

## DEPARTMENT OF COMMERCE

## United States Patent and Trademark Office

## 37 CFR Part 1

RIN 0651-AB19

## Treatment of Unlocatable Patent Application and Patent Files

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

**SUMMARY:** The United States Patent and Trademark Office is amending the rules of practice to provide for the replacement of patent application and patent files that cannot be located after a reasonable search. This change is designed to expedite the process of application and patent file reconstruction to minimize the processing or examination delays resulting when the Office cannot locate an application or patent file after a reasonable search.

**EFFECTIVE DATE:** November 17, 2000.

**FOR FURTHER INFORMATION CONTACT:**

Robert W. Bahr 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) 872-9411, marked to the attention of Robert W. Bahr.

**SUPPLEMENTARY INFORMATION:** Over 330,000 patent applications (provisional and nonprovisional) were filed in the United States Patent and Trademark Office (Office) in fiscal year 1999. On occasion, an application or patent file cannot be located.

When a patent application or patent file cannot be located after a reasonable search and the application or patent file is necessary to conduct business before the Office, the Office will “reconstruct” the application or patent file. This involves placing a duplicate copy of the original application papers and all of the correspondence between the Office and applicant or patentee in a new file wrapper. The Office currently (since the spring of 1997) uses its Patent Application Capture and Review (PACR) system to image scan the application papers submitted on the filing date of the application (except for any appendix or information disclosure statement) and to create an electronic database (PACR database) containing a duplicate record of the original application papers (application papers were microfilmed prior to the spring of 1997). Thus, the Office can obtain a copy of the original application papers from its PACR database (or microfilm records).

The Office, however, does not possess a duplicate copy of subsequent correspondence from the applicant or patentee (e.g., applicant replies or other papers) concerning the application or patent. While the Office may have a copy of some Office correspondence (Office actions saved on a disc or computer hard drive), the Office often does not possess a complete copy of the Office correspondence concerning the application or patent (e.g., paper-based forms or notices). Thus, to reconstruct a file accurately, the Office must request that the applicant or patentee either provide a complete copy of his or her record of the correspondence between the Office and the applicant or patentee, or produce his or her record of the correspondence between the Office and the applicant or patentee for the Office to copy.

Formerly, the request that applicant provide a copy of (or produce) his or her record of the correspondence between the Office and the applicant did not require a reply within any set time period. In a pending application, this added to the delay in processing and examination resulting from the inability to locate the application file. To expedite the process of reconstructing the file of an application or patent file, the Office is amending the rules of practice to provide that the Office will now set a time period within which applicant or patentee must either provide a complete copy of his or her record of the correspondence between the Office and the applicant or patentee, or produce his or her record of the correspondence between the Office and the applicant or patentee for the Office to copy. Since the Office cannot continue to examine an application for which it does not have a complete copy, the failure to provide a copy of (or produce) his or her record of the correspondence between the Office and the applicant in a pending application within this time period will result in abandonment of the application. See 35 U.S.C. 133 (failure to prosecute an application in a timely manner “after any action therein” shall be regarded as abandonment of the application).

Corresponding with an applicant or patentee when an application is abandoned or patented is often difficult because address information is often not current. There are many good reasons for keeping correspondence information current in an abandoned application or patent. Patent applicants and patent owners should keep the correspondence address and any fee address current for the patent to ensure that correspondence is mailed to applicant’s or patentee’s current address. In an

abandoned application, the Office may attempt to communicate with applicant regarding a petition for access. If the address has not been updated, then the Office may not be able to consider applicant’s views in deciding whether to release the application to a member of the public. The Customer Number Practice described in section 403 of the *Manual of Patent Examining Procedure (MPEP)* (7th ed. 1998) (Rev. 1, Feb. 2000) provides a procedure where a patent applicant or owner can easily change the correspondence address for a number of patents or patent applications. In addition, the “Fee Address” Indication Form (PTO/SB/47) (reproduced at *MPEP* 2595) enables a patent owner to complete one form to designate a single fee address for any number of patents or applications in which the issue fee has been paid.

When changing the address(es) associated with a patent, the patent owner should bear in mind that the Office has a number of addresses related to the patent: (1) An application correspondence address; (2) the return address for the assignment documents; and (3) the fee address for maintenance fee purposes. See *MPEP* 2540. The correspondence address is the address to which Office actions and notices are mailed during the patent application process and is often not current within a few years of patent issuance. As a result, the regulations related to reexamination proceedings require that a patent owner be served with a copy of a Reexamination Request at the Office of Enrollment and Discipline address for the attorney or agent of record, if there is an attorney or agent of record. See *MPEP* 2220. If there is no attorney or agent of record, the copy is required to be served upon the patent owner. See 37 CFR 1.33(c). In the procedure to obtain a copy of a patent file set forth in this notice, the request will be directed to the correspondence address.

The Office is planning for full electronic submission of applications and related documents by fiscal year 2003. Once the Office transitions to a total Electronic File Wrapper environment, the inability to locate a paper application file should no longer be a significant issue. However, this rule change is necessary to provide for the replacement of unlocatable application and patent files until the Office has completely transitioned to a total Electronic File Wrapper environment.

**Discussion of Specific Rules**

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

Section 1.251 is added to set forth a procedure for the reconstruction of the file of a patent application, patent, or any other patent-related proceeding that cannot be located after a reasonable search. The phrase "an application" applies to any type of application (national or international), and regardless of the status (pending or abandoned) of the application.

Section 1.251(a) provides that in the event the Office cannot locate the file of an application, patent, or any other patent-related proceeding after a reasonable search, the Office will notify the applicant or patentee and set a time period within which the applicant or patentee must comply with the notice. The applicant or patentee may comply with a notice under § 1.251 by providing: (1) A copy of his or her record (if any) of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (except for U.S. patent documents); (2) a list of such correspondence; and (3) a statement that the copy is a complete and accurate copy of the applicant's or patentee's record of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (except for U.S. patent documents), and whether applicant or patentee is aware of any correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding that is not among applicant's or patentee's records (§ 1.251(a)(1)). The applicant or patentee may also comply with a notice under § 1.251 by: (1) Producing his or her record (if any) of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding for the Office to copy (except for U.S. patent documents); and (2) providing a statement that the papers produced by applicant or patentee are applicant's or patentee's complete record of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (except for U.S. patent documents), and whether applicant or patentee is aware of any correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding that is not among applicant's or patentee's records (§ 1.251(a)(2)). If applicant or patentee does not possess any record of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding, the applicant or patentee must comply with a notice under § 1.251 by providing

a statement that applicant or patentee does not possess any record of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (§ 1.251(a)(3)).

According to § 1.251(a), if the applicant or patentee possesses all or just some of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding, the applicant or patentee is to reply by providing a copy of (or producing) his or her record of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (§§ 1.251(a)(1) or (a)(2)). If applicant or patentee does not possess any record of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding, the applicant or patentee is to reply with a statement to that effect (§ 1.251(a)(3)).

Any appendix or information disclosure statement submitted with an application is not contained in the Office's PACR database. Therefore, the applicant or patentee must also provide a copy of any appendix or information disclosure statement (except in the limited circumstance discussed below) submitted with the application. Since the Office can obtain copies of U.S. patent documents (U.S. patent application publications and patents) from its internal databases, the Office is not requiring applicants or patentees to provide copies of U.S. patent application publications and patents that are among the applicant's or patentee's record of the correspondence between the Office and the applicant or patentee for the application, patent, or other proceeding.

Section 1.251(b) provides that with regard to a pending application, the failure to provide a reply to such a notice within the time period set in the notice will result in abandonment of the application.

#### Response to Comments

The Office published a notice proposing changes to the rules of practice to provide for the replacement of application and patent files that cannot be located after a reasonable search. See *Treatment of Unlocatable Application and Patent Files*, Notice of Proposed Rulemaking, 65 FR 42309 (July 10, 2000), 1237 *Off. Gaz. Pat. Office* 28 (Aug. 1, 2000) (notice of proposed rulemaking). The Office received eleven written comments (from intellectual property organizations, patent practitioners, and the general public) in response to the notice of

proposed rulemaking. Comments generally in support of the change are not discussed. The comments and the Office's responses to the remaining comments follow:

*Comment 1:* Several comments inquired as to how long an applicant or patentee will be given to provide a copy of the file in reply to a notice under § 1.251. The comments suggested that: (1) Applicants be given a minimum period of three months to reply to a notice under § 1.251; (2) this period for reply be set forth in § 1.251 (rather than merely set forth in the *MPEP* or left completely up to the discretion of Office officials); and (3) this period for reply be extendable under § 1.136(a). One comment also suggested that patentees be given at least five months to reply to a notice under § 1.251.

*Response:* The Office will set a time period of three months for reply in a notice under § 1.251 in an application. The time period will be extendable under § 1.136(a) (unless the notice indicates otherwise) by three months up to a maximum period for reply of six months in an application. See 35 U.S.C. 133.

The Office will set a time period of six months for reply in a notice under § 1.251 in a patent. The time period will not be extendable under § 1.136(a) in a patent because 35 U.S.C. 41(a)(8) only authorizes the Office to charge fees for extensions of time in proceedings involving an application. See *MPEP* 2265.

Section 1.251 will not include these time periods. These time periods, however, will be included in the *MPEP* and not left to the complete discretion of various Office officials.

*Comment 2:* One comment suggested that there should be no reduction in patent term adjustment for the entire delay for the initial search and for compliance with a notice under § 1.251. Another comment suggested that for purposes of patent term adjustment, all of the time taken to reconstruct the file "should be charged against the Office."

*Response:* Patent term and patent term adjustment are provided for by statute. See 35 U.S.C. 154(a)(2) and (b) and 173. The inability to locate an application file in and of itself does not give rise to patent term adjustment under 35 U.S.C. 154(b). Rather, patent term adjustment is an issue only if the inability to locate the application file causes the Office to miss one of the time frames specified in 35 U.S.C. 154(b)(1)(A) or (B), or prolongs the duration of one of the proceedings specified in 35 U.S.C. 154(b)(1)(C). In addition, if an applicant fails to reply to a notice under § 1.251 within three

months of its mailing date, any patent term adjustment under 35 U.S.C. 154(b) will be reduced by a period equal to the number of days (if any) beginning on the day after the date that is three months after the mailing date of the notice under § 1.251 and ending on the date the reply to the notice under § 1.251 was filed. See 35 U.S.C. 154(b)(2)(C)(ii) and § 1.704(b).

*Comment 3:* Several comments inquired as to what steps are taken to search for a file before it is determined to be unlocatable (*i.e.*, inquired as to what is a reasonable search). One comment expressed concern that the procedure in § 1.251 not be used as a substitute for a reasonable search for such a file. Another comment suggested that a reasonable time limit (*e.g.*, three months) be established for such a search so that reconstruction of the file (if necessary) can begin promptly.

*Response:* When an application file is determined to be unlocatable, the Official Search Unit or a Technology Center designee conducts a search for the application file in every location where the application file might reasonably be located: *e.g.*, its location as indicated in the Office automated application tracking system (the Patent Application Locating and Monitoring or PALM system), the examiner's office, and the Technology Center's central files, technical support, and receptionist areas. If the application file still cannot be located, the application is flagged as "lost" in the PALM system. The flagging of an application in the PALM system as "lost" causes the PALM system to signal any person who then attempts a PALM transaction for the application (for which the application file is required) that the application file was previously unlocatable and should be taken to the person who was conducting a search for the application file. If no PALM transaction for the application occurs within thirty days, the Office then begins the file reconstruction process.

*Comment 4:* One comment opposed the proposed change on the basis that it did not address the problem (*i.e.*, the Office's inability to locate certain files). The comment indicated that the Office should better train its staff to track application and patent files, and to conduct a more diligent search for an application or patent files.

*Response:* The Office is addressing this issue by: (1) Revising procedures for searches for applications; and (2) moving towards a total Electronic File Wrapper environment. Nevertheless, the majority of comments recognize that establishing procedures for the prompt reconstruction of unlocatable files is

important not only to the conduct of business before the Office, but is also important to the public (third parties) which relies upon the information in a patent file when conducting an infringement or validity analysis.

*Comment 5:* One comment suggested that the Office provide a printout of the contents entries from the Office's PALM system with any notice under § 1.251 to assist the applicant or patentee.

*Response:* The suggestion is adopted.

*Comment 6:* One comment inquired as to how long it takes the Office to realize it has lost a file.

*Response:* The Office usually realizes that it cannot locate a patent file when a member of the public requests a copy of the file. The Office usually realizes that it cannot locate an application file when its PALM system indicates that the application is due for some action.

*Comment 7:* One comment inquired as to how long it will take for the Office to act on an application once the file has been reconstructed.

*Response:* Once an application file has been reconstructed, it is docketed for action based upon its stage in the application examination process. In most situations, the application will be acted upon immediately.

*Comment 8:* Several comments suggested that the Office should take special steps with files that have been reconstructed to ensure that the applicant or patentee is not again required to provide a copy of the file.

*Response:* The Office takes the steps that can reasonably be taken to avoid misplacing any application or patent file. Thus, there are no further "special" steps that could reasonably be taken to avoid misplacing reconstructed application or patent files.

*Comment 9:* One comment suggested that the Office should first attempt to reconstruct the file based upon the material it has (*i.e.*, copies of Office actions, and sequence listings), and then require the applicant or patentee to supply the specific materials that the Office does not have. Another comment suggested that the applicant or patentee should not be required to produce copies of documents available to the Office from other sources (*e.g.*, U.S. or foreign patents or patent publications).

*Response:* The Office has considered attempting to reconstruct portions of the application or patent file based upon material contained in other Office databases. These databases, however, do not always contain accurate or complete copies of the papers actually in the application or patent file (*e.g.*, Office actions may be draft or incomplete and may not include the pre-printed forms sent with Office actions). The best way

to reconstruct an application or patent file quickly, completely, and accurately is to obtain a copy of the applicant or patentee's records of correspondence between the Office and applicant or patentee for the application or patent.

The Office can obtain copies of U.S. patent application publications and patents from its databases. Therefore, the Office is not requiring applicants or patentees to provide copies of U.S. patent application publications and patents that are among the applicant's or patentee's record of the correspondence between the Office and the applicant or patentee for the application, patent, or other proceeding. The Office, however, may not be able to obtain copies of foreign patent documents or nonpatent literature from its databases. Therefore, the Office is requiring applicants or patentees to provide copies of foreign patent documents and nonpatent literature that are among the applicant's or patentee's record of the correspondence between the Office and the applicant or patentee for the application, patent, or other proceeding.

*Comment 10:* One comment suggested that the applicant or patentee be required to provide a copy of only the papers formally of record in the application or patent file (*i.e.*, not proposed amendments submitted to an examiner for consideration on an informal basis).

*Response:* The applicant or patentee is required to provide a copy of applicant's or patentee's record of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding. While an "informal" (or "proposed") amendment submitted to an examiner for consideration is not entered into the specification or drawings of the application, Office practice is to make such an informal or proposed amendment of record in the application file (usually by attachment to an interview summary record). Thus, "informal" amendments submitted to examiners for consideration are part of the correspondence between the Office and the applicant (or patentee) that must be submitted (if contained in applicant's or patentee's records of the application or patent).

*Comment 11:* One comment questioned whether § 1.251 applies when the file is otherwise available, but is missing specific documents.

*Response:* Section 1.251 generally applies only to situations in which the file of an application or patent (not just certain documents) is unlocatable. When a document is missing from an application, Office practice is to call the applicant's representative and request

submission (generally by facsimile) of a copy of the missing document. While the Office intends to continue to treat missing documents in this relatively informal manner (rather than issuing a notice under § 1.251), the Office may issue a notice under § 1.251 to obtain a copy of a missing document if the Office's informal attempts to obtain a copy of the document are unsuccessful.

*Comment 12:* One comment questioned what the Office does with the original file if it is discovered after the file has been reconstructed.

*Response:* The Office will combine the papers into a single file wrapper and then destroy the other file wrapper (as well as any duplicate papers).

*Comment 13:* One comment argued that the provisions of § 1.251 are not effective as to a patentee since there is no threat (e.g., threat of abandonment) if a patentee does not comply with a notice requiring a copy of the patent file. Another comment suggested that the Office expressly indicate that there is no consequence if a patentee fails to comply with a notice under § 1.251 because a statutory change would be required for the Office to be able to impose a consequence such as lapse of the patent on a patentee.

*Response:* If a patentee does not timely reply to a notice under § 1.251, the patent will not "lapse" or expire. Nevertheless, it is incorrect to say that there is no consequence to a patentee who fails to comply with a notice under § 1.251. If a patentee fails to timely comply with a notice under § 1.251, the only certified copy of the patent file that the Office will be able to produce will be a copy of the patent and a copy of the application-as-filed (which may have an adverse impact during attempts to enforce the patent). In addition, if the patent is involved in a proceeding before the Office, the Office may take action under § 1.616 or § 10.18. Thus, the provisions of § 1.251 will be effective as to a patentee even in the absence of a statutory change to impose some other consequence (e.g., lapse of the patent).

*Comment 14:* Several comments argued that the threat of holding an application abandoned when the file was lost by the Office was patently unfair. One comment suggested that the sanction for noncooperation with a requirement for a copy of the application file for applications subject to the twenty-year patent term provisions of 35 U.S.C. 154(a)(2) be a reduction of any patent term adjustment under 35 U.S.C. 154(b), and that the sanction for noncooperation with a requirement for a copy of the application file for applications not

subject to the twenty-year patent term provisions of 35 U.S.C. 154(a)(2) be a requirement for a terminal disclaimer.

*Response:* As discussed above, the Office cannot process or examine an application if its file is unlocatable. Treating noncooperation with a requirement for a copy of the application file for applications solely by a reduction of any patent term adjustment or requirement for a terminal disclaimer would give rise to an open-ended suspension of action for any application in which the applicant chooses not to timely reply to a notice under § 1.251.

It is well established that keeping an application pending before the Office for an indeterminate period of time with no prospect of action being taken by either the Office or the applicant is not consistent with the spirit of the patent application examination process. See *Planning-Machine Co. v. Keith*, 101 U.S. (11 Otto) 479, 485 (1879) (applicant cannot without cause hold an application pending during a long period without prosecuting the application). If an applicant fails to cooperate with the Office's attempt to reconstruct the file of an unlocatable application, there is no prospect of action being taken by either the Office or the applicant until the applicant replies to the notice under § 1.251. Therefore, if the file of an application is unlocatable and the applicant fails to cooperate with the Office's attempt to reconstruct the file, it is appropriate to terminate proceedings in that application and treat the application as abandoned.

*Comment 15:* One comment suggested that if an application becomes abandoned for failure to reply to a notice under § 1.251, the applicant should be able to revive the application. Another comment suggested that the Office should permit the applicant to revive the application for unintentional abandonment at no cost to the applicant (the cost being absorbed by the Office).

*Response:* An application abandoned for failure to timely reply to a notice under § 1.251 may be revived pursuant to § 1.137, provided that the conditions specified in § 1.137 can be met (i.e., the delay in reply to the notice under § 1.251 was unavoidable or unintentional). 35 U.S.C. 41(a)(7) requires the Office to charge a fee for filing a petition to revive an abandoned application, regardless of whether the delay was unintentional or unavoidable. In any event, an application abandoned for failure to timely reply to a notice under § 1.251 is not abandoned because the Office cannot locate the application,

but because the applicant failed to timely reply to the notice under § 1.251.

*Comment 16:* Several comments argued that applicants and patentees are unable to state with absolute confidence that their records are a complete and accurate copy of the correspondence between the Office and the applicant or patentee for the application, patent, or other proceeding (since correspondence from the Office may have been lost in the mail). Some comments suggested that an applicant or patentee be required to state only that the copy is a complete and accurate copy of the applicant or patentee's record of the correspondence between the Office and the applicant or patentee for the application, patent, or other proceeding. Another comment suggested that an applicant or patentee be required to state only that the copy is complete and accurate to the best of the individual's knowledge and belief, upon reasonable investigation.

*Response:* Sections 1.251(b)(1) and (b)(2) as proposed provided for the situation in which the applicant or patentee possessed a complete and accurate copy of the applicant's or patentee's record of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding, and § 1.251(b)(3) as proposed provided for the situation in which an applicant or patentee did not possess a complete and accurate copy of the applicant's or patentee's record of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding. Since applicants and patentees cannot be certain of whether their records are a complete and accurate copy of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding, §§ 1.251(a)(1) and (a)(2) as adopted provide for the situation in which the applicant or patentee possesses some record (whether complete or incomplete) of the correspondence between the Office and the applicant or patentee, and § 1.251(a)(3) provides for the rare situation in which an applicant or patentee does not possess any record of the correspondence between the Office and the applicant or patentee.

Sections 1.251(a)(1) and (a)(2) will require a statement that the copy produced by applicant or patentee is a complete and accurate copy of the applicant's or patentee's record of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (except for U.S. patent documents), and whether applicant or patentee is aware of any correspondence between the

Office and the applicant or patentee for such application, patent, or other proceeding that is not among applicant's or patentee's records. An applicant or patentee should be able to state with confidence that the copy provided to or produced for the Office is a complete and accurate copy of the applicant's or patentee's record (if any) of all of the correspondence between the Office and the applicant or patentee, and whether applicant or patentee is aware of any correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding that is not among applicant's or patent's records.

*Comment 17:* One comment suggested that § 1.251 was unclear as to whether the applicant or patentee was being required to state that the copy being produced by the applicant or patentee for copying by the Office, or the copy produced by the Office, was a complete and accurate copy of the correspondence between the Office and the applicant or patentee for the application, patent, or other proceeding.

*Response:* Section 1.251(a)(2) requires a statement that the copy produced by applicant or patentee (not the copy produced by the Office) is a complete and accurate copy of applicant's or patentee's record of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding.

*Comment 18:* One comment required that the Office indicate where or to whom the applicant or patentee is to produce the applicant's or patentee's record of the correspondence between the Office and the applicant or patentee for the application, patent, or other proceeding for copying by the Office.

*Response:* If an applicant or patentee decides to produce his or her record of the correspondence between the Office and the applicant or patentee for the application, patent, or other proceeding for copying by the Office under § 1.251(a)(2) (rather than provide a copy under § 1.251(a)(1)), the record should be brought to the Customer Service Center in the Office of Initial Patent Examination (Crystal Plaza 2, 2011 South Clark Place, Arlington, VA 22202).

*Comment 19:* One comment noted that § 1.251 provides the option of producing the applicant's or patentee's record of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding for the Office to copy when the applicant or patentee possesses a complete copy of the correspondence between the Office and the applicant or patentee for such

application, patent, or other proceeding. The comment suggests that the Office should also provide the option of producing the applicant's or patentee's record of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding for the Office to copy when the applicant or patentee does not possess a complete copy of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding.

*Response:* Section 1.251(a)(2) provides the option of producing the applicant's or patentee's record of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding for the Office to copy even when the applicant or patentee does not possess a complete copy of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding.

*Comment 20:* Several comments suggested that the Office should reimburse applicants or patentees for the costs of copying the application or patent file and delivering the copy to the Office.

*Response:* The Office does not currently reimburse applicants or patentees for the costs of copying the application or patent file and delivering the copy to the Office. The changes in this final rule will not affect the costs of copying the application or patent file and delivering the copy to the Office as compared to current practice. The Office will study the reimbursement question to consider the costs and operational considerations associated with such a proposal.

## Classification

### *Administrative Procedure Act*

The changes in this final rule concern only the procedures for obtaining a copy of applicant's or patentee's record of the correspondence between the Office and the applicant or patentee for an application, patent, or other proceeding when necessary to reconstruct the file of such application, patent, or other proceeding. Therefore, prior notice and an opportunity for public comment are 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).

### *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), an initial regulatory flexibility

analysis under the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*) is not required. *See* 5 U.S.C. 603.

### *Executive Order 13132*

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

### *Paperwork Reduction Act*

This document involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*). The collection of information involved in this document was submitted for approval by OMB under control number 0651-0031. The United States Patent and Trademark Office submitted this information collection package to OMB for its review and approval because the changes in this notice affect the information collection requirements associated with that information collection package.

The title, description, and respondent description of this information collection is shown below with an estimate of the annual reporting burdens. Included in the estimate is the time for reviewing instructions, gathering and maintaining the data needed, and completing and reviewing the collection of information. The principal impact of the changes in this notice is to set forth the procedures for obtaining a copy of applicant's or patentee's record of the correspondence between the Office and the applicant or patentee for an application, patent, or other proceeding when necessary to reconstruct the file of such application, patent, or other proceeding.

*OMB Number:* 0651-0031.

*Title:* Patent Processing (Updating).

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

*Type of Review:* Approved through October of 2002.

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

*Estimated Number of Respondents:* 2,231,365.

*Estimated Time Per Response:* 0.46 hours.

*Estimated Total Annual Burden Hours:* 1,018,736 hours.

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

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

Interested persons are requested to send comments regarding these information collections, including suggestions for reducing this burden, to Robert J. Spar, Director, Office of Patent Legal Administration, United States Patent and Trademark Office, Washington, DC 20231, or to the Office of Information and Regulatory Affairs, OMB, 725 17th Street, NW., Washington, DC 20503 (Attn: Desk Officer for the United States Patent and Trademark Office).

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

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

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

For the reasons set forth in the preamble, 37 CFR Part 1 is 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 1.251 is added immediately following § 1.248 to read as follows:

##### § 1.251 Unlocatable file.

(a) In the event that the Office cannot locate the file of an application, patent, or other patent-related proceeding after a reasonable search, the Office will notify the applicant or patentee and set a time period within which the applicant or patentee must comply with the notice in accordance with one of paragraphs (a)(1), (a)(2), or (a)(3) of this section.

(1) Applicant or patentee may comply with a notice under this section by providing:

(i) A copy of the applicant's or patentee's record (if any) of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (except for U.S. patent documents);

(ii) A list of such correspondence; and

(iii) A statement that the copy is a complete and accurate copy of the applicant's or patentee's record of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (except for U.S. patent documents), and whether applicant or patentee is aware of any correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding that is not among applicant's or patentee's records.

(2) Applicant or patentee may comply with a notice under this section by:

(i) Producing the applicant's or patentee's record (if any) of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding for the Office to copy (except for U.S. patent documents); and

(ii) Providing a statement that the papers produced by applicant or patentee are applicant's or patentee's complete record of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (except for U.S. patent documents), and whether applicant or patentee is aware of any correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding that is not among applicant's or patentee's records.

(3) If applicant or patentee does not possess any record of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding, applicant or patentee must comply with a notice under this section by providing a statement that applicant or patentee does not possess any record of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding.

(b) With regard to a pending application, failure to comply with one of paragraphs (a)(1), (a)(2), or (a)(3) of this section within the time period set in the notice will result in abandonment of the application.

Dated: October 31, 2000.

**Q. Todd Dickinson,**

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

[FR Doc. 00-29411 Filed 11-16-00; 8:45 am]

BILLING CODE 3510-16-P

#### FEDERAL COMMUNICATIONS COMMISSION

##### 47 CFR Parts 2 and 90

[ET Docket No. 98-237; FCC 00-363]

##### 3650-3700 MHz Government Transfer

**AGENCY:** Federal Communications Commission.

**ACTION:** Final rule.

**SUMMARY:** This document allocates 50 megahertz of spectrum in the 3650-3700 MHz band to the fixed and mobile (base stations) terrestrial services on a primary basis. We are "grandfathering" existing fixed satellite service ("FSS") earth station sites in this band and, for a limited time, will accept new applications for FSS earth stations in the vicinity (*i.e.*, within 10 miles) of these grandfathered sites to operate on a co-primary basis in the band. We will also permit additional FSS earth station operations on a secondary basis. This will ensure the continuity of FSS operations and permit new FSS operations to help alleviate congestion in the adjacent 3700-4200 MHz FSS band. Finally, to provide for compatibility with both terrestrial fixed service and FSS operations in the band, we are limiting the terrestrial mobile service use of the band to base station operations.

**DATES:** Effective February 15, 2001.

**FOR FURTHER INFORMATION CONTACT:** Rodney Conway, Office of Engineering and Technology, (202) 418-2904.

**SUPPLEMENTARY INFORMATION:** This is a summary of the Commission's *First Report and Order*, ET Docket No. 98-237, FCC 00-363 adopted October 12, 2000, and released October 23, 2000. The full text of this Commission decision is available for inspection and copying during normal business hours in the FCC Reference Information Center, Room CY-A257, 445 12th Street, SW., Washington, DC, and also may be purchased from the Commission's duplication contractor, International