Response to Comments on the Rules

The comments received in response to the notice of proposed rulemaking have been given careful consideration. The comments and responses are discussed below.

Comment: One comment was received which approved of the proposed rule changes but noted other aspects of the U.S. National Phase filing procedures that could be changed to make the PCT more user-friendly.

Response: The Office is interested in making the PCT more user friendly. Amendments to §§ 1.494 and 1.495, which were effective on May 1, 1993, removed many of the differences in practice involving the filing of a regular U.S. application under 35 U.S.C. 111 and the entry of the national stage under 35 U.S.C. 371. These regulations now provide for a notice of missing requirements, similar to a notice under § 1.53(d), where a defective oath or declaration or a defective translation is filed.

Comment: Regarding § 1.412(c), one comment suggested that the proposed rule should be made consistent with PCT Rule 19.4(b) which provides for the transmittal of international applications to the International Bureau as Receiving Office "unless prescriptions concerning national security prevent the international application from being so transmitted" by incorporating such language into the proposed rule.

Response: The Office has adopted the suggestion and modified the rule by incorporating the suggested language from PCT Rule 19.4(b) in the regulation.

Comment: One comment regarding § 1.445(a)(5) mentioned that the word "competent" should be deleted because it is not "necessary and may be inaccurate" when no applicant in an international application is a "resident or national of a PCT Contracting State."

Response: The Office has adopted the suggestion and modified the rule by deleting "competent" from § 1.445(a)(5). The second occurrence of the word "competent" has also been deleted from 37 CFR 1.412(c)(6), for the same reasons.

Comment: Regarding § 10.9(c), there were a few comments which focus on the wording. Specifically, one comment noted that the word "appointed" is confusing because it is not clear if it includes "an officer or employee of a legal-entity patent applicant" in cases where the United States of America is not designated. An example was provided which noted "if the only applicant was XYZ Company, would the president of the Company be authorized to prosecute the application before the USPTO as an International Searching

and Preliminary Examining Authority? In countries permitting assignee filing it is normal for any authorized officer or employee of the company to be able to represent the company without regard as to whether he is authorized to practice as an agent or attorney before the patent office."

Response: The proposed regulation is sufficiently clear on this point. If a person has the authority to represent an applicant, either a legal entity applicant or a real person, before the International Bureau as Receiving Office, then that person has the right to represent that applicant before the United States International Searching Authority and the United States International Preliminary Examining Authority.

Comment: Another comment about Rule 10.9(c) is that the word "only" is overlimiting and should be deleted from the Rule because it excludes Article 19 amendments filed before the International Bureau. It was suggested that the Rule be changed as follows:

—* * * prosecute an International Application before the United States Patent and Trademark Office acting as an International Searching or Preliminary Examining Authority,

Response: The Office will not adopt the suggestion. The word "only" in the Rule signifies that such persons may not prosecute an international application in the national stage before the USPTO. The rule is not meant to control who may practice before the International Bureau. Such a person would clearly be allowed to file Article 19 amendments with the International Bureau by virtue of PCT Rule 90.1(a).

Comment: A final comment made about Rule 10.9(c) is that the last phrase added is "too broad" because it does not recite who is entitled to act before the International Bureau. It was suggested that the rule should be changed to include the phrase—* * * for a national Office of a Contracting State of which an applicant is a resident or national—at the end of the rule.

Response: The Office has adopted the suggestion to the extent that an explicit reference to PCT Rule 83.1^{bis} has been inserted in the regulation. Since PCT Rule 83.1^{bis} clearly sets forth who may practice before the International Bureau, it is not necessary to repeat that information here. Thus, the regulation clearly sets forth who may practice before the United States International Searching and Preliminary Examining Authorities.

Other Considerations

The rule changes are in conformity with the requirements of the Regulatory

Flexibility Act, 5 U.S.C. 601 *et seq.*, Executive Order 12612, and the Paperwork Reduction Act of 1980, 44 U.S.C. 3501 et seq. These rule changes have been determined to be not significant for the purposes of Executive Order 12866.

The Assistant General Counsel for Legislation and Regulation of the Department of Commerce has certified to the Chief Counsel for Advocacy, Small Business Administration, that the rule changes will not have a significant economic impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)), because the rules would affect only a small number of international applications and would provide more streamlined and simplified procedures for filing and prosecuting international applications under the PCT.

The Office has also determined that these rule changes have no federalism implications affecting the relationship between the National government and the States as outlined in Executive Order 12612.

These rule changes will not impose any additional burden under the Paperwork Reduction Act of 1980, 44 U.S.C. 3501 *et seq.* The paperwork burden imposed by adherence to the PCT is currently approved by the Office of Management and Budget under control number 0651–0021.

List of Subjects

37 CFR Part 1

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

37 CFR Part 10

Administrative practice and procedure, Inventions and patents, Lawyers, Reporting and recordkeeping requirements, Trademarks.

For the reasons set forth in the preamble, 37 CFR parts 1 and 10 are amended to read 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. 6 unless otherwise noted

2. Section 1.412 is amended by adding new paragraph (c)(6) to read as follows:

§1.412 The United States Receiving Office.

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