business Goals*, 65 FR 78958, 78959 (Dec. 18, 2000), 1242 *Off. Gaz. Pat. Office* 65 (Jan. 9, 2001) (final rule and correction) ("If continuity data is included in an application data sheet, but not in the first sentence of the specification, the continuity data to be set forth in the application data sheet will not be printed in the first line of the specification in the patent")).

*Comment 6:* One comment questioned whether there is any mechanism for correcting the absence of a priority claim in an international application if an applicant files the international application designating the United States of America, but subsequently files a continuation application that claims the benefit of the international application and the international application never enters the national stage under 35 U.S.C. 371.

*Response:* The requirement that a claim to the benefit of a prior-filed provisional application, a prior-filed nonprovisional application, or a prior-filed international application designating the United States be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed application does not apply to an international application that never entered the national stage under 35 U.S.C. 371. Therefore, to amend the

later-filed international application to add a claim to the benefit of a prior-filed provisional application, a prior-filed nonprovisional application, or a prior-filed international application designating the United States, the applicant need only file a petition under § 1.182 to amend an abandoned application (the later-filed international application) with the claim to the benefit of a prior-filed application (regardless of whether the later-filed international application was filed in the United States Receiving Office).

*Comment 7:* Several comments supported the proposed change by which the Office would issue a notice in a nonprovisional application claiming the benefit of a non-English language provisional application that sets a time period within which the English translation must be filed, but noted that if the Office fails to issue such a notice and the applicant does not provide such a translation before publication, the burden will fall on applicants against whom the resulting patent application publication is cited as a reference to obtain a translation of the provisional application.

*Response:* The Office plans to check during the preexamination processing of a nonprovisional application to determine whether the nonprovisional application claims the benefit of a provisional application that was filed in a language other than English and, if so, whether an English-language translation of the provisional application was filed in the provisional application. If the nonprovisional application claims the benefit of a provisional application that was filed in a language other than English and no English-language translation of the provisional application was filed in the provisional application, the Office will issue a notice requiring the applicant to timely file an English-language translation and a statement that the translation is accurate. If the Office schedules an application that claims the benefit of a provisional application filed in a language other than English for publication without issuing a notice requiring the applicant to file an English-language translation of the non-English-language provisional application, the applicant should file the English-language translation of the non-English-language provisional application and a statement that the translation is accurate before the scheduled publication date.

The situation in which a patent application publication results from a nonprovisional application that claims the benefit of a provisional application that was filed in a language other than

English, and no English-language translation of the provisional application was filed in either the provisional application or the nonprovisional application, will not occur unless: (1) The Office fails to issue a notice during the preexamination processing of the nonprovisional application requiring the applicant to timely file an English-language translation of the provisional application; and (2) the applicant fails to provide the English-language translation of the non-English-language provisional application before the publication date of the patent application publication. Once this situation comes to the Office's attention, § 1.78(a)(5)(iv) as now amended provides that the Office may issue a notice requiring the applicant (in the nonprovisional application that resulted in the patent application publication) to provide an English-language translation of the non-English-language provisional application and a statement that the translation is accurate (the Office may also simply obtain its own English-language translation of the non-English-language provisional application if that appears to be the most convenient course of action). Failure to timely provide an English-language translation of the non-English-language provisional application and a statement that the translation is accurate in reply to such a notice will result in abandonment in a pending nonprovisional application, and may jeopardize the claim to the benefit of the provisional application in any situation (since the requirements of § 1.78(a)(5) have not been complied with).

*Comment 8:* One comment questioned whether a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371 must include a reference under § 1.78 to the underlying international application.

*Response:* A reference under § 1.78 to the underlying international application is neither necessary nor appropriate in a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371. See *Manual of Patent Examining Procedure* § 1893.03(c) (8th ed. 2001) (a national stage application filed under 35 U.S.C. 371 may not claim benefit of the filing date of the international application of which it is the national stage since its filing date is the date of filing of that international application).

*Comment 9:* One comment suggested that the surcharge for the unintentionally delayed submission of a priority claim was excessive.

*Response:* As indicated in the final rule to implement eighteen-month publication, this surcharge amount must be sufficient to provide an incentive for applicant to exercise care to ensure that any desired claim under 35 U.S.C. 119, 120, 121, or 365(a) or (c) is timely presented. As such, the surcharge amount tracks the fee amount for a petition to revive an unintentionally abandoned application (35 U.S.C. 41(a)(7)). See *Changes to Implement Eighteen-Month Publication of Patent Applications*, 65 FR at 57040, 1239 Off. Gaz. Pat. Office at 77 (comment 8 and response).

*Comment 10:* One comment noted that a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371 has already been published as an international application.

*Response:* As indicated in the final rule to implement eighteen-month publication, the International Bureau publication of an international application will not be included in the Office's patent application publication search database. The Office must (re)publish international applications that entered the national stage to place these applications into its patent application publication search database. The benefit gained by ensuring that these prior art documents will be included in the Office's patent application publication search database outweighs the cost of (re)publishing these applications. See *Changes to Implement Eighteen-Month Publication of Patent Applications*, 65 FR at 57045, 1239 Off. Gaz. Pat. Office at 82 (comment 47 and response).

#### Classification

##### *Administrative Procedure Act*

The changes in this final rule concern only the procedures for filing claims for the benefit of a prior-filed application under 35 U.S.C. 119(e) or 120, the procedures for filing an English language translation of a non-English language provisional application, and technical corrections to the provisions of §§ 1.78, 1.311, and 1.434. Because all of the changes relate to Office practices and procedures, prior notice and an opportunity for public comment was not required pursuant to 5 U.S.C. 553(b)(A) (or any other law), and thirty-day advance publication is not required pursuant to 5 U.S.C. 553(d) (or any other law). However, because the Office desired the benefit of public comment on this topic, the Office voluntarily accepted comments pursuant to a

published notice proposing the above-mentioned changes.

##### *Regulatory Flexibility Act*

As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 (or any other law), the analytical requirements of the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*) are inapplicable. As such, the regulatory flexibility analysis is not required, and none has been provided. See 5 U.S.C. 603.

##### *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 final rule involves information collection requirements that 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.*). The collections of information involved in this final rule have been reviewed and previously approved by OMB under the following control numbers: 0651-0021, 0651-0031, 0651-0032, and 0651-0033.

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:* 0651-0021.

*Title:* Patent Cooperation Treaty.

*Form Numbers:* PCT/RO/101, ANNEX/134/144, PTO-1382, PCT/IPEA/401, PCT/IB/328.

*Type of Review:* Regular submission (approved through December of 2003).

*Affected Public:* Individuals or Households, Business or Other For-Profit Institutions, Federal Agencies or Employees, Not-for-Profit Institutions, Small Businesses or Organizations.

*Estimated Number of Respondents:* 331,288.

*Estimated Time Per Response:* Between 15 minutes and 4 hours.

*Estimated Total Annual Burden Hours:* 401,083.

*Needs and Uses:* The information collected is required by the Patent Cooperation Treaty (PCT). The general purpose of the PCT is to simplify the

filing of patent applications on the same invention in different countries. It provides for a centralized filing procedure and a standardized application format.

*OMB Number:* 0651-0031.  
*Title:* Patent Processing (Updating).  
*Form Numbers:* PTO/SB/08/21-27/30-32/35-37/42/43/61/62/63/64/67/68/91/92/ 96/97/PTO-2053/PTO-2055.  
*Type of Review:* Regular submission (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 Revoke; 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:* Regular submission (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.

*OMB Number:* 0651-0033.  
*Title:* Post Allowance and Refiling.  
*Form Numbers:* PTO/SB/13/14/44/50-57; PTOL-85b.  
*Type of Review:* Regular submission (approved through September of 2000).  
*Affected Public:* Individuals or Households, Business or Other For-Profit Institutions, Not-for-Profit Institutions and Federal Government.  
*Estimated Number of Respondents:* 135,250.  
*Estimated Time Per Response:* 0.325 hour.

*Estimated Total Annual Burden Hours:* 43,893 hours.  
*Needs and Uses:* This collection of information is required to administer the patent laws pursuant to title 35, U.S.C., concerning the issuance of patents and related actions including correcting errors in printed patents, refiling of patent applications, requesting reexamination of a patent, and requesting a reissue patent to correct an error in a patent. The affected public includes any individual or institution whose application for a patent has been allowed or who takes action as covered by the applicable rules. 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 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 1.14 is amended by revising paragraph (i)(2) to read as follows:

**§ 1.14 Patent applications preserved in confidence.**

- \* \* \* \* \*
- (i) \* \* \*

(2) A copy of an English language translation of an international application which has been filed in the United States Patent and Trademark Office pursuant to 35 U.S.C. 154(d)(4) will be furnished upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate fee (§ 1.19(b)(2) or § 1.19(b)(3)).

\* \* \* \* \*

3. Section 1.55 is amended by revising paragraphs (a)(1)(i) and (c) to read as follows:

**§ 1.55 Claim for foreign priority.**

(a) \* \* \*

(1)(i) In an original application filed under 35 U.S.C. 111(a), the claim for priority must be presented during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. This time period is not extendable. The claim must identify the foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. The time periods in this paragraph do not apply in an application under 35 U.S.C. 111(a) if the application is:

- (A) A design application; or
- (B) An application filed before November 29, 2000.

\* \* \* \* \*

(c) Unless such claim is accepted in accordance with the provisions of this paragraph, any claim for priority under 35 U.S.C. 119(a)-(d) or 365(a) not presented within the time period provided by paragraph (a) of this section is considered to have been waived. If a claim for priority under 35 U.S.C. 119(a)-(d) or 365(a) is presented after the time period provided by paragraph (a) of this section, the claim may be accepted if the claim identifying the prior foreign application by specifying its application number, country (or intellectual property authority), and the day, month, and year of its filing was unintentionally delayed. A petition to accept a delayed claim for priority under 35 U.S.C. 119(a)-(d) or 365(a) must be accompanied by:

- (1) The claim under 35 U.S.C. 119(a)-(d) or 365(a) and this section to the prior



foreign application, unless previously submitted;

(2) The surcharge set forth in § 1.17(t); and

(3) A statement that the entire delay between the date the claim was due under paragraph (a)(1) of this section and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

4. Section 1.78 is amended by revising paragraph (a) to read as follows:

**§ 1.78 Claiming benefit of earlier filing date and cross references to other applications.**

(a)(1) A nonprovisional application or international application designating the United States of America may claim an invention disclosed in one or more prior-filed copending nonprovisional applications or international applications designating the United States of America. In order for an application to claim the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America, each prior-filed application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior-filed application must be:

(i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America; or

(ii) Complete as set forth in § 1.51(b); or

(iii) Entitled to a filing date as set forth in § 1.53(b) or § 1.53(d) and include the basic filing fee set forth in § 1.16; or

(iv) Entitled to a filing date as set forth in § 1.53(b) and have paid therein the processing and retention fee set forth in § 1.21(l) within the time period set forth in § 1.53(f).

(2)(i) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international

filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see § 1.14).

(ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed application. These time periods are not extendable. Except as provided in paragraph (a)(3) of this section, the failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (a)(2)(i) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to such prior-filed application. The time periods in this paragraph do not apply if the later-filed application is:

(A) An application for a design patent;  
(B) An application filed under 35 U.S.C. 111(a) before November 29, 2000; or

(C) A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.

(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76), or the specification must contain or be amended to contain such reference in the first sentence following the title.

(iv) The request for a continued prosecution application under § 1.53(d) is the specific reference required by 35 U.S.C. 120 to the prior-filed application. The identification of an application by application number under this section is the identification of every application assigned that application number necessary for a specific reference required by 35 U.S.C. 120 to every such application assigned that application number.

(3) If the reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section is presented in a nonprovisional application after the time period

provided by paragraph (a)(2)(ii) of this section, the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America may be accepted if the reference identifying the prior-filed application by application number or international application number and international filing date was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed application must be accompanied by:

(i) The reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section to the prior-filed application, unless previously submitted;

(ii) The surcharge set forth in § 1.17(t); and

(iii) A statement that the entire delay between the date the claim was due under paragraph (a)(2)(ii) of this section and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

(4) A nonprovisional application, other than for a design patent, or an international application designating the United States of America may claim an invention disclosed in one or more prior-filed provisional applications. In order for an application to claim the benefit of one or more prior-filed provisional applications, each prior-filed provisional application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior-filed provisional application must be entitled to a filing date as set forth in § 1.53(c), and the basic filing fee set forth in § 1.16(k) must be paid within the time period set forth in § 1.53(g).

(5)(i) Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed provisional applications must contain or be amended to contain a reference to each such prior-filed provisional application, identifying it by the provisional application number (consisting of series code and serial number).

(ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four

months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed provisional application. If the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed provisional application. These time periods are not extendable. Except as provided in paragraph (a)(6) of this section, the failure to timely submit the reference is considered a waiver of any benefit under 35 U.S.C. 119(e) to such prior-filed provisional application. The time periods in this paragraph do not apply if the later-filed application is:

(A) An application filed under 35 U.S.C. 111(a) before November 29, 2000; or

(B) A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.

(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76), or the specification must contain or be amended to contain such reference in the first sentence following the title.

(iv) If the prior-filed provisional application was filed in a language other than English and an English-language translation of the prior-filed provisional application and a statement that the translation is accurate were not previously filed in the prior-filed provisional application or the later-filed nonprovisional application, applicant will be notified and given a period of time within which to file an English-language translation of the non-English-language prior-filed provisional application and a statement that the translation is accurate. In a pending nonprovisional application, failure to timely reply to such a notice will result in abandonment of the application.

(6) If the reference required by 35 U.S.C. 119(e) and paragraph (a)(5) of this section is presented in a nonprovisional application after the time period provided by paragraph (a)(5)(ii) of this section, the claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application may be accepted during the pendency of the later-filed application if the reference identifying the prior-filed application by

provisional application number was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application must be accompanied by:

(i) The reference required by 35 U.S.C. 119(e) and paragraph (a)(5) of this section to the prior-filed provisional application, unless previously submitted;

(ii) The surcharge set forth in § 1.17(t); and

(iii) A statement that the entire delay between the date the claim was due under paragraph (a)(5)(ii) of this section and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

\* \* \* \* \*

5. Section 1.311 is amended by revising paragraph (a) to read as follows:

**§ 1.311 Notice of allowance.**

(a) If, on examination, it appears that the applicant is entitled to a patent under the law, a notice of allowance will be sent to the applicant at the correspondence address indicated in § 1.33. The notice of allowance shall specify a sum constituting the issue fee which must be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. The sum specified in the notice of allowance may also include the publication fee, in which case the issue fee and publication fee (§ 1.211(e)) must both be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable.

\* \* \* \* \*

6. Section 1.434 is amended by revising paragraph (d)(2) to read as follows:

**§ 1.434 The request.**

\* \* \* \* \*

(d) \* \* \*

(2) A reference to any prior-filed national application or international application designating the United States of America, if the benefit of the filing date for the prior-filed application is to be claimed.

Dated: December 19, 2001.

**James. E. Rogan,**  
*Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.*

[FR Doc. 01-31872 Filed 12-27-01; 8:45 am]

**BILLING CODE 3510-16-P**

**ENVIRONMENTAL PROTECTION AGENCY**

**40 CFR Part 62**

[AZ, CA, HI, NV-066-MSWa; FRL-7122-9]

**Approval and Promulgation of State Plans for Designated Facilities and Pollutants: Negative Declarations; Municipal Waste Combustion; Arizona; California; Hawaii; Nevada**

**AGENCY:** Environmental Protection Agency (EPA).

**ACTION:** Direct final rule.

**SUMMARY:** EPA is amending certain regulations to reflect the receipt of negative declarations from Arizona, California, Hawaii, and Nevada. These negative declarations certify that there are no small municipal waste combustion units in these States that would be subject to the control requirements of the federal emission guidelines.

**DATES:** This direct final rule is effective on February 26, 2002 without further notice, unless EPA receives relevant adverse comments by January 28, 2002. If EPA receives such comments, then it will publish a timely withdrawal in the **Federal Register** informing the public that this rule will not take effect.

**ADDRESSES:** Comments must be submitted to Andrew Steckel at the Region IX office listed below. Copies of the letters of negative declaration are available for public inspection at EPA's Region IX office during normal business hours. U.S. Environmental Protection Agency, Region IX, Rulemaking Office (AIR-4), Air Division, 75 Hawthorne Street, San Francisco, CA 94105-3901.

**FOR FURTHER INFORMATION CONTACT:** Mae Wang, U.S. Environmental Protection Agency, Region IX, 75 Hawthorne Street (AIR-4), San Francisco, CA 94105-3901, Telephone: (415) 947-4124.

**SUPPLEMENTARY INFORMATION:**

**I. Background**

Under section 111(d) of the Clean Air Act (CAA), EPA has established procedures whereby States submit plans to control certain existing sources of "designated pollutants." Designated pollutants are defined as pollutants for which a standard of performance for new sources applies under section 111 but which are not "criteria pollutants" (i.e., pollutants for which National Ambient Air Quality Standards (NAAQS) are set pursuant to sections 108 and 109 of the CAA) or hazardous air pollutants (HAPs) regulated under section 112 of the CAA. As required by CAA section 111(d), EPA established a